

IN THE MATTER OF AN OPPOSITION by Munsingwear, Inc. to application No. 542,002 for the trade-mark PINGOUIN filed by Prouvost S.A.

On May 14, 1985, the applicant, Prouvost S.A., filed an application to register the trade-mark PINGOUIN based upon use and registration of the trade-mark in France in association with

"fils fabriqués en matières textiles naturelles ou artificielles; articles d'habillement tricotés, nommément: vestes, manteaux, costumes, robes, gilets, pantalons, pull-overs, cardigans, jupes, cravates, gants, bas, chaussettes, collants, tapis, tapisseries".

The opponent, Munsingwear, Inc., filed a statement of opposition on December 28, 1988 in which it alleged that the applicant is not the person entitled to registration for the knitwear covered in the applicant's application in that the applicant's trade-mark is confusing with the opponent's trade-mark Penguin Design or a variant thereof which had been previously used in Canada. The second ground of opposition is that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-mark Penguin Design, registration No. 261,104. The final ground of opposition is that the applicant's trade-mark is not distinctive in that "it does not actually distinguish the Applicant's wares from the wares of others including those of the Opponent and its registered user and those of the Applicant's franchisees or licensees who are not recorded as registered users". In respect of this ground, the opponent further alleged that the applicant had allowed its trade-mark to be used in Canada in association with at least some of the listed wares by the applicant's franchisees, licensees, or other parties who are not recorded as registered users of the mark.

The applicant served and filed a counter statement in which it asserted that its trade-mark is registrable and distinctive, and that it is the person entitled to its registration.

The opponent filed as its evidence the affidavits of Cecilia M. Hageman, Karen B. A. Astaphan, Lochiel Cameron and Aubrey Hughes. Both Mr. Hughes and Mr. Cameron were cross-examined on their affidavits. The transcript of the Cameron cross-examination forms part of the record in this opposition although there is no record in the Office file that the transcript of the Hughes cross-examination was ever filed by the applicant. Further, the applicant requested that orders for cross-examination be issued in respect of the affiants Astaphan and Hageman although the applicant does not appear to have proceeded with these cross-examinations.

The applicant elected not to file any evidence in support of its application.

The opponent alone submitted a written argument and both parties were represented at an oral

hearing.

Considering initially the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538 (TMOB)). In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including, but not limited to, the criteria which are specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the material date.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark PINGOUIN as applied to the applicant's wares and the opponent's registered trade-mark Penguin Design as applied to the wares covered in the opponent's registration are inherently distinctive.

As no evidence has been adduced by the applicant, I must conclude for the purposes of deciding the outcome of this opposition that its trade-mark PINGOUIN has not become known to any extent in Canada in respect of any of the wares covered in its application. On the other hand, the opponent's evidence supports the conclusion that its trade-mark Penguin Design has become known in Canada in association with sports shirts. Likewise, the length of time that the trade-marks at issue have been in use favours the opponent in this opposition. In this regard, the Cameron affidavit attests to use of the trade-mark Penguin Design in Canada in association with sports shirts since at least as early as 1960.

The applicant's various knitted garments covered in its application are similar to the opponent's sports shirts and walking shorts covered in registration No. 261,104 in that these wares fall into the general class of items of clothing. On the other hand, I consider there to be little similarity between the applicant's threads, carpets and wall coverings and the opponent's wares. In La Lainière de Roubaix v. Stanfield's Ltd., 62 C.P.R. (2d) 217, the following comments were made with respect to the wares and channels of trade at issue in that case:

"The wares associated with the applicant's trade mark, namely, sports shirts and walking shorts, are not related to threads or yarns and the channels of trade associated with such wares are not, in my opinion, overlapping."

Further, as the knitted garments of the applicant and the sports shirts and walking shorts of the opponent are similar, the channels of trade associated with these wares would or could overlap.

There is no similarity in appearance between the trade-marks Penguin Design and PINGOUIN. As the opponent's trade-mark would be identified by the average consumer orally as a penguin or, in the French language, as pingouin, the trade-marks at issue are similar in sounding, as well as being identical in the ideas suggested by them.

In view of the above, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark PINGOUIN as applied to the knitted garments covered in its application and the opponent's registered trade-mark Penguin Design. On the other hand, I do not consider that there would be any reasonable likelihood of confusion between the applicant's trade-mark as applied to "fils fabriqués en matières textiles naturelles ou artificielles; tapis, tapisseries" and the opponent's registered trade-mark Penguin Design.

The opponent has relied upon the Astaphan and Hageman affidavits in respect of its non-distinctiveness ground of opposition. However, the Astaphan affidavit relates to a purchase of a sweater made by the affiant in a PINGOUIN store located in Toronto in September of 1989. A photocopy of the sweater annexed as Exhibit "A" to the Astaphan affidavit includes a label bearing a PINGOUIN & Design trade-mark and the wording "Fait main en Fil à tricoter". However, this evidence is of little relevance as the material date in respect of this ground of opposition is the date of opposition (December 28, 1988). As well, the label attached to the sweater identifies the sweater as having been hand made from PINGOUIN & Design yarn, as opposed to distinguishing PINGOUIN & Design sweaters from sweaters of other manufacturers. In any event, the determination of the issue of confusion between the applicant's trade-mark and the opponent's registered trade-mark effectively decides this issue as I have already concluded that the applicant's trade-mark is not registrable under Section 12(1)(d) in relation to the knitted clothing identified in the applicant's application.

In view of the above, I refuse the applicant's application as applied to knitted garments in view of the provisions of Section 12(1)(d) of the Trade-marks Act and otherwise reject the opponent's opposition to registration of the trade-mark PINGOUIN as applied to "fils fabriqués en matières textiles naturelles ou artificielles; tapis, tapisseries". In this regard, I would note the decision of the Federal Court, Trial Division in Produits Ménagers Coronet Inc. v. Coronet-Werke

Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC THIS 23rd DAY OF December, 1992.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.