

IN THE MATTER OF AN OPPOSITION by General Motors Corporation and General Motors of Canada Limited to application No. 687,450 for the trade-mark GM & Design filed by Gunn & Moore Limited

On August 12, 1991, the applicant, Gunn & Moore Limited, filed an application to register the trade-mark GM & Design, a representation of which appears below, based on proposed use of the trade-mark in Canada in association with “Games, toys, gymnastic and sporting articles and apparatus, and parts and fittings therefor”. The applicant amended its statement of wares at the examination stage to cover the following:

“Billiard, pool and snooker cues, cue tips, cue extensions, cue ferrules, cue tip shapers, cue-carrying cases, cue chalk, cue rests, cue clamps; billiard balls, pool balls and snooker balls; cricket bats, stumps, bails, leg guards, arm guards, chest protectors, thigh protectors, protective helmets, protective gloves, wicket-keeper's gloves, balls, bags adapted for carrying cricket apparatus and equipment, covers for cricket bats, abdominal protectors, athletic supporters, grips for cricket bats, scorebooks and scorecards for cricket, and bat mallets; bags adapted for carrying apparatus and equipment for field hockey, covers for field hockey sticks; shin guards, face guards and protective headgear, all for use in the game of field hockey; hockey balls; darts, flights and stems for darts, dart sharpeners, carrying cases for darts and for flights for darts and for shafts for darts, measuring mats for use in the game of darts; dartboards, apparatus and equipment for use in scoring in the game of darts, trophies for presentation in the game of darts, dartboard cabinets, and holders for darts.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of July 1, 1992 and the opponents, General Motors Corporation and General Motors of Canada Limited, filed a statement of opposition on December 1, 1992, a copy of which was forwarded to the applicant on January 8, 1993. The opponents alleged the following grounds of opposition in their statement of opposition:

- (a) The present application does not comply with Subsection 30(i) of the *Trade-*

marks Act in that the applicant could not have been satisfied that it was entitled to use the trade-mark GM & Design in Canada in association with the wares covered in the present application in that, as of the applicant's filing date, the applicant was aware of the opponents' prior use in Canada, by itself or through its licensees and/or registered users of the marks and registrations identified below;

(b) The applicant's trade-mark GM & Design is not registrable in that it is confusing with the following registered trade-marks owned by the opponent, General Motors Corporation, under registration Nos. UCA03835, TMDA17009, TMDA52699, TMDA52700, 185,350, 359,377, 364,923 and 388,217, and in respect of which the opponent, General Motors of Canada Limited, is a registered user;

(c) The applicant's trade-mark GM & Design is not registrable in that it is confusing with the following registered certification marks owned by the opponent, General Motors Corporation, under registration Nos. 107,714, 107,723, 107,724 and 370,623, which are in use in Canada by licensees of General Motors Corporation in association with the services set forth in the registrations;

(d) The applicant is not the person entitled to registration of the trade-mark GM & Design in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the trade-marks covered in the opponent's registrations identified in the second ground which stand in the name of General Motors Corporation, and which had previously been used and made known in Canada by General Motors Corporation and/or its registered user, General Motors of Canada Limited, as well as being confusing with the certification marks identified in the third ground which had previously been used and made known by the certification mark licensees of General Motors Corporation;

(e) The applicant's trade-mark GM & Design is not distinctive in view of the prior and continuing use of the trade-marks and certification marks identified in the previous grounds. Moreover, the opponents have been involved for many years in the promotion and sponsorship of a large number of sporting events in Canada in association with, *inter alia*, the marks set out above.

The opponents filed as their evidence the affidavits of Lawrence Fink, Jr., Tonia Pedro, Mary Noonan and two affidavits of David F. Mitchell, the second of which is dated March 14, 1997 and was adduced as further evidence pursuant to Rule 44(1) of the *Trade-marks Regulations*. The applicant submitted as its evidence the affidavit of Susan Pearce. Both parties filed a written argument and both were represented at an oral hearing. The opponents requested leave to amend their statement of opposition pursuant to Rule 40 of the *Trade-marks Regulations*. However, this request was refused by way of the Office letter of August 2, 1996. Further, the opponents were granted an order to cross-examine Susan Pearce on her affidavit but subsequently elected not to proceed with the cross-examination. The opponents requested and, on April 21, 1998, were granted leave pursuant to Rule 44(1) of the *Regulations* to adduce the affidavit of Christopher Dejardin as further evidence in this opposition while the applicant's Rule 44(1) request for leave to adduce the affidavit of David S. Sher as further evidence was refused by the Opposition Board.

