

IN THE MATTER OF AN OPPOSITION filed by Siebe North, Inc.
to application No. 635,560 for the trade-mark COMFIT filed by
Philip Shum carrying on business as Allied Pioneer Supply

On June 30, 1989, Philip Shum carrying on business as Allied Pioneer Supply filed an application to register the trade-mark COMFIT based upon proposed use of the trade-mark in Canada in association with "latex examination gloves".

The opponent, Siebe North, Inc., filed a statement of opposition on August 7, 1990 in which it alleged that the applicant's trade-mark COMFIT is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant's trade-mark is confusing with its registered trade-mark COM-FIT, registration No. 318,233, which had been previously used and made known in Canada.

The applicant filed a counter statement in which he denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Maureen Singh which introduces into evidence a photocopy of the certificate of registration for the opponent's trade-mark COM-FIT, registration No. 318,233, covering "ear plugs". The applicant submitted as his evidence an affidavit of Philip Shum. As evidence in reply, the opponent filed the affidavit of Marjorie Shearn.

Both parties submitted written arguments while the opponent alone was represented at an oral hearing.

As its second ground of opposition, the opponent has alleged that the applicant is not the person entitled to registration in view of its prior use of the trade-mark COM-FIT in Canada. Under Sections 16(5) and 17(1) of the Trade-marks Act, there is a burden on the opponent to establish its alleged use and making known of its trade-mark in Canada prior to the applicant's filing date, as well as non-abandonment of the trade-marks in this country as of the date of advertisement of the applicant's application in the Trade-mark Journal (March 14, 1990). However, no evidence of use or making known of its trade-mark COM-FIT in Canada has been filed by the opponent. As a result, the opponent has failed to meet the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act. I have therefore rejected the Section 16(3)(a) ground of opposition.

The third ground of opposition is based on the alleged non-distinctiveness of the applicant's trade-mark. While the legal burden is on the applicant to establish that his trade-mark is distinctive,

there is an initial evidential burden on the opponent to establish the facts being relied upon by it in support of this ground. As no evidence has been adduced by the opponent in respect of the alleged non-distinctiveness of the applicant's trade-mark, the opponent has failed to meet the evidential burden upon it with respect to this ground of opposition which I have therefore dismissed.

The only remaining ground of opposition is that based on Section 12(1)(d) of the Trade-marks Act, the opponent alleging that the applicant's trade-mark COMFIT is not registrable in that it is confusing with the opponent's registered trade-mark COM-FIT. The material date with respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act would appear to be the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538 (TMOB)). Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark COMFIT and the registered trade-mark COM-FIT, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the Trade-marks Act. As well, 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 as of the date of my decision.

With respect to the inherent distinctiveness (ss. 6(5)(a)) of the trade-marks at issue, both the applicant's trade-mark COMFIT and the opponent's registered trade-mark COM-FIT as applied to the respective wares of the parties possess some measure of inherent distinctiveness although both marks suggest that the respective wares of the parties provide the user with a comfortable fit.

The extent to which the trade-marks at issue have become known (ss. 6(5)(a)) in Canada is not a relevant factor in this opposition. In particular, no evidence of use of its trade-mark in Canada has been filed by the opponent and, while Mr. Shum in his affidavit does state that the applicant commenced using his trade-mark COM-FIT in this country in October 1989 and has provided a sample of the packaging in which his wares are distributed, no evidence relating to the volume or dollar value of sales of the applicant's COM-FIT latex examination gloves has been provided by Mr. Shum in his affidavit from which I could conclude that the applicant's mark has become known to any measurable extent in Canada.

The length of use (ss. 6(5)(b)) of the trade-marks at issue weighs in the applicant's favour in this opposition in that Mr. Shum's affidavit points to the applicant's use of his use of his trade-mark

COM-FIT in Canada since October of 1989.

As for the wares (ss. 6(5)(c)) of the parties and their respective channels of trade (ss. 6(5)(d)), the applicant's latex examination gloves differ from the opponent's ear plugs although the wares of both parties are used for purposes of safety in the marketplace. Additionally, the Shearn affidavit, which has not been challenged or contradicted by the applicant, establishes that both ear plugs and latex examination gloves can be purchased through the same retail outlet in Canada.

The applicant has argued that its latex gloves are sold to dental offices and may, in the future, be sold to hospitals and laboratories. However, the statement of wares set forth in the applicant's application determines the scope of the monopoly which will be accorded the applicant should his application proceed to registration. As a result, the scope of the applicant's trade must be assessed by reference to the applicant's statement of wares rather than being based on the applicant's actual trade to date (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pages 10-12). As the applicant's statement of wares contains no restriction as to the channels of trade associated with its latex examination gloves, I must presume that the applicant is seeking protection for its trade-mark for all normal channels of trade associated with such wares, which would include their sale through safety supply outlets. Accordingly, the channels of trade associated with the wares covered in the applicant's application and the opponent's registration could overlap.

With respect to the degree of resemblance between the trade-marks at issue (ss. 6(5)(e)), the marks COMFIT and COM-FIT are very similar in appearance and are identical in sounding and in the ideas suggested by them.

As a further surrounding circumstance, the opponent relied upon the existence of registrations for the trade-marks COMFITS, registration No. 240,272, and COMFITTS, registration No. 302,601 with the view to establishing that the opponent's registration should only be entitled to a narrow ambit of protection. However, both registrations cover wares which differ from the wares of the parties and no evidence has been furnished by the applicant to establish that either of these trade-marks have been used in Canada. Accordingly, little weight can be accorded this evidence.

In view of the above, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark COMFIT as applied to latex examination gloves and the opponent's registered trade-mark COM-FIT as applied to ear plugs. As a result, the applicant's trade-mark 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 30th DAY OF June, 1993.

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