

**IN THE MATTER OF AN OPPOSITION
by York Barbell Holdings Limited
to application No. 653,349 for
the trade-mark HERCULES filed by
York Barbell Company, Inc.**

On March 16, 1990, the applicant, York Barbell Company, Inc., filed an application to register the trade-mark HERCULES for the following wares:

- (1) barbells, barbell sets and parts and components of barbells and barbell sets,**
- (2) physical fitness machines,**
- (3) athletic supplies namely, barbells, dumb bells, expansion and contraction exercising apparatus, (wall pulley expander sets) [sic], and abdominal exercise boards for gymnastic and exercising use,**
- (4) barbells, dumb bells, expansion and contraction exercising apparatus, abdominal exercise boards, weight resistance machines, standing press machines and seated calf machines for gymnastic and exercising use.**

The application is based on use of the trade-mark in Canada since 1946 with the wares marked (1), use of the mark in Canada since 1985 with the wares marked (2), use and registration of the mark in the United States under No. 440,565 with the wares marked (3) and use and registration of the mark in the United States under No. 1,545,473 with the wares marked (4). The application was advertised for opposition purposes on March 27, 1991.

The opponent, York Barbell Holdings Limited, filed a statement of opposition on April 24, 1991, a copy of which was forwarded to the applicant on May 17, 1991. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(b) of the Trade-marks Act because the applicant did not use its applied for trade-mark with the wares marked (1) and (2) since the dates claimed. The second ground is that the applicant's application does not comply with the provisions of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use its applied for trade-mark because it had not used the mark in Canada as alleged.

The third ground of opposition reads as follows:

The Applicant is not the person entitled to registration of the trade-mark HERCULES by virtue of section 16(2)(b) of the Trade-marks Act since, on March 16, 1990 the date of filing of the application for the trade-mark, it was confusing with the Opponent's trade-mark HERCULES which had been used in Canada by the Opponent since at least as early as January 15, 1990.

The fourth ground of opposition is that the applicant's trade-mark is not distinctive in view of the opponent's use of the identical mark for similar wares.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of William Irvine dated March 24, 1992 and an affidavit of G. Lee Muirhead dated March 6, 1992. The applicant did not file evidence. Both parties filed a written argument but no oral hearing was conducted.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, if pleaded and if the opponent has met its evidential burden, a ground of non-compliance with Section 30(b) of the Act may require a showing of non-abandonment by the applicant for any periods of non-use: see the opposition decisions in Georgia-Pacific Corp. v. Scott Paper Ltd. (1984), 3 C.P.R.(3d) 469 at 473 and Bedesse Imports Ltd. v. D.A. Macrae Ltd. (1988), 23 C.P.R.(3d) 387 at 388. Finally, the material time for considering the circumstances respecting the issue of non-compliance with the provisions of Section 30(b) of the Act is the filing date of the application: see page 475 of the Georgia-Pacific decision.

In his affidavit, Mr. Irvine identifies himself as the President of the opponent and states

that he has held this position with the opponent or its predecessors for 38 years. He further states that he is familiar with his company's competitors including the applicant and that, to the best of his knowledge, no products of the applicant are sold anywhere in Canada.

The Muirhead affidavit introduces into evidence documentation relating to a Section 45 proceeding against the applicant's registration No. 309,946 for the trade-mark HERCULES covering the same wares listed as (1) and (2) in the present application. The Section 45 notice issued on February 7, 1990 and the applicant (as registered owner) failed to file evidence in reply. Consequently, the applicant's registration was expunged on May 31, 1991.

It is the opponent's contention that the foregoing evidence meets its evidential burden. I do not agree. The opponent's evidence only goes to show that the applicant's mark was likely not in use in Canada as of the date of Mr. Irvine's affidavit and as of the date of the Section 45 notice issued against the applicant's registration. Thus, the opponent's evidence points to there being no use of the applicant's mark in the early 1990's. However, it does not show that the applicant's claimed dates of first use of 1946 and 1985 are wrong. The first ground of opposition is therefore unsuccessful.

