

IN THE MATTER OF AN OPPOSITION by Codet
Inc. to application No. 658,078 for the trade-mark
BIG BILL filed by Les Magasins Libre Service Pitt
Ltée - Pitt Self Service Stores Ltd.

On May 22, 1990, the applicant, Les Magasins Libre Service Pitt Ltée - Pitt Self Service Stores Ltd., filed an application to register the trade-mark BIG BILL for the wares (1) work boots and (2) footwear namely, walking shoes, work shoes and jogging shoes. The application is based on use in Canada since as early as April 1977 for work boots, and on proposed use in Canada for the remaining wares.

The subject application was advertised for opposition purposes on March 6, 1991. The opponent, Codet Inc., filed a statement of opposition on April 8, 1991, a copy of which was forwarded to the applicant on May 6, 1991. The applicant responded by filing and serving a counter statement. Only the applicant filed a written argument, however, both parties were represented at an oral hearing.

Included among the grounds of opposition is that the applied for mark is not distinctive of the applicant's wares pursuant to Section 38(2)(d) of the Trade-marks Act in view of the opponent's use and making known of its registered marks namely GROS BILL (regn. No. UCA42091) and the two marks illustrated below:

regn. No. 319,204

regn. No. 364,938

The registration for GROS BILL covers "work and play garments, namely: pants,...slacks and overalls"; registration No. 319,204 covers various items of clothing including "work clothing"; and registration No. 364,938 covers additional items of clothing. Also

included as a ground of opposition is that the applied for mark is not registrable pursuant to Section 12(1)(d) in view of the opponent's above mentioned registrations.

The opponent's evidence consists of certified copies of its above-mentioned registrations, and the affidavits of Gilbert Audet, Vice-President of the opponent company, and Pascale Goyer, chief librarian with the firm representing the opponent. The Goyer affidavit serves to introduce into evidence Trade-marks Office documents showing that regn. No. 223,248 for the mark BIG BILL owned by the applicant herein was expunged from the register on October 5, 1990 pursuant to Section 45 when the registrant (the applicant herein) failed to file evidence of use of the mark.

The applicant's evidence consists of the affidavit of Henry Avrith, President of the applicant company. Mr. Avrith's cross-examination on his affidavit was conducted on November 23, 1992 and continued on March 26, 1993. The complete transcript of his cross-examination, exhibits thereto, and answers to undertakings form part of the record of this proceeding [the original exhibits HA-11 to HA-14, inclusive, were absent from the file, however, the opponent provided facsimile copies].

With respect to the ground of opposition pursuant to Section 38(2)(d), the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal burden means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case April 8, 1991: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v.*

Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Further, I am permitted to take into account evidence of all the surrounding circumstances including, for example, the parties' sales and advertising under their respective marks and trade-names, up to the material date: see *Castle & Cooke, Inc. v. Popsicle Industries Ltd.* (1990), 30 C.P.R.(3d) 158 (TMOB).

The applicant's evidence is that it owns and operates sixty-one "self-serve" shoe stores of which sixty are located in Quebec and one is located in Ontario. The applicant imports shoes or buys job lots (that is, clearing lots from other traders) and sells shoes under a variety of marks including a French language version of the subject mark, namely GROS BILL. The applicant has applied the subject mark BIG BILL in plain black lettering to work boots since 1977. Total sales for all brands of shoes sold in the applicant's stores range between fifteen and twenty million dollars annually from 1985 to 1992. Related items such as shoe-laces, shoe polishes, and items of clothing such as jogging suits and tennis shorts account for a small proportion of sales. The applicant does not keep records of sales under specific marks. Thus, Mr. Avrith was not able to provide any quantitative estimates of sales of work boots under the mark BIG BILL. In the circumstances I am unable to infer that the applicant has used its mark BIG BILL above the *de minimus* level.

The opponent's evidence is that it has been selling work clothing and sports clothing (for outdoor work and hunting and the like) under its registered marks since 1975. Wholesale sales under the opponent's marks were about \$5.6 million in 1986 rising steadily to \$8.3 million in 1990. During the same period the opponent expended about \$285,000 for advertising and promoting its clothing wares under its marks. On the basis of actual samples of labels and advertising attached as exhibits to Mr. Audet's affidavit, and in the absence of cross-examination, I conclude that a significant

proportion of the opponent's sales and advertising were under its mark BIG BILL & Design, regn. No. 364,938 or under a variation of the mark namely, BIG BILL.

The wares of the parties namely, footwear and clothing, are different but are related : see *Salamander Aktiengesellschaft v. Pacific Clothing Exchange Ltd.*, 19 C.P.R. (3d) 349, at 351; *I. Hignell & Associates Ltd. v. H.H. Brown Shoe Co. (Canada) Ltd. - Chaussures H.H. Brown (Canada) Ltée.*, 34 C.P.R. (3d) 569; and *Patagonia, Inc. v. Chaussures André S.A., Société Anonyme*, 55 C.P.R. (3d) 408. The applicant submitted that the parties' channels of trade would not overlap since the applicant sells shoes exclusively through its own stores. According to the applicant, its shoes and the opponent's clothing would not be sold through the same retail outlets. I do not accept the applicant's submission. The applicant is requesting registration of its mark BIG BILL for the wares specified in the subject application. In the absence of any restrictions to the wares as specified in the application, I must have regard to all the usual channels of trade available to the applicant and not limit my considerations solely to the applicant's present mode of doing business: see, for example, *Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.* 2 C.P.R.(3d) 361 at 372 (F.C.T.D.), 12 C.P.R.(3d) 110 at 112 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* 19 C.P.R.(3d) 3 at 10-11 (F.C.A.).

The applicant also contends that the lack of incidents of actual confusion notwithstanding the contemporaneous use of both marks for many years is relevant to my considerations. I disagree. As noted previously, the applicant has failed to evidence use of its mark BIG BILL (or GROS BILL) above the *de minimus* level and to date the applicant has sold its shoes exclusively through its own retail outlets. Thus, the fact that there have been no incidents of actual confusion is not surprising.

In view of the above, and considering the similarity between the applied for mark and the opponent's marks, and bearing in mind the extent to which the opponent's marks have become known in Canada, I have concluded that the applicant has failed to discharge the legal burden on it to establish that the applied for mark distinguishes or is adapted to distinguish its work boots or footwear from the opponent's clothing.

As the opponent has succeeded on the ground of opposition alleging non-distinctiveness of the applied for mark, it is not necessary for me to consider the remaining grounds of opposition. I would mention, however, that the opponent would also have succeeded on its ground of opposition pursuant to Section 12(1)(d).

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 31st DAY OF JULY, 1995.

Myer Herzig,
Member,
Trade-marks Opposition Board