

IN THE MATTER OF AN OPPOSITION by Chauvin International Ltd. to application No. 744,649 for the trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design filed by Rosemary McKanna, Joanne Robertson, and Sherry Starke carrying on Business as Hockey Bums by Hockey Mums

On December 20, 1993, the applicant, Rosemary McKanna, Joanne Robertson, and Sherry Starke carrying on Business as Hockey Bums by Hockey Mums, filed an application to register the trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design, a representation of which appears below, based upon use of the trade-mark in Canada in association with "Seat cushions" since at least as early as December 1, 1993, as well as being based upon proposed use of the trade-mark in Canada in association with "Men's underwear, boxer shorts, sweatshirts, t-shirts, novelty hockey pucks, ties, noise makers, ball caps, tote bags, cook books, mugs, thermal mugs, keychains and fanny packs." The applicant disclaimed the right to the exclusive use of the word HOCKEY apart from the trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of September 14, 1994 and the opponent, Chauvin International Ltd., filed a statement of opposition on October 27, 1994, a copy of which was forwarded to the applicant on January 30, 1995. The applicant filed and served a counter statement in which it generally denied the allegations set forth in the statement of opposition. The opponent filed as its evidence certified copies of registration Nos. 340,130 and 414,409 while the applicant elected not to file any evidence in support of its application. The opponent requested leave of the Registrar to file further evidence pursuant to Rule 44(1) of the *Trade-marks Regulations*. However, that request was refused by the Opposition Board by way of the Office letter dated May 15, 1997. Neither party filed a written argument and no oral

hearing was conducted in respect of this opposition.

The first two grounds of opposition are based on Subsections 30(e) and 30(i) of the *Trade-marks Act*. The legal burden or onus is on the applicant to show that its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an evidential burden on the opponent to prove those allegations [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 of 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 [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

With respect to the Subsection 30(e) ground, the opponent asserted that the present application does not contain a statement that the applicant intends to use its trade-mark in Canada. However, the applicant asserts in its application that the trade-mark is proposed to be used in Canada by it in association with “Men's underwear, boxer shorts, sweatshirts, t-shirts, novelty hockey pucks, ties, noise makers, ball caps, tote bags, cook books, mugs, thermal mugs, keychains and fanny packs.” Subsection 30(e) of the *Trade-marks Act* provides as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing
(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

While the wording of the applicant's application does not conform to the specific wording of Subsection 30(e), the claim that the applicant itself intends to use its trade-mark in Canada meets the requirements of Subsection 30(e) if it is not the applicant's intention to license its trade-mark in Canada. In this regard, no evidence has been furnished by the opponent to show either that the

applicant itself does not intend to use the trade-mark in Canada or that the applicant intends to use its trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design in Canada through a licensee. As a result, the opponent has failed to meet its evidential burden and the Subsection 30(e) ground is therefore unsuccessful.

With respect to the Subsection 30(i) ground, no evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design in Canada. Moreover, to the extent that this ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon that one, or more, of these grounds is successful [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition.

As its third ground, the opponent asserted that the applicant's trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design is not registrable in that it is confusing with its registered trade-marks as follows:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
B.U.M. EQUIPMENT & Design	340,130	Men's, women's and children's wearing apparel, namely, pants, shirts, sweatshirts, shorts, t-shirts, tank tops, overalls, jackets, sweatpants and cardigans. Unconstructed suits, sweaters. Blouses, jersey, dresses, slacks, skirts, suits, vests, coats, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, mittens, gloves, bags, belts, bibs (overalls) parkas, earmuffs, bicycle clothing namely shorts, pants, jackets, shoes, shirts; headwear namely helmets, hats, caps; rainwear namely raincoats, rainhats, rubber boots; diaper covers, and diaper bags. Jeans.
B.U.M. IT & Design	393,062	Men's t-shirts, tank tops, sweatshirts, sweatpants, shorts, woven pants, shirts, jackets, hats and caps.
B.U.M. BLUES & Design	393,119	Men's wearing apparel, namely: T-shirts, sweatshirts, tank tops, woven shirts, sweaters, cardigans, vests, jackets, pants, shirts, hats, caps and underwear.

B.U.M. WEAR & Design	409,643	Men's, boys', women's and children's t-shirts, tank tops, sweatshirts, sweatpants, shorts, woven pants, shirts, jackets, coats, hats and caps.
B.U.M. GEAR & Design	409,644	Shirts, sweatshirts, sweatpants, t-shirts, shorts. Pants, tank tops, overalls, jackets, sweaters, cardigans, unconstructed suits.
B.U.M.	414,409	Clothing and clothing accessories namely, blouses, tops, jersey, dresses, slacks, skirts, suits, vests, tank tops, coats, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, gloves, bags, belts, wallets. Jeans, pants, shirts, sweatshirts, shorts, t-shirts, sweatpants, jackets, unconstructed suits, sweaters.
L'IL B.U.M.	421,918	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jerseys, sweaters, dresses, slacks, pants, shorts, skirts, suits, vests, sweatshirts, sweatpants, tank tops, coats, jackets, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, mittens, gloves, bags, belts, wallets, diaper covers and diaper bags.
B.U.M. BIKERS	426,127	Bicycle shorts, tops, pants, bottoms, jackets, gloves, shoes, shirts, headwear, namely, helmets, hats, caps, and rainwear namely, raincoats, rainhats, rubber boots.
SKIBUM	427,751	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jersey, sweaters, dresses, slacks, pants, shorts, skirts, suits, vests, sweatshirts, sweatpants, tank tops, coats, jackets, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, gloves, belts, bibs (overalls), parkas, earmuffs.
BEACHBUM	427,754	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jersey, sweaters, dresses, slacks, pants, shorts, skirts, suits, vests, sweatshirts, sweatpants, tank tops, coats, jackets, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, gloves, belts.
BABY B.U.M.	427,809	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jerseys, sweaters, dresses, slacks, pants, shorts, skirts, suits, vests, sweatshirts, sweatpants, tank tops, coats, jackets, bathing suits, socks, ties, scarves, underwear, leotards, unitards, tights, hats, caps, mittens, gloves, bags, diaper covers and diaper bags.
B.U.M. KIDS	428,137	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jerseys, sweaters, dresses, slacks, pants, shorts, denim, skirts, suits, vests, sweatshirts, sweatpants, tank tops, coats, jackets, bathing suits, socks, ties, scarves, underwear,

