

**IN THE MATTER OF AN OPPOSITION
by Shen Manufacturing Company, Inc. to
application No. 689,788 for the trade-mark
LE RITZ filed by The Ritz Hotel Limited**

On September 6, 1991, the applicant, The Ritz Hotel Limited, filed an application to register the trade-mark LE RITZ based on use and registration in France. The applicant claimed priority based on its corresponding French application and thus the effective filing date of the present application is March 19, 1991. The application, as amended, covers the following wares:

coûtellerie, fourchettes, cuillères, ciseaux, trousse de manucure; rasoirs; services à thé en métaux précieux, services à café en métaux précieux, vases en métaux précieux, louches en métaux précieux, porte-couteaux en métaux précieux, salière-poivrière en métaux précieux, panier, plateaux, bougeoirs, porte-cigares en métaux précieux, timbale naissance en métaux précieux, ronds de serviette en métaux précieux, coquetiers en métaux précieux, boîtes à pilules en métaux précieux, coupe-papier en métaux précieux, boutons de manchettes; porte-monnaie, porte billets, porte carte de crédit, valises, attaché-cases, sacs de voyage, sacs de chasse; plats, nommément: plats à viande, plats à poisson, plats à fruits de mers, plats à fromage, plats à tarte, service à thé, services à café, assiettes, vases, verres, porte-couteaux, porte-noms nommément: supports d'étiquettes ou écriteaux en papier, carton, bois, matières plastiques ou en métal portant un nom, porte-serviette, panier, salière, poivrière, casseroles, poêles, marmites, moules à gâteaux, plateaux, coupelle de tastevin, ouvre-bouteilles, tire-bouchons, décanteurs, mélangeurs manuels, ensemble peigne-brosse, ronds de serviettes, coquetiers, vaporisateurs, brosse et verre à dents; linge de table, nappes, serviettes, sets de table, draps, taies, linge de bain; confitures; foies gras, caviars, saumons; chocolat; confiserie nommément: fruits confits, bonbons.

The application was advertised for opposition purposes on September 22, 1993.

The opponent, Shen Manufacturing Company, Inc. ("Shen"), filed a statement of

opposition on November 17, 1993, a copy of which was forwarded to the applicant on February 23, 1994. Leave was granted on July 5, 2000 to the opponent pursuant to Rule 40 of the Trade-marks Regulations to effect a minor amendment to its statement of opposition.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(d) of the Trade-marks Act because the applicant had not used its applied for trade-mark in France as claimed. The second ground is that the applicant's application does not conform to the requirements of Section 30(i) of the Act. The opponent alleges that the applicant could not have been satisfied that it was entitled to use its applied for mark in view of the opponent's trade-mark registration No. 101,832 and the opponent's use of its trade-mark RITZ with towels, tea towels, tie towels, dish cloths, potholders, oven mitts, aprons and appliance covers.

The third ground of opposition is that the applicant's trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark RITZ & Design (shown below) registered under No. 101,832 for the following wares:

- (1) cleaning and polishing cloths,
- (2) towels, tie towels, dish cloths, potholders, oven mitts, aprons and appliance covers.



The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(2)(a) because, as of the effective filing date of the present application (i.e. - March 19, 1991), the applied for trade-mark was confusing with the trade-marks RITZ and RITZ & Design previously used in Canada by the opponent in association with the registered wares noted above. The fifth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Howard Steidle dated August 11, 1994. Mr. Steidle was cross-examined on his affidavit on January 26, 1995 and the transcript of that cross-examination and the replies to undertakings given during the cross-examination form part of the record of this proceeding. The applicant did not file any evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The Evidence

In his affidavit, Mr. Steidle identifies himself as the President of Shen, a company he has been with for many years. According to Mr. Steidle, Shen acquired rights in Canada to the trade-mark RITZ on April 8, 1968 when it acquired John Ritzenthaler Company. Since that time, Shen has been selling the wares listed in registration No. 101,832 under the trade-mark RITZ & Design. The wares are sold with packaging or labelling which identifies the source of the goods as John Ritzenthaler Company which Mr. Steidle has identified as a

division of Shen (see questions 82 and 473 of the Steidle transcript).

According to Mr. Steidle, Shen has sold many of its RITZ products in Canada for over twenty-five years. He identifies a number of Canadian customers such as Woodwards, Simpsons, Eatons and the Hudson Bay Company. Mr. Steidle could not provide any Canadian sales figures (see questions 183, 215 and 285 of the Steidle transcript). He was, however, able to provide copies of invoices covering sales to Canadian customers from as early as March of 1990. He was also able to provide copies of several order forms from Canadian customers dating back as early as 1976 but he could not provide any related documentation for any of the pre-1990 orders such as an invoice or a bill of lading (see pages 68 ff. of the Steidle transcript).

