

IN THE MATTER OF AN OPPOSITION by Montreal Forum Inc./Forum de Montréal Inc. to application No. 742,289 for the trade-mark LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design filed by Michel Rivard

On November 25, 1993, the applicant, Michel Rivard, filed an application to register the trade-mark LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with:

“Articles of clothing, namely: sweaters, sweatshirts, T-shirts, caps; novelty items and souvenirs, namely: badges, stickers pennants, macarons, lapel pins, buttons, decals, license plates, magnets, wallets, key holders, key rings, key chains, inflatable toys; tote bags, towels, back-packs, sports bags, water bottles; drinking glasses, mugs, bottle openers; letter openers, pen holders, ball point pens, pencils, pens, paper pads, wrapping paper.”

[Translation] “Articles vestimentaires, nommément chandails, pulls d'entraînement, tee-shirts, casquettes; articles de fantaisie et articles souvenirs, nommément insignes, autocollants, fanions, macarons, épinglettes de revers, boutons, décalcomanies, plaques d'immatriculation, aimants, portefeuilles, porte-clés, anneaux porte-clés, chaînes porte-clés, jouets gonflables; sacs fourre-tout, serviettes, sacs à dos, sacs de sport, bidons; verres, chopes, décapsuleurs; coupe-papier, porte-stylos, stylos à bille, stylos, crayons, blocs de papier à lettres, papier d'emballage”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of August 3, 1994 and the opponent, Montreal Forum Inc./Forum de Montréal Inc., filed a statement of opposition on April 3, 1995, a copy of which was forwarded to the applicant on July 19, 1995. The opponent alleged, *inter alia*, that the applicant is not the person entitled to registration of the trade-mark LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-mark LE FANTÔME DU FORUM & Design, a representation of which appears below, which has been used

in Canada by the opponent since June 1993 in association with articles of clothing, namely, T-shirts.

The applicant served and filed a counter statement in which he generally denied the opponent's grounds of opposition. The opponent filed as its evidence the affidavit of Yves Renaud while the applicant elected not to file any evidence. The opponent alone submitted a written argument and neither party requested an oral hearing.

The first ground of opposition is based on Paragraph 16(3)(a) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design since the applicant's trade-mark is confusing with the opponent's trade-mark LE FANTÔME DU FORUM & Design which has been previously used in Canada in association with T-shirts. Having regard to the provisions of Subsections 16(5) and 17(1) of the *Trade-marks Act*, there is a burden on the opponent to establish its use of the trade-mark LE FANTÔME DU FORUM & Design in Canada in association with T-shirts prior to the applicant's filing date [November 25, 1993], as well as to show that it had not abandoned its trade-mark as of the date of advertisement of the present application in the *Trade-marks Journal* [August 3, 1994].

The opponent has submitted as its evidence the affidavit of Yves Renaud, Director of Boutiques with the opponent. Mr. Renaud, who had been employed by the opponent since August 13, 1973, states that he has heard of the legend of the “Fantômes du Forum” on many occasions since he started working for the opponent. According to the legend, the “Fantômes du Forum” have helped the Montreal Canadians Hockey club, and particularly the goalies on the club, to defeat their opponents by stopping their shots. In order to commemorate this legend, the opponent has sold T-shirts in its boutiques bearing the words FANTÔME DU FORUM from June 1993 to March 1996. Annexed to Mr. Renaud’s affidavit are copies of receipts confirming sales of the T-shirts between May 29, 1993 and December 12, 1994, together with a photograph of one of the T-shirts. According to Mr. Renaud, there are no more T-shirts in the opponent’s inventory of the 391 shirts which the opponent purchased from its supplier, Starter Canada. As a result, the opponent has established that it has used the trade-mark LE FANTÔME DU FORUM & Design since May 1993 in association with T-shirts and that it had not abandoned its trade-mark as of the date of advertisement of the present application in the *Trade-marks Journal*.

Since the opponent has met the initial burden upon it under Subsections 16(5) and 17(1) of the *Trade-marks Act*, this ground remains to be determined on the issue of confusion between the applicant’s trade-mark LES FANTÔMES DU FORUM FORUM’S GHOSTS & Design as applied to the wares covered in the present application and the opponent’s trade-mark LE FANTÔME DU FORUM & Design as applied to T-shirts. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of the applicant’s filing date, the material date in respect of this ground, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the applicant’s filing date.

Both of the trade-marks at issue are inherently distinctive as applied to the respective wares of the parties. Further, the opponent’s trade-mark had become known to only a limited extent as of the applicant’s filing date while the applicant’s trade-mark had not become known to any extent in

Canada as of that date. Further, the length of time the trade-marks at issue have been in use weighs slightly in the opponent's favour in that the opponent's evidence points to its use of the trade-mark LE FANTÔME DU FORUM & Design since May 1993 whereas the applicant has not evidenced any use of his trade-mark in Canada.

The opponent's T-shirts are identical to the applicant's T-shirts and are closely related to the applicant's sweaters, sweatshirts and caps. On the other hand, the opponent's T-shirts differ from the applicant's various novelty items and souvenirs covered in the present application, as well as the applicant's tote bags, towels, back-packs, sports bags, water bottles, drinking glasses, mugs, bottle openers, letter openers, pen holders, ball point pens, pencils, pens, paper pads and wrapping paper. As for the respective channels of trade associated with the wares of the parties, Mr. Renaud states in his affidavit that the opponent sells clothing, souvenirs and novelty items, sports bags, mugs, key rings and flags in its boutiques. As a result, there could well be a potential overlap in the respective channels of trade of the parties.

The trade-marks at issue bear little similarity in appearance when considered in their entireties. However, the trade-marks are very similar in sounding in that the opponent's trade-mark would be sounded as LE FANTÔME DU FORUM and the applicant's mark would be sounded as either LES FANTÔMES DU FORUM or FORUM'S GHOSTS. Moreover, the trade-marks are similar in the ideas suggested by them in that both marks suggest a phantom and an association with hockey.

Considering the degree of resemblance in sounding and ideas suggested by the trade-marks LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design and LE FANTÔME DU FORUM & Design as applied to wares which could travel through the same channels of trade, and bearing in mind that certain of the wares of the parties overlap, I have concluded that the applicant has failed to meet the legal burden upon it of satisfying the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue. As a result, the applicant is not the person entitled to registration of the trade-mark LES FANTÔMES DU FORUM FORUM'S GHOSTS & Design.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS DAY 29th OF DECEMBER, 1997.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board