		leotards, unitards, tights, hats, caps, gloves, bags, belts, wallets.
B.U.M.	428,305	Ski poles, ski bindings, skis, ski boots, ski glasses, and ski goggles; bicycle clothing namely shorts, tops, pants, bottoms, jackets, gloves, shoes, shirts; headwear namely, helmets, hats, caps; and rainwear namely, raincoats, rainhats, rubber boots.
B.U.M. SPORTS	709,985	Clothing and clothing accessories namely, shirts, blouses, t-shirts, tops, jerseys, pants, shorts, skirts, vests, sweatshirts, sweatpants, tank tops, jackets, bathing suits, socks, underwear, leotards, unitards, tights, hats, caps, bags.

In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the *Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date in relation to the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. Upon review of the register, I note that all of the registrations relied upon by the opponent now stand in the name of Wal-Mart Stores, Inc. (A Delaware Corporation) but that the identity of the opponent in this proceeding remains unchanged. However, an opponent is free to rely upon third party registrations in challenging the registrability of a trade-mark under Paragraph 12(1)(d) of the *Trade-marks Act*.

With respect to Paragraph 6(5)(a) of the *Act*, the applicant's trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design is inherently distinctive when considered in its entirety in that it is neither descriptive nor suggestive of the applicant's wares, nor does it otherwise possess any other apparent significance which would detract from its inherent distinctiveness. Likewise, the opponent's registered trade-marks are inherently distinctive as applied to the wares covered in the opponent's registrations.

As no evidence has been furnished by the applicant and the only evidence submitted by the

opponent comprises copies of registration Nos. 340,130 and 414,409, I find that the extent to which the trade-marks at issue have become known and the length of time the trade-marks have been in use are not relevant surrounding circumstances in this opposition.

As for the wares and channels of trades of the parties, the present application covers seat cushions, men's underwear, boxer shorts, sweatshirts, t-shirts, novelty hockey pucks, ties, noise makers, ball caps, tote bags, cook books, mugs, thermal mugs, keychains and fanny packs. Of these wares, the applicant's men's underwear, boxer shorts, sweatshirts, t-shirts, ties, ball caps, tote bags and fanny packs overlap the wares covered in the various registrations relied upon by the opponent which include *inter alia* underwear, shorts, sweatshirts, t-shirts, ties, caps, hats and bags. Further, in the absence of any evidence to the contrary, I would expect that the channels of trade associated with these wares could potentially overlap. On the other hand, the remaining wares covered in the present application, namely, seat cushions, novelty hockey pucks, noise makers, cook books, mugs, thermal mugs and keychains bear no similarity to the wares covered in the registrations relied upon by the opponent and I would not expect there to be any overlap in the channels of trade associated with these wares.

The applicant's trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design, when considered in its entirety, bears little, if any, similarity in appearance, sounding or in the ideas suggested to any of the registered trade-marks relied upon by the opponent.

Having regard to the absence of any degree of resemblance between the trade-marks at issue, I have concluded that there would be no reasonable likelihood of confusion between the applicant's mark and the registered trade-marks identified above. I have therefore dismissed the Paragraph 12(1)(d) ground of opposition.

The fourth ground is that the applicant is not the person entitled to registration of the trade-mark HOCKEY BUMS BY HOCKEY MUMS & Design in view of Paragraphs 16(1)(a) and 16(3)(a) of the *Trade-marks Act* in that, as of the material dates, the applicant's trade-mark was confusing with the trade-marks identified above, which had previously been used in Canada. 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 prior to the date of first use in relation to seat cushions and prior to the applicant's filing date in relation to the remaining wares covered in the present application, as well as to show that it had not abandoned its marks as of the date of advertisement of the present application [September 14, 1994]. As no evidence has been submitted by the opponent with the exception of copies of registration Nos. 340,130 and 414,409, the opponent has failed to meet the initial burden upon it in respect of this ground. This ground of opposition is also unsuccessful.

The final ground relates to the alleged non-distinctiveness of the applicant's trade-mark. However, as no evidence has been furnished by the opponent apart from the certified copies of registration Nos. 340,130 and 414,409, the opponent has failed to meet the evidential burden upon it in respect of this ground. I have therefore rejected this ground of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 20th DAY OF OCTOBER, 1998.

G.W. Partington
Chairperson
Trade-marks Opposition Board