

IN THE MATTER OF AN OPPOSITION
by Canada Games Company Limited
to application No. 617,832 for
the trade-mark YOS filed by
Llumar Star Kites Inc.

On October 25, 1988, the applicant, Llumar Star Kites Inc., filed an application to register the trade-mark YOS for "groved [sic] double disk returning string toy" based on proposed use in Canada and on use and registration (No. 1,534,484) in the United States. The applicant claimed priority based on its corresponding United States application and the effective filing date of the present application is therefore August 30, 1988. The application was advertised for opposition purposes on January 31, 1990.

The opponent, Canada Games Company Limited, filed a statement of opposition on May 31, 1990, a copy of which was forwarded to the applicant on June 14, 1990. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(i) of the Trade-marks Act. The opponent alleges that the applicant could not have been satisfied that it was the person entitled to use the applied for trade-mark in view of the applicant's prior knowledge of the opponent's various trade-marks comprising or including the word YO-YO.

The second ground of opposition is that the applied for trade-mark is not registrable because it is confusing with various registered trade-marks of the opponent comprising or including the word YO-YO. The most pertinent of the opponent's registrations is No. UCA24465 for the trade-mark YO-YO for "toys and games." (The registration was erroneously identified by its application number in the statement of opposition.)

The third ground of opposition is that the applicant is not the person entitled to registration in that, as of the applicant's effective filing date, the applied for trade-mark was confusing with the opponent's various registered trade-marks which had previously been used and made known in Canada by the opponent and with the opponent's trade-marks MEGA YO-YO and YO-YO for which applications had previously been filed. The fourth ground of opposition is that the applied for trade-mark is not distinctive in view of the opponent's use of its various trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Richard E. Albert and Benjamin J. Trister. As its evidence, the applicant filed the affidavits of Mark F. Walker and Frank Alonso and two affidavits of Kevin L. Wright. Both parties filed a written argument but no oral hearing was conducted.

As for the first ground of opposition, the opponent's allegations of fact do not support a ground of opposition of non-compliance with Section 30(i) of the Act. The mere fact that the applicant may have been aware of the opponent's trade-marks did not, by itself, preclude the applicant from stating that it believed that it was entitled to use its applied for mark. The first ground of opposition is therefore unsuccessful.

As for the second ground of opposition, as noted above, the most pertinent of the opponent's registrations is No. UCA24465 for the trade-mark YO-YO. Thus, a consideration

of the issue of confusion between that mark and the applicant's mark will effectively determine the outcome of the second ground. The material time for considering the circumstances respecting the issue of confusion arising pursuant to Section 12(1)(d) of the Act is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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.

As for Section 6(5)(a) of the Act, the second Wright affidavit establishes that the word "yo-yo" is the name of a particular type of string toy. Appended to Mr. Wright's second affidavit are photocopied excerpts from eleven different dictionaries (including two Canadian dictionaries) which include definitions of the word "yo-yo." For example, Funk & Wagnalls Canadian College Dictionary contains the following definition:

A wheellike toy with a string wound about
it in a deep groove, commonly attached to
the operator's finger and spun up and down
by manipulating the string. [Origin unknown]

The other dictionary definitions are similar to the above although most indicate that the word "yo-yo" was formerly a trade-mark and two definitions state that the word had its origins in the Philippines as the name of a toy.

The second Wright affidavit also evidences a number of references in newspapers and magazines to the word "yo-yo" as a type of toy or as a term used to describe an activity characterized by repeated ups and downs such as "yo-yo dieting." Mr. Wright also purchased several wheellike string toys manufactured by others, each of which is labelled as a "yo-yo." Mr. Walker purchased a kit for making "yo-yos."

The opponent contends that most of the publications relied on by the applicant are printed in the United States and that the opponent does not claim any rights for its trade-mark YO-YO in that country. Although the opponent's contention is correct, it is also true that some of the publications are Canadian in origin and many of the American publications are circulated in Canada.

