COLLEGIATE filed Miller Harness Company, Inc.

On December 17, 1990, Miller Harness Company, Inc. filed an application to register the trade-mark COLLEGIATE based upon use of the trade-mark in Canada since at least as early as April 1987 in association with:

> "SADDLERY EQUIPMENT FOR HORSES, NAMELY, SADDLES, GIRTHS, STIRRUP LEATHERS, BRIDLES AND PARTS THEREOF; MARTINGALES, CRIBBING STRAPS AND PROTECTIVE BOOTS FOR HORSES".

The applicant's application was advertised for opposition purposes in the Trade-marks Journal of August 7, 1991 and Sports Experts Inc. filed a statement of opposition on September 6, 1991 in which it alleged the following grounds of opposition:

> (a) The applicant's application does not comply with Section 30 of the ***Trade-marks Act*** in that:
> (i) the applicant has not used the trade-mark in association with the wares identified in the application;
> (ii) the applicant has abandoned its trade-mark either in whole or in part;
> (iii) it is false that the applicant has said that it is satisfied that it is entitled to use the mark in Canada;
>
> (b) The applicant's trade-mark is not registrable in view of the provisions of subsection 12(1)(d) of the ***Trade-marks Act*** in that the applicant's trade-mark is confusing with the following registered trade-marks of the opponent:

Trade-mark	***Registration No.***
COLLEGIATE SPORTS	324,164
	285,190
	285,236
COLLEGIATE TEAM SPORTS	294,154

> (c) The applicant is not the person entitled to registration of the trade-mark in that, as of the claimed date of first use, the applicant's trade-mark was confusing with one or more of the trade-marks COLLEGIATE SPORTS, registration No.324,164; COLLEGIATE SPORTSWORLD & Design, registration No. 285,190;

COLLEGIATE SPORTSWORLD & Design, registration No. 285,236; and COLLEGIATE TEAM SPORTS, registration No. 294,154 previously used and made known in Canada by the opponent or its predecessors-in-title in association with the services of the operation of a retail business offering sports equipment, contrary to Section 16(1)(a) of the Act;

(d) The applicant's trade-mark is not distinctive in that the trade-mark COLLEGIATE is confusing with the trade-marks noted above which had previously been adopted, used, made known and registered by the opponent. Further, as a result of a transfer, there existed rights to use the trade-mark COLLEGIATE in two or more persons and these rights were exercised concurrently by these persons, contrary to Section 48 of the Act. Finally, the opponent alleged that the applicant has permitted third parties to use the trade-mark in Canada outside the legislative provisions regulating the permitted use of trade-marks, contrary to Section 50 of the ***Trade-marks Act.***

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Paul Pinsonnault who was cross-examined on his affidavit, the transcript of the cross-examination forming part of the opposition record. The applicant filed as its evidence the affidavit of Paul Morgan. Both parties submitted written arguments and both parties were represented at an oral hearing.

The opponent's first ground of opposition is based on Section 30 of the ***Trade-marks Act.*** While the legal burden is upon the applicant to show that its application complies with Section 30 of the Act, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. No evidence has been adduced by the opponent in relation to its Section 30 grounds, nor have any of the statements made by Mr. Morgan in his affidavit been challenged by cross-examination or contradicted by way of admissible evidence from the opponent. Further, with respect to the Section 30(i) ground, and even had the applicant been aware of the opponent's trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark COLLEGIATE in Canada on the basis *inter alia* that its mark is not confusing with the trade-marks COLLEGIATE SPORTS, COLLEGIATE SPORTSWORLD & Design, COLLEGIATE SPORTSWORLD & Design, and COLLEGIATE TEAM SPORTS. Thus, the success of the Section 30(i) ground is

contingent upon a finding that the trade-marks at issue are confusing [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at pg. 195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R. (2d) 152, at pg. 155]. I have therefore dismissed the Section 30 grounds of opposition.