At the oral hearing, the applicant raised for the first time the issue of there having been an abuse of process in that the opponents obtained an order for cross-examination of Susan Pearce on April 18, 1996 and, after the Opposition Board established a time and date for the cross-examination of Ms. Pearce in the Office letter of August 2, 1996, the opponents on September 18, 1996 advised the Board that they would not be proceeding with the cross-examination in view of the Board's refusal to accept the amendment to the opponents' statement of opposition. Even assuming, as has been submitted by the applicant, that the opponents had obtained the order for cross-examination merely as a tactic to delay the opposition in view of Section 45 proceedings initiated against the registrations identified in the Pearce affidavit, I seriously doubt that such would justify my terminating the opposition in favour of the applicant at the oral hearing stage of the proceeding, there being no provisions in either the *Trade-marks Act* or *Trade-marks Regulations* which would support the Registrar proceeding in such a manner. Further, I have my doubts as to whether the Registrar has the inherent jurisdiction in the administration of opposition proceedings to proceed as requested by the applicant in that the applicant's request would appear to offend the provisions of Subsection 38(8) of the *Trade-marks Act* which is mandatory in requiring the Registrar, after considering the evidence and representations of the parties, to either refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision. I have therefore rejected the applicant's request that this opposition be immediately terminated in the applicant's favour.

With respect to the first ground, the onus or legal burden is on the applicant to show that its application complies with the provisions of Section 30 of the *Trade-marks Act* [see *Joseph Seagram & Sons v. Seagram Real Estate*, 3 C.P.R.(3d) 325, at pp 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. There is, however, an initial evidential burden on the opponents to establish the facts being relied upon by them in support of this ground. As no evidence has been filed by the opponents in support of their allegations that the applicant could not have been satisfied that it was entitled to use the trade-mark GM & Design in Canada, they have failed to meet the evidential burden upon them in respect of this ground. In any event, and even had the applicant been aware of the opponents' trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled

to use the trade-mark GM & Design in Canada on the basis *inter alia* that its mark is not confusing with the opponents' trade-marks [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155].

The second and third grounds of opposition are based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponents alleging that the applicant's trade-mark GM & Design is not registrable in that it is confusing with the following registered trade-marks and registered certification marks standing in the name of General Motors Corporation:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares/Services</u>
GM	UCA03835	Transportation elements, namely, motor driven vehicles, automobiles and trucks of all kinds and for all purposes; parts of motor driven vehicles, automobiles and trucks, and their accessories of every description; internal combustion engines, parts of internal combustion engines, and their accessories of every description; automobile heaters, batteries, antifreeze compounds, automobile windshield defrosters, liquid polish, cleaners, seat covers, battery chargers, water jacket heaters and radiator flush, rust resisting oils, upholstery cleaners, and waterproof top preservers for automobiles. Pumps and pumping apparatus for supplying water under pressure in residential and farm water supply systems, and parts thereof. Complete oil and gas building heating units, oil and gas burners, boilers, furnaces, service water heaters and parts thereof. Radio receiving sets, controls, and parts and accessories thereof. Electric motors and generators. Electric clocks. Electric ranges. Refrigerating apparatus, including refrigerators and devices for cooling foods by refrigeration of all kinds; ice making machinery; air conditioning systems. Washing machines. Washing machines. Ironing machines. Steel tubing.
	TMDA17009	Automobile trucks and component parts thereof
	TMDA52699	Automobiles

TMDA52700 Automobile parts of every description.

GMC 185,350 Trucks, buses, internal combustion engines and parts and accessories therefor, namely, generators, starting motors, oil and fuel filters, air cleaners and silencers, radiators, emission control devices, carburetors, radios, clocks, wheel covers, rear window defoggers, heating and cooling systems, floor mats, mirrors, lamps, luggage carriers, trailer hauling equipment, namely, trailer hitch, brake tie-ins, and electrical connections.

359,377 Re-manufactured automotive parts.

364,923 Automobiles, motor trucks, truck tractors, buses, engines therefor and structural parts thereof.

388,217 Motor vehicles, parts and accessories therefor.

Certification mark

Registration No.

Wares/Services

G.M. 107,714 The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories.

G.M.C.	107,717	The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories.
	107,723	The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories and electric motors.
	107,724	The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories including diesel motors.
	370,623	The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories.

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark GM & Design and one, or more, of the opponent's registered trade-marks and registered certification marks identified above, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date. In this regard, the material date in respect of the Paragraph 12(1)(d) ground is the date of decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al*, 37 C.P.R. (3d) 413 (F.C.A.)].

