

IN THE MATTER OF AN OPPOSITION
by The Gillette Company to
application No. 645,685 for the
trade-mark MARKER MATE filed by
Pro Caddy International Inc.

On November 23, 1989, the applicant, Pro Caddy International Inc., filed an application to register the trade-mark MARKER MATE based on proposed use in Canada with "erasers for use on whiteboard." The application was advertised for opposition purposes on August 22, 1990.

The opponent, The Gillette Company, filed a statement of opposition on September 21, 1990, a copy of which was forwarded to the applicant on October 22, 1990. 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 PAPER MATE registered under No. 112,769 for "writing instruments and ink."

The applicant filed and served a counter statement. As its evidence, the opponent filed two affidavits of Ross E. Murray. As its evidence, the applicant filed the affidavit of Victor Noel. Only the opponent filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, 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 trade-mark MARKER MATE when used with the applicant's wares suggests that the applicant's eraser is a companion or "mate" for a whiteboard marker. Thus, the applicant's mark is not inherently strong. There is no evidence that the applicant's mark has been used or advertised and I must therefore conclude that it has not become known at all in Canada.

The registered trade-mark PAPER MATE suggests that the opponent's writing instrument is a companion or "mate" for writing paper. Thus, the opponent's mark is also not inherently strong. However, the opponent has evidenced very extensive use and advertising of its mark throughout Canada for many years for various writing instruments including markers. Thus, I can conclude that the trade-mark PAPER MATE has become very well known in Canada.

The length of time the marks have been in use favors the opponent. The wares are not identical although they are related. The opponent's wares are writing instruments such as pens and markers. The applicant's wares are erasers to be used in conjunction with certain types of markers. Presumably, the wares of the parties would be sold through

the same type of retail outlets. The second Murray affidavit points to the potential for an even greater overlap in the channels of trades of the parties since Mr. Murray indicates that the opponent's Canadian subsidiary plans to market a marker for use on a whiteboard in association with the trade-mark PAPER MATE.

As for Section 6(5)(e) of the Act, I find there to be a fair degree of resemblance between the marks at issue in all respects. Both marks comprise two words with a total of three syllables. Both end with the word "mate" and both begin with a word ending in the letters "er." Both suggest a "mate" or companion for a writing medium (i.e. - paper) or a writing instrument (i.e. - a marker).

Although the applicant did not file a written argument, it would appear that it was seeking to rely on state of the register evidence introduced by the Noel affidavit to minimize the effect of the resemblance between the two marks at issue. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Initially, I would note that Mr. Noel merely states that he was advised that a "computer check" of the trade-marks register was conducted. It is clear that Mr. Noel did not conduct the search and he does not indicate who did. There is no evidence as to the parameters of the search. A photocopy of a printout supposedly obtained from that search lists what appear to be a number of registrations of trade-marks which include the word "mate" followed by an incomplete listing of associated wares. There is no indication as to who the owners of those marks are or the status of the registrations.

In view of the deficiencies in the alleged state of the register evidence, I can give little, if any, weight to it. Even if I could give some consideration to that evidence, I cannot assume it is reliable for the purpose for which it has been submitted. Mr. Noel states that the printout contains "...a number of writing instruments." By my count, only five entries cover writing instruments or pens and one is the opponent's registration No. 112,769. It may be that one or more of the remaining four entries are owned by the opponent or have been expunged. Even if none of them are, the mere existence of four relevant registrations on the register would not allow me to conclude that any of those marks has been used more than minimally.

Mr. Noel has also appended to his affidavit photocopies of pages from a stationer's catalogue illustrating products offered for sale in association with MATE-suffixed trade-marks. However, most of the items evidenced are unrelated to writing instruments and accessories. There is a series of four MATE-suffixed marks used for desk accessories on page 104 of the catalogue (all associated with a company identified as Esselte Pendaflex Canada Inc.) but there is no evidence of the extent of use of those marks. Thus, Mr.

Noel's evidence is of limited value in establishing that there has been common use of MATE-suffixed marks in the marketplace for wares similar to those at issue.

As an additional surrounding circumstance, I have considered the fairly substantial sales of pens by the opponent's Canadian subsidiary in association with the opponent's registered trade-mark ERASERMATE. Such sales establish that a number of Canadian consumers are familiar with two MATE-suffixed trade-marks of the opponent. This, in my view, increases the likelihood that consumers seeing an eraser for use on a whiteboard sold under the trade-mark MARKER MATE would assume that such an item came from the same source as the opponent's products.

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 resemblance between the wares, trades and marks of the parties, the extensive reputation associated with the opponent's registered trade-mark PAPER MATE and the reputation associated with the opponent's registered trade-mark ERASERMATE, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's registered mark PAPER MATE. The first ground of opposition is therefore 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 30th DAY OF November, 1993.

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