

IN THE MATTER OF AN OPPOSITION by Caribbean Cultural
Committee to application No. 750,100 for the trade-mark TORONTO
CARIBANA CITY & Design filed by Chatac Corporation

On March 17, 1994, the applicant, Chatac Corporation, filed an application to register the trade-mark TORONTO CARIBANA CITY & Design (shown below) based on proposed use in Canada in association with the following wares:

“Men's, ladies' and children's clothing, namely: bibs, sleepers, slippers, sandals, shoes, boots, pants, sweat pants, shorts, panties, briefs, skirts, belts, belt buckles, tank tops, body suits, socks, leggings, pantyhose, shirts, T-shirts, rugby shirts, golf shirts, ski-shirts, cricket shirts, sweaters, dresses, blouses, vests, robes, pullovers, cardigans, jackets, coats, parkas, caps, hats, barrettes, scarves, ties, mittens, gloves, hand bags, wristbands, suits, jumpsuits, tracksuits, swimsuits, overalls, pyjamas, nightshirts, accessories, namely; cuff links, tie pins/bars, headbands, visors, eyewear and hair ornamentation, namely; baubles, pins, pony tails, combs, side combs, Afro-picks, ribbons, aprons, backpacks, rainwear, namely; raincoats, rain hats, spring jackets, umbrellas, parasols, packaged information/music (CDS/books/tapes) puzzles, games, namely picture books, story books, cross-word books, comics, book marks, books on tape, paper and pencil puzzles, posters, postcards, notecards, stickers/decals; playing cards, mechanical puzzles, board games, floppy disks, compact disks, audio tapes, video tapes, school/college supplies, namely; rulers, erasers, clip-boards, binders, pencils, pencil sharpeners, planning books, exercise books, folders, markers, pen and pencil cases/boxes, note pads computerized puzzles/games and portable or hand-held computers, souvenirs namely; pins, spoons, thimbles, emblems, key rings/chains, letter openers, pens, pen holders, lighters; poly-resin figurines, porcelain figurines, time pieces, namely; stop watches, wrist watches, pocket watches, desk clocks, wall clocks, mantel clocks, magnets, napkin holders, serving trays, place mats, coasters, plaques; hand towels, towel sets, luggage, travel accessories namely; duffel bags, sleeping bags, hiking bags, and portfolios, toiletries, perfumes, brooches, lens cleaner; assorted items, namely; buttons, pot-pourri holders, oven mittens, pot holders, piggy-banks, lunch boxes, ice buckets, bicycle tags, balloons, bottle and can openers, beach/throw blankets, bed sheets, bed skirts, pillows, pillow cases/shams, telephone and address books, greeting cards, collectible plates, base balls, basket balls, pennants; novelties namely; interior home decor, namely; unusual wall coverings, floor coverings, Christmas decorations; exterior home decor, namely; sundials; office accents, namely; wall display units, knick knacks, paper weights, planters, business card holders, pen/pencil holders, wall hangings, wood carvings; automotive accessories, namely; rear view mirror suspenders, deoderizers, chamois, license plate frames, ice scrapers, splash guards, car floor mats, car/van truck window signs, bumper stickers; assorted items, namely; face masks”

and the following services:

Organizational development and management development services, educational services, namely; lectures, and seminars, marketing services, namely; market research and analysis in a consulting capacity, to the carnival/culture and tourism sectors.

The applicant disclaimed the right to the exclusive use of the words Toronto, Caribana and City apart from the trade-mark. The application was advertised for opposition purposes on April 10, 1996.



The opponent, Caribbean Cultural Committee, filed a statement of opposition on September 6, 1996. The first ground of opposition is that the application is not in compliance with s.30(i) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (hereinafter “the Act”), because the applicant could not have been satisfied that it was or is entitled to use the trade-mark in Canada

