

IN THE MATTER OF AN OPPOSITION  
by Rentalex Limited to applica-  
tion No. 629,175 for the trade-  
mark THE PARTY WORKS filed by  
Leslie Sales Corp.

On April 10, 1989, the applicant, Leslie Sales Corp., filed an application to register the trade-mark THE PARTY WORKS based on use in Canada since April 2, 1988 with the following wares:

balloon arrangements, tableware: namely,  
disposable cups, cutlery, napkins, plates

and with the following services:

providing consulting services, decorating  
facilities and party supplies in relation  
to group gatherings.

The application as filed contained a disclaimer to the word PARTY. The application was advertised for opposition purposes on October 11, 1989.

The opponent, Rentalex Limited, filed a statement of opposition on November 1, 1989, a copy of which was forwarded to the applicant on November 22, 1989. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark PARTY WORLD registered under No. 349,954 for the following services:

operation of a business dealing in party and  
banquet supplies, equipment and accessories.

The applicant filed and served a counter statement. The opponent filed the affidavit of Jeff La Morre as its evidence. However, the applicant objected that proper service of the affidavit was not effected. The opponent took no steps to remedy the matter and consequently, by letter dated March 18, 1991, the Chairman of the Trade Marks Opposition Board ruled that the opponent had not timely complied with Rule 43 of the Trade-marks Regulations. Consequently, I have given no consideration to the La Morre affidavit in this proceeding.

As its evidence, the applicant filed the affidavit of Carl Wickens. Both parties filed a written argument but no oral hearing was conducted.

As for the ground of opposition based on Section 12(1)(d) of the Act, the opponent has not evidenced its trade-mark registration. However, in accordance with the opposition decision in Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at 411, I have checked the trade-marks register and confirmed that registration No. 349,954 is on the register.

The material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks of both parties are inherently distinctive although neither mark is inherently strong. Both marks are suggestive of wares and services related to parties. Both the present application and the opponent's registration contain a disclaimer to the word PARTY.

Neither party has evidenced any use of its mark. Thus, I must conclude that neither mark has become known in Canada. The length of time the marks have been in use in Canada is not a material circumstance in the present case.

The services of the parties appear to be the same, namely, the provision of party supplies. The applicant's wares appear to be of the type that one would expect to be sold, leased or provided through the opponent's business. Thus, the trades of the parties would appear to be very similar, if not identical. It should be noted that it is the applicant's statement of wares and services and the statement of services in the opponent's registration that govern the assessment of the circumstances listed in Sections 6(5)(c) and 6(5)(d) of the Act: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.).

The marks of the parties bear a fairly high degree of resemblance in all respects. Both marks include the word PARTY followed by a five letter word commencing with the letters WOR. The applicant's mark commences with the non-distinctive word THE. Both marks suggest the same idea, namely, a business (i.e. - a "world" or a "works") that provides wares or services for parties.

The applicant submitted in its written argument that when the word PARTY is eliminated from both marks, the comparison between the two marks is between the words THE WORKS and WORLD. However, that is an incorrect characterization of the test for confusion. Notwithstanding that the word PARTY is not distinctive in the context of the two marks at issue, those marks are still to be considered in their entirety rather than dissected into their individual components.

The applicant also contended that the Wickens affidavit establishes that the state of the trade-marks register reveals that the word WORLD is weak and that consequently the opponent's mark PARTY WORLD is not entitled to a broad ambit of protection. However, the alleged search results listed in paragraph 4 of Mr. Wickens' affidavit cannot be given any significant weight. First, Mr. Wickens did not conduct the search and he did not indicate who did. Second, he did not indicate when the search was carried out or how it was conducted. Third, he did not provide copies of the registrations referred to. Fourth, he provided incomplete particulars of the registrations referred to, Mr. Wickens having listed only the registration numbers and the trade-marks.

Even if I could assume that the search results are reliable, the most that I could conclude is that a number of traders have adopted the word WORLD as a component of various trade-marks in association with undisclosed wares and services. However, there is nothing to indicate that anyone other than the opponent has adopted such a trade-mark in the party supplies trade. Thus, even if paragraph 4 of the Wickens affidavit could be considered

to be reliable, it would add little to the issue at hand.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the overlap in the wares, services and trades of the parties and the presence of a fair degree of resemblance between the marks at issue, I am left in a state of doubt respecting the issue of confusion. Since the onus or legal burden is on the applicant to show no reasonable likelihood of confusion, I must resolve that doubt against the applicant. Consequently, the ground of opposition based on Section 12(1)(d) of the Act is successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 23rd DAY OF December, 1992.

David J. Martin,  
Member,  
Trade Marks Opposition Board.