

**IN THE MATTER OF AN  
OPPOSITION by Logotex Mfg.  
Ltd. to application No. 747,815  
for the trade-mark CANADIAN  
COUNTRY COLLECTION &  
Design filed by Canadian Duty  
Free Distributors Inc.**

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**On February 18, 1994, the applicant, Canadian Duty Free Distributors Inc., filed an application to register the trade-mark CANADIAN COUNTRY COLLECTION & Design for golf paraphernalia, namely golf tee-shirts, golf balls, golf tees, golf ball markers, golf towels, and umbrellas; souvenir items, namely, cuff links, ball point pens, manicure sets, wallets, card holders, passport holders, coffee mugs; glassware, namely drinking and decorative glasses, cups, mugs, beer steins, shotglasses, shooter glasses, tumblers, highball glasses, salt and pepper sets, pitcher sets, vases and ashtrays; and the operation of a business establishment dealing in the distribution of retail and souvenir store items based on proposed use. The application was advertised for opposition purposes on May 1, 1996. The mark is shown below:**

The opponent, Logotex Mfg. Ltd., filed a statement of opposition on October 1, 1996. The opponent is the owner of the trade-mark CANADA COUNTRY that is the subject of application No. 742,577. Application No. 742,577 was filed December 2, 1993 based on use since at least as early as September 1993. While the statement of opposition says that CANADA COUNTRY is for use in association with shirts, t-shirts, polo shirts, sweaters, hats and caps and the services of operation of a retail business providing embroidery and screen-printing services to the public, the Trade-marks Register shows that application No. 742,557, when filed, covered additional wares. However, the opponent's agent confirmed at the oral hearing that the grounds of opposition are meant to be restricted to the CANADA COUNTRY wares listed in the statement of opposition.

The grounds of opposition are non-compliance with Subsection 30(i) of the *Trade-marks Act*, non-entitlement pursuant to Paragraphs 16(3)(a) and (b) of the *Act*, and non-distinctiveness.

The applicant filed and served a counterstatement. The opponent filed as its evidence the affidavit of Stan Shackell. The applicant submitted as its evidence the affidavit of Peter Raju. Neither affiant was cross-examined and no reply evidence was filed.

Both parties filed a written argument. In its written argument, the applicant made ample reference to a cross-examination conducted of Mr. Shackell in another proceeding. As the transcript of cross-examination is not of record in the present proceeding, I have not given any consideration to submissions based on it.

An oral hearing was conducted at which both parties were represented.

With respect to the Subsection 30(i) ground of opposition, no evidence has been furnished by the opponent in support of its allegation that the applicant was aware of the use of the opponent's mark. As the opponent has failed to meet its evidentiary burden in respect of this ground, I have dismissed the Subsection 30(i) ground of opposition.

The remaining grounds of opposition are all based on allegations of confusion between the opponent's trade-mark CANADA COUNTRY and the applicant's trade-mark CANADIAN COUNTRY COLLECTION & Design. The applicant has the legal onus of proving that there would be no reasonable likelihood of confusion between the marks. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

The material dates with respect to the grounds of opposition are as follows: Paragraphs 16(3)(a) and (b) - the date of filing of the application, February 18, 1994; non-distinctiveness - the date of filing of the opposition, October 1, 1996 [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.)]. In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

Subsections 16(5) and 17(1) of the *Trade-marks Act* place a burden on the opponent to establish that it had not abandoned its trade-mark CANADA COUNTRY as of the date of advertisement of the present application, May 1, 1996. The opponent has met this evidentiary burden by means of the Shackell affidavit.

**Mr. Shackell, the President of the opponent, attests that the opponent has used the CANADA COUNTRY mark with respect to shirts, t-shirts, polo shirts, sweaters, hats and caps and the operation of a retail business providing embroidery and screen-printing services since at least as early as September, 1993. He supports this statement by providing a label bearing the mark that he states is affixed to each item sold under the CANADA COUNTRY line (exhibit C). Invoices have been provided regarding sales of CANADA COUNTRY clothing dated November 29, 1993, April 24, 1995, April 17, 1996 and June 26, 1996 (exhibits G and H). In addition, he provides a copy of a sales agent=s order form relating to CANADA COUNTRY garments dated September 21, 1993.**

**Mr. Shackell explains that the opponent=s mode of business with respect to the CANADA COUNTRY line involves the use of independent selling agents. The opponent provides such agents with garments, which the agent then uses to solicit orders. In addition, the opponent has a showroom where sales are made. The opponent also provides embroidery and screen-printing services to others for marking garments already owned by others under the trade-mark COUNTRY CANADA.**

**Mr. Shackell has provided a 1994 promotional brochure which discusses the opponent=s CANADA COUNTRY line and indicates that customers of that line include golf pro shops, ski resorts and fishing lodges. It is stated that several thousand dollars were spent on advertising the CANADA COUNTRY trade-mark in 1994.**

**Annual sales of CANADA COUNTRY wares and services were \$11,000 in 1993, \$25,000 in 1994, \$5,000 in 1995 and \$23,000 in 1996.**

**Peter Raju, the President of the applicant, attests that his company has**

continuously used the CANADIAN COUNTRY COLLECTION & Design mark since at least as early as September 1994 in association with all of the applied-for wares and services. His exhibits C and D show use of the mark on the following wares: golf shirt, manicure set, ball marker and tee set, passport holder, golf balls, business card holder, and wallet. Invoices have been provided as exhibit E.

