

IN THE MATTER OF AN OPPOSITION
by Kiddie Products, Inc. to appli-
cation No. 591,967 for the trade-
mark LES PREMIERES ANNEES DE BEBE
filed by The Procter & Gamble Company

On September 17, 1987, the applicant, The Procter & Gamble Company, filed an application for "baby care mail order programme" based on proposed use in Canada. The application was amended to include a disclaimer to the word BEBE and was subsequently advertised for opposition purposes on June 15, 1988.

The opponent, Kiddie Products, Inc., filed a statement of opposition on October 7, 1988, a copy of which was forwarded to the applicant on October 26, 1988. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark THE FIRST YEARS & Design (illustrated below) registered under No. 205,530 for the following wares:

plastic cups and plastic dishes; toilet potties,
toilet and bath seats; baby banks, rattles,
stuffed toys, squeeze toys, suction toys, roly
polys, pull toys, blocks, play phones, play balls,
crib mobiles and crib gyms; baby record books;
diaper pins, comb and brush sets, shoelace locks
and blanket fasteners; baby teethers, baby bottles,
baby bottle accessories and bottle holders.

The applicant filed and served a counter statement. The opponent did not file evidence pursuant to Rule 43 of the Trade-marks Regulations. As its evidence, the applicant filed the affidavit of Denis G. Weil. As purported evidence in reply, the opponent filed a certified copy of its registration. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 at pages 541-542. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's proposed mark LES PREMIERES ANNEES DE BEBE is inherently weak in relation to baby-related wares and services. Since the applicant has failed to evidence any use or advertising of its mark in Canada, I must conclude that its mark has not become

known at all.

The opponent's mark THE FIRST YEARS & Design is also inherently weak when used with baby care items and toys. Since the opponent did not file any evidence in chief, I must conclude that its mark has also not become known at all in Canada.

The length of time the marks have been in use is not a material circumstance in this case. The opponent's wares set forth in its registration comprise various baby care items and toys for infants. In his affidavit, Mr. Weil identifies himself as an employee of the applicant's proposed registered user and describes the manner in which the applicant's mark will be used. According to Mr. Weil, the applicant's mark will be used in association with a mailing campaign to provide new parents with information on baby care and to provide discount coupons for the applicant's products.

It is the applicant's contention that the applicant's services differ from the opponent's wares. However, the applicant's services are to be assessed based on the broad wording of the statement of services in its application rather than the more limited description provided by Mr. Weil: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.). The description "baby care mail order programme" would seem to encompass the solicitation of mail order sales of baby care products including toys. This is confirmed, to some extent, by Mr. Weir who states that the applicant's campaign will include

...mail order services for toys of a particular company such as Mattel Canada Inc. or The Walt Disney Company.

Thus, there is a potential overlap as between the applicant's "baby care mail order programme" and the opponent's baby care items and toys. The trades of the parties could therefore also be overlapping insofar as both could be trying to sell baby care items and toys to consumers. Furthermore, the opponent's statement of wares is not restricted to a particular manner of sale. Thus, it is open to the opponent to sell its merchandise through a mail order program.

As noted, Mr. Weir's description of the applicant's intended use of its trade-mark is narrower in scope than the applicant's statement of services. If the wording of the applicant's statement of services had conformed to the specific intended use of the mark (e.g. - "distribution of information booklets and discount coupons"), there may well have been no connection or overlap between the wares, services and trades of the parties.

As for Section 6(5) (e) of the Act, the applicant submitted that the marks at issue differ visually and phonetically. I agree. However, the question of resemblance (at least in respect of the ideas suggested by the marks) is to be assessed from the standpoint of the average bilingual Canadian, at least where the marks are comprised of words of everyday speech: see Ferrero S.p.A. v. Les Produits Freddy Inc. (1988), 22 C.P.R.(3d) 346 at 354 (F.C.A.). The opponent's mark comprises the words THE FIRST YEARS together with representations of babies or small infants. The applicant's mark LES PREMIERES ANNEES DE BEBE translates into English as "the first years of baby" or "baby's

first years." Thus, I find that there is a very high degree of resemblance between the marks at issue as to the respective ideas suggested by them.

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 resemblance between the wares, services, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark is not confusing with the opponent's registered mark. The ground of opposition based on Section 12(1)(d) is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF NOVEMBER 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.