



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 16
Date of Decision: 2011-01-27

**IN THE MATTER OF AN OPPOSITION
by Highland Feather Inc. to application
No. 1,313,238 for the trade-mark
ALLER-CHECK in the name of
American Textile Company**

[1] On August 16, 2006, American Textile Company (the Applicant) filed an application to register the trade-mark ALLER-CHECK (the Mark) for pillow covers and mattress covers based upon proposed use of the Mark in Canada.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 4, 2007.

[3] On June 6, 2007, Highland Feather Inc. (the Opponent) filed a statement of opposition, which pleaded the following grounds of opposition, pursuant to the indicated sections of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. s. 38(1)(b)[sic]/12(1)(d): the Mark is not registrable because it is confusing with the trade-mark ALLER-SAFE registered by the Opponent under No. TMA659,893;
2. s. 38(2)(c)/16(3)(a): the Applicant is not the person entitled to registration of the Mark because at the date of filing of the application the Mark was confusing with the Opponent's ALLER-SAFE mark, which had been previously used in Canada by the Opponent;

3. s. 38(2)(d): the Mark is not distinctive because it does not distinguish the wares of the Applicant from the wares of the Opponent having regard to the use and advertising of the Opponent's trade-mark ALLER-SAFE in Canada.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. The Applicant also stated that it assumed that the reference in the statement of opposition to s. 38(1)(b) was a typographical error and that it was treating it as referring to the correct section, s. 38(2)(b).

[5] In support of its opposition, the Opponent filed an affidavit of Cheney Q. Chen (its Executive – Vice President). In support of its application, the Applicant filed affidavits of John Angelini (its vice president of compliance and sustainability) and Jane Buckingham (a trade-mark searcher). No cross-examinations were conducted.

[6] Only the Applicant filed a written argument. An oral hearing was not held.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(3)(a) - the filing date of the application;

- s. 38(2)(d) - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 12(1)(d) Ground of Opposition

[9] Mr. Chen has provided a printout of registration No. TMA659,893 for ALLER-SAFE. I have checked the Register to confirm that the registration has not subsequently been expunged [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. ALLER-SAFE is registered for mattresses, pillows and duvets; mattress, pillow and duvet protectors. The Opponent's initial burden has therefore been met.

[10] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[11] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

[12] Neither party's mark is inherently strong since both suggest that the associated products are good for people who have allergies.

[13] According to Mr. Chen, the Opponent's Canadian sales of ALLER-SAFE wares amounted to \$35,600 and \$49,000 in 2006 and 2007, respectively. Mr. Chen attests that the Opponent promotes its ALLER-SAFE mark through its website and by visiting retailers and providing samples and information about its various products, but no information has been provided that would enable me to determine to what extent such activities might have made the Opponent's mark known in Canada. (I disagree with the Applicant's submission that the mark

shown on the packaging provided by Mr. Chen is not the word mark ALLER-SAFE; the fact that a design appears above the words ALLER-SAFE, which are displayed in lower case, does not mean that this is not use of ALLER-SAFE *simpliciter*.)

[14] As of the date of signature of Mr. Angelini's affidavit (September 19, 2008), the Applicant had only used its Mark in Canada in association with "cotton pillow protectors". Such use began in approximately August 2007 and Canadian sales (in US dollars) have equaled or exceeded the following: fiscal year 2007 - \$44,819; January to July 2008 - \$20,952. Those sales represent approximately 13,000 units. Mr. Angelini did not provide any information concerning promotion of the Applicant's Mark.

[15] Both parties manufacture and distribute bedding products. The parties' wares overlap. Both parties sell their wares through retailers and even if they are not presently selling their wares through the same retailers, it is reasonable to conclude that their channels of trade could be identical or overlap.

[16] It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction. However, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[17] It seems reasonable to conclude that a typical purchaser of the parties' wares would respond to "aller" as an abbreviated reference to "allergy" or some other form of that word. Thus the significance of the first component of the parties' marks decreases. As a result, the overall degree of resemblance between the marks in appearance and sound is not great. (I note that if one considers the bilingual consumer, even though "aller" means "to go" in French, a bilingual consumer might also respond to "aller" as an abbreviated reference to "allergie".)