The Grounds of Opposition

The opponent's first ground of opposition is that the applicant's application is not in conformance with the requirements of Section 30(d) of the Trade-marks Act in that the applicant did not use the alleged mark in France as claimed. With respect to a ground of opposition based on non-conformance with Section 30 of the Trade-marks Act, there is a legal burden on the applicant to establish that its application was in compliance with Section 30 of the Act as of the filing date of the applicant's application. However, there is an initial evidential burden on the opponent to establish the facts which it alleges in support of the ground of opposition (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.

(1984), 3 C.P.R. (3d) 325 at 329).

As pointed out in the opposition decision in Tune Masters v. Mr. P's Mastertune Ignition Services Ltd. (1986), 10 C.P.R. (3d) 84 at 89, “.....it is difficult for an opponent to prove an allegation of non-use by an applicant, the relevant facts being readily available to the applicant.” While those comments related to a ground of opposition based on Section 30(b) of the Act, they are equally applicable in respect of a ground of opposition based on Section 30(d): see 105272 Canada Inc. v. Grands Moulins de Paris (1990), 31 C.P.R. (3d) 79 (T.M.O.B.). Furthermore, in the opposition decision in Canadian Council of Professional Engineers v. Ontario Corp. No. 407,736 (1987), 15 C.P.R. (3d) 551 it was held at page 553 that “.....the amount of evidence required to discharge this evidential burden may be very slight.”

At the oral hearing, the opponent’s agent submitted that the opponent’s evidential burden, in the present case, should be lifted entirely. He submitted that, when an applicant claims use abroad (in this case, France), it is too difficult for an opponent to adduce evidence of non-use. Although I sympathize with the opponent’s dilemma, I consider that an evidential burden remains on an opponent respecting each of its grounds of opposition. As noted, however, with some grounds of opposition, very little evidence may be needed to meet that burden.

In the present case, the opponent has submitted no evidence to support its contention that the applicant has not used its trade-mark in France as claimed. Furthermore, on cross-

examination, Mr. Steidle admitted that he had no knowledge of alleged non-use by the applicant of its trade-mark in France. Thus, the opponent has failed to meet its evidential burden and the first ground of opposition is unsuccessful.

At the oral hearing, the opponent's agent further submitted that the prosecution history of the present application before the Examination Section of the Trade-marks Office was sufficient to meet the opponent's evidential burden respecting the first ground of opposition. He stated that the applicant (whose principal office or place of business is in London, England) initially based its application on use and registration in Great Britain and subsequently amended the application to base it instead on use and registration in France. He submitted that these circumstances alone are sufficient to satisfy the opponent's evidential burden. Although there is some merit in the opponent's submission, it does not apply in the present case because the relevant facts were not properly evidenced. More importantly, it does not apply because the opponent's first ground of opposition does not cover such a pleading and I am therefore precluded from considering it: see Imperial Developments Ltd. v. Imperial Oil Ltd. (1984), 79 C.P.R.(2d) 12 at 21 (F.C.T.D.).

The second ground does not raise a proper ground of opposition. The fact that the opponent has a registration for the trade-mark RITZ & Design and has used that mark in Canada does not, by itself, support a ground of non-conformance with Section 30(i) of the Act. The opponent failed to allege that the marks at issue were confusing and that the applicant was aware of that fact when it filed its application. Thus, the second ground is also unsuccessful.

As for the third 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 Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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, I consider that the marks of both parties are inherently distinctive although neither mark is particularly strong. As I noted in a previous opposition between the parties, the word “ritzy” means fashionable or smart which indicates that the marks are at least somewhat suggestive of the related wares: see Ritz Hotel Ltd. v. Shen Manufacturing Co. (1992), 47 C.P.R.(3d) 106 at 113. The applicant has not evidenced any reputation for its mark in Canada and, due to the deficiencies in the opponent’s evidence, I cannot ascribe any reputation of note for its mark in this country.

The opponent has evidenced a handful of Canadian orders for its products (see Exhibit D to the Steidle affidavit) with the earliest dating back to 1976. On a balance of probabilities, I can conclude that at least some of those orders were filled and that some sales were made in Canada well prior to the applicant’s priority filing date. Thus, the length of time the marks have been in use favors the opponent.

