



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 230
Date of Decision: 2011-11-30

**IN THE MATTER OF AN OPPOSITION
by Pierce Arrow Society to application
No. 1,339,865 for the trade-mark
PIERCE-ARROW in the name of Olaf
vom Heu and IBBTG AG, a partnership
trading as Pierce-Arrow**

[1] On March 19, 2007, Olaf vom Heu and IBBTG AG, a partnership trading as Pierce-Arrow (the Applicant), filed an application to register the trade-mark PIERCE-ARROW (the Mark) based upon proposed use of the Mark in Canada. The statement of wares currently reads:

Vehicles, namely automobiles, motorcycles and bicycles.

[2] In response to a request from the Examination Section of the Trade-marks Office, the Applicant acknowledged that a registration issuing from the subject application shall be subject to Section 67 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), as regarding the following pre-April 1, 1949 Newfoundland trade-mark registrations: No. NFLD 1728 and NFLD 1636.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 16, 2008.

[4] On September 15, 2008, Pierce Arrow Society (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant's application does not conform to the requirements of s. 30(i) of the Act, the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a) and (c), and the Mark is not distinctive.

In view that this application is based on proposed use, I have proceeded on the assumption that the Opponent's non-entitlement grounds are based on s. 16(3)(a) and (c) as opposed to s. 16(1)(a) and (c). The non-entitlement and non-distinctiveness grounds are based on confusion with the Opponent's PIERCE ARROW trade-mark and trade-name, allegedly used in Canada by the Opponent since 1957 in association with the operation of an organization devoted to the preservation and maintenance of PIERCE ARROW automobiles, motorcycle, bicycles, trucks and Travelodge trailers.

[5] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[6] The Opponent's evidence consists of the affidavit of Ralph J. McKittrick, President of the Pierce Arrow Society, an Illinois non-profit corporation. The Applicant's evidence consists of the affidavit of Michelle Anderson, legal assistant with the solicitors for the Applicant, as well as certified copies of U.S. trade-mark registrations Nos. 1,185,514 (PIERCE and Design); 1,051,583 (PIERCE ARROW SOCIETY and Design); 3,110,904 (PIERCE ARROW); 1,058,801 (PIERCE ARROW SOCIETY); 2,625,651 (PIERCE ARROW FOUNDATION and Design); 705,872 (PIERCE ARROW and Design) and the file wrapper and contents of file wrapper application No. 75/827,149 (registration No. 2,625,651). The Opponent filed a second affidavit of Mr. McKittrick as its evidence in reply.

[7] Neither affiant was cross-examined. Only the Opponent filed a written argument. Neither party requested an oral hearing.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[9] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Preliminary Issue

[10] The Opponent has objected to certain parts of Ms. Anderson's evidence on the following two bases: 1) in view that Ms. Anderson is an employee of the Applicant's agent, her affidavit should not be admissible because it contains clearly contentious matters; and 2) the Anderson affidavit sets forth a number of arguments rather than evidentiary facts. In support of this position, the Opponent relies upon *Cross-Canada Auto Body Shop Supply (Windsor) Ltd. v. Hyundai Auto Canada* (2006), 53 C.P.R. (4th) 286 (F.C.A.).

[11] Ms. Anderson conducted various Internet searches to determine whether the Opponent's Canadian address as provided by Mr. McKittrick in his first affidavit was an active business address. She also made statements regarding estimates from Statistics Canada about the population of Canada and the extent of Canadian automobile production and sales. Further, she describes her experience browsing the Opponent's website and notes that she was unable to make any direct purchases through the Opponent's website.

[12] I agree with the Opponent that Ms. Anderson's evidence about the Opponent's website is contentious evidence which should not be introduced by an employee of a party's agent. I also agree that less weight should be given to those portions of the Anderson affidavit that contain argument as opposed to evidence. With respect to the admissibility of evidence from Statistics Canada, I have had regard to the following comment from Madame Justice Tremblay in *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 (F.C.T.D.) regarding the reliability of Internet evidence:

"With regard to the reliability of the Internet, I accept that in general, official web sites, which are developed and maintained by the organization itself, will provide more reliable information than unofficial web sites, which contain information about the organization but which are maintained by private persons or businesses.

In my opinion, official web sites of well-known organizations can provide reliable information that would be admissible as evidence, the same way the Court can rely on Carswell or C.C.C. for the publication of Court decisions without asking for a certified copy of what is published by the editor. For example, it is evident that the official web site of the Supreme Court of Canada will provide an accurate version of the decisions of the Court."

Applying this reasoning to the present case, I am prepared to consider the evidence from Statistics Canada to be reliable in view that it comes from what I consider to be an official website. I am therefore prepared to give full weight to this evidence.