The opponent also contends that it has taken active steps to police its trade-marks and the Albert affidavit evidences various actions the opponent has taken to stop other traders from using the trade-mark YO-YO to describe their wheellike string toys. Notwithstanding the opponent's vigilance, the applicant's evidence shows that other traders continue to use the word "yo-yo" generically to describe a particular type of toy. The opponent did not file evidence in reply to answer the applicant's evidence on point.

As noted by the applicant in its written argument, the opponent's own product labelling is further support for the contention that the word "yo-yo" is the name of the wares. The opponent's product labelling and sales literature refer to YO-YO tops. However, the opponent's product is not a top since a top is a tapered cylindrical or conoidal spinning toy. This suggests that the opponent itself has been unable to come

up with an accurate descriptor for its wares other than the word "yo-yo."

Although the opponent's registration covers "toys and games", the opponent has only evidenced use of its registered trade-mark for yo-yos. Thus, insofar as the registration covers such wares, the trade-mark possesses no inherent distinctiveness since it is the name of the wares. Insofar as the registration covers other toys and games, the trade-mark YO-YO lacks inherent distinctiveness since it would be misdescriptive of such wares. As noted by the opponent, the validity of its registration is not in issue in this proceeding: see Sunshine Biscuits, Inc. v. Corporate Foods Ltd. (1982), 61 C.P.R.(2d) 53 at 62 (F.C.T.D.). However, the evidence of record establishes that the opponent's mark is not inherently distinctive and therefore its registration must be restricted to a narrow ambit of protection.

The opponent has evidenced some sales for its YO-YO product for the period 1988 to 1990. This would suggest that the opponent's trade-mark has acquired at least some distinctiveness in fact when used with yo-yos. However, since the mark is the name of the wares, it would seem just as likely (if not more likely) that purchasers of the opponent's product would not ascribe any trade-mark significance to the opponent's use of YO-YO. Thus, any acquired distinctiveness associated with the opponent's registered mark would appear to be minimal.

The applicant's trade-mark YOS possesses at least some degree of acquired distinctiveness. Mr. Alonso, in his affidavit, states that he derived his company's mark from the exclamation "yo." However, I doubt that the average consumer would perceive the applicant's mark to be the plural form of that word. If the average consumer gives any meaning to the mark when used with the applied for wares, I expect that he or she might view it as the second component of the word yo-yos. There being no evidence of use of the applicant's mark, I must conclude that it has not become known at all in Canada.

The length of time the marks have been in use favors the opponent. The applicant's wares fall within the scope of the statement of wares in the opponent's registration and are identical to the wares actually sold by the opponent in association with its trade-mark. Presumably the trades of the parties would be the same.

As for Section 6(5) (e) of the Act, I consider there to be some visual and phonetic resemblance between the marks of the parties. The applicant's mark is the plural form of either component of the opponent's mark. There would appear to be no resemblance in the ideas suggested by the marks. The opponent's mark is the name of a toy, namely a yo-yo. The applicant's mark, on the other hand, does not, by itself, suggest any idea in particular.

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, and particularly in view of the inherent weakness of the opponent's mark and the fact that there are at least some differences between the two marks at issue, I find that they are not confusing. The second ground of opposition is therefore unsuccessful.

The remaining grounds of opposition all turn on the same issue as the second ground - i.e. - is the applicant's mark confusing with any of the opponent's marks, the most pertinent of which is the registered mark YO-YO? The only difference is that the material times are earlier respecting the remaining grounds, the material time for the third ground being the effective filing date of the applicant's application and the material time for the fourth ground being the filing of the opposition. If anything, the earlier material time for each of these grounds makes the opponent's case slightly weaker. Thus, I find that the applicant's trade-mark is not confusing with the opponent's previously used trade-mark YO-YO. It therefore also follows that the applicant's mark is not confusing with any of the other marks relied on by the opponent. The remaining grounds are therefore also unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 29th DAY OF APRIL 1994.

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