The second ground of opposition is based on Section 12(1)(d) of the ***Trade-marks Act***, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark COLLEGIATE and one, or more, of the registered trade-marks identified in the statement of opposition. With respect to a ground of opposition based on Section 12(1)(d) of the ***Trade-marks Act***, the material date is the date of my decision [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (FCA)]. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the ***Trade-marks Act***, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark COLLEGIATE as applied to the wares covered in the present application is inherently distinctive. Further, the opponent's registered trade-marks COLLEGIATE SPORTS, COLLEGIATE SPORTSWORLD & Design, COLLEGIATE SPORTSWORLD & Design, and COLLEGIATE TEAM SPORTS as applied to the services covered in the opponent's registrations are inherently distinctive when considered in their entireties even though the words SPORTS, TEAM SPORTS, and SPORTSWORLD are descriptive when applied to the operation of retail outlets selling sporting goods and sports equipment.

The Morgan affidavit establishes that the applicant's trade-mark COLLEGIATE has become known to some extent in Canada in association with equestrian products. In particular, Mr. Morgan, the General Manager of the applicant, attests to in excess of $889,000 in sales of COLLEGIATE

equestrian products in Canada from 1990 to June of 1993 inclusive, as well as promotional activities in Canada associated with the COLLEGIATE mark. Furthermore, according to Mr. Morgan, the applicant has sold COLLEGIATE equestrian equipment in Canada since 1987.

The opponent's evidence comprises the affidavit of Paul Pinsonnault, legal counsel and assistant secretary of the opponent for two years prior to the date of his affidavit. The applicant raised a number of objections to the sales figures and advertising and promotional figures set forth in the Pinsonnault affidavit in that the affiant was not involved in the preparation of these figures. For example, from pages 21-22 of the transcript of the Pinsonnault cross-examination, the following questions were asked and responses given :

> Dans votre Affidavit vous mentionnez, vous affirmez que le chiffre d'affaires en 1986 était de trente-six millions neuf cent onze mille soixante-seize dollars (36 911 076.00 $)?
>
> C'est exact.
>
> Comment avez-vous déterminé que le chiffre d'affaires en 1986 était de trente-six millions neuf cent mille soixante-seize dollars (36 900 076.00 $)?
>
> J'ai consulté des documents préparés à l'enterne afin d'être en mesure de pouvoir mentionner ces chiffres-là.
>
> Est-ce que vous pouvez me dire exactement quel dossier
> vous avez consulté?
>
> J'ai fait, j'ai placé une commande auprès de notre directeur de la comptabilité des magasins corporatifs, qui lui m'a fourni ces renseignements-là.

Having regard to the above and to other portions of the transcript of the Pinsonnault cross-examination in respect of the sales figures for other years, it is apparent that Mr. Pinsonnault did not review any corporate records prior to preparing his affidavit nor did he submit as exhibits to his affidavit extracts from the corporate records which would have supported the figures provided by him in his affidavit. Rather, the affiant merely relied upon information provided to him by others

in the opponent corporation. As a result, I am not prepared to accord much weight to the sales and promotional figures set forth in the Pinsonnault affidavit [see ***Santa Maria Foods Ltd. v. Pietro Negroni S.p.A. (Now Pietro Negroni S.r.l.)***, 55 C.P.R. (3d) 110, at pg. 113].

The Pinsonnault affidavit establishes that, as of the date of his affidavit, more than twenty-five stores were in operation throughout the province of Ontario under the COLLEGIATE trade-mark. In this regard, I am mindful of the fact that Mr. Pinsonnault admitted on cross-examination that he erred in including in the list of COLLEGIATE outlets annexed as Exhibit A-5 to his affidavit a store which did not operate under the mark COLLEGIATE. However, the list of stores provided by Mr. Pinsonnault permitted the applicant to verify the accuracy of Mr. Pinsonnault's assertions concerning the number of stores operating under the COLLEGIATE marks. I am prepared, therefore, to accord weight to this evidence. The Pinsonnault affidavit also points to the opponent having used its trade-mark COLLEGIATE SPORTS in Canada since at least 1986.

In view of the above, both the extent to which the trade-marks at issue have become known and the length of use of the trade-marks weigh in the opponent's favour in this proceeding.