The applicant's evidence comprises the affidavit of Susan Pearce which introduces into evidence copies of three registrations standing in the names of third parties for the trade-marks GM

& Design and two registrations for the trade-mark GMC & Design. However, the Dejardin affidavit establishes that two of the three GM & Design registrations were expunged from the register on November 18, 1996 and January 30, 1998 and the third registration was cancelled on June 19, 1997. Thus, the applicant's evidence is of no assistance to the applicant in assessing the likelihood of confusion between its trade-mark and the opponent's registered GM and GM & Design trade-marks, bearing in mind that the material date for considering the paragraph 12(1)(d) ground is the date of decision.

The Noonan and first Mitchell affidavit introduce into evidence copies of the opponents' registrations relied upon in the statement of opposition while the Pedro affidavit evidences photocopies of advertisements appearing in several issues of Macleans magazine which include the element GM. The Mitchell affidavits also provide details relating to the licensing and the records of General Motors of Canada Limited as a registered user of the registered trade-marks standing in the name of General Motors Corporation, as well as noting that General Motors Corporation exercises control over the character and quality of the wares associated with *inter alia* the GM and GM & Design trade-marks. As well, Mr. Mitchell states that use of the certification marks has been under license to third parties and such use of the marks in association with services has met standards set by General Motors Corporation.

The first Mitchell affidavit also provides details relating to unit sales of automobiles and trucks in Canada which have featured one or more of the GM trade-marks, the total being in excess of 5,740,000 units from 1982 to 1994 inclusive. As well, Mr. Mitchell provides photographs showing the manner in which the GM trade-mark appears on Canadian dealership signs, there being 870 licensed dealers in Canada displaying the GM logo as of October 1994. Further, Mr. Mitchell notes that his company has advertised its cars and trucks in association with the GM logo at race track events including the Montreal Grand Prix, the Molson Indy Toronto, the Molson Indy Vancouver and Mosport, as well as at football games such as the CIAU Championship and the Vanier Cup, the Commonwealth Games, the Calgary Stampede, and basketball games, and golf and skiing events.

Lawrence Fink, Jr., Director of Sales and Marketing of Service Parts Operation, a Division of General Motors of Canada Limited, states that he is responsible for the procurement, warehousing, marketing and sale of wares to General Motors' dealers, including the sale of automotive parts and accessories, and various clothing and other merchandise. Mr. Fink provides details of various sporting events in the fields of auto racing, fishing tournaments, golf, horse jumping and bicycling which were sponsored by his Division either alone or in conjunction with General Motors of Canada Limited. As well, according to Mr. Fink, GM Canada and his Division are also involved in advertising at and the sponsorship of a variety of motorsport events and miscellaneous special events such as Junior A hockey games in Oshawa, Ontario, the sponsorship of GM Place in Vancouver, British Columbia, the sponsorship in conjunction with the Ontario Provincial Police of the Ontario Law Enforcement Torch Run for the Ontario Special Olympics from 1989 - 1994, and the co-sponsorship of the Poker Run boat racing event in Ontario in 1994 where the GM trade-marks and logo were displayed. As well, Mr. Fink notes that the GM logo and trade-marks have been prominently displayed at various auto and trade shows across Canada as detailed in paragraph 9 of his affidavit.

Annexed as exhibits to the Fink affidavit are representative brochures which General Motors of Canada Limited has used in Canada to advertise and promote the sale of various clothing and sporting items in association with the GM logo and trade-marks, including jackets, sweaters, t-shirts, baseball caps, totebags, golf balls, mechanical pencils, rings, binoculars, playing cards, golf shirts, sports bags, sweat shirts, wrist watches, lighters, flashlights, key chains, pens, fishing vests, fishing rollers, jogging suits, shorts, coffee mugs, coolers, fleece tops, golf tee holders, rugby shirts, and army knives. According to Mr. Fink, total sales of clothing of the type identified in the brochures annexed to his affidavit from 1990 to 1993 inclusive was \$3,250,000 while sales in the first ten months of 1994 exceeded \$1,400,000 with 85% of these products featuring the GM trade-marks.

With respect to the criteria under Subsection 6(5) of the *Trade-marks Act*, the applicant's trade-mark GM & Design comprises the initials GM which are inherently weak combined with design features which add at least some measure of inherent distinctiveness to the trade-mark. Thus, the applicant's trade-mark possesses some inherent distinctiveness when considered in its entirety.

