

IN THE MATTER OF AN OPPOSITION
by Faber-Castell Canada Inc. to
application No. 594,866 for the
trade-mark MY FIRST filed by
Binney & Smith Inc.

On November 5, 1987, the applicant, Binney & Smith Inc., filed an application to register the trade-mark MY FIRST based on use in Canada since December of 1985 with the following wares:

art supplies, namely crayons, markers, chalks
for use in writing or drawing, paint brushes,
coloured pencils, modelling clay, all sold
separately or in kits.

The application was advertised for opposition purposes on June 1, 1988.

The opponent, Faber-Castell Canada Inc., filed a statement of opposition on June 30, 1988, a copy of which was forwarded to the applicant on August 11, 1988. The first ground of opposition is that the application does not comply with the provisions of Section 30(b) of the Trade-marks Act because the applicant has not used the applied for trade-mark since December of 1985 as alleged. The second ground of opposition reads as follows:

The Trade Mark is not registrable for use in respect of art supplies...having regard to Section 12(1)(b) of the Act, because, at the date of filing of the Application, it was clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which the Trade Mark is used.

The third ground of opposition reads as follows:

The Trade Mark is not distinctive of the wares of the Applicant, nor is it adapted to so distinguish them from the wares of others.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Sarah F. Llewelin. The applicant did not file evidence. Each party filed a written argument and an oral hearing was conducted at which only the applicant was represented.

As for the 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. However, there is an evidential burden on the opponent to file evidence in support of the allegations of fact underlying this ground. Since the opponent did not file any evidence on point, the first ground is unsuccessful.

As for the second ground of opposition, it is not in sufficient detail for the applicant to reply to it. The opponent has essentially reproduced the words appearing in Section 12(1)(b) of the Act without providing any supporting allegations of fact. Thus, the second ground is unsuccessful on that basis alone.

From a review of the opponent's written argument, it is apparent that the opponent intended to base its second ground of opposition on the allegation that the words MY FIRST comprise a common phrase used for a variety of children's products to describe the first goods of a given type to be purchased for or by a child. However, even if that allegation had been included in the statement of opposition, the second ground would have been unsuccessful.

In her affidavit, Ms. Llewelin identifies herself as a law clerk employed with the

firm of trade-mark agents representing the opponent. Much of her affidavit relates to purchases made by her in Toronto in November of 1988. Most of those purchases were of children's books with titles that included the words "my" and "first" such as My First Wordbook and My Very First Things. Several purchases were of items for children on which the words "my first" appeared as part of a trade-mark or as part of a description of the goods. Although the purchases were made about one year after the material time for considering the issue arising pursuant to Section 12(1)(b) of the Act (i.e. - the filing date of the applicant's application), I consider that they are likely fairly representative of the marketplace as of the earlier date.

The opponent contends that the foregoing helps to establish that the words "my first" used on different wares indicate that the wares are intended for young children. I agree with the opponent's contention, at least insofar as it applies to the mark and wares at issue in the present case. However, the fact that the trade-mark MY FIRST may indicate that the applied for wares are for young children does not establish that the mark offends Section 12(1)(b) of the Act.

The mark does not, in my view, describe any particular character or quality of the applied for wares. The fact that the various art supplies may be intended for young children does not provide the consumer with any additional information about the wares. Because the crayons, markers or brushes are for young children does that mean that they are smaller or safer or cheaper? Or does it mean that they are more expensive since, being a child's first, they are intended to last a long time? The trade-mark may be suggestive of any number of characters or qualities but it does not describe any particular one. More importantly, it does not clearly describe any particular character or quality of the wares. Thus, even if the second ground had been supported by appropriate allegations of fact, I consider that it still would have been unsuccessful.

As for the third ground, again, the opponent has not provided any specific supporting allegations of fact as required by Section 38(3)(a) of the Act. The ground is therefore restricted to the relevant allegations appearing in the previous grounds. In other words, the third ground is restricted to an assertion that the applicant's mark is not distinctive because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares. Since no supporting allegations of fact were provided in respect of the second ground, the third ground is also unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MAY 1991.

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