

**IN THE MATTER OF AN OPPOSITION by Stay Alert Stay Safe Organization to application No. 778,397 for the trade-mark BE ALERT BERT & Design filed by Richard Shergold**

On March 16, 1995, the applicant, Richard Shergold, filed an application to register the trade-mark BE ALERT BERT & Design, a representation of which appears below, based upon use of the trade-mark in Canada since December 1993 by the applicant in association with “*Videos, stuffed dolls of bee-like appearance, t-shirts and posters*” and based upon proposed use of the trade-mark in Canada in association with “*Boardgames*”.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 20, 1996 and the opponent, Stay Alert Stay Safe Organization, filed a statement of opposition on April 21, 1997, a copy of which was forwarded to the applicant on May 6, 1997. The opponent alleged the following grounds of opposition in its statement of opposition:

a) The present application does not comply with Subsection 30(i) of the *Trade-marks Act* in that the applicant could not have stated that it was entitled to use the trade-mark BE ALERT BERT & Design in Canada in view of the prior use by the opponent of the trade-marks:

STAY ALERT STAY SAFE  
STAY ALERT STAY SAFE & Rabbit Design  
STAY ALERT STAY SAFE & Skateboard Design  
BERT  
BERT & Design  
GERT  
GERT & Design

in association with educational materials, including videotapes and posters, and in association with child safety (street-proofing) lectures, and in view of the prior registration by the opponent of the trade-marks:

STAY ALERT STAY SAFE  
STAY ALERT STAY SAFE & Rabbit Design  
STAY ALERT STAY SAFE & Skateboard Design

in association with educational materials, including videotapes and posters, and in association with child safety (street-proofing) lectures;

b) The applicant is not the person entitled to registration of the trade-mark BE ALERT BERT & Design having regard to the provisions of Paragraphs 16(1)(a) and 16(3)(a) because, as of the date of first use with respect to “boardgames” and as of the filing date of the present application in respect of “Videos, stuffed dolls of

bee-like appearance, t-shirts and posters”, the applicant’s trade-mark was confusing with the following trade-marks previously used in Canada by the opponent, in association with educational materials, including videotapes and posters, and in association with child safety (street-proofing) lectures:

STAY ALERT STAY SAFE  
 STAY ALERT STAY SAFE & Rabbit Design  
 STAY ALERT STAY SAFE & Skateboard Design  
 BERT  
 BERT & Design  
 GERT  
 GERT & Design

c) The applicant is not the person entitled to registration of the trade-mark BE ALERT BERT & Design having regard to the provisions of Paragraphs 16(1)(b) and 16(3)(b) because, as of the date of first use with respect to “boardgames” and as of the filing date of the present application in respect of “Videos, stuffed dolls of bee-like appearance, t-shirts and posters”, the applicant’s trade-mark was confusing with the following trade-marks previously registered in Canada by the opponent, in association with educational materials, including videotapes and posters, and in association with child safety (street-proofing) lectures:

<i>Trade-mark</i>	<i>Registration No.</i>
STAY ALERT STAY SAFE	419,316
STAY ALERT STAY SAFE & Rabbit Design	419,317
STAY ALERT STAY SAFE & Skateboard Design	419,318

d) The trade-mark BE ALERT BERT & Design is not distinctive of the applicant because it does not distinguish the applicant’s wares in association with which it is used and intended to be used from the wares and services of others, including the wares and services of the opponent, nor is the applicant’s trade-mark adapted so as to distinguish the applicant’s wares.

The applicant served and filed a counter statement in response to the statement of opposition on September 2, 1997. The opponent filed as its evidence the affidavit of Elaine Goraj, together with certified copies of the following registrations:

<u>Trade-mark</u>	<u>Registration No.</u>
Rabbit and Children Design	477,610
Rabbit Design	477,608
STAY ALERT STAY SAFE	419,316
STAY ALERT STAY SAFE & Rabbit Design	419,317
STAY ALERT STAY SAFE & Skateboard Design	419,318
TOUJOURS PRUDENT...JAMAIS MAL PRIS & Design	437,696
TOUJOURS PRUDENT...JAMAIS MAL PRIS & Design	441,812

The applicant submitted as its evidence the affidavit of Richard Shergold. Both parties filed written

arguments and neither party requested an oral hearing.

