

**IN THE MATTER OF AN OPPOSITION by
BUFFALO-EASTCANTRA INC. to application No. 772,225 for
the trade-mark BUFFALO filed by SARAFINA INVEST LTD.**

On January 3, 1995, the applicant, SARAFINA INVEST LTD., filed an application to register the trade-mark BUFFALO based on use of the trade-mark in Canada by the applicant since at least as early as April 1993 in association with “socks”, as well as being based on proposed use of the trade-mark in Canada in association with “Shoes, boots, slippers, hosiery, men's and women's underwear, sunglasses, neckties, bows, bathrobes, bathing suits, luggage, bracelets, necklaces, earrings, anklet charms, bed sheets, pillow covers, comforters, towels, packsacks.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of May 28, 1997 and the opponent, BUFFALO-EASTCANTRA INC., filed a statement of opposition on July 15, 1997, a copy of which was forwarded to the applicant on July 25, 1997. The applicant served and filed a counter statement in response to the statement of opposition on August 25, 1997. The opponent submitted as its evidence the affidavit of Danny Fonfeder while the applicant elected not to file any evidence. Mr. Fonfeder was cross-examined on his affidavit, the transcript of the cross-examination and the exhibits to the cross-examination, as well as the responses to undertakings given during the cross-examination, forming part of the opposition record. Both parties submitted a written argument and both parties were represented at an oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

- a)* The present application does not comply with the requirements of Section 31 [sic.] of the *Trade-marks Act* in that, as of the filing date of the present application, the applicant could not have been satisfied that it was entitled to use the trade-mark BUFFALO in Canada in view of the opponent's prior rights in the same trade-mark;
- b)* The trade-mark BUFFALO is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* because it is confusing with the opponent's registered trade-mark BUFFALO & Design, registration No. 226,024;
- c)* The applicant is not the person entitled to secure registration of the trade-mark BUFFALO because, at the filing date of the present application, the applicant's trade-mark was confusing with the trade-mark BUFFALO & Design which the opponent has previously used in Canada since at least January, 1978 in association with *inter alia* school bags.

As its first ground, the opponent has asserted that the present application does not comply

with the requirements of Paragraph 39(2)(a) and Section 31 of the *Trade-marks Act*. However, it would appear that the opponent intended to rely on Paragraph 38(2)(a) and Section 30 of the *Act* in relation to this ground; and paragraph 3 a) of the counter statement indicates that the applicant understood that such was the case. I have therefore ignored the errors in the misidentification of the Sections of the *Act* in the opponent's first ground.

With respect to the first ground, the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*. There is, however, an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. In the present opposition, the opponent has not submitted any evidence which would support its allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark BUFFALO in Canada. Thus, the opponent has not met the evidential burden upon it in relation to the first ground. Moreover, even had the applicant been aware of the opponent's trade-mark BUFFALO & Design prior to filing the present application, such a fact does not preclude the applicant from being satisfied that it was entitled to use the trade-mark BUFFALO in Canada on the basis *inter alia* that its mark is not confusing with the opponent's trade-mark. Thus, the success of this ground is contingent upon a finding that the trade-mark BUFFALO is confusing with the opponent's trade-mark BUFFALO & Design and is therefore not registrable or the applicant is not the person entitled to its registration, as alleged in the remaining grounds [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]. I will therefore consider the remaining grounds of opposition.

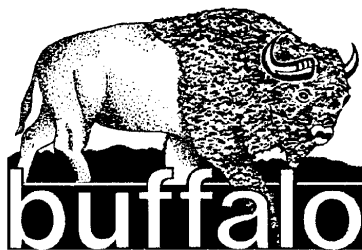
As its second ground, the opponent has alleged that the applicant's trade-mark BUFFALO is confusing with its registered trade-mark BUFFALO & Design, registration No. 226,024. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all of the surrounding circumstances including those specifically set forth in Subsection 6(5) of the *Trade-mark Act*. Further, the Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material

date with respect to the Paragraph 12(1)(d) ground of opposition [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

Since the opponent has only opposed the applicant's application in relation to "packsacks", the trade-mark BUFFALO will proceed to registration in relation to the remaining wares covered in the present application. The applicant submitted at the oral hearing that the remaining wares include "luggage" which are closely related to "packsacks" and therefore the opponent's opposition should be summarily rejected as it did not oppose its application in relation to these wares. Apart from the provisions of Subsection 38(4) of the *Trade-marks Act* which do not apply in the present case, there are no provisions in either the *Act* or the *Trade-marks Regulations* which give the Registrar the discretion to summarily reject an opposition at any stage of the proceeding. I have therefore dismissed the applicant's request that this opposition be summarily rejected.

The opponent has adduced a photocopy of its registration for the trade-mark BUFFALO & Design, a representation of which is set out below, as an exhibit to the Fonfeder affidavit.

