

**IN THE MATTER OF AN OPPOSITION
by The T. Eaton Company Limited to
application No. 692,012 for the trade-mark
VIKING & Design filed by Viking GmbH
& Co. and now standing in the name of
Viking Umwelttechnik Gesellschaft m.B.H.**

On October 23, 1991, Viking GmbH & Co. filed an application to register the trade-mark VIKING & Design (illustrated below) for the following wares:

Motor driven lawn mowers, motor driven chippers and shredders for organic and inorganic garden waste, motor driven picks, motor driven tillers, motor driven front mowers, motor driven scythes, motor driven road sweepers, motor driven lawn scarifiers, motor driven hedge clippers, motor driven grass trimmers, engines for garden equipment as well as parts and spare parts for the aforesaid wares.

The application is based on proposed use in Canada and on use and registration (No. 2,001,735) in Germany. The applicant claimed priority based on its corresponding German application and thus the effective filing date of the present application is April 24, 1991. The application was advertised for opposition purposes on March 9, 1994 and was subsequently assigned to Viking Umwelttechnik Gesellschaft m.B.H., the current applicant of record.



The opponent, The T. Eaton Company Limited, filed a statement of opposition on May 4, 1994, a copy of which was forwarded to the applicant on July 5, 1994. The first ground of opposition is 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 VIKING registered under No. TMDA47453. At the time the opposition commenced, the registration covered the following services:

Restaurant services namely, the serving of food, beverages and refreshments, catering services for food, beverages and refreshments.

and the following wares:

- (1) Radio sets, radio supplies, phonographs and musical instruments.
- (2) Electric and gas kitchen stoves.
- (3) Refrigerators, sewing machines, washing machines (electrical and otherwise), vacuum cleaners.
- (4) Flashlights.
- (5) Boats.
- (6) Television receivers and parts thereof.
- (7) Electric home laundry equipment namely, washers, driers and ironers; electric food freezers, storage batteries and dry cell batteries; lawn mowers (hand and power); electric power tools namely, drills, table saws, wood turning and metal turning lathes, and planers; electric household appliances of the plug-in type namely: irons, kettles, toasters, heaters, floor polishers, heating pads, grills, fans and food mixers; and air conditioning devices (circulating and refrigerating).
- (8) Tape recorders, tape recorder parts, and tape recorder tapes.
- (9) Outboard motors for boats.
- (10) Outboard motor tanks and motor boat auxillary [sic] fuel tanks.
- (11) Life preserver jackets and cushions.
- (12) Boating hardware and equipment and battery chargers.
- (13) Domestic automatic electric dishwashers-dryers, domestic electric garbage disposal units (as normally used in kitchen sinks) and domestic electric and gas built-in ovens and surface cooking units.
- (14) Kitchen stove vent hoods.
- (15) Boat trailers, portable dishwashers, built-in dishwashers, convertible mobile dishwashers.
- (16) Transistor batteries.
- (17) Non-electric and electric typewriters.
- (18) Non-electric and electric adding machines and calculators.
- (19) Outdoor, indoor and table-top barbecues; insulated picnic chests and picnic jugs, electric chemical and mechanical [sic] barbecue lighters, barbecue lighter fluid and patio torches; gas and electric glass-lined water heaters; water softeners.
- (20) Electric light bulbs.
- (21) Gasoline powered garden and farm tractors and tillers.
- (22) Gasoline powered snow throwers.
- (23) Wheelbarrows.
- (24) Electric household appliances, namely, percolators, can openers, fry pans, knives, grillettes, hot plates, cookers, deep fryers, warming trays, blenders, juicers, griddles, broilers.
- (25) Stereo hi-fi radio phonograph combination sets.
- (26) Stereo hi-fi components namely, speakers, amplifiers, tuners, tuner amplifiers and record turntables.
- (27) Portable humidifiers and portable dehumidifiers.
- (28) Tape players.
- (29) Oil space heaters, gas space heaters and forced air oil furnaces.

