

**IN THE MATTER OF AN OPPOSITION by
Wolverine World Wide, Inc. to application
No. 724,424 for the trade-mark ADVENTURE
PEGABO & Design filed by Chaussures Aldo
Inc./Aldo Shoes Inc., sometimes trading as
Chaussures Pegabo/ Pegabo Shoes**

On March 11, 1993, the applicant, Chaussures Aldo Inc./Aldo Shoes Inc., sometimes trading as Chaussures Pegabo/Pegabo Shoes, filed an application to register the trade-mark ADVENTURE PEGABO & Design, illustrated below.

The application is based on proposed use in Canada in association with the following wares

men's, women's and children's footwear, namely: shoes, boots, sandals, slippers; men's and women's accessories, namely: handbags, purses, wallets, belts; men's and women's leather apparel, namely: jackets, coats, pants and skirts.

The subject application was advertised for opposition purposes in the Trade-marks Journal dated December 15, 1993 and was opposed by Wolverine World Wide, Inc. on March 23, 1994. A copy of the statement of opposition was forwarded to the applicant on April 26, 1994. The applicant responded by filing and serving a counter statement.

The first ground of opposition, pursuant to Section 12(1)(d) of the Trade-marks Act, is that the applied for mark is not registrable because it is confusing with the opponent's registered mark WOLVERINE & Design, illustrated below, used in association with footwear and with various items of clothing and accessories.

registration No. 402,114

The second ground of opposition is that the applicant is not entitled to register the applied for mark, pursuant to Section 16(3)(a), in view of the opponent's prior use of its above-mentioned mark WOLVERINE and Design. The third ground, pursuant to Section 16(3)(c), alleges that the applicant is not entitled to register the applied for mark because it is confusing with opponent's previously filed (on February 11, 1992) trade-mark application No. 698,574 for the mark WORLD ADVENTURE FOOTWEAR, covering footwear, various items of clothing and accessories. I note that application No. 698,574 was pending as of December 15, 1993 (the date of advertisement of the subject application) and was registered on July 8, 1994 under No. 430,148.

The fourth and final ground of opposition alleges that the applied for mark is not distinctive of the applicant's wares. In this regard, the opponent contends that:

The applicant's trade-mark is a combination of the trade-marks of the opponent. The applicant has utilized virtually the identical shape of the opponent's mark as registered under No. 402,114, and taken a distinctive word from the opponent's allowed application for WORLD ADVENTURE FOOTWEAR to construct a trade-mark. The applicant's wares would appear for sale in the same type of retail outlets as the opponent's and would be of interest to the same class of consumers, thus, making it impossible for the applicant's trade-mark to distinguish the [applicant's] wares from those of the opponent.

The opponent's evidence consists of the affidavit of Blake W. Krueger, General Counsel and Secretary of the opponent company; of certified copies of its above mentioned trade-mark registrations; and of a certified copy of the opponent's application No. 757,508 for the mark WORLD ADVENTURE FOOTWEAR & APPAREL (filed on June 22, 1994 and based on use in Canada since January 1, 1993), which mark was not pleaded in the statement of opposition. Mr. Krueger refers to registration No. 402,114 as WOLVERINE & SUN DESIGN and I will do likewise. The applicant's evidence consists

of the affidavit of David Martz, Secretary of the applicant company, and the affidavit of Louise Gendron, a trade-mark agent.

The determinative issue in this proceeding is whether the applied for mark is confusing with one, or both, of the opponent's marks pleaded in the statement of opposition namely, WOLVERINE & SUN DESIGN and WORLD ADVENTURE FOOTWEAR. In accordance with the clear wording in Section 16(3), the material time for considering the issue of confusion in respect of entitlement to registration is the date that the subject application was filed namely, March 11, 1993. As the opponent's case is strongest at the earliest material date, that is, before the applicant began to use the applied for mark, I will consider the issue of confusion, arising pursuant to Section 16(3), at the material date March 11, 1993.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark ADVENTURE PEGABO & Design and either of the opponent's marks WOLVERINE & SUN DESIGN and WORLD ADVENTURE FOOTWEAR. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight.

The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), C.P.R.(3d) 308 (F.C.T.D).

