

**IN THE MATTER OF AN OPPOSITION
by 943524 Ontario Limited to application
no. 745,256 for the trade-mark TALL BOYS
filed by Price International Inc.**

On January 17, 1994, the applicant, Price International Inc., filed an application to register the mark TALL BOYS, based on intended use in Canada, in association with the wares trading cards and confectionary, namely, chewing gum.

The subject application was advertised in the *Trade-marks Journal* issue dated August 10, 1994 and was opposed by the opponent, 943524 Ontario Limited, on October 7, 1994. A copy of the statement of opposition was forwarded to the applicant on December 8, 1994. The applicant responded by serving and filing a counter statement.

The first ground of opposition alleges that the application is not in compliance with Section 30(i) of the *Trade-marks Act* in that the applicant could not have been satisfied as to its entitlement to use the mark TALL BOYS (i) “in view of the facts contained herein,” and because (ii) the applicant did not and does not intend to use the mark TALL BOYS as the applicant is not in the business of manufacturing or selling the wares specified in the application. The second ground of opposition alleges that the applied for mark TALL BOYS is not registrable, pursuant to Sections 12(1)(b) and 12(1)(c) of the *Act*, because the terms “tall boy” and “tall boys” are used by manufacturers, distributors, retailers and collectors of trading cards to refer to a certain type of trading card namely, to a particular set of hockey cards which are taller than standard size trading cards. Thus, the mark is clearly descriptive or deceptively misdescriptive of trading cards and is also the name of a certain type of card. The last ground of opposition alleges that the applied for mark is not distinctive in view of the above pleadings and also because the mark TALL BOYS does not distinguish the applicant’s wares from “ the wares of a manufacturer of trading cards known by others as TOPPS.”

The opponent’s evidence in chief consists of the affidavit of Andrew K. Jarzyna, barrister and solicitor, sworn September 11, 1995. The applicant’s evidence consists of the affidavits of Ken Whitmell, Vice President of the applicant company, and Laura M. Chapman, trade-mark

searcher. The opponent's evidence in reply consists of a further affidavit of Andrew Jarzyna, sworn September 3, 1997, and the affidavit of Martin Lindegggar, a businessman involved with the sports card business. Neither party submitted a written argument and only the opponent was represented at the oral hearing. Although Mr. Jarzyna is acting as the agent for the opponent, nevertheless his evidence is admissible: see *Institut National des Appellations d'Origine v. Pepperidge Farm Inc.*, (1997) 84 C.P.R. (3d) 540 at 547 (TMOB).

Mr. Jarzyna's affidavit evidence may be summarized as follows. He is knowledgeable about the purchase and sale of hockey trading cards having been involved, since 1989, with wholesale distributors of hockey cards in Canada and the United States, and with the retail sale of hockey cards in Canada. Paragraphs 7 to 11 of his affidavit of September 11, 1995 are reproduced below:

Paragraphs 3 and 4 of Mr. Jarzyna's affidavit of September 3, 1997 are reproduced below.

Mr. Lindeggar identifies himself as a businessman who has been involved in the sports card business for over fifteen years. Paragraphs 4 and 5 of his affidavit are shown below.

Thus, Mr. Lindeggar's evidence is supportive of Mr. Jarzyna's testimony and confirms the authenticity of Exhibit A referred to in paragraph 4 of Mr. Jarzyna's affidavit, above. In my review of Exhibit A of Mr. Jarzyna's affidavit, I have found numerous references to the term "tall boy" or "tallboys" in the context of (i) specifying the 1964/5 series of TOPPS hockey cards or (ii) referring generically to any oversized sports trading card.

Mr. Whitmell's evidence may be summarized as follows. Since about 1993, the applicant

has been manufacturing, selling and distributing in Canada, the United States and abroad, various series of hockey cards generally sold in packs of eight to fourteen. The applicant's current product line includes the following series: MISSING LINK, TALL BOYS and BOBBY ORR. Trading cards are sold to members of the public who are card hobbyists or collectors. The applicant's sales in Canada average about \$4 million annually for the period 1993 - 1995 inclusive. The applicant began to sell hockey cards in association with the trade-mark TALL-BOYS in and around January 1995. The cards measure 2 ½" by 4 11/16" and are therefore larger than the average size trading card which measures 2 ½" by 3 ½". As of June 1996, sales in Canada under the mark TALL BOYS amounted to about \$1.3 million. The applicant advertises its trading cards in trade publications including *Beckett Monthly*, *The Hockey News*, *Sports Collectors Digest*, and *Canadian Sportscard Collector*. The applicant also advertises its products at various trade shows and dealer exhibitions. In 1995 the applicant expended about \$45,000 in promoting its TALL BOYS trading cards. Paragraphs 11 and 12 of Mr. Whitmell's affidavit are reproduced below.

The issue as to whether the trade-mark TALL BOYS is clearly descriptive in the English

language of trading cards sold by the applicant must be considered from the point of view of the purchaser of those wares namely, card hobbyists or collectors. In determining whether the trade-mark TALL BOYS is clearly descriptive, the mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186. While the legal onus is on the applicant to show that its trade-mark is registrable, there is an initial evidential burden on the opponent to adduce sufficient evidence which, if believed, would support the truth of its factual allegations supporting the Section 12(1)(b) ground of opposition. Lastly, the material date to decide the issue of whether the applied for mark is clearly descriptive is the date of my decision: see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.).

In my view, the opponent has supported its allegation the term “tall boys,” used in connection with sports trading cards, alludes to a subset of such cards namely, oversized cards. Further, the opponent has supported its allegation the term “tall boys” may also have reference, depending on the context, to a particular series of hockey trading cards dating back to 1964/5. Where Mr. Whitmell’s evidence on these points conflicts with the evidence of Messrs. Jarzyna and Lindeggar, I prefer the evidence of Messrs. Jarzyna and Lindeggar because their evidence, although far from overwhelming, is supported by documentation namely, Exhibit A of Mr. Jarzyna’s affidavit sworn September 13, 1997.

In view of the above, I find that the opponent succeeds, on a balance of probabilities, on the grounds of opposition alleging that the applied for mark is clearly descriptive of the applicant’s wares and is the name of the applicant’s wares. Further, the opponent succeeds, on a balance of probabilities, on the grounds of opposition alleging that the applied for mark is not distinctive of the applicant’s wares because, *inter alia*, the mark connotes a particular series of 1964/5 hockey trading cards manufactured by TOPPS. Accordingly, the subject application is refused.

DATED AT HULL, QUEBEC, THIS 26th DAY OF JANUARY, 2001.

Myer Herzig,
Member,
Trade-marks Opposition Board