

**IN THE MATTER OF AN OPPOSITION
by Horn Abbot Ltd. to application No. 647,412
for the trade-mark PURSUITS filed by T. Eaton
Holdings Limited (now The T. Eaton Company Limited)**

On December 27, 1989, the applicant, T. Eaton Holdings Limited (now The T. Eaton Company Limited), filed an application to register the trade-mark PURSUITS based on proposed use in Canada. The application covers "womens' dresses, blazers, jackets, sweaters, t-shirts, blouses, skirts, pants and shorts" and was advertised for opposition purposes on July 11, 1990.

The opponent, Horn Abbot Ltd., filed a statement of opposition on November 9, 1990, a copy of which was forwarded to the applicant on November 27, 1990. The first ground of opposition is 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 TRIVIAL PURSUIT registered under No. 291,533 for various wares and services including the following wares:

(1) board game and equipment, namely playing board, die, rules of play, question and answer cards, card boxes, player tokens and scoring wedges sold both as a unit and separately for playing a board game (2) clothing, namely hats, socks, shoes, dresses, suits, skirts, trousers, baby clothes and shirts and jackets....

On December 9, 1994, the opponent's registration was amended pursuant to Section 45 of the Act to delete all of the wares and services except those listed above as (1).

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks TRIVIAL PURSUIT & Design (illustrated below) as set forth in the opponent's application No. 475,168 and TRIVIAL PURSUIT previously used in Canada "...in association with, inter alia, clothing." The third ground is that the applicant's mark is not distinctive because it is confusing with the opponent's marks.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its President, James G. Ware. The applicant filed the affidavits of John Dawkins, Carol Luciani and Susan Burkhardt. Both parties filed a written argument and leave was subsequently granted to the applicant to file a certified copy of the opponent's registration No. 291,533 reflecting the amendments effected pursuant to Section 45 of the Act. An oral hearing was conducted on November 7, 1995 at which both parties were represented.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act 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.

As for Section 6(5)(a) of the Act, the opponent's mark TRIVIAL PURSUIT is inherently distinctive although it is somewhat suggestive of a board game and the related paraphernalia. The Ware affidavit establishes that the opponent's mark has become very well known throughout Canada in association with a question and answer board game dealing with trivia.

The applicant's mark PURSUITS is inherently distinctive since it has no apparent suggestive or descriptive connotation in association with the applied for wares. The Dawkins

affidavit establishes that the applicant sold womens' clothing in association with its mark in the amount of approximately \$1 million between 1990 and 1992 but was not using the mark as of the date of Mr. Dawkins affidavit (i.e. - December 7, 1992). Thus, as of today's date, I can only assume that there is some minor residual reputation associated with the applicant's mark.

The length of time the marks have been in use favors the opponent. The opponent's registered wares are quite different in nature from the clothing items listed in the applicant's application. The opponent contends that there is, or was, a potential overlap between the trades of the parties. Mr. Ware states, in his affidavit, that the opponent's mark had been licensed to another company to be used with clothing items but he gives no indication as to the extent of any such use or, in fact, whether such use ever occurred. Thus, I cannot conclude that there was, or is, any similarity between the trades of the parties.

As for Section 6(5)(e) of the Act, there is a fairly high degree of resemblance between the marks of the parties in all respects. In fact, the applicant's mark is virtually identical to the second component of the opponent's mark.

The applicant has submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the Luciani affidavit. 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.

The Luciani affidavit evidences a dozen registrations for trade-marks incorporating the word "pursuit" for a wide variety of wares. In the absence of evidence that those marks are in use, I am only able to infer that a few of those registered marks are in active use. Thus, I

can only conclude to a very limited extent that consumers would be accustomed to seeing such marks in the marketplace. Given the wide disparity between the applicant's wares and the opponent's registered wares, the fact that a few traders are using similar marks for other wares decreases, to a limited extent, the likelihood of consumers mistaking any such marks. In any event, as conceded by the opponent's agent at the oral hearing, the opponent is not claiming broad protection for the word "pursuit" 'per se.'

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 differences between the wares and trades of the parties, I find that the marks at issue are not confusing notwithstanding the fact that the opponent's mark has become widely known in association with a board game. The first ground of opposition is therefore unsuccessful. If the opponent's registration had still covered clothing items, my finding might well have been different.

As for the second ground, it was incumbent on the opponent to evidence use of its two trade-marks prior to the applicant's filing date and it has done so in respect of a board game. However, the Ware affidavit does not clearly evidence use of either of those marks prior to the material time in association with clothing items. Mr. Ware states that the opponent licensed a company to use its marks for clothing and he appended as an exhibit to his affidavit a photograph of a T-shirt bearing the trade-mark TRIVIAL PURSUIT & Design which he states was produced by his company's licensee. But he does not state that any such goods were ever sold in Canada. The opponent has therefore failed to satisfy its burden to show prior use of its marks for clothing.

Thus, the second ground remains to be decided on the issue of confusion but only in relation to use of the opponent's trade-marks in association with a board game. The material time for considering the circumstances is as of the applicant's filing date. At that time, there was no reputation associated with the applicant's mark and the opponent's mark was, as it is now, very well known. Otherwise, my conclusions respecting the issue of confusion under the first ground are equally applicable under the ground of prior entitlement. The second ground

is therefore also unsuccessful. If the opponent had also included a ground of prior entitlement pursuant to Section 16(3)(b) of the Act based on its previously filed application to extend the statement of wares in its registration No. 272,481 for its trade-mark TRIVIAL PURSUIT & Design (application No. 475,168), such a ground might well have been successful because the opponent's extension application was still pending as of the applicant's advertisement date and it included clothing items identical to, or very similar to, those listed in the applicant's application.

As for the third ground of opposition, it turns on the issue of confusion between the applicant's mark and the opponent's marks as used with a board game. The material time for considering the circumstances respecting the issue of non-distinctiveness is the filing of the opposition. My conclusions respecting the issue of confusion for the second ground of opposition are generally applicable for the third ground as of that later date. Thus, the third ground of opposition is also unsuccessful.

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

DATED AT HULL, QUEBEC, THIS 22nd DAY OF NOVEMBER, 1995.

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