

IN THE MATTER OF AN OPPOSITION by Stoneage Creations Canada Inc., to application No. 1,014,719 for the trade-mark STONEAGE filed by STONEAGE LIGHTING CREATIONS LTD.

On May 7, 1999, the applicant, Stoneage Lighting Creations Ltd. (“SLC”), filed an application to register the trade-mark STONEAGE based on use in Canada since November, 1998, for the following wares: rock lamps, puddle rocks, and rock flower pots, and for the following services: consulting services relating to exterior lighting schemes. The application was advertised for opposition purposes on January 26, 2000.

Basis of Opposition

The opponent, Stoneage Creations Canada Inc. (“SCC”), filed a statement of opposition against the application on November 21, 2000. The Registrar forwarded a copy of the statement of opposition to the applicant on December 5, 2000. The grounds of opposition, as pleaded, are as follows:

- a) Having regard to Section 38(2)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (the “Act”), the Application does not comply with the requirements of Section 30(b) in that the Applicant had not used the trade-mark in Canada in association with the wares and services covered by the Application as of the date of first use claimed in the Application.
- b) Having regard to Sections 38(2)(b) and 12(1)(d) of the Act, the trade-mark is not registrable in that it is confusing with the Opponent’s registered trade-mark

STONAGE CREATIONS which has been registered in Canada under registration No. TMA531,768 dated August 24, 2000.

- c) Having regard to Sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Trade-mark in that, as of the date of first use of the Trade-mark in Canada claimed in the Application and/or as of the date of filing of the Application, the Trade-mark was confusing with the Opponent's trade-mark STONEAGE CREATIONS, previously used in Canada by the Opponent in association with the developing, promoting, marketing and commercializing creative products of others.
- d) Having regard to Sections 38(2)(c) and 16(1)(c) of the Act, the Applicant is not the person entitled to registration of the Trade-mark in that, as of the date of first use of the Trade-mark in Canada claimed in the Application and/or as of the date of filing of the Application, the Trade-mark was confusing with the Opponent's trade-name STONEAGE CREATIONS, previously used in Canada by the Opponent in association with the developing, promoting, marketing and commercializing creative products of others.
- e) Having regard to Sections 38(2)(d) and 2 of the Act, the Trade-mark is not distinctive in that it does not distinguish nor is it adapted to distinguish the wares and services of the Applicant for those of others including the Opponent, having regard, among other things, to the Opponent's trade-mark and trade-name STONEAGE CREATIONS as above-described.

The applicant filed and served a counter statement in which it generally denied the allegations asserted by the opponent in its statement of opposition. The opponent's evidence consisted of the affidavit of Patricia Watrin-Bates, President and Chairman of SCC, and the applicant's evidence included the affidavit of Carl Christiansen, President, Chief Executive Officer and Chairman of SLC. Only the applicant filed a written argument and an oral hearing was not conducted.

Opponent's Evidence

Ms. Watrin-Bates explains that her company was incorporated federally on March 4, 1986, under the name 149513 Canada Inc., and it has operated continuously since that time under the name "Stoneage Creations". She further states that the name of her company was changed formally to Stoneage Creations Canada Inc. on April 21, 1997.

At paragraph 4 of her affidavit, Ms. Watrin Bates asserts that since at least as 1986 or 1987, her company has assisted others with the development, promotion, marketing and commercialization of their creative products. She states at paragraph 5 that her company has been involved in assisting the partnership of herself and Agnes LaDon Kirby, trading as Spunky Rox, in developing, promoting, marketing and commercializing a creative concept involving a series of dolls and related merchandise under the name SPUNKY ROX.

Attached as Exhibit M to Ms. Watrin-Bates' affidavit is a certified copy of the opponent's registration TMA531,768 for STONEAGE CREATIONS. Also attached as exhibits to her affidavit were various documents including newspaper releases, newspaper articles, copies

of certificates of registration in copyright, and other items purporting to show the opponent's participation in the development, promotion, marketing and commercializing of its Spunky Rox dolls and related merchandise.

Applicant's Evidence

Mr. Christiansen asserts that he incorporated SLC on November 5, 1998, and has operated it continuously ever since. He states at paragraph 8 of his affidavit that he has been responsible for the sale of approximately 8000 STONEAGE lighting units since January 1, 1999. Attached as Exhibits A and B to his affidavit are representative flyers describing the applicant's wares and services which Mr. Christiansen states were distributed all over Canada beginning January 1, 1999, and August 1, 2001, respectively. Exhibit C was comprised of a packing slip that Mr. Christiansen asserts has accompanied each shipment of stone products produced by SLC. He further states that SLC has issued approximately 900 of these documents since 1998. Marked as Exhibit D to his affidavit is a stamp imprint that Mr. Christiansen claims is printed on the lower surface of the lid of each lamp sold or marketed by SLC.

Analysis

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, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership* (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

In the present case, the opponent did not submit any evidence to support this ground of opposition. As the applicant's evidence is not clearly inconsistent with its claimed date of first use, this ground of opposition is unsuccessful.

The material dates with respect to the grounds of opposition based on a likelihood of confusion are as follows: registrability under paragraph 12(1)(d) - the date of my decision [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.)]; entitlement under subsection 16(1) - the applicant's date of first use; non-distinctiveness - the date of filing of the opposition [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.)].

The test for confusion is one of first impression and imperfect recollection. 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 [see *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.)].

As for Section 6(5)(a) of the Act, both the applicant's and the opponent's marks are inherently distinctive. Since most of the opponent's evidence points to use of the mark SPUNKY ROX as opposed to use of the opponent's mark STONEAGE CREATIONS, I can only conclude that the opponent's STONEAGE CREATIONS mark has become known to a very limited extent in Canada. I am satisfied from the applicant's evidence that its STONEAGE mark has become known to some extent in Canada.

With respect to Section 6(5)(b), according to the opponent's registration the opponent's mark has been in use since at least as early as 1987 while the applicant's application is based on use since January 1999. This factor therefore favours the opponent.

As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares and services of the parties are different. The Opponent's services include the developing, marketing and commercializing of creative products for others, while the applicant's wares and services comprise rock lamps, puddle rocks and rock flower pots and consulting services relating to exterior lighting schemes. Presumably the parties' channels of trade would also be different.

As for Section 6(5)(e) of the Act, the marks are somewhat similar in appearance and in sounding as both begin with the word STONEAGE. The ideas suggested by the marks are less similar, however, as the applicant's mark suggests a prehistoric period while the opponent's mark suggests products designed to appear as though they are from a prehistoric period.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the differences in the parties' wares, services and channels of trade, I find that the applicant has established on a balance of probabilities that there would be no reasonable likelihood of confusion between the applied for mark and the opponent's registered mark STONEAGE CREATIONS. Thus, the second ground of opposition in respect of application No. 1,014,719 is unsuccessful.

As my conclusion is the same as of each of the material dates, the grounds of opposition based on entitlement and distinctiveness also fail.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the Act, pursuant to subsection 38(8) of the Act I reject the opposition.

DATED AT GATINEAU, QUEBEC, THIS 27th DAY OF April, 2004.

C. R. Folz
Member,
Trade-Marks Opposition Board