in association with the wares and services described in the application. As its second ground of opposition, the opponent maintains that the trade-mark is not registrable under s.12(1)(d) because it is confusing with the opponent's registered trade-mark No. 219,611 for CARIBANA which covers the following services: "Entertainment services, namely the arranging, promotion and presentation of a Caribbean cultural festival providing dances, musical entertainment, theatrical entertainment, boat cruises, parades, cultural displays, arts and crafts, and restaurant services to the public". The third ground of opposition is that the applicant is not the person entitled to registration of the mark under s.16(3)(a) of the *Act* because at the date of filing the trade-mark was confusing with the trade-mark CARIBANA, which had been previously used in Canada by the Opponent in association with clothing namely t-shirts, sweat shirts, sweat pants, shorts, jackets and tank tops; key chains, mugs, sport drinking bottles, pencils, whistles, and cloth bags, and "other related wares". As its fourth ground, the opponent submits that the applicant is not the person entitled to registration of the trade-mark under s.16(3)(c) of the *Act* because at the date of filing the trade-mark was confusing with the trade-names CARIBANA and CARIBBEAN CULTURAL COMMITTEE, which had been previously used by the opponent in association with entertainment services namely the arranging, promotion and presentation of a Caribbean cultural festival providing dances, musical entertainment, theatrical entertainment, boat cruises, cultural displays, arts and crafts, and restaurant services to the public. The opponent's final ground of opposition is that pursuant to s.38(2)(d) and s.2 the applicant's trade-mark is not distinctive as it does not actually distinguish nor is adapted to distinguish the wares of the applicant from the aforesaid wares and services of the opponent.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavit of Craig Wellington, sworn June 5, 1997. The opponent was subsequently granted leave under s.44(1) of the *Trade-Mark Regulations* to file a supplementary affidavit of Craig Wellington, sworn March 13, 1998, to which a copy of Registration No. 485,030, for the trade-mark CARIBANA was attached. The affidavit of Netto Kefentse, sworn January 31, 1998, was submitted as the applicant's evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As a preliminary matter, I would like to address the applicant's submission that the word CARIBANA is not a valid trade-mark because it is non-distinctive and non-registrable for being clearly descriptive (or deceptively misdescriptive). In my view, a trade-mark opposition proceeding is not the proper forum to question the validity of a registered trade-mark. Rather, as the opponent has pointed out, only the Federal Court has exclusive jurisdiction under s.57(1) of

the *Act* to order that a registered trade-mark be struck out or amended on the grounds that at the date of application the register did not accurately express or define the existing rights of the person appearing to be the registered owner of the mark. Consequently, I will not have regard to the applicant's submissions with respect to the validity of the opponent's registered CARIBANA mark (Regn. No 219,611).

The first ground of opposition is not properly pleaded because it fails to set out the ground in sufficient detail to enable the applicant to reply thereto in accordance with s.38(3)(a) of the *Act*. Thus, the first ground of opposition is unsuccessful.

The second ground of opposition is based on Section 12(1)(d) of the *Act*, the opponent asserting that the applicant's trade-mark is not registrable in that the mark TORONTO, CARIBANA CITY & Design is confusing with its CARIBANA trade-mark, Registration No. 219,611. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the *Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in s.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 material date in relation to the s.12(1)(d) ground. The material date to consider the issue of confusion is the date of decision (see **Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 413 (F.C.A.)). For a review of case law concerning material dates in opposition proceedings, see **American Retired Persons v. Canadian Retired Persons** (1998), 84 C.P.R. (3d) 198 at 206-209 (F.C.T.D.).

While the opponent did not submit a copy of its registration as part of its evidence in this opposition, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registration relied upon by the opponent (see **Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.**, 11 C.P.R. (3d) 410). In doing so, I noted that the registered trade-mark CARIBANA, registration No. 219,611, presently stands in the name of Caribana Festival International Inc. and was registered March 25, 1977, in association with the following services:

“Entertainment services, namely the arranging, promotion and presentation of a Caribbean cultural festival providing dances, musical entertainment, theatrical entertainment, boat cruises, parades, cultural displays, arts and crafts, and restaurant services to the public.”

With respect to Paragraph 6(5)(a) of the *Act*, the applicant has evidenced dictionary definitions which suggest that the opponent's mark is a derivative of the word Cariban which is the name of a language and the stock of peoples occupying the islands and coastal regions of the mainland bound by the Caribbean Sea. Therefore, although I consider the word CARIBANA to be inherently distinctive because it is a coined word, I do not consider it inherently strong when used in association with the opponent's services because it is suggestive of the type of entertainment services the opponent provides. As for the applicant's TORONTO, CARIBANA CITY & Design mark, even though it has two non-distinctive components (*i.e.* the word TORONTO and the word CITY), I consider it to be inherently stronger than the opponent's mark because of its distinctive design component.

With respect to the extent to which the trade-marks have become known, the opponent's CARIBANA mark appears to have become known in Canada in association with an annual festival occurring over the August long week-end each year in Metropolitan Toronto since 1967 (see Exhibit D, Wellington Affidavit). According to Mr. Wellington, the CARIBANA festival attracts hundreds of thousands of people from Canada and the United States and other countries. The applicant's mark, on the other hand, is based on proposed use. Thus, the extent to which the trade-marks at issue have become known favours the opponent. Likewise, the length of time the trade-marks have been in use is another surrounding circumstance which weighs in the opponent's favour, the opponent having used the trade-mark CARIBANA as applied to the presentation of a Caribbean cultural festival since August of 1967 whereas the applicant's mark is based on proposed use in Canada.

