

**IN THE MATTER OF AN OPPOSITION
by Woolworth Canada Inc. to application
No. 690,162 for the trade-mark THE SHOE
COMPANY & Design filed by Town Shoes Limited**

On September 24, 1991, the applicant, Town Shoes Limited, filed an application to register the trade-mark THE SHOE COMPANY & Design (illustrated below) for "retail shoe store services" and for the following wares:

shoes, boots, slippers, shoe clasps and bows, shoe care products, namely creams, waxes and liquids used for polishing, preserving, waxing or waterproofing leather, vinyl or fabric and luggage.

The application is based on use in Canada since September 18, 1991 for the services and on proposed use for the wares. The application as filed included a disclaimer to the word SHOE. The application was advertised for opposition purposes on July 22, 1992.

The opponent, Kinney Canada Inc. (now Woolworth Canada Inc.), filed a statement of opposition on October 13, 1992, a copy of which was forwarded to the applicant on November 23, 1992. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Trade-marks Act because it is clearly descriptive of the character or quality of the applicant's wares and services. The second ground of opposition is that the applied for trade-mark is not distinctive because it is clearly descriptive of the character or quality of the applicant's wares and services and the design features in the mark are insufficient to make the mark distinctive.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Kassandra Heroux and Ruth Palazzolo. The applicant did not file evidence.

Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

In her affidavit, Ms. Heroux states that she began working with the opponent Kinney Canada Inc. on August 25, 1986. Appended to her affidavit are photocopies of the 1992 and 1993 Retail Buyers' Guide from a publication identified as Canadian Footwear Journal. Ms. Heroux gives no particulars about that publication. She doesn't indicate what the publication is, where it is published, where it is distributed, what the listings in the Buyers' Guides signify, etc. Thus, I can give little weight to the materials appended to Ms. Heroux' affidavit. To the extent I have considered those materials, they appear to list various Canadian and American companies and businesses that manufacture, import or distribute footwear and related products. There is no indication that any of those businesses operate retail shoe stores under their listed names.

In her affidavit, Ms. Palazzolo states that she requested a "Nuans search report for Shoe Company." She didn't indicate what a Nuans search is, who conducted the search and what the search results mean. Thus, I can give little weight to that evidence. Ms. Palazzolo as exhibits to her app appended certified copies of three Canadian registrations for trademarks which include the words SHOE COMPANY and are registered for services similar to the applicant's. However, she did not evidence any use of those marks in Canada. Thus, I cannot conclude that there has been common adoption of those words in the shoe retailing sector.

Ms. Palazzolo also appended to her affidavit photocopies of two pages from something called Canadian Trade Index. She didn't indicate what that index is, who compiles it, who receives it, etc. Thus, I can give little weight to that evidence. I would note, however, that the index appears to list shoe manufacturers rather than shoe retailers. Finally, Ms. Palazzolo appended several excerpts from telephone directories for Montreal, Ottawa, Toronto and Vancouver, the excerpt from each city showing one entry which includes the words SHOE(S) CO. However, the Montreal and Vancouver listings appear to be for shoe manufacturers.

As for the first ground of opposition, Section 12(1)(b) of the Act reads as follows:

12. (1) Subject to section 13, a trademark is registrable if it is not...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.... (emphasis added)

The material time for considering the circumstances respecting this issue is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

As discussed, the opponent's evidence either can be given little weight or it does little to advance the opponent's case. The most that I can conclude from that evidence is that there may be some shoe manufacturing, importing or distributing businesses in Canada that have the words "shoe company" or the like in their names. The evidence regarding possible use of such names by shoe retailers is minimal.

Notwithstanding the weakness of the opponent's evidence, I find that the opponent has met its evidential burden in respect of the applicant's services simply by reference to standard dictionary definitions. In light of those definitions, the ordinary meaning of the applicant's trade-mark THE SHOE COMPANY & Design is a commercial enterprise dealing in shoes. That meaning, in my view, clearly describes the character of the applicant's services, namely the operation of a retail shoe store. As for the applicant's wares, however, the trade-mark THE SHOE COMPANY & Design does not point to any specific character or quality of those

wares. It is arguable that it describes the place of origin of those wares (in line with the opposition decision in Jordan & Ste-Michelle Cellars Ltd. v. T.G. Bright & Co. Ltd. (1982), 72 C.P.R.(2d) 263) but the opponent did not specifically plead such a ground.

In view of the above, I find that the opponent's first ground of opposition is successful in relation to the applicant's services but is unsuccessful in relation to the proposed wares. As for my former finding, the applicant's position is that there is sufficient design matter in its mark to render it registrable even if the words THE SHOE COMPANY are clearly descriptive. I disagree. When the mark is viewed, the design element is so minor that it adds no distinctive element to the mark. However, even if I am wrong in that finding, it should be noted that Section 12(1)(b) of the Act also prohibits the registration of trade-marks that are clearly descriptive when sounded and the only way that consumers would sound the applicant's mark for retail shoe store services is by using the clearly descriptive words THE SHOE COMPANY.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition. The onus or legal burden is on the applicant to show that its applied for trade-mark actually distinguishes or is adapted to distinguish its wares from those of others throughout Canada. There is, however, an evidential burden on the opponent to prove his supporting allegations of fact. Given that the second ground is entirely dependent on my findings respecting the first ground, the disposition of the second ground is the same as that for the first.

In view of the above, I refuse the applicant's application for "retail shoe store services" and I otherwise reject the opposition.

DATED AT HULL, QUEBEC, THIS 18th DAY OF DECEMBER, 1995.

**David J. Martin,
Member,
Trade Marks Opposition Board.**