The exhibit material attached to Mr. Krueger's affidavit shows that the opponent uses its above-mentioned marks in the following forms:

Form 1

Form 2

Form 3

The mark WOLVERINE & SUN DESIGN is a prominent component of Forms 2 and 3 and I therefore consider that their use qualifies as use of WOLVERINE & SUN DESIGN *per se*. However, I do not consider that the opponent has demonstrated any use of the mark WORLD ADVENTURE FOOTWEAR *per se*. Nevertheless, the opponent's use of Forms 2 and 3 may be taken into account as relevant surrounding circumstances.

The opponent's mark WOLVERINE & SUN DESIGN possesses a fair degree of inherent distinctiveness since there is no connection between the word WOLVERINE, or the SUN DESIGN feature, and the wares sold under the composite mark namely, footwear and clothing. The opponent's sales in Canada under its mark WOLVERINE & SUN DESIGN has totalled about \$31.5 million for the period 1987-1992 while advertising in connection with the mark for the same period totalled about \$1.46 million. As best as I can determine from Mr. Krueger's affidavit and exhibit material, about 40% of sales were under the mark shown in Form 2, and the majority of sales and advertising were in relation to footwear. Thus, I am able to conclude that by the material date the opponent's mark WOLVERINE & SUN DESIGN had acquired a significant reputation in Canada in association with shoes and, to a lesser extent, in association with clothing. The

applied for mark possesses a fairly high degree of inherent distinctiveness owing to the invented word component PEGABO. While the applied for mark itself would not have acquired any distinctiveness at the material date, it is a relevant surrounding circumstance that the applicant was operating some fifty retail outlets for footwear and clothing, under the trade-name CHAUSSURES PEGABO/ PEGABO SHOES, prior to the material date: see paragraphs 8,13, and 14 of Mr. Martz' affidavit. On a fair reading of Mr. Martz' affidavit as a whole, and in the absence of cross-examination, I am prepared to extrapolate post 1993 sales (about \$92 million from December 1993 to June 1995) and advertising under the trade-name CHAUSSURES PEGABO/ PEGABO SHOES backward in time to conclude significant sales and advertising under the trade-name for at least five years prior to the material date. Thus, I am able to conclude that, as of the material date March 11, 1993, the public was familiar with the word component PEGABO used in association with retail stores selling shoes and clothing.

The opponent has been using its mark WOLVERINE & SUN DESIGN in Canada since 1987 and this fact, taken in isolation, favours the opponent. However, the applicant has been using its trade-name CHAUSSURES PEGABO/ PEGABO SHOES in Canada since about 1980. Considering that the most distinctive component of the applied for mark is the word component PEGABO, the applicant's use of its trade-name mitigates the opponent's advantage in the length of time that the marks in issue have been in use. The nature of the parties' wares are essentially the same and therefore I must consider that the parties' channels of trade could potentially overlap. In this regard, while the applicant has to date sold its wares exclusively through its own retail outlets (as discussed above), there is no such restriction in the description of wares in the subject application. Thus, the applicant would have the option to market its wares in any manner available to it, that is, through retail outlets which might also sell the opponent's wares. There are some points of similarity between the applied for mark and the marks used by the opponent namely,

the generally rectangular and semi-circle design shapes and the word ADVENTURE (comprising part of the phrase WORLD ADVENTURE in Form 2). However, Ms. Gendron's evidence of the state of the trade-marks register supports, to some extent, the applicant's contention that the above components are not uncommon for marks used in association with clothing, thus lessening the significance of the similarities between the marks in issue. In any event, in my view any similarities between the opponent's mark WOLVERINE & SUN DESIGN and the applicant's mark ADVENTURE PEGABO & Design are outweighed by the disparity in their main word components namely, WOLVERINE and PEGABO. Similarly, the component PEGABO distinguishes the applicant's mark from the opponent's mark WORLD ADVENTURE FOOTWEAR.

In view of the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark is not confusing with any of the opponent's marks at the material date March 11,1993. For essentially the same reasons as above, I find that the applied for mark is not confusing with any of the opponent's marks at later material dates in respect of the remaining grounds of opposition.

The opponent's opposition is therefore rejected.

DATED AT HULL, QUEBEC, THIS 8th DAY OF MAY, 1997.

Myer Herzig,
Member,
Trade-marks Opposition Board