As for Sections 6(5)(c) and 6(5)(d) of the Act, many of the wares listed in the applicant's application differ from the opponent's registered wares. In particular, the food items, personal use items, luggage items and items made from precious metals differ in their natures from the opponent's fabric items designed for kitchen use. The trades associated with such wares would likely be quite distinct. On the other hand, the applicant's wares described as "linge de table, nappes, serviettes, sets de table, draps, taies, linge de bain" are similar to the opponent's wares and could easily be sold through the same types of retail outlets.

The remaining items in the applicant's application could be generally described as everyday cooking and dining items which would be used in the kitchen or dining room. Although these wares are not the same as the opponent's wares, they all fall within the general category of ordinary housewares or kitchenware. To this extent, there could be an overlap in the trades of the parties in retail stores or departments of department stores that specialize in such items: see page 113 of the Ritz Hotel decision noted above. The applicant contends otherwise but failed to file evidence on point.

As for Section 6(5)(e) of the Act, there is a high degree of resemblance between the marks in all respects. Both marks are dominated by the word RITZ.

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 high degree of resemblance between the marks at issue, the similarities between the opponent's wares and the applicant's wares that qualify as linens and ordinary housewares or kitchenware and the similarities in the related trades, I find that I am left in a state of doubt

respecting the issue of confusion. Since the legal burden is on the applicant, I must resolve that doubt against it. Consequently, the third ground of opposition is successful in respect of the following wares:

coûtellerie, fourchettes, cuillères

panière, plateaux, bougeoirs

plats, nommément: plats à viande, plats à poisson, plats à fruits de mers, plats à fromage, plats à tarte, service à thé, services à café, assiettes, vases, verres, porte-couteaux, porte-noms nommément: supports d'étiquettes ou écriteaux en papier, carton, bois, matières plastiques ou en métal portant un nom, porte-serviette, panière, salière, poivrière, casseroles, poêles, marmites, moules à gâteaux, plateaux, coupelle de tastevin, ouvre-bouteilles, tire-bouchons, décanteurs, mélangeurs manuels

ronds de serviettes, coquetiers

linge de table, nappes, serviettes, sets de table, draps, taies, linge de bain.

The remaining wares in the applicant's application are quite distinct from the opponent's wares as are the related trades. Thus, I find that the marks at issue are not confusing in respect of the remaining wares notwithstanding the high degree of resemblance between the marks at issue. Therefore, to that extent, the third ground is unsuccessful.

As for the fourth ground of opposition, there was an initial onus on the opponent to evidence use of its marks prior to the applicant's priority filing date and non-abandonment of those marks as of the applicant's advertisement date. As discussed, the opponent's evidence is sketchy and deficient in some respects. However, I am able to conclude that the opponent did effect at least some sales to Canadian customers of RITZ-branded goods prior to March 19, 1991. Furthermore, the evidence shows that the opponent had not abandoned its trade-

marks RITZ and RITZ & Design as of September 22, 1993.

The fourth ground of opposition therefore remains to be decided on the issue of confusion between the applicant's mark and the opponent's marks RITZ and RITZ & Design as of the material time which is the applicant's priority filing date. My conclusions respecting the third ground are, for the most part, applicable to this ground as well. Thus, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's previously used marks in respect of the linen items and ordinary housewares listed in the applicant's statement of wares. To that extent, the fourth ground is successful. Otherwise, I find that the marks are not confusing and that the fourth ground is unsuccessful.

As for the fifth 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. - November 17, 1993): 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.).

Given my conclusions respecting the third and fourth grounds of opposition, it also follows that the applicant's mark is confusing with the opponent's trade-marks as of the filing of the opposition in respect of the applicant's linen wares and ordinary housewares but is otherwise not confusing. Thus, as with the third and fourth grounds, the fifth ground is

partially 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 in respect of the following wares:

coûtellerie, fourchettes, cuillères

panière, plateaux, bougeoirs

plats, nommément: plats à viande, plats à poisson, plats à fruits de mers, plats à fromage, plats à tarte, service à thé, services à café, assiettes, vases, verres, porte-couteaux, porte-noms nommément: supports d'étiquettes ou écriteaux en papier, carton, bois, matières plastiques ou en métal portant un nom, porte-serviette, panière, salière, poivrière, casseroles, poêles, marmites, moules à gâteaux, plateaux, coupelle de tastevin, ouvre-bouteilles, tire-bouchons, décanteurs, mélangeurs manuels

ronds de serviettes, coquetiers

linge de table, nappes, serviettes, sets de table, draps, taies, linge de bain

and I otherwise reject the opponent's opposition. Authority for such a divided result may be found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).

DATED AT HULL, QUEBEC, THIS 27th DAY OF NOVEMBER, 2001.

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