

IN THE MATTER OF AN OPPOSITION  
by Majdell Manufacturing Company  
Limited / Les Fabricants Majdell  
Compagnie Limitee to application  
No. 570,092 for the trade-mark  
BAD BOY CLUB & Design filed by  
Life's A Beach, Inc.

On September 30, 1986, the applicant, Life's A Beach, Inc., filed an application to register the trade-mark BAD BOY CLUB & Design (illustrated below) based on use and registration in the United States for the following wares:

men's and women's clothing, namely shirts,  
pants, jackets, shorts, t-shirts, hats and  
visors.

The effective filing date of the application is April 4, 1986 based on the filing date of the corresponding United States application. The Canadian application was amended to include a disclaimer to the word BOY and was subsequently advertised for opposition purposes on September 7, 1988.

The opponent, Majdell Manufacturing Company Limited / Les Fabricants Majdell Compagnie Limitee, filed a statement of opposition on September 29, 1988, a copy of which was forwarded to the applicant on October 21, 1988. The opponent was subsequently granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition. The sole ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks BAD BOYZ COMPANY and LES BAD BOYS used in Canada in association with "boys' tops, pants and combinations thereof."

The applicant filed and served a counter statement. The applicant was subsequently granted leave to file a revised counter statement. As its evidence, the opponent filed the affidavit of Beth Majdell and a certified copy of the Trade-marks Office file for application No. 563,664. As its evidence, the applicant filed the affidavit of Brian Simo. Neither party filed a written argument and no oral hearing was conducted.

The material time for considering the circumstances respecting the sole ground of opposition is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show that its trade-mark is adapted to distinguish, or actually distinguishes, its wares from those of others throughout Canada. However, there is an evidential burden on the opponent to adduce evidence in support of the allegations of fact underlying its ground.

In the present case, the opponent has only evidenced use of its trade-mark LES BAD BOYS. Thus, the opponent's ground is restricted to a consideration of the issue of confusion between that mark and the applicant's mark. In applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

Both marks are inherently distinctive. The opponent has effected some sales of clothing items for boys in association with its trade-mark throughout Canada. The applicant has had limited sales of its clothing wares in Canada in association with its mark, primarily in the Vancouver area.

The length of time the marks have been in use is not a significant factor in this case. The wares of the parties are very similar and presumably the trades of the parties could overlap. The marks themselves bear a relatively high degree of phonetic similarity and a fair degree of visual similarity. Insofar as both marks incorporate the words BAD BOY or BAD BOYS, they suggest the same idea.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's mark LES BAD BOYS. Thus, the applicant has also failed to show that its mark is distinctive throughout Canada. The sole ground of opposition is therefore successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF April, 1991.

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