With respect to Sections 6(5)(c) and (d) of the ***Trade-marks Act***, regard must be had to the nature of the wares and services associated with the trade-marks at issue and the nature of the trade associated with the applicant's wares and opponent's services. The opponent's registration Nos. 324,164 and 348,146 cover the operation of a sporting goods store while registration Nos. 285,190, 285,236 and 294,154 cover the operation of retail outlets for sporting equipment, sporting goods, sportswear and casual clothing, and recreational and leisure equipment, supplies and accessories. These services differ from the applicant's 'saddlery equipment for horses, namely, saddles, girths, stirrup leathers, bridles and parts thereof; martingales, cribbing straps and protective boots for horses'. Furthermore, the applicant's wares differ from sporting goods and sports and leisure clothing which would be sold through retail outlets such as those operated by the opponent under its COLLEGIATE trade-marks.

The Morgan affidavit and the photocopies of the catalogues annexed thereto establish that

equestrian products are distributed to consumers of such wares through saddlery outlets, equestrian shops, tack shops and the like which bear no similarity to the opponent's retail sporting goods outlets. Moreover, the opponent's services are directed to the average consumer of sporting goods and sports and leisure clothing whereas the average consumer of the applicant's wares are those individuals who own or ride horses for pleasure and in competition. As a result, I do not consider there to be any potential overlap in the channels of trade associated with the wares and services of the parties.

As for the degree of resemblance between the trade-marks at issue, I consider the applicant's trade-mark COLLEGIATE to be very similar in appearance, sounding and ideas suggested to the opponent's trade-marks COLLEGIATE SPORTS, COLLEGIATE SPORTSWORLD & Design, COLLEGIATE SPORTSWORLD & Design, and COLLEGIATE TEAM SPORTS.

Considering the differences in the wares and services of the parties and their respective channels of trade, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark COLLEGIATE and any of the opponent's registered trade-marks. I have therefore rejected the Section 12(1)(d) ground of opposition.

As its third ground, the opponent alleged that, as of the claimed date of first use, the applicant's trade-mark was confusing with one or more of the trade-marks: COLLEGIATE SPORTS, registration No.324,164; COLLEGIATE SPORTSWORLD & Design, registration No. 285,190; COLLEGIATE SPORTSWORLD & Design, registration No. 285,236; and COLLEGIATE TEAM SPORTS, registration No. 294,154 previously used and made known in Canada by the opponent or its predecessors-in-title in association with the services of the operation of a retail business offering sports equipment. While the material date for determining this ground of opposition is as of April 30, 1987, the conclusions reached in assessing the likelihood of confusion in relation to the Section 12(1)(d) ground are likewise applicable in considering the issue of confusion in respect of the Section 16 ground. As a result, I have dismissed the Section 16 ground of opposition.

The final ground is that the applicant's trade-mark COLLEGIATE is not distinctive in that

the applicant's trade-mark COLLEGIATE is confusing with the opponent's trade-marks noted above which had previously been adopted, used, made known and registered by the opponent. Again, the conclusions in assessing the likelihood of confusion in respect of the Section 12(1)(d) ground are applicable even though the material date for considering the non-distinctiveness ground is as of the date of opposition. I have therefore rejected this aspect of the final ground.

The opponent also alleged that, as a result of a transfer, there existed rights to use the trade-mark COLLEGIATE in two or more persons and these rights were exercised concurrently by these persons. Additionally, the opponent alleged that the applicant permitted third parties to use the trade-mark COLLEGIATE in Canada outside the legislative provisions regulating the permitted use of trade-marks, contrary to Section 50 of the ***Trade-marks Act***. There is an evidential burden on the opponent to adduce evidence which would support the truth of these allegations. In the present case, no evidence has been furnished by the opponent in respect of either of these allegations and I have therefore dismissed the grounds of non-distinctiveness which are founded on these allegations.

Having rejected each of the opponent's grounds, I reject the opponent's opposition in view of the provisions of Section 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC, THIS 25th DAY OF MARCH,1996.

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