As its first ground, the opponent alleged that the applicant could not have stated that it was entitled to use the trade-mark BE ALERT BERT & Design in Canada in view of the prior use and registration by the opponent of the trade-marks noted above in association with educational materials, including videotapes and posters, and in association with child safety (street-proofing) lectures. While the legal burden is upon the applicant to show that its application complies with Subsection 30(i) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. However, no evidence has been furnished by the opponent to show that the applicant adopted and used its trade-mark knowing that its mark was confusing with one, or more, of the opponent's trade-marks. Thus, the opponent has failed to meet the evidential burden upon it in relation to this ground. In any event, the success of this ground would have been contingent upon a finding that the applicant's mark is confusing with one, or more, of the opponent's marks, as alleged in the remaining grounds of opposition. I will therefore consider the remaining grounds relied upon by the opponent.

As for the second ground, there is an initial burden on the opponent in view of Subsections 16(5) and 17(1) of the *Trade-marks Act* to establish its use of its trade-marks in Canada prior to the applicant's claimed date of first use [December 31, 1993] and prior to the filing date of the present application [March 16, 1995], as well as to show that it had not abandoned its trade-marks as of the date of advertisement of the present application [November 20, 1996]. In this regard, the opponent has asserted that it has previously used the trade-marks STAY ALERT STAY SAFE, STAY ALERT STAY SAFE & Rabbit Design, STAY ALERT STAY SAFE & Skateboard Design, BERT, BERT & Design, GERT and GERT & Design in Canada in association with educational materials, including videotapes and posters, and child safety (street-proofing) lectures.

In her affidavit, Elaine Goraj, Program Manager of the opponent, states that the opponent organization, which was founded in 1987 and was granted Letters Patent on February 3, 1989, coordinates and distributes information and education programs and related materials for children, parents, teachers and other caregivers regarding child safety. Ms. Goraj also indicates that the opponent has adopted and registered eight trade-marks as listed in paragraph 3 of her affidavit, the marks being generally designed to be recognizable and attractive to children. According to the affiant, the fanciful rabbit characters featured in the opponent's design marks which appear in its promotional and educational materials are named "Bert" and "Gert" and these characters have been identified by the opponent as being trade-marks. Ms. Goraj has annexed to her affidavit numerous exhibits which have been distributed throughout Canada and which bear the opponent's trade-marks, the exhibits including newsletters, booklets and introductory materials for teachers, activity books and activity kits, community guide booklets, pamphlets, guides published for babysitters, stickers, printed publications distributed through most Canadian Tire stores and schools across Canada, videotapes, promotional items, and order cards which are sent to Stay Alert Participants. Also annexed to Ms. Goraj's affidavit is a photocopy of a Kellogg's Rice Krispies package bearing the opponent's trade-marks and including the characters "Bert" and "Gert", the package evidencing a cross-promotion between the opponent and Kellogg's which took place from 1992-1993 and in which a special offer was made for the opponent's STAY ALERT publications which also bear the opponent's marks.

Having regard to the opponent's evidence, I am satisfied that the opponent has established its prior use and non-abandonment of several of its trade-marks including the trade-marks STAY ALERT STAY SAFE and BERT as applied to *inter alia* educational materials including videotapes relating to child safety. Consequently, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark BE ALERT BERT & Design and the opponent's marks STAY ALERT STAY SAFE and BERT as of the applicant's filing date and its claimed date of first use. In determining whether there would be a reasonable likelihood of confusion between these trade-marks within the scope of Subsection 6(2) of the *Trade-marks Act* as of the material dates, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Subsection 6(5) of the *Act*.