With respect to s.6(5)(c) and s.6(5)(d) of the *Act*, the applied for services, which include "Organizational development and management development services, educational services, namely; lectures, and seminars, marketing services, namely; market research and analysis in a consulting capacity, to the carnival/culture and tourism sectors" are similar to the opponent's entertainment services which are identified as comprising the arranging, promotion and presentation of a Caribbean cultural festival.

The opponent also referred to the wares in association with which its CARIBANA trade-mark, Application No. 768,356, is now registered under TMA 485,030, which include: (1) Clothing, namely t-shirts; (2) Clothing namely sweat shirts, sweat pants, shorts, jackets, and tank tops; mugs, sports drinking bottles, pencils, whistles, and cloth bags. However, as the s.12(1)(d) ground of opposition was not amended during the opposition proceeding in order to rely upon the

trade-mark registration which matured from application No. 768,356, this registration cannot be relied upon in support of this ground of opposition. I have therefore not considered the above noted wares in my consideration of this ground of opposition, and in particular of my considerations under s.6(5)(c) and (d) of the *Act*.

As for Section 6(5)(e) of the *Act*, the trade-marks TORONTO, CARIBANA CITY & Design and CARIBANA are similar in sounding because the applicant's mark incorporates the entirety of the opponent's registered trade-mark CARIBANA as one of its components. The ideas suggested by the parties marks are also similar in that the opponent's mark suggests that its entertainment services are associated with the Caribbean while the applicant's mark suggests a connection between the City of Toronto and the Caribbean. The marks are less similar visually, however, because of the applicant's distinctive design component.

As a further surrounding circumstance, I have considered the copy of the proposal presented on January 18, 1994, by Mr. Kefentse, the President of the applicant company, to the Executive Committee of the Caribbean Cultural Committee regarding use of the CARIBANA trade-mark in the applicant's TORONTO, CARIBANA CITY & Design mark (see Exhibit E to the Wellington affidavit and Exhibit D to Nefentse affidavit). In this proposal, Mr. Kefentse acknowledges the opponent's trade-mark rights in the CARIBANA trade-mark and requests that the two organizations "cooperate" so that he can use his TORONTO, CARIBANA CITY trade-mark. In this regard, the following is stated at page 4:

"...The update of this history is that I have developed a) a design and b) a combination of words for registration as a trade-mark. Caribana City, Toronto are the three words of the proposed word mark. My aim is to promote Caribana each time I pitch Toronto...

Given your trade-mark rights to the word Caribana, I am here seeking an accommodation between our two organizations.

Clearly, "Caribana" is yours. By the same logic, "Caribana City, Toronto" is mine. How can we cooperate?...

What are the benefits of cooperation?

- a) Every time I promote Toronto, Caribana is promoted.
- b) Every sale is a defacto promotion of Caribana..."

In my view, this proposal appears almost to be an admission by the applicant that it is likely that the public, who is already familiar with the opponent's mark, would assume that the applicant's goods are approved, licensed or sponsored by the opponent. I consider that this admission supports a finding of a reasonable likelihood of confusion between the marks at issue. In this regard, see the decision in **Glen-Warren Productions Ltd. v. Gertex Hosiery Ltd.** 29 C.P.R. (3d) 7.

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, in particular, to the fact that the opponent's mark has been shown to have become known in relation to a festival held annually in Metropolitan Toronto since 1967, and that the applicant has adopted the entirety of the opponent's mark as one of the components in its mark, and even bearing in mind that the applicant's wares differ from the services covered in registration No. 219,611, I find that the applicant has failed to satisfy the onus on it to show that there would be no reasonable likelihood of confusion between the trade-marks at issue. Thus, the applicant's trade-mark TORONTO, CARIBANA CITY & Design is not registrable in view of Section 12(1)(d) of the *Act* and this ground of opposition is successful.

In view of the above, I do not propose to consider the remaining grounds of opposition in detail. However, in view of my previous comments concerning the surrounding circumstances in assessing the likelihood of confusion in relation to the s.12(1)(d) ground, I would expect that the s.16(3)(c) ground and non-distinctiveness ground would also be successful even though the material dates for considering these grounds are the applicant's date of filing (*i.e.* March 17, 1994) and the date of opposition (*i.e.* September 6, 1996). I would likely have rejected the Section 16(3)(a) ground, however, because of the opponent's failure to meet its evidential burden under this ground. In this regard, and as the applicant pointed out, the opponent has failed to show any use or making known of its CARIBANA mark in association with the clothing and novelty wares identified above.

With the authority delegated to me under s. 63(3) of the *Act*, I refuse the applicant's application pursuant to s.38(8) of the *Act*.

DATED AT HULL, QUEBEC, THIS 28th DAY OF October, 1999.

Cindy R. Folz
Member,
Trade-Marks Opposition Board