Mr. Raju states that advertising expenses for promoting the trade-mark CANADIAN COUNTRY COLLECTION & Design have been \$120,000 since September 1994. Representative advertisements have been provided as exhibits F and G. The revenue generated by the CANADIAN COUNTRY COLLECTION & Design wares and services for the three years prior to January 16, 1998 (the date of the affidavit) amounted to approximately two million dollars.

Mr. Raju has also provided information concerning his company's use of the trade-mark KIDS COUNTRY CANADA & Design for a variety of wares and the operation of a manufacturing and wholesale distribution business dealing with gift, novelty and souvenir items.

In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [*Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Neither of the marks is very inherently distinctive. Both marks suggest a connection with Canada. The applicant's trade-mark has a greater degree of inherent distinctiveness as a result of its incorporation of a large design comprising mountains and Canada geese.

The extent to which the trade-marks had become known as of February 18, 1994 favours the opponent. It is difficult to tell which party is favoured by this consideration as of October 1, 1996 because the applicant had by then commenced use of its mark but the volume of its use and promotion was not broken down so as to allow us to know the extent as of such date.

The length of time the marks have been in use favours the opponent the slightly. The parties' services are, at most, only slightly related but their wares overlap with respect to clothing. Although the opponent has not claimed to have used its mark on the exact wares "golf tee-shirts", it has said that it uses it on clothing of a similar nature, e.g. t-shirts and polo shirts. The applicant's statement of wares is not restricted to any particular channels of trade and the clientele of both parties could overlap. The applicant classifies some of its wares as golf paraphernalia and the opponent's CANADA COUNTRY product has been said to be especially popular with golf pro shops.

Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction. [K-Tel International Ltd. v. Interwood Marketing Ltd. (1997), 77 C.P.R. (3d) 523 (F.C.T.D.) at 527] The first parts of the trade-marks, CANADA COUNTRY and CANADIAN COUNTRY, are remarkably similar. However, the question is whether the marks, when considered as a whole, are likely to be confused. Furthermore, one must consider the issue of confusion as a matter of first impression and imperfect recollection.

**CANADA and CANADIAN are not words that can be monopolised by anyone and no one is likely to be confused by this commonality. However, the combination of CANADA or CANADIAN with COUNTRY has not been shown to be a common occurrence. Moreover, despite the fairly significant design feature of the applicant=s mark, a consumer would likely refer to the applicant=s mark, or its associated wares or services, as CANADIAN COUNTRY COLLECTION or, given the nature of the word COLLECTION, merely as CANADIAN COUNTRY. Therefore, orally the marks are highly similar. In ideas suggested, the marks share a fair degree of similarity. Visually, the marks display their greatest differences. There is however nothing preventing the opponent from using its mark with a design and its evidence does in fact show that its products are offered for sale in association with CANADA COUNTRY combined with various designs, including designs of mountains and geese.**

**As a surrounding circumstance, I would consider the evidence of the opponent=s use of KID=S COUNTRY CANADA & Design. That mark is said to have been used since at least as early as January 1992. Related advertising expenditures for the three years prior to January 16, 1998 are said to have exceeded \$300,000 while sales exceeded \$3,500,000. However, there is no indication as to the percentage of promotion or advertising attributable to each of the various categories of wares marketed under the KID=S COUNTRY CANADA & Design mark. Such details would have been useful as some of the wares, such as toys, are totally unrelated to the wares in issue here. Accordingly, I find the evidence of use of KID=S COUNTRY CANADA & Design mark to be too vague to be a significant surrounding circumstance.**

**I find that the applicant has satisfied the onus on it to show that there is no reasonable likelihood of confusion between the marks with respect to the services and the following wares:**

souvenir items, namely, cuff links, ball point pens, manicure sets, wallets, card holders, passport holders, coffee mugs; glassware, namely drinking and decorative glasses, cups, mugs, beer steins, shotglasses, shooter glasses, tumblers, highball glasses, salt and pepper sets, pitcher sets, vases and ashtrays. I reach this decision primarily in view of the differences between the parties' services and between the aforementioned wares and the opponent's clothing. However, I conclude that there is a reasonable likelihood of confusion between the applicant's golf tee-shirts and the opponent's clothing items. In addition, I have some doubt as to whether there is a likelihood of confusion between the applicant's remaining golf paraphernalia and the opponent's wares given that the opponent's clientele includes golf pro shops and the marks resemble each other to a fair degree. The grounds of opposition based on entitlement and distinctiveness therefore succeed in part and I am issuing a split decision, under the authority set out in *Produits M.Jnagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act* and in view of the provisions of Subsection 38(8) of the *Act*, I refuse the application with respect to golf paraphernalia, namely golf tee-shirts, golf balls, golf tees, golf ball markers, golf towels, and umbrellas and reject the opposition with respect to souvenir items, namely, cuff links, ball point pens, manicure sets, wallets, card holders, passport holders, coffee mugs; glassware, namely drinking and decorative glasses, cups, mugs, beer steins, shotglasses, shooter glasses, tumblers, highball glasses, salt and pepper sets, pitcher sets, vases and ashtrays; and the operation of a business establishment dealing in the distribution of retail and souvenir store items.



**DATED AT TORONTO, ONTARIO, THIS 25th DAY OF FEBRUARY, 1999.**

**Jill W. Bradbury  
Hearing Officer  
Trade-marks Opposition Board**