The opponent's trade-marks: GM [UCA03835]; GMC Design [TMDA17009]; GM & Maple Leaf Design; GMC [185,350]; GM & Circle design [359,377]; GM & Design [364,923]; GM & Design [388,217]; G.M. [107,714]; G.M.C. [107,717]; and GM & Design [370,623] either comprise or are dominated by the letters GM, G.M., GMC or G.M.C. and the design features associated with these design marks add relatively little to their inherent distinctiveness. Thus, these marks are weak marks and therefore, in the absence of evidence of acquired distinctiveness, would be entitled to a narrow ambit of protection. On the other hand, the opponent's trade-marks GM GENERAL MOTORS PRODUCTS & Design [TMDA52699], GM GENERAL MOTORS PRODUCTS & Design [107,723] and GM GENERAL MOTORS DIESEL POWER & Design possess a somewhat greater degree of inherent distinctiveness than the opponents' other marks, having regard to the wording associated with them.

No evidence has been furnished by the applicant relating to its use of its trade-mark GM & Design in Canada and its mark must therefore be considered as not having become known to any extent in Canada. On the other hand, the opponents' evidence establishes that its trade-mark GM and certain of the design trade-marks which include the letters GM have become well known in Canada in association with automobiles and automotive parts, as well as the servicing and maintenance of automobiles. As well, the trade-mark GMC and certain of the design marks including these letters have also become fairly well known in Canada in association with trucks and truck parts, as well as the servicing and maintenance of trucks. Consequently, the extent to which the trade-marks at issue have become known clearly favours the opponents. Likewise, the length of time the trade-marks at issue have been in use is a further factor weighing in the opponents' favour.

As for the nature of the wares and services of the parties and their respective channels of trade, there is no similarity between the wares covered in the present application and the wares and services covered in the registrations relied upon by the opponents. Furthermore, I would not expect that there would normally be an overlap in the channels of trade associated with the applicant's wares and the automobiles, trucks and parts therefor, as well as the related servicing and maintenance services covered in the opponents' registrations.

As for the degree of resemblance between the trade-marks at issue, the applicant's trade-mark GM & Design is very similar in appearance and identical in sounding to the opponents' GM and certain of the GM & Design trade-marks covered in their various registrations. The trade-marks at issue suggest the idea that the marks are initials representing the names of the parties although the opponents are not entitled to a monopoly in respect of such an idea.

The agent for the applicant conceded at the oral hearing that the opponents' trade-mark GM was famous as applied to the wares and services covered in their registrations. Both parties relied upon various decisions which have dealt with famous trade-marks and both made submissions concerning the recent unreported decision of the Federal Court of Appeal in *Pink Panther Beauty Corporation v. United Artists Corporation*, [F.C.A. No. A-365-96, dated March 30, 1998]. In the *Pink Panther Beauty Corporation* case, the Federal Court of Appeal reversed a decision of the Federal Court, Trial Division and rejected an opposition by the opponent, United Artists Corporation, to registration of the trade-mark PINK PANTHER as applied to "hair care and beauty product supplies" and to the following services: "operation of a business dealing in the distribution of hair care and beauty product supplies, and instructing and educating others in the distribution of beauty products and hair care supplies".

The opponents' agent sought to distinguish the PINK PANTHER decision on the basis that its trade-mark GM is far more famous in Canada than is the PINK PANTHER trade-mark and is therefore entitled to a far broader ambit of protection than should be accorded the trade-mark PINK PANTHER. However, in the *Pink Panther Beauty Corporation* case, Linden, J.A. pointed out that much of the jurisprudence in cases involving similar famous trade-marks "has little precedential value" as the "cases turn on the particular and often unique facts". Thus, Mr. Justice Linden concluded that "cases decided in the past may be interesting", but are generally not helpful. I agree with the observations of Linden, J.A. and will therefore accord little precedential value to the Court of Appeal decision in the PINK PANTHER case or to the other decisions involving famous trade-marks relied upon by the parties.

As a further surrounding circumstance in respect of the issue of confusion, the opponents

have adduced evidence of advertising and promotion of its GM and GM & Design trade-marks in association with the sponsorship of or advertising at numerous sporting events across Canada, as well as the offering for sale of such sporting goods as golf balls, golf tee holders and fishing vests, as well as the sale of clothing. Thus, the opponents have shown that there is some connection between the applicant's wares and the opponents' activities associated with its GM mark.

In view of the above, I am left in a state of doubt as to whether there would be a reasonable likelihood of confusion between the trade-marks at issue. Apart from the degree of resemblance between the trade-marks at issue and the reputation in Canada associated with the opponents' trade-mark GM as applied to automobiles and their parts and related automotive services, the opponents' GM mark has been applied to sporting goods and a range of other wares. Furthermore, the opponents have sponsored various sporting events and have advertised their GM automobiles at numerous other sporting events across Canada. As a result, and bearing in mind that the applicant's evidence is of no value in this opposition, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion and have therefore refused the applicant's application pursuant to the provisions of Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 28th DAY OF JULY, 1998.

G.W. Partington
Chairperson
Trade-marks Opposition Board