IN THE MATTER OF AN OPPOSITION by Cluett, Peabody Canada Inc. to application No. 614,564 for the mark SPRINTOR & Design filed by Steven Gellis Sports Inc.

On September 7, 1988, Steven Gellis Sports Inc. filed an application to register the mark SPRINTOR & Design, illustrated below, for the wares

clothing, namely, swimwear, T-shirts, shorts, jackets and pants,

based on use of the mark in Canada since at least as early as January 15, 1987.

An objection was raised at the examination stage that the applied for mark was confusing with the mark SPRINTER, regn. No. 139,045, covering the wares "underwear", standing in the name of Cluett, Peabody Canada Inc. The applicant overcame that objection by deleting all of the wares except

swimwear.

Nevertheless, the Office sent a notice, pursuant to Section 37(3) of the Trade-marks Act, to Cluett, Peabody at its last recorded mailing address. That notice was intended to advise Cluett, Peabody that the subject application was to be advertised in the Trade Marks Journal dated March 14, 1990. However, the notice still in its mailing envelope was returned to the Office as Cluett, Peabody was no longer at its last recorded address. In any event, Cluett, Peabody opposed the subject application on April 17, 1990. A copy of the statement of opposition was forwarded to the applicant on May 4, 1990.

The first ground of opposition is that the application does not comply with Section 30(b) of the Trade-marks Act because the applicant has not used the trade-mark SPRINTOR & Design in Canada in association with swimwear since at least as early as January 15, 1987. The second ground is that the applied for mark is not registrable, pursuant to Section 12(1)(d), because it is confusing with the opponent's above mentioned registered mark SPRINTER. The third ground is that the applicant is not entitled to registration, pursuant to Section 16(1)(a), because at the date on which the applicant first used the applied for mark, it was confusing with the opponent's mark SPRINTER previously used by the opponent in Canada in association with underwear. Lastly, the opponent alleges that the applied for mark

SPRINTOR & Design is not distinctive of the applicant's swimwear in view of the above. The applicant filed and served a counter statement in response.

The opponent's evidence consists the affidavit of its President namely, Philip. C. Turner, and of a certified copy of registration No. 139,045 for the mark SPRINTER. Mr. Turner was cross-examined on his affidavit; the transcript thereof and exhibits thereto, and answers to undertakings and questions taken under advisement, form part of the evidence of this proceeding. The applicant's evidence consists of the affidavit of its President namely, Steven Gellis. The opponent chose not to cross-examine Mr. Gellis. Both parties filed written arguments, however, an oral hearing was not conducted.

The first ground of opposition is that the application does not comply with Section 30(b) of the Trade-marks Act which requires the application to contain the date from which the applicant has used its mark in association with the wares specified in the application. With respect to this ground of opposition, the legal burden or onus is on the applicant to show that its application complies with Section 30(b). That is, the applicant must show that the date of first use alleged is factually correct. The applicant may allege a date of first use later than the actual date of first use, but may not allege a date earlier than the actual date of first use. There is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to establish the facts inherent in its allegation that the applicant's date of first use is incorrect. The presence of an evidential burden on a party with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. The evidential burden on the opponent with respect to Section 30(b) is lighter than in the ordinary case: see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at pp. 298-300 (F.C.T.D.). The presence of the legal burden on a party means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against that party: see Joseph E Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R.(3d) 325 at pp. 329-330 (TMOB). The material time for considering the circumstances respecting the issue of non-compliance with Section 30(b) is the filing date of the application: see Thomas J. Lipton Inc. v. Primo Foods Ltd. (1992), 44 C.P.R.(3d) 556 at p. 560 (TMOB); Georgia-Pacific Corp. v. Scott Paper Ltd. (1984), 3 C.P.R. (3d) 468 at p. 475 (TMOB).

Mr. Gellis throughout his affidavit refers to the trade-mark SPRINTOR rather than to the applied for mark SPRINTOR & Design. In particular, he refers to the trade-mark SPRINTOR as it appears in the following variations:

Exhibit A - 1990 catalog, see front cover

Exhibit B - 1991 catalog, see front cover

Exhibit C - 1992 catalog, see front cover

Exhibit F - advertising poster

I will refer to the above variations simply as "the word mark SPRINTOR" since the script form is intrinsic to the word SPRINTOR: see Canadian Jewish Review Ltd. v. The Registrar of Trade Marks (1961), 37 C.P.R. 89 (Ex. C.). The only occurrence of the applied for mark SPRINTOR & Design (or at least a variant of it) in Mr. Gellis' evidence is on the inside back cover of Exhibit B where it appears together with the word mark SPRINTOR, as shown below:

In his affidavit Mr. Gellis makes no distinction between the word mark SPRINTOR and the applied for mark SPRINTOR & Design. Further, there is no clear description of, or example showing, precisely how the word mark SPRINTOR was used in relation to the wares aside from advertising, that is, did the mark appear on the wares themselves, or on hangtags attached to the wares, or on packaging? The above deficiencies are sufficient, in my view, to

satisfy the opponent's evidential burden with respect to two distinct issues namely, (i) was the word mark SPRINTOR ever used within the meaning of Section 4(1) of the Act? (ii) assuming that the answer to (i) is yes, does such use qualify as use of the mark SPRINTOR & Design for the purpose of supporting the subject application?

