

IN THE MATTER OF AN OPPOSITION by United Parcel Service
of America, Inc. to application No. 547,431 for the trade-mark UP
filed Executive Transports S.A.

On August 9, 1985, the applicant, Executive Transports S.A., filed an application to register the trade-mark UP based upon use and registration of the trade-mark in France in association with "vehicles, namely: airplanes, helicopters" and in association with the following services:

"Transportation and storage services, namely, transportation services for business, tourism and entertainment, namely, airplane and helicopter transportation services; furniture removal; operation of transporter bridges; towing of ships, unloading, heaving off of ships; packaging of goods; information on travelling (tourism and travel agencies, reservation of seats); renting of horses, of transport vehicles; warehousing; storing of goods in a warehouse for the purpose of their safekeeping or guarding; safety deposit, guarding of clothes; garages for vehicles; renting of refrigerators; renting of garages."

"Hotels, restaurants; rest homes and convalescent homes; day nurseries; escort services, beauty and hair dressing salons; reservation of hotel rooms for travellers, travel organizations and touristic tours; professional engineering consultations and services; prospecting, drilling; material testing laboratory services; renting of material for farming, of clothing, of bedding, or vending machines."

During the prosecution of its application, the applicant submitted an amended application which was accepted by the Trade-marks Office in which the applicant omitted to include "in France" in respect of its Section 16(2) claim to registration. At the oral hearing, the agent for the applicant submitted that this omission was merely a clerical error in the amended application and, subsequent to the oral hearing, the applicant filed an amended application which was accepted by the Opposition Board in which the applicant included the claim to use of the trade-mark UP in France. Further, the advertisement of the present application in the Trade-marks Journal indicated that the application was based on both use and registration in France. Accordingly, I am prepared to consider that the applicant's claim to use abroad remains as was claimed in the application as filed, namely, use in France and that the amendment deleting "in France" was clerical in nature.

The opponent, United Parcel Service of America, Inc., filed a statement of opposition on April 3, 1987 and was subsequently granted leave on two occasions during the course of the opposition to amend its statement of opposition pursuant to Rule 42 of the Trade-marks Regulations. In its amended statement of opposition, the opponent alleged that the applicant's application is not in compliance with section 29(d) (now section 30(d)) of the Trade-marks Act in that, as of the filing date, the applicant had not used its trade-mark in France. Further, the opponent alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior use and prior making known in Canada by the opponent of the registered trade-marks UPS & Design, registration No. 144,919 and UPS, registration No. 242,333. The applicant also challenged the applicant's entitlement to

registration and distinctiveness of the applicant's trade-mark in view of the prior use and prior making known in Canada by the opponent of the trade-name United Parcel Service.

The applicant served and filed a counterstatement, and subsequently was granted leave to file an amended counterstatement, in which it denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavits of David D. Taylor, Robert N. Parke, Aletta Radonicich, Glendon C. Smith and Robert E. Smith. The applicant filed as its evidence the affidavit of Frank Haigh.

With respect to the evidence filed by the parties, I would note that the jurat in the Parke affidavit is incomplete in that it fails to include the month of execution of the affidavit. However, no objection was raised by the applicant to this matter and I am therefore prepared to overlook this technical deficiency in the jurat of the Parke affidavit. The Haigh affidavit is replete with hearsay evidence and I am therefore not prepared to accord much weight to it in this proceeding.

The opponent alone filed a written argument while both parties were represented at an oral hearing. At the oral hearing, the opponent withdrew its grounds of opposition based on prior use and prior making known of its trade-name UNITED PARCEL SERVICE.

In its amended application filed subsequent to the oral hearing, the applicant deleted the wares from its application and restricted its statement of services to "helicopter services for tourists". While the opponent objected to the late filing by the applicant of its amended application, the opponent was advised by the Opposition Board that the amendment sought by the applicant did not offend the provisions of Rules 36 or 37 of the Trade-marks Regulations and was therefore accepted by the Board.

