

IN THE MATTER OF AN OPPOSITION
by Mandarin Oriental Services B.V.
to application No. 639,812 for the
trade-mark MANDARIN HOME filed by
Home-Sweet-Home Publishing Inc.

On September 14, 1989, the applicant, Home-Sweet-Home Publishing Inc., filed an application to register the trade-mark MANDARIN HOME for "periodical publications, namely magazines" based on use in Canada since June, 1989. The application was advertised for opposition purposes on May 23, 1990.

The opponent, Mandarin Oriental Services B.V., filed a statement of opposition on July 31, 1990, a copy of which was forwarded to the applicant on August 23, 1990. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's date of first use, the applied for mark was confusing with the opponent's trade-mark MANDARIN ORIENTAL for which an application had previously been filed (on November 17, 1988) for a number of wares and services including "magazines." The second ground is that the application does not comply with the provisions of Section 30(b) of the Act. The third ground is that the application does not comply with Section 30(i) of the Act.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Klara Rajda which served simply to introduce into evidence a certified copy of the opponent's application. The applicant did not file evidence. Neither party filed a written argument but an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the opponent has established that its application was filed prior to the applicant's claimed date of first use and that it was pending as of the applicant's advertisement date. Thus, the first ground remains to be decided on the issue of confusion between the marks of the parties. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Furthermore, the material time for considering the circumstances respecting this issue is as of the applicant's claimed date of first use. 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 marks of both parties are inherently distinctive. In the absence of evidence on point, I must conclude that neither mark had become known at all in Canada as of the material time. The length of time the marks have been in use is not a significant factor in this case. The opponent's application includes "magazines" which is the identical ware for which the applicant seeks registration. Presumably the trades of the parties would be similar. The two marks at issue bear a fair degree of resemblance in all respects in view of the common use of the word "mandarin" as the first component of each mark.

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, I find that the applicant has failed to satisfy the onus on it to show that its trade-mark MANDARIN HOME is not confusing with the applicant's mark MANDARIN ORIENTAL. Thus, the first ground of opposition is 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 October, 1992.

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