

IN THE MATTER OF AN OPPOSITION
by Conroe Corporation to application No.
695,588 for the mark FUNSTIK filed by
Lepage's Limited

On December 13, 1991, the applicant, Lepage's Limited, filed an application to register the mark FUNSTIK, based on intended use in Canada, for the wares "adhesives namely, glue in stick form."

The application was advertised for opposition purposes in the Trade-marks Journal issue dated July 15, 1992. The opponent, Conroe Corporation, filed a statement of opposition on September 21, 1992, a copy of which was forwarded to the applicant on October 28, 1992. The applicant responded by serving and filing a counter statement.

The first ground of opposition, pursuant to Sections 38(2)(c) and 16(3)(a) of the Trade-marks Act, is that the applicant is not the person entitled to registration in view of the opponent's prior use of its registered mark KIDS STIK, regn. No. 386,945, for glue in stick form "and the Opponents [sic] proposed trade-mark WRAP-IT STIK for which a notice of allowance has been issued under Application No. 673,739."

The second ground of opposition, pursuant to Section 38(2)(d), is that the applied for mark FUNSTIK is not adapted to distinguish the applicant's wares from the opponent's wares sold under its marks.

The third ground of opposition is that the application does not comply with the requirements of Section 30(i) in that the applicant knew or ought to have known, at the date of filing the application, of the opponent's marks KIDS STIK and WRAP-IT STIK and therefore the applicant could not have been satisfied that it was entitled to use the mark FUNSTIK for glue in a stick form.

I note in passing that the opponent did not plead that the applied for mark is not registrable, pursuant to Section 12(1)(d), in view of the opponent's registered mark KIDS STIK nor did the opponent rely on its trade-mark application No. 673,739 to plead that, pursuant to Section 16(3)(b), the applicant was not entitled to register the mark FUNSTIK.

The opponent did not file any evidence in support of its opposition. The applicant's evidence consists of the affidavit of Maria Teresita Fernando, Senior Legal Secretary with the firm representing the applicant. Her affidavit serves to introduce into evidence, by way of exhibits, (i) searches on the trade-marks register for marks in which the term STICK or STIK appears as a component (ii) a photograph of packaging for the applicant's wares showing the mark FUNSTIK (iii) invoices showing sales of the applicant's adhesive product sold under the mark FUNSTIK. Only the applicant filed a written argument and only the applicant was represented at an oral hearing.

As for the first ground of opposition raising the issue of prior entitlement, in view of the provisions of Sections 16(3) and 16(5) of the Act, it was incumbent on the opponent to evidence the use of its trade-marks prior to the applicant's filing date and to show that one, or both, of its marks were not abandoned as of the applicant's date of advertisement (- July 15, 1992). The opponent has not satisfied any of these requirements and therefore the first ground of opposition must be rejected.

With respect to the second ground of opposition alleging non-distinctiveness, it was incumbent on the opponent to evidence either use of, or a reputation for, at least one of its marks in Canada. The opponent has not satisfied any of these requirements and therefore the second ground of opposition must be rejected.

With respect to the third ground of opposition, there is no evidence that the applicant was aware of the opponent's trade-marks prior to filing the present application. In any event, even had the applicant been aware of the opponent's marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant is entitled the use its mark FUNSTIK in Canada [see *The Information Technology Association of Canada v. Siemens Aktiengesellschaft*, January 10, 1996, re application No. 622,588 for the mark ITAC, yet unreported, (TMOB)].

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

The result would not have been any different had the opponent pleaded Sections 12(1)(d) and/or 16(3)(b). In regard to the former, the applicant's state of the trade-mark register evidence shows numerous marks containing the component STIK, or its phonetic equivalent, for adhesives.

DATED AT HULL, QUEBEC, THIS 15th DAY OF February, 1996.

Myer Herzig,
Member,
Trade-marks Opposition Board