

IN THE MATTER OF AN OPPOSITION
by The Beaumaris Yacht Club to
application No. 552,999 for the
trade-mark B.Y.C. & Design
filed by Baik Yang Co., Ltd.

On November 21, 1985, the applicant, Baik Yang Co., Ltd., filed an application to register the trade-mark B.Y.C. & Design (illustrated below) for the following wares:

(1) children's clothing, namely jumpers, trousers, vests, polo shirts, blouses, undershirts, pants, shirts, uniforms (for exercise), sweaters, stockings, socks, hats, slippers, chemises, petticoats, corsets, brassieres, negligees, pajamas and night-gowns

(2) children's clothing, namely skirts, vests, blouses, polo shirts, panties, undershirts, chemises, slippers, corsets, brassieres, pajamas, bathing suits, negligees, uniforms (for exercise), hats, ornamental ribbons, buttons, socks and handkerchiefs.

The application is based on proposed use in Canada for the wares marked (1) and on use and registration (No. 133,866) in the Republic of Korea for the wares marked (2). The application claims priority on the basis of the corresponding Korean application and the effective filing date of the present application is therefore July 20, 1985. The application was advertised for opposition purposes on September 21, 1988.

The opponent, The Beaumaris Yacht Club, filed a statement of opposition on January 11, 1989, a copy of which was forwarded to the applicant on February 3, 1989. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to the provisions of Sections 16(2)(a) and 16(3)(a) of the Trade-marks Act because, as of the applicant's actual filing date and its convention priority filing date, the applied for trade-mark was confusing with the trade-marks BYC and BYC & Design (illustrated below) previously used by the opponent in association with the following wares:

crests, cups, medals, pins, golf balls, towels, hats, flags, burgees, shirts, sweatshirts, t-shirts, polo shirts and sweatpants.

The second ground is that the applied for trade-mark is not distinctive in view of opponent's use of its marks BYC and BYC & Design.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Patrick Kernohan and Thomas J. Hilliard Jr. The applicant did not file evidence. Both parties filed a written argument but no oral hearing was conducted.

As for the first ground of opposition, the opponent is required to evidence use of its trade-marks prior to the applicant's filing date and its convention filing date. The opponent's evidence fails to satisfy this requirement.

In his affidavit, Mr. Kernohan identifies himself as the General Manager of the opponent which he describes as a club which operates as a yacht club and a golf and country club. He has held that position only since August 4, 1989 although he and his family have been members of the club since about 1957. He states that the opponent has been selling "BYC clothing" since 1957. But since Mr. Kernohan only assumed his current position well after the material times, he does not have personal knowledge as an officer or employee of the opponent relating to the use of the mark BYC & Design prior to those dates.

Furthermore, in his capacity as the General Manager of the opponent, Mr. Kernohan is unable to provide sufficient physical evidence to show use of the mark BYC & Design prior to the material dates. He has appended a number of invoices to his affidavit relating to individual sales of clothing items but none of these relates to the period prior to the material times. He has also appended several invoices from the early 1970's but they cover sales of wares to the opponent from suppliers rather than sales from the opponent to consumers. Furthermore, it is not entirely clear those earlier invoices covered goods bearing either of the trade-marks relied on in this proceeding.

Although Mr. Kernohan provides approximate sales figures for 1988 and 1989, he is unable to provide any figures for earlier years. He does state that a Mr. Ken Reucassel informed him that annual sales of "BYC clothing" exceeded \$8,000 for the period 1983 to 1985. However, that statement is hearsay and cannot be given sufficient weight to satisfy the burden on the opponent to evidence use of at least one of its marks prior to the material times.

Mr. Kernohan also states that, from his personal recollection, he is aware that the opponent was selling clothing bearing the initials BYC going back to 1957. He also states that he has personal knowledge that sales of "BYC clothing" have been continuous and uninterrupted since 1957. However, he provides no information to support this contention. For example, he does not state that he made a purchase of any such items nor does he indicate that he witnessed any relevant sales transactions. In fact, he acknowledges that the opponent itself does not have records of such sales. In the absence of additional evidence, Mr. Kernohan's bare recollection does not constitute reliable evidence of sales by the opponent in association with the trade-mark BYC or BYC & Design.

In view of the above, I find that the opponent has failed to clearly evidence use of its marks BYC and BYC & Design prior to the applicant's filing date and its convention priority filing date. Consequently, the ground of prior entitlement is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition (January 11, 1989). As discussed above, the evidence of sales figures for the period 1983 to 1985 is hearsay and can be given little, if any, weight.

Mr. Kernohan attests to sales of "BYC clothing" totalling approximately \$18,000 for 1988. However, given Mr. Kernohan's admission about the state of the opponent's records, the accuracy of the 1988 total is open to question. Furthermore, from a reading of paragraph 8 of Mr. Kernohan's affidavit, it is not entirely clear that all of those sales related to clothing bearing one of the marks relied on by the opponent in this proceeding.

Photocopies of several invoices from 1987 are appended as exhibits to the Kernohan affidavit. The only "BYC clothing" items referred to on those invoices are t-shirts and shirts.

In summary, the Kernohan affidavit establishes that the opponent effected minor sales of clothing items bearing either the trade-mark BYC or BYC & Design in 1987 and 1988. Those limited sales would appear to have been primarily to club members and would appear to have been primarily for adult clothing in the nature of t-shirts, shirts and hats. Furthermore, it is evident that the appearance of either of the opponent's trade-marks on the clothing items functioned less as a trade-mark and more as a badge of club membership or affiliation.

The wares of the parties are similar in that they are all clothing items. However, the applicant's wares are all children's clothing whereas the opponent's wares comprise a few items of adult clothing for a specialized market - i.e. - members or friends of The Beaumaris Yacht Club. The opponent's manner of doing business is extremely limited since it is restricted to its pro shop. The applicant, on the other hand, would presumably sell its wares through clothing and department stores which carry children's clothing.

Given the extremely limited sales by the opponent and its very limited market, it is apparent that the opponent's marks had acquired an insignificant reputation, at best, within a limited area. Furthermore, those marks have functioned primarily as badges of membership rather than trade-marks. The wares of the parties are somewhat different and the trades are quite distinct. Thus, I consider that the applicant has satisfied the onus on it to show that its trade-mark is adapted to distinguish its wares from those of others throughout Canada. Thus, the second ground of opposition is also unsuccessful.

In view of the above, I reject the opponent's opposition.

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

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