[13] I also disagree with the Opponent that the Internet search portions of the Anderson affidavit are inadmissible. In considering this issue, I had regard to the following decision of Board Member Bradbury in *Canadian Jewellers Assn. v. American Gem Society* (2010), 86 C.P.R. (4th) 131:

" I disagree with the Applicant's position that the Internet search portions of the Cheng evidence are controversial.... I personally do not see that the concerns expressed by the Federal Court of Appeal in *Cross-Canada* legitimately apply here. I do not see how any self-interest of an agent employed by a party could be seen to bias these search results. It is quite apparent that the search was directed to see if anyone other than the Applicant has employed the phrase "certified gemologist" on Canadian websites. I do not see how the fact that this evidence was introduced by an employee of the Opponent's agent makes it less proper or open to suspicion than if the Opponent or its agent had hired an outside investigator to do and swear an affidavit. Either way, the Applicant could, if it desired, cross-examine the provider of such evidence to ask why they chose the search terms that they chose. In the present case, the answer seems self-evident. Overall, the evidence does not appear to me to be controversial. I also note that the Applicant could have, if it wished, provided its own Internet searches to rebut the Opponent's Internet searches.

[14] Similarly, in the present case, Ms. Anderson's searches to determine whether the Opponent's Canadian address may be an active business address is not evidence that is less proper than if the Applicant had hired an outside investigator to do so. In any event, Mr. McKittrick confirmed in his second affidavit that the address for the Opponent provided in his first affidavit was not the principal address of the Opponent.

[15] This evidence is therefore admissible, along with the remainder of Ms. Anderson's affidavit.

Section 30(i) Ground

[16] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] I note that the Applicant in the present case has made the requisite statement and there is no evidence that it did so in bad faith. I am therefore dismissing this ground of opposition.

Section 16(3) Grounds of Opposition

[17] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) on the basis that the Mark is confusing with the Opponent's PIERCE ARROW trade-mark which had been previously used in association with services related to the preservation and maintenance of PIERCE ARROW automobiles, motorcycle, bicycles, trucks and Travelodge trailers. Under its s. 16(3)(c) ground, the Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(c) on the basis that the Mark is confusing with the Opponent's PIERCE ARROW trade-name, previously used by the Opponent in association with the above noted services.

[18] With respect to these grounds of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark or trade-name prior to the Applicant's filing date and that it had not abandoned its mark or trade-name as of the date of advertisement of the Applicant's application [s. 16(5)]. Section 4(2) of the Act explains what is required in order for a mark to have been used in association with services:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[19] The Opponent must therefore provide assertions of fact and documentary evidence showing that the services were performed and how the PIERCE ARROW mark was displayed in association with the performance or advertising of the services.

[20] With respect to the Opponent's trade-name, however, there is no definition in the Act of what constitutes proper use of a trade-name. On this issue I refer to Madam Justice Simpson's comments in *Mr. Goodwrench Inc. v. General Motors Corp.*, (1994) 55 C.P.R. (3d) 508 wherein she stated:

“There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.”

[21] Therefore, the Opponent will have met its evidential burden in the present case if it has evidenced that, prior to March 19, 2007, it has used its trade-mark in Canada in the performance or advertising of its services, or its trade-name in the normal course of trade. I turn now to the Opponent's evidence to assess whether it has met its evidential burden.

[22] Mr. McKittrick identifies himself as President of The Pierce Arrow Society (the Society), an Illinois non-profit corporation. As previously noted, he confirms in his second affidavit that the current principal address of the Society is 1054 Ashmont Avenue, Oakland, California 94610-1261. He explains that the PIERCE ARROW automobile has a long history in Canada, commencing with the organization in 1931 of the Pierce Arrow Company of Canada, a subsidiary of The Pierce Arrow Motor Car Company headquartered in Buffalo, New York. The Pierce Arrow Company of Canada had a plant located in Walkerville, Ontario, that continued to operate as an assembly plant for PIERCE ARROW automobiles sold in Canada until 1935.

[23] He explains that the Society was founded in August of 1957 by R. Vale Faro, in order to form an international organization to foster and preserve interest in PIERCE ARROW vehicles and to provide technical, historical and aesthetic information to those who own or are interested

in these vehicles. The Society is a non-profit corporation that for over fifty years has been actively engaged, both in the United States and Canada, in the preservation of the heritage of and fostering interest in PIERCE ARROW automobiles, trucks, bicycles and motorcycles that were last produced in 1938.

[24] Mr. McKittrick states that as of January, 2009, the Society had almost 1,100 members in at least sixteen different countries. Canada has the largest number of members outside of the United States who, among them, own approximately 35-50 original or restored PIERCE ARROW vehicles. The Society has owned and operated a website at www.pierce-arrow.org since 1995.

[25] Part of the Society's activities consist of providing educational and entertainment services, including the operation of a museum devoted to specific classic or antique motor cars and related products and artifacts and offering educational seminars and workshops in furtherance of the appreciation of specific classic or antique motorcars and related products and artifacts. These services are provided under the service marks PIERCE ARROW SOCIETY and Design and PIERCE ARROW FOUNDATION and Design, shown below.



Mr. McKittrick maintains that these service marks have been in continuous use in both Canada and the U.S. since 1964 and 1998, respectively.

[26] The Society, together with the Pierce Arrow Foundation, support the Pierce Arrow Museum located in Kalamazoo, Michigan where approximately 8500 Canadians have visited since it opened in 1999. An illustration of a portion of the exhibit at the Pierce Arrow Museum is shown in his affidavit at paragraph 9.

