

IN THE MATTER OF AN OPPOSITION  
by Danica Imports Ltd. to application No.  
639,673 for the mark DANICA INTERNATIONAL  
INC. & Design filed by Danica International Inc.

On September 1, 1989, Danica International Inc. filed an application to register the mark DANICA INTERNATIONAL INC. & Design, illustrated below, based on intended use of the mark in Canada.

The applicant was advised at the examination stage that, among other things, its mark was considered to be confusing with several registered marks. It appears from the file record that the applicant then submitted a revised application, dated January 25, 1990, overcoming the examiner's objections. However, the examiner subsequently raised further objections based on two pending applications for the marks DANICA and DANICA & Design, application Nos. 643,800 and 643,801, respectively (the word DANICA is underlined in the design mark). It appears from the record that the subject application was amended a second time (the date of the second amendment is not indicated) to overcome the examiner's further objections. The subject application, covering the wares and services shown below, and disclaiming the word INTERNATIONAL apart from the mark as a whole, was advertised for opposition purposes on August 22, 1990:

clothing namely, T-shirts, sweatsuits, skirts, dresses, sweaters,  
pants, lingerie, jackets, fashion accessories namely scarves

operation of an import agency; operation of a real estate  
brokerage; operation of a business dealing in the retail and  
wholesale sale of clothing.

Danica Imports Ltd. filed a statement of opposition on December 18, 1990, and subsequently filed a revised statement to overcome objections raised by this Board. A copy of the amended statement of opposition was forward to the applicant on July 8, 1992. The grounds of opposition are summarized below:

(1) the applicant is not entitled to register the mark DANICA INTERNATIONAL INC. & Design, pursuant to Sections 16(3)(a) and (b), because the applied for mark is confusing with

(a) the opponent's marks namely DANICA and DANICA & Design previously used by the opponent, since at least as early as June 1980, in association with a variety of wares including

clutch bags, tote bags, back packs, satchels, briefcases,  
various desk top accessories, parlour and board games,  
beach accessories including travel bags, sun visors, and  
belt bags,

and in association with the operation of stores dealing in the distribution of the above wares,

(b) the opponent's trade-mark application Nos. 643,800 and 643,801 for its above mentioned marks,

(2) the applied for mark is not distinctive of the applicant's wares and services,

(3) the application is not in compliance with Section 30(i) in that the applicant could not have been satisfied as to its entitlement to use the applied for mark.

The applicant filed and served a form of counter statement which I am taking as a general denial of the opponent's allegations. The opponent did not file any evidence in support of its opposition. The applicant filed as its evidence a document, dated April 5, 1993, which is neither an affidavit nor a statutory declaration and which I have therefore disregarded. As might be expected, the opponent did not attempt to file evidence in reply. The applicant attempted to file further evidence without regard to the rules and practice governing opposition proceedings; that evidence was returned to the applicant and does not form part of the record (see the Board ruling dated January 31, 1994). Consequently, there is no evidence of record from either party. Only the applicant filed a written argument and neither party requested an oral hearing.

The ground of opposition denoted by 1(a) above, and the grounds of opposition denoted by (2) and (3) above as pleaded in the statement of opposition, are based on the opponent's use of its marks DANICA and DANICA & Design. As there is no evidence showing that the opponent has in fact used its marks, the above grounds of opposition are rejected.

The remaining ground of opposition, denoted by 1(b) above, is based on the opponent having filed trade-marks application Nos. 643,800 and 643,801 prior to the applicant's filing date namely, September 1, 1989. As the opponent has not evidenced its applications, I have exercised my discretion, in the public interest, to review the above-mentioned application files relied on by the opponent: see Royal Appliances Mfg. Co. v. Iona Appliances Inc. (1990), 32 C.P.R.(3d) 525 at 529

(TMOB). I have determined that application Nos. 643,800 and 643,801 were filed by the opponent on November 2, 1989 (the marks were registered on September 18 and September 4, 1992, respectively), that is, after the applicant filed its application. The ground of opposition denoted by 1(b) above is therefore rejected.

In view of the above, the opponent's opposition is rejected.

I would add that the outcome of this proceeding, in the absence of evidence from the opponent, would likely have been the same even if the opponent had amended its statement of opposition to rely on its trade-mark registrations which issued from application Nos. 643,800 and 643,801. In this regard, the distinctive design features of the applied for mark and the differences in the parties' wares and services would have weighed in the applicant's favour.

DATED AT HULL, QUEBEC, THIS 30<sup>TH</sup> DAY OF SEPTEMBER ,1994.

Myer Herzig,  
Member,  
Trade-marks Opposition Board.