Registration No. 225,024



covers the following wares:

“Colouring pens, lead pencils, mechanical pencils, elastic bands, staplers, staples, writing chalk, crayons, marking pens, mathematical sets containing protractors, compasses, rulers and plastic triangles,

pencils, rubber erasers, fountain

candles; printed
or lithographed
metal or paper
boxes for
holding
students'
geometry
requirements;
printed or
lithographed
metal or paper
boxes for
holding water
colours, oil
colours or oil
pastels; water
colours, oil
colours, poster
colours or oil
pastels;
protractors,
triangles,
compasses,
rulers, slide
rules, pencil
boxes, cases or
pouches, pencil
sharpeners,
artist brushes,
paper clips,
letter clips,
clipboards, coil
notebooks,
address books,
telephone
books, diaries,
autograph
books, recipe
books binder
books, "My
Trip" books,
stencils, hole
punchers,
thumbtacks,
push pins,
mapping pins,
bingo chips,
scissors,
photo-albums,
school bags,
writing paper
and envelopes,
erasers, card
rings, dice, glue
[sic.], rubber
bands,
magnifying
glasses, pipe
cleaners, paper

reinforcements,
gum labels,
stamp pads and
stampers, and
p a p e r
fasteners.”

Considering initially the inherent distinctiveness of the trade-marks at issue [Para.6(5)(a)], both the applicant’s trade-mark BUFFALO as applied to the wares covered in the present application and the opponent’s registered trade-mark BUFFALO & Design as applied to the wares covered in registration No. 226,024 are inherently distinctive. As for the extent to which the trade-marks at issue have become known [Para.6(5)(a)] and the length of time the marks have been in use [Para.6(5)(b)], no evidence has been furnished by the applicant and its trade-mark BUFFALO must be considered as not having become known to any extent in Canada. On the other hand, the Fonfeder affidavit shows that the opponent’s registered trade-mark BUFFALO & Design has become known in Canada in association with pouches with in excess of \$4,200,000 in sales of pouches [see para. 12, Fonfeder affidavit; and response to undertaking No. 5]. However, I would note that the opponent’s evidence fails to show any use of its trade-mark in association with school bags. While the opponent in its evidence generally characterized its pouches as being pencil pouches, I believe that the average consumer would view at least some of the opponent’s pouches, specimens of which have been adduced by Mr. Fonfeder, as being of a size that they could be used for carrying a variety of items including school supplies, transistor radios, cellular telephones, calculators, address books, diaries and the like.

Considering next the nature of the wares of the parties [Para.6(5)(c)] and the nature of the trade associated with the trade-marks at issue, the applicant’s “packsacks” are, in my view, similar to the “school bags” covered in the opponent’s registration and also bear some minor degree of similarity to the pencil pouches which are also covered in the opponent’s registration. I would note that the advertisement comprising Exhibit A-9 to the Fonfeder affidavit shows a school bag described as a “High School Book Bag” which is similar to the “Children’s Backpack” appearing in the same advertisement. Further, backpacks and packsacks would, in my view, be quite similar in nature. Moreover, I would expect that there could be a potential overlap in the channels of trade

associated with the applicant's "packsacks" and the opponent's school bags and pencil pouches. In any event, the applicant has failed to adduce any evidence which might have lead me to conclude that the channels of trade associated with these wares would differ, bearing in mind that the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue.

As for the degree of resemblance between the trade-marks at issue [Para.6(5)(e)], the applicant's trade-mark BUFFALO is very similar in appearance and is identical in sounding and in the ideas suggested to the opponent's registered trade-mark BUFFALO & Design.

Having regard to the foregoing and, in particular, to the degree of resemblance between the applicant's trade-mark BUFFALO and the opponent's registered trade-mark BUFFALO & Design, and considering that the applicant's "packsacks" are similar to the "school bags" covered in the opponent's registration, and considering further that applicant's "packsacks" and the opponent's "school bags" and "pencil pouches" could travel through the same channels of trade, I find that the applicant has failed to meet the legal burden on it of satisfying the Registrar that there would be no reasonable likelihood of confusion between its trade-mark BUFFALO as applied to "packsacks" and the opponent's registered trade-mark BUFFALO & Design covering school bags and pencil pouches. As a result, the applicant's trade-mark BUFFALO is not registrable as applied to "packsacks" in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

The third ground relates to the applicant's entitlement to registration of the trade-mark BUFFALO, the opponent relying on its prior use of its trade-mark BUFFALO & Design in Canada. While the opponent has not specifically identified the wares associated with its trade-mark in its non-entitlement ground, paragraph 2 of the statement of opposition refers to the opponent's use of its trade-mark BUFFALO & Design in association with school bags. While the Fonfeder affidavit establishes that the opponent has used its trade-mark BUFFALO & Design in Canada in association with pouches and briefcases prior to the applicant's filing date, it has failed to show that it had previously used its trade-mark BUFFALO & Design in association with wares which the average consumer would consider as being "school bags". The opponent has therefore failed to meet the

burden on it under Subsections 16(5) and 17(1) of the *Trade-marks Act* of showing that it has previously used its trade-mark in Canada in association with “school bags”. As a result, this ground of opposition is unsuccessful.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application as applied to “packsacks”. In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a decision in which the Registrar refuses only certain of the wares covered in an application such as the present.

DATED AT HULL, QUEBEC THIS 27th DAY OF NOVEMBER, 2000.

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