[27] Each year, the Opponent hosts a four to five day Annual Meet in various part of the U.S. where many Canadian members of the Opponent and their spouses travel to attend and bring their PIERCE ARROW automobiles. There has also been an active trade relationship between a number of Canadian and U.S. vendors of PIERCE ARROW parts and accessories which also provide automotive restoration services to the Opponent's members. One of these Canadian vendors is Fawcett Motor Carriage Company Ltd. located in Toronto, Ontario. As of March, 2009, this company had six antique PIERCE ARROW automobiles in various stages of restoration. Fawcett Motor Carriage Co. (1981) located in Whitby, Ontario, has restored a number of PIERCE ARROW automobiles owned by the Opponent's members who live in both Canada and the U.S. and also services these automobiles on a regular basis.

[28] Having considered all of the Opponent's evidence, I am not satisfied that the Opponent has shown use of its mark in association with the "preservation and maintenance of PIERCE-ARROW automobiles, motorcycle, bicycles, trucks and Travelodge trailers" in Canada pursuant to s. 4(2) of the Act. The Opponent has not provided any examples of advertising, signage or telephone listings showing how its mark or name was displayed in association with the performance and advertising of its services in Canada. Further, the servicing of automobiles is not provided by the Opponent itself to its members but rather by "vendors" including Fawcett Motor Carriage Company Ltd. and Fawcett Motor Carriage Co. (1981). The Opponent has not explained how any use by these companies would have accrued to its benefit for the purposes of s. 50(1). Finally, the fact that the Opponent holds an annual Meet in the U.S. which some Canadian members attend, and supports The Pierce Arrow museum in the U.S. together with the Pierce Arrow Foundation, is not relevant to a determination of whether use has been shown in Canada pursuant to s.4 (2) of the Act.

[29] The s. 16(3)(a) and (c) grounds are therefore dismissed on the basis that the Opponent has not met its initial evidential burden.

Distinctiveness Ground of Opposition

[30] The Opponent's distinctiveness ground of opposition reads:

The alleged trade-mark PIERCE ARROW is not distinctive of the Applicant, and does not distinguish the proposed wares of the Applicant nor it is adapted so as to distinguish them, because of the Opponent's pre-existing use and reputation in the PIERCE – ARROW trade-mark and PIERCE-ARROW trade-name in Canada, and the extensive use and residual reputation in the PIERCE ARROW trade-mark as owned and used in Canada by The Pierce Arrow Motor Car Company.

[31] The legal onus is on the Applicant to show that its mark is adapted to distinguish or actually distinguishes its services from the services of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)]. However, there is an evidential burden on the Opponent to prove the allegations of fact supporting its ground of non-distinctiveness. While an opponent need not show that its trade-mark is well known in Canada in order to meet this evidential burden [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)], an opponent's mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient [*Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. It is noted that in *Bojangles*, the opponent had presented considerable evidence to show that many Canadians were familiar with its operations abroad (in that case the U.S.) but the Federal Court of Appeal nevertheless found that the opponent's evidence did not meet the initial onus re: distinctiveness.

[32] The material date with respect to distinctiveness is the date of filing of the opposition, September 15, 2008 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[33] Based on the evidence furnished, I am not prepared to accept that the Opponent has met its initial burden to show that its mark or name had acquired a reputation in Canada as of September 15, 2008, that was sufficient to affect the distinctiveness of the Mark. In this regard, this case is unique in that it regards a trade-mark and trade-name that have been used in association with automobiles in Canada in the 1930's, and the Opponent now alleges that the mark and name continue to be used in association with services related to the preservation and

maintenance of such automobiles which are now antique. The Opponent has not, however, established through evidence that its mark or name has a sufficient reputation among a significant section of the Canadian population. Instead, it appears that the Opponent's mark and name are only known among the select few Canadians who are members of the Opponent's society.

[34] In this regard, at best, the evidence shows that Canadian members of the Opponent's society own approximately 35-50 original or restored PIERCE ARROW vehicles and have such vehicles serviced occasionally, some Canadian members attend an annual Meet in the U.S., about 8500 Canadians have visited the PIERCE ARROW FOUNDATION exhibit at the Pierce Arrow Museum located in Kalamazoo Michigan since it opened in 1999, and the Opponent operates a website under the name www.pierce-arrow.org. It is not clear to me how this evidence shows that the Opponent's PIERCE ARROW trade-mark and trade-name have acquired reputation in Canada in association with services related to the preservation and maintenance of automobiles that is sufficient to negate the distinctiveness of the Mark. In my view, in order to have met its burden under this ground, the Opponent should have provided evidence showing that the services provided in association with its mark are known by a greater number of Canadians than the select few who own such antique vehicles or have visited the Opponent's museum in the U.S. As stated in paragraph 33 of *Bojangles*, "A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect."

In view that the Opponent has not met its burden under this ground, this ground of opposition is unsuccessful.

Disposition

[35] In view of the above, and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office