With respect to (i) above, Mr. Gellis testifies in paragraph 4 of his affidavit as to the retail value of sales of "swimwear bearing the SPRINTOR trade-mark . . ." In the absence of cross-examination, I am prepared to accept Mr. Gellis' above testimony at face value and find that the word mark SPRINTOR was used in accordance with Section 4(1). That is, I am satisfied that notice of the association between the word mark SPRINTOR and the applicant's swimwear was given at the time of transfer of the property in or possession of the wares in the normal course of trade.

With respect to (ii) above, I am satisfied that the mark SPRINTOR & Design is a variant of the word mark SPRINTOR, that is, I find that the same dominant features are maintained in the design mark, and that the differences between the design mark and the word mark are so unimportant as not to mislead an unaware purchaser. In so finding I have been guided by the decision in Promafil Canada Ltée v. Munsinger Inc. (1992), 44 C.P.R.(3d) 59 at pp. 70-71 (F.C.A.) which endorses the approach that in circumstances such as these a trade-mark user ought to be permitted to change the form of a mark and to retain the benefit of its use of the earlier form. I am aware that Promafil concerned a Section 45 proceeding and is distinguishable from the instant case on that basis. Nevertheless, I see no reason why the notion that "cautious variations [to a trade-mark] can be made without adverse consequences", as discussed in Promafil, ought not to apply to a trade-mark user who is applying to register an updated version of his mark. This does no more than put Canadian applicants on an equal footing with foreign applicants who are permitted to register in Canada a variant of a mark registered abroad so long as the applied for mark differs from the foreign mark " . . . only by elements that do not alter its [the foreign mark's] distinctive character or affect its identity . . .": see Section 14(2) of the Act. In view of the above, the first ground of opposition is rejected.

The remaining grounds of opposition, in the circumstances of this case, turn on the issue of confusion between the applied for mark SPRINTOR & Design and the opponent's mark SPRINTER (i) at the material date January 15, 1987 with respect to the ground of entitlement, (ii) at the material date April 17, 1990 with respect to the ground of distinctiveness, and (iii) at the material date namely, the date of my decision, with respect to the ground of registrability.

I will first consider the issue of confusion arising pursuant to the ground of entitlement at the earliest material date namely January 15, 1987. In view of the provisions of Sections 16(1) and 16(5) of the Act, it is incumbent on the opponent to evidence the use of its trade-mark SPRINTER prior to the applicant's first use and to show that its trade-mark was not abandoned as of the applicant's date of advertisement (i.e. -March 14, 1990). The Turner affidavit satisfies both of these requirements. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion. 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 out in Section 6(5) of the Act.

The opponent's mark SPRINTER does not possess a high degree of inherent distinctiveness because the mark suggests that the opponent's wares are suitable for athletes or runners. The applied for mark possesses a greater degree of inherent distinctiveness than the opponent's mark owing to its design features and also because the word "sprintor" is a coined word. However, the inherent distinctiveness of the applied for mark is diminished to the extent that it suggests the word "sprinter." The applied for mark SPRINTOR & Design would not have acquired any reputation at the material date January 15, 1987 (its date of first use). The opponent's mark SPRINTER is used only in association with men's underwear and appears on shipping boxes in which the wares are delivered to retailers. The opponent's mark SPRINTER does not appear either on the wares themselves or on the packaging in which the wares are sold to the public; the mark that appears on the opponent's wares and on their packaging is the mark ARROW & Design: see pages 8-11 of Mr. Turner's transcript of cross-examination and Exhibits 1,2 thereto. Sales volumes for men's underwear sold to retailers under the mark SPRINTER were 11,000 dozen in the year 1986 and 11,500 dozen in 1987. Thus, the opponent's mark was known to some extent at the wholesale level by the material date, but was not known to the general public at any material time.

The opponent's mark SPRINTER has been in use since 1965. However, in the absence of evidence of use of the mark above *de minimus* levels prior to 1986, the length of time that the mark has been in use favours the opponent only to a slight extent. The parties' wares are commonplace clothing items and thus there is potential for overlap in the parties' channels of trade.

The marks SPRINTER and SPRINTOR & Design resemble each other aurally owing to the prefix "SPRINT" common to both marks; however, the marks resemble each other to a far lesser extent visually, and the resemblance between the marks in ideas suggested is limited to the extent to which the applied for mark suggests the word "sprinter."

Considering the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the marks in issue are not confusing as of the material date January 15, 1987. I am far from certain in this conclusion, rather, the balance of probabilities tips slightly in the applicant's favour. The opponent's case is not appreciably stronger under the remaining grounds of opposition at the later material dates and the same result follows. Thus, the second, third and fourth grounds of opposition are rejected.

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

DATED AT HULL, QUEBEC, THIS 30th DAY OF NOVEMBER ,1994.

Myer Herzig,
Member,
Trade-marks Opposition Board