However, the registration was subsequently amended on May 5, 1998 pursuant to Section 45 of the Act to delete the services and most of the wares. The registration now covers only the following wares:

- (1) Electric and gas kitchen stoves.
- (2) Refrigerators, vacuum cleaners.
- (3) Electric home laundry equipment namely, washers, driers; electric food freezers.
- (4) Domestic automatic electric dishwashers-dryers and domestic electric and gas built-in ovens and surface cooking units.

- (5) Portable dishwashers, built-in dishwashers, convertible mobile dishwashers.
- (6) Outdoor, indoor and table-top barbecues.
- (7) Portable humidifiers and portable dehumidifiers.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Sections 16(2)(a) and 16(3)(a) of the Act because, as of the applicant's actual filing date and as of its effective filing date, the applied for trade-mark was confusing with the trade-mark VIKING previously used in Canada by the opponent or its licensee in association with the wares and services noted above. The third ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the opponent's mark.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Eric Williamson and Carl David Swan. As its evidence, the applicant submitted the affidavits of Michael Cormier, Grace Di Tiello and Nikolas Andreas Stihl. Both parties filed a written argument and an oral hearing was conducted on May 7, 1998 at which both parties were represented.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). 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.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive since neither is suggestive or descriptive of the associated wares. While the applicant has evidenced European sales figures for its VIKING & Design products, there is no evidence of any sales or advertising in Canada. Thus, I must conclude that the applicant's mark has not

become known at all in this country. The opponent, on the other hand, has evidenced significant use and advertising of its mark throughout Canada in association with barbecues and home appliances such as refrigerators, ranges and dishwashers. Thus, I am able to conclude that the opponent's mark VIKING has become well known in association with such wares.

The length of time the marks have been in use favors the opponent. As for the wares and trades of the parties, it is the applicant's statement of wares and the opponent's statement of wares in its registration that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The applicant's wares comprise motor driven devices for yard and garden use such as lawn mowers, tillers, hedge clippers and the like. The statement of wares in the opponent's registration includes various types of appliances as well as barbecues. Thus, although the wares of the parties are different, there is a connection between the applicant's wares and the opponent's barbecues, barbecues being an appliance commonly used in the yard or on the patio. Furthermore, it is apparent that the opponent previously sold the same type of wares as the applicant under its trade-mark VIKING. Exhibit A to the Williamson affidavit evidences two 1987 advertisements featuring a VIKING lawn mower and two VIKING snow throwers. Although the opponent has not evidenced any recent sales of such items, this evidence shows that the opponent, at least at one time, considered motor driven devices for yard and garden use to be a natural extension of its VIKING line of products.

Presumably the trades of the parties would, or could, overlap. The brochures appended as exhibits to the Stihl affidavit illustrate that the applicant's wares are intended for the average consumer. They would therefore be sold through the normal channels of trade for such wares such as hardware stores, garden supply stores and department stores. The opponent's evidence establishes that it operates a chain of retail department stores across Canada which sells a wide variety of items including those sold by the applicant. The applicant contended that there would be no overlap in the trades of the parties since the opponent sells its VIKING wares only through its own retail outlets. However, it is not apparent that consumers are necessarily aware of that fact. More importantly, there is no such restriction in the opponent's statement of wares and that is what governs. In other words, the opponent's registered statement of wares covers all normal channels of trade for such wares.

As for Section 6(5)(e) of the Act, the marks are virtually identical in all respects. The applicant argued that its mark differed from the opponent's mark due to the design component. However, the design component is minimal and only serves to underscore the meaning of the word VIKING since it consists of a Viking helmet.

The applicant also submitted that the opponent's trade-mark VIKING is often used in association with its trade-mark EATON such that consumers only recognize the combination EATON VIKING. However, as noted by the opponent, the trade-mark VIKING is typically used in larger typeface than the trade-mark EATON such that consumers would recognize it as a separate trade-mark. Furthermore, even if consumers associate the trade-mark VIKING with the opponent, this does not lessen the likelihood that they will be confused when presented with the applicant's trade-mark VIKING & Design with no accompanying reference to EATON. As noted by the opponent, consumers faced with that mark for items such as lawn mowers in retail outlets such as hardware stores may well assume that the opponent has licensed its VIKING mark to others.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence in the Di Tiello affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Initially, it should be noted that Ms. Di Tiello conducted a search of her company's internal database which, according to her, is her company's version of the trade-marks register from the Canadian Trade-marks Office. She states that this database contains all of the official information from the trade-marks register as well as information about expunged registrations and abandoned applications since 1978.

