

IN THE MATTER OF AN OPPOSITION by Les Caoutchoucs Acton Ltée to application No. 525,551 for the trade-mark VULCAN filed by Vinaflex Canada Ltd., and presently standing in the name of Chamberlain Phipps Canada Limited

On July 18, 1984, the applicant, Vinaflex Canada Ltd., filed an application to register the trade-mark VULCAN based upon proposed use of the trade-mark in Canada in association with "protective footwear and waterproof footwear, namely, boots shoes and sandals".

The opponent, Les Caoutchoucs Acton Ltée, filed a statement of opposition on September 9, 1985 and subsequently was granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition. In its amended statement of opposition, the opponent alleged that the applicant's application is not in compliance with Section 29 (now Section 30) of the Trade-marks Act in that the applicant could not have been satisfied that it was entitled to use the trade-mark VULCAN in Canada in association with the wares covered in the applicant's application in that the applicant was aware of the use in Canada by the opponent of the trade-mark VULCAN. Also, the opponent claimed that, as of the filing date of its application, the applicant had already used the trade-mark VULCAN in Canada in association with the wares covered in the application and, in the alternative, that the applicant did not have the intention of using the trade-mark VULCAN in Canada. The opponent further alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark VULCAN was confusing with the opponent's trade-mark VULCAN which had been previously used and previously made known in Canada by the opponent in association with safety boots since 1967. As well, the opponent asserted that the applicant is not the person entitled to registration of the trade-mark VULCAN in Canada in that the applicant's application is not in compliance with Section 29 (now Section 30) of the Trade-marks Act. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement, and subsequently a revised counter statement in response to the amended statement of opposition, in which it denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavit of Raymond B. Lamarche while the applicant submitted as its evidence the affidavit of Peter Hubner.

During the opposition proceeding, the applicant submitted evidence of a change of name, such that the application now stands in the name of Chamberlain Phipps Canada Limited as

applicant.

Both parties submitted written argument and the opponent alone was represented at an oral hearing.

With respect to its Section 30 grounds of opposition, there is an evidential burden on the opponent to establish the facts being relied upon by it in respect of these grounds. As no evidence has been adduced by the opponent which would support any of the Section 30 grounds of opposition, they have been rejected. Likewise, I have rejected the opponent's ground relating to the applicant's alleged non-entitlement to registration based on the applicant's application not being in compliance with Section 30 of the Trade-marks Act.

The opponent also challenged the applicant's entitlement to registration in view of the prior use and prior making known in Canada by the opponent of its trade-mark VULCAN in association with safety boots. With respect to this ground of opposition, there is a burden on the opponent in view of Sections 16(5) and 17(1) of the Trade-marks Act to establish its prior use (and/or prior making known) of the trade-mark VULCAN in Canada in association with safety boots, as well as non-abandonment of the trade-mark in this country as of the date of advertisement for opposition purposes of the applicant's application in the Trade-marks Journal (August 7, 1985).

With respect to the burden upon it, the opponent has submitted the affidavit of Raymond B. Lamarche, Vice-President and Director General of the opponent. The Lamarche affidavit establishes that the opponent manufactures safety boots which are sold to retailers or other purchasers by Alfred Lambert Inc. (or Alfred Lambert (1985) Inc.). The exhibits annexed to the Lamarche affidavit establish that the trade-mark VULCAN appears on the invoices and in the price lists which are sent to the customers of Alfred Lambert Inc. and that both the invoices and the price lists only bear the name of Alfred Lambert Inc. The evidence also establishes that catalogues which include reference to VULCAN safety boots are distributed to the public and, in certain years (Exhibits 1-C and 1-D), the catalogues identify Alfred Lambert Inc. as distributor and the opponent as manufacturer of the wares identified in the catalogues. In this regard, Exhibit 1-A appears to be a catalogue for 1985 and therefore subsequent to the material date (July, 18, 1984) in respect of the Section 16 ground of opposition while Exhibit 1-B includes reference on the last two pages of the catalogue to "PAR-BY ACTON" which has not been established by the opponent as being recognized by potential purchasers of the opponent's wares as referring to the opponent and cannot therefore be considered as identifying the trade-mark VULCAN as the opponent's trade-mark.

The issue in my opinion is whether the distribution of those catalogues which identify the opponent as manufacturer and Alfred Lambert Inc. as the opponent's distributor has been such that the average purchaser of footwear sold by Alfred Lambert Inc. would recognize that the trade-mark VULCAN distinguishes footwear manufactured by Les Caoutchoucs Acton Ltée. as opposed to solely distinguishing footwear sold or distributed by Alfred Lambert Inc.

In the absence of any reference to the opponent in the invoices or on the packaging or labelling associated with the safety boots distributed by Alfred Lambert Inc., any other evidence which identifies the opponent as a manufacturer of footwear must clearly indicate to potential purchasers of those wares that the opponent is, in fact, the source of the wares and that the trade-mark VULCAN is its trade-mark. As the opponent has failed to establish that such is the case, I have rejected the opponent's Section 16 ground of opposition.

The opponent's final ground of opposition relates to the alleged non-distinctiveness of the applicant's trade-mark. However, in challenging the distinctiveness of the applicant's mark, the opponent in its amended statement of opposition has alleged that the trade-mark is not distinctive of the wares of the applicant and is not capable of distinguishing the applicant's wares "de l'opposante ACTON ou de ses marchandises et que, par ailleurs, LA MARQUE créait de la confusion, tel que ci-haut décrit, avec la marque de commerce "VULCAN" de l'opposante ACTON". As the opponent's evidence fails to establish that purchasers of the wares of the parties would recognize the trade-mark VULCAN as being a trade-mark of the opponent (as opposed to Alfred Lambert Inc.) and as the opponent in respect of its amended statement of opposition has not relied upon any activities of Alfred Lambert Inc. in challenging the distinctiveness of the applicant's trade-mark, I have no alternative but to reject the opponent's final ground of opposition.

Having rejected each of the opponent's grounds of opposition, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29<sup>th</sup> DAY OF JUNE 1990.

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