The opponent's first ground of opposition is based on section 30(d) of the Act, the opponent alleging that the applicant "at the date of filing of the application, had not used the trade mark in France". With respect to this ground, there is an evidential burden on the opponent to furnish some evidence in respect of its allegation that the applicant has not used its trade-mark in France. Further, the material date in respect of the section 30(d) ground is as of the filing date of the applicant's application. As the applicant's application included a claim to use of the trade-mark in France in the original application as filed and in its amended application filed subsequent to the oral hearing, and as no evidence has been adduced by the opponent in respect of its allegation that the trade-mark UP

had not been used in France prior to applicant's filing date, I have rejected the first ground of opposition.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark UP and the opponent's registered trade-marks UPS and UPS & Design. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue. With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date is as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, F.C.A. No. A-263-89, dated June 24,1991, yet unreported).

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's UPS trade-mark does not possess much inherent distinctiveness in that it comprises initials or letters which, per se, add little inherent distinctiveness to a trade-mark. However, the design features associated with the opponent's UPS & Design mark do add some measure of inherent distinctiveness to that mark. To the extent that the applicant's trade-mark would, as a matter of first impression, be perceived by the average Canadian as comprising the word "up", the applicant's trade-mark is inherently distinctive. On the other hand, the opponent submitted that, depending on the manner of its use, the applicant's mark might also be perceived as comprising the letter U and P and not the word "up", in which case the applicant's mark would be considered a weak mark possessing little inherent distinctiveness. I am uncertain as to the manner in which the public would perceive the applicant's word trade-mark UP. However, I would note that the legal burden is upon the applicant in respect of the issue of confusion which would include the burden of establishing the manner in which its mark would be identified by the average Canadian consumer and no admissible evidence has been adduced in this regard.

At the oral hearing, the agent for the applicant conceded that the opponent's trade-mark UPS was well known in Canada. On the other hand, the applicant failed to file any evidence relating to use or making known of its trade-mark UP in Canada. Accordingly, the applicant's trade mark must be assumed to have not become known to any extent in this country. Likewise, the length of time that the trade-marks have been in use favours the opponent in this opposition.

Both of the opponent's registrations cover services identified as "transportation of personal property for hire by diverse modes of transportation". Additionally, the opponent's registration for the trade-mark UPS & Design covers "motor vehicle delivery service for retail stores". The opponent has not, however, relied upon use of either of its trade-marks in association with any services beyond those covered in its two registrations in challenging either the applicant's entitlement to registration or the distinctiveness of the applicant's trade-mark. The applicant's helicopter services for tourists would appear to be similar to the opponent's services which contemplate the transporting of personal property by differing modes of transportation which could include the transporting of personal property by helicopter. Thus, there would appear to be a potential overlapping in the services of the parties and therefore in the channels of trade associated with these services. In this regard, I would note that the opponent's evidence establishes that two companies which operate passenger transportation systems in Canada also operate a package transportation system in this country.

As for the degree of resemblance between the trade-marks at issue, I consider there to be a fair degree of similarity in appearance between the trade-marks UP and the opponent's registered trade-mark UPS although the degree of similarity is less in the case of the applicant's mark and the opponent's trade-mark UPS & Design in view of the design features associated with the opponent's registered trade-mark. On the other hand, the applicant's trade-mark UP and the opponent's UPS and UPS & Design trade-marks are somewhat similar in sounding, to the extent that the applicant's mark might, as a matter of immediate impression, be identified by the average Canadian by reference to the letter U and P rather than by referring to it as the word "up". Apart from the possibility that the applicant's trade-mark UP and the opponent's UPS marks would be identified as being marks comprising initials, I do not consider that the trade-marks at issue suggest any ideas in common.

In view of the above, I have concluded that the applicant has failed to discharge the burden upon it with respect of the issue of confusion. As a result, the applicant's trade-mark UP is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF OCTOBER 1991.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.