Ms. Di Tiello conducted a search based on the word VIKING and found more than 100 references. However, some of those references do not include the word VIKING. A number of references are pending applications which are not particularly relevant given that they may be based on proposed use or may be opposed. Still more references consist of expunged registrations or abandoned applications. Nevertheless, the search results do reveal more than 70 registrations for trade-marks comprising or including the word VIKING. Thus, I am able to conclude that the word VIKING is a fairly common component of trade-marks in general. However, further examination of those registrations reveals that only a handful cover wares that are even arguably related to those at issue in the present case. Given such small numbers, I am not able to infer that any of them are in active use such that consumers would be used to seeing such marks in the field of machines and appliances for use in the yard and garden. Thus, the Di Tiello affidavit does little to assist the applicant's case.

Ms. Di Tiello also conducted a search of an Internet domain name database. Her search revealed 31 domain names which include the component VIKING, many of which appear to be associated with commercial enterprises. However, there is little or no indication as to the type of business, if any, carried on by these entities. More importantly, only one of the 31 names located is based in Canada. Thus, nothing useful can be inferred from Ms. Di Tiello's domain name search.

The applicant also relied on the Cormier affidavit in which Mr. Cormier states that he conducted a "Common Law search" for the word VIKING. Although Mr. Cormier is not that precise in detailing the nature and scope of his search, it appears that it covered a wealth of business and trade directories and a number of corporate and trade-name registers. As noted by the opponent, Mr. Cormier gives no basis for concluding that the sources he searched are reliable. As further noted, his search results essentially comprise a list of names drawn from various sources with no attempt to cross reference the sources to eliminate duplication and with little or no indication as to the nature of the related businesses. Finally, there is no evidence of use of any of these names in Canada.

At best, the Cormier search leads to a conclusion similar to that flowing from the Di Tiello trade-mark search, namely that VIKING is a common component of trade-names and corporate names in general. However, as conceded by the applicant at page 14 of its written argument, the Cormier search only revealed four business names covering businesses arguably relevant to the services and trades at issue in this opposition. In the absence of evidence of use of those names, their mere existence in a directory or on a register is of no import in this case.

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 similarities between the marks, wares and trades of the parties and the reputation associated with the opponent's mark, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark VIKING & Design is not confusing with the opponent's registered mark VIKING. The first ground is therefore successful.

The second ground is one of prior entitlement based on prior use of the opponent's mark VIKING. The opponent has evidenced use of its trade-mark prior to the applicant's effective filing date (April 24, 1991) and non-abandonment of its mark as of the applicant's date of advertisement. The opponent has only shown prior use of its mark for various appliances and for barbecues. As noted by the applicant, the opponent did not evidence prior use of its mark for lawn mowers, snow throwers or the like.

In view of the above, the second ground remains to be decided on the issue of confusion between the marks at issue. Again, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. My conclusions respecting the first ground are, for the most part, applicable here. One difference of note is that the level of sales evidenced by the opponent as of April 24, 1991 is less although still significant. As previously noted, the opponent's evidence establishes that it has advertised lawn mowers and snow throwers in association with its trade-mark VIKING which supports the conclusion that the trades of the parties are similar. Thus, 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 previously used mark. The second ground is therefore also successful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - May 4, 1994): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The third ground essentially turns on the issue of confusion between the applicant's mark and the opponent's mark as used and advertised. My conclusions respecting the first

and second grounds are, for the most part, applicable to this ground as well. Thus, I find that the marks are confusing as of the filing of the opposition and that the applicant has failed to satisfy the onus on it to show that its mark is distinctive throughout Canada. The third ground is therefore also successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 28th DAY OF MAY, 1998.

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