It may well be that the opponent's evidence supports a finding that the applicant has abandoned its trade-mark. The fact that the applicant did not even file evidence in response to the Section 45 notice issued against its registration would seem to support such a finding: see the opposition decision in Kayser-Roth Corp. v. William H. Kaufman Inc. (1991), 36 C.P.R.(3d) 256 at 259. The Irvine affidavit provides further support for such a finding. However, the opponent only alleged that the applicant had not used its trade-mark since 1946 and 1985. It did not allege that the applicant had not complied with Section 30(b) of the Act because it had subsequently abandoned its mark. If it had, the first ground may well have been successful.

The second ground of opposition is not a proper ground. Even if the opponent had successfully shown that the applicant had not used its trade-mark as claimed in the present

application, this would not necessarily have any bearing on the applicant's ability to accurately and truthfully state that it was satisfied that it was entitled to use its trade-mark in Canada.

As for the third ground of opposition, the statement of opposition includes an allegation that the opponent had filed its own application (No. 667,131) for the trade-mark HERCULES on September 25, 1990 based on use of the mark in Canada since January 15, 1990 for the following wares:

exercise equipment, namely barbell, exercise weights, exercise benches, exercise boots, dumbbells, weight machines, devices incorporating pulleys and stacked barbell plates, rowing machines, exercise bicycles, stepping machines, trampolines and treadmills.

Although the opponent's third ground refers to Section 16(2)(b) of the Act, the opponent did not specifically rely on its own application but only on its own alleged prior use of the mark HERCULES. Thus, I consider that the opponent's third ground is restricted to the provisions of Section 16(2)(a) of the Act.

Since the opponent is alleging use of its own trade-mark only since January 15, 1990, the third ground must be restricted to the wares marked (3) and (4) in the present application which are based on use and registration in the United States. It was therefore incumbent on the opponent to evidence use of its mark in Canada prior to the applicant's filing date of March 16, 1990. This the opponent has failed to do. The only evidence to support prior use of the opponent's mark is paragraph 15 of the Irvine affidavit which reads as follows:

Since January 15, 1990 the Opponent has sold at least \$810,000 worth of exercise equipment in Canada bearing the trade-mark HERCULES.

Mr. Irvine does not indicate when his company's first sale of HERCULES items occurred. It may well be that all of the opponent's sales have occurred subsequent to March 16, 1990. Furthermore, Mr. Irvine fails to show that any of the sales occurred in the normal course of trade. Finally, Mr. Irvine does not provide sufficient information to determine whether the items sold were marked with the trade-mark HERCULES in such a manner that the mark would have been readily visible to the consumer or purchaser.

In view of the above, I must find that the opponent has failed to meet its initial evidential burden to clearly show use of its trade-mark prior to the applicant's filing date. The third ground of opposition is therefore also unsuccessful. In passing, it should be noted that the third ground would likely have been successful if the opponent had relied on its previously filed application.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - April 24, 1991): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); Molnlycke Aktiebolag v. Kimberly-Clark Ltd. (1982), 61 C.P.R.(2d) 42 at 52 (F.C.T.D.); Work Wear Corp. v. Triple G. Manufacturing Inc. (1990), 32 C.P.R.(3d) 463 at 467 (F.C.T.D.); Murjani International Ltd. v. Universal Impex Co. Ltd. (1986), 12 C.P.R.(3d) 481 at 484 (F.C.T.D.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

As noted above, Mr. Irvine did not provide much information in relation to the use of his company's trade-mark HERCULES. It may well be that the sales he referred to in paragraph 15 of his affidavit all took place after the filing of the present opposition. In any event, Mr. Irvine failed to show how his company's mark is used on the wares; it may well appear in small lettering not readily visible to the purchaser. Thus, I am unable to ascribe any measurable reputation for the opponent's mark as of the material time. The opponent has failed to satisfy its evidential burden and the fourth ground is therefore also unsuccessful.

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

DATED AT HULL, QUEBEC, THIS 31ST DAY OF MAY 1994.

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