With respect to the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the applicant's trade-mark BE ALERT BERT & Design possesses some measure of inherent distinctiveness when considered in its entirety even though the given name BERT adds little inherent distinctiveness to the mark and the words BE ALERT suggest that the applicant's wares are related to child safety. The opponent's trade-marks STAY ALERT STAY SAFE and BERT possess relatively little inherent distinctiveness, the former suggesting that the opponent's educational materials relate to child safety and the latter having a given name significance.

The extent to which the trade-marks at issue have become known [Para. 6(5)(a)] and the length of time the marks have been in use [Para. 6(5)(b)] both weigh in the opponent's favour, the opponent having evidenced use of its trade-marks STAY ALERT STAY SAFE and BERT in Canada in association with educational materials since at least early 1992. On the other hand, the applicant's trade-mark BE ALERT BERT & Design must be considered as not having become known to any extent as of the applicant's claimed date of first use [December 31, 1993] as applied to "Videos, stuffed dolls of bee-like appearance, t-shirts and posters", the material date for considering the Paragraph 16(1)(a) ground, or as of the applicant's filing date as applied to "Boardgames", the material date for considering the Paragraph 16(3)(a) ground.

As for the nature of the wares [Para. 6(5)(c)] of the parties and the nature of the trade [Para. 6(5)(d)] associated with those wares, the applicant's "videos" are the same as the opponent's videotapes while the applicant's "posters" are related to the opponent's educational materials. Also, I would expect that the channels of trade associated with these wares might well overlap. The applicant's "stuffed dolls of bee-like appearance, t-shirts" and "boardgames" differ specifically from the opponent's educational materials. However, considering that the applicant's stuffed dolls of bee-like appearance, t-shirts and boardgames might well be associated with a child safety program, I consider there to be a potential overlap in the nature of the trade associated with these wares and the opponent's educational materials which relate to child safety.

As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I find there to be a fair degree of similarity in appearance, sounding and in the ideas suggested between the

applicant's trade-mark BE ALERT BERT & Design and the opponent's trade-mark STAY ALERT STAY SAFE. Further, I consider there to be an even greater degree of similarity in appearance, sounding and in the ideas suggested between the applicant's mark and the opponent's trade-mark BERT, the applicant's mark including the entirety of the opponent's trade-mark.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the opponent's evidence points to the fact that it uses its trade-marks STAY ALERT STAY SAFE and BERT in close proximity to each other in a number of the exhibits annexed to the Goraj affidavit.

Having regard to the foregoing and, in particular, to the degree of resemblance between the trade-marks at issue as applied to wares which overlap and which could well travel through the same channels of trade, I find that the applicant has failed to meet the legal burden upon it of showing that there would be no reasonable likelihood of confusion between its trade-mark BE ALERT BERT & Design and the opponent's trade-marks STAY ALERT STAY SAFE and BERT. Thus, the opponent's second ground of opposition is successful in that the applicant is not the person entitled to registration of the trade-mark BE ALERT BERT & Design.

In view of the above, I do not propose to consider the remaining grounds of opposition in any detail. However, having regard to my conclusions in relation to the second ground, I am satisfied that the non-distinctiveness ground, to the extent that it relates to the issue of confusion between the applicant's mark and its trade-marks STAY ALERT STAY SAFE and BERT, would also be successful. On the other hand, the opponent's allegation in its third ground that the applicant's trade-mark is confusing with the opponent's trade-marks which were previously registered, while relevant to a Paragraph 12(1)(d) ground, is not *per se* a proper basis for challenging the applicant's entitlement to registration under Paragraphs 16(1)(a) and 16(3)(a) of the *Act*. I have therefore dismissed this ground of opposition.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-*

*marks Act.*

DATED AT HULL, QUEBEC THIS 31<sup>st</sup> DAY OF MARCH, 2000.

G.W.Partington,  
Chairperson,  
Trade-marks Opposition Board.