

**IN THE MATTER OF AN OPPOSITION
by Precision Labels Ltd. to application No.
715,568 for the trade-mark PRECISION &
Design filed by Precision Label & Tag Inc./
Precision Etiquette et Marquage Inc.**

On October 26, 1992, the applicant, Precision Label & Tag Inc./Precision Etiquette et Marquage Inc., filed an application to register the trade-mark PRECISION & Design (illustrated below) for “labels and tags” based on use in Canada since December 1987. The application was amended to include a disclaimer to the words ETIQUETTE, LABEL and TAG and was subsequently advertised for opposition purposes on December 8, 1993.

The opponent, Precision Labels Ltd., filed a statement of opposition on February 4, 1994 and a revised statement on May 10, 1994. A copy of the revised statement was forwarded to the applicant on July 25, 1994. The sole ground of opposition is that the applied for trade-mark is not distinctive

....in that the applicant’s trade-mark neither distinguishes the applicant’s wares from those offered for sale and sold by opponent and others in association with its trade-mark as aforesaid.

The applicant filed and served a counter statement. As its evidence, the opponent filed two affidavits of Gregory Bruce Bumstead, two affidavits of Herbert McPhail and an affidavit of David Sheppard. As its evidence, the applicant filed an affidavit of its President, Brian Weller. Only the opponent filed a written argument and no oral hearing was conducted.

As for the sole 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. - February 4, 1994): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

Initially, it should be noted that the statement of opposition appears to be restricted to reliance on the opponent's use of its trade-mark PRECISION. However, the opponent's evidence deals with use of the trade-name Precision Label Ltd. by the opponent and the trade-name Precision Labels Limited by a third party. Furthermore, the opponent relied on such uses in its written argument and the applicant has raised no objections to the opponent's position. Thus, I have interpreted the opponent's ground of opposition liberally to include use of the opponent's trade-name and that of the third party.

The applicant has evidenced use of its applied for trade-mark in association with labels and tags, sales prior to the material time being in excess of \$4 million. However, Mr. Bumstead has evidenced use of the opponent's trade-name Precision Label Ltd. in association with the same type of wares, sales up to the filing of the opposition being about \$750,000. Furthermore, Mr. Sheppard, the President of Precision Datalabel Ltd., has evidenced use of his company's trade-name in association with labels, tags and name plates, sales being about \$1.5 million. The opponent has also introduced evidence of various trade-mark and trade-name searches which shows that the word "precision" has been commonly adopted by traders in general. However, those searches do not point to any common adoption of that word in the applicant's field of commerce.

Given the similarities between the applicant's trade-mark and the trade-names of the opponent and Precision Datalabel Ltd. and the fact that the three different companies are engaged in the same business, I find that the applicant's trade-mark is not capable of distinguishing its wares from those of others throughout Canada. The sole ground of opposition is therefore successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 2nd DAY OF JANUARY, 1997.

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