[18] Regarding the idea suggested by each mark, the Opponent's mark suggests that its wares are safe for users who have allergies. The idea suggested by the Applicant's Mark is perhaps a little bit less direct, i.e. that one should check the allergy issues or that the manufacturer has

taken allergy issues into consideration. Given that the idea suggested by each mark is suggestive of a characteristic of the wares, I do not consider this resemblance to be particularly significant.

[19] The Applicant also filed evidence concerning two other surrounding circumstances.

[20] First, Mr. Angelini evidenced that the Applicant has already registered ALLER-EASE for mattress covers and pillow covers. However, s. 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Groupe Lavo Inc. v. Proctor & Gamble Inc.* (1990), 32 C.P.R. (3d) 533 (T.M.O.B.) at p. 538].

[21] Second, Ms. Buckingham provided the results of searches conducted of both the Canadian Trade-marks Register and of the Internet for other “aller” trade-marks or business names. On the Register, she located the following ALLER prefix marks, in the name of eight different third parties:

1. ALLERGUARD for bedding, quilt covers and pillow covers;
2. ALLERFRESH for pillows and mattress covers;
3. ALLERGY CONTROL & Design for covers for mattresses, box springs and pillows, pillowcases and duvets;
4. ALLERCARE for pillows, mattress covers, duvets;
5. ALLERREST for pillows and comforters
6. ALLERBAN for synthetic fibre containing an anti-bacterial agent as an integral part of sheets, pillows, mattress pads, comforters, duvets;
7. ALLERGON for fabric for use as an allergen barrier;
8. ALLERX for pillows;
9. ALLERZIP for bed pillow covers, duvet covers, bed mattress protectors.

[22] On the Internet, she located websites that refer to ALLERCARE, ALLERREST, ALLERZIP and ALLERGUARD. She also located references to the Applicant's ALLER-EASE mark on the Internet.

[23] Although the number of third party uses of the prefix ALLER in the parties' field is not large, Ms. Buckingham's evidence does support the conclusion that I was already prepared to make, namely that ALLER, due to its suggestiveness, is a weak prefix such that members of the public will rely on the accompanying words to distinguish one ALLER prefix mark from another.

[24] In the circumstances of this case, I am satisfied that the differences between the suffixes of each mark in both appearance and sound are sufficient that confusion between the marks as a whole is not likely. I note that while the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [*Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at para. 34] and that, in the case of weak marks, small differences may suffice to distinguish one mark from the other [see for example: *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.); *Associated Brands Inc. v. Scott Paper Ltd.* (2004), 43 C.P.R. (4th) 361 (T.M.O.B.)].

[25] Although there are close similarities between the parties' wares and trades, as stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70:

Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.

[26] The first ground of opposition is accordingly dismissed.

Section 16 Ground of Opposition

[27] In order to meet its initial burden with respect to the second ground of opposition, the Opponent must show that it used its mark prior to August 16, 2006. Mr. Chen has attested at

paragraph 5 of his affidavit that ALLER-SAFE wares “have been sold and/or advertised in Canada since as early as April 2006.” He has also provided sales figures for the year 2006. Overall, his evidence does not show use of the Opponent’s mark prior to August 16, 2006. I reach this conclusion because his evidence is ambiguous regarding activities prior to August 16, 2006. I interpret his use of “and/or” in paragraph 5 as indicating that he is attesting to either or both of the two stated possibilities, i.e. he may simply be saying that ALLER-SAFE wares have been advertised in Canada since as early as April 2006. The appearance of a trade-mark in an advertisement does not typically amount to trade-mark use as per s. 4 of the Act and therefore it is not clear from paragraph 5 that the Opponent’s mark was used in Canada in accordance with s. 4 prior to the material date. This ambiguity might have been resolved if Mr. Chen had broken the 2006 sales down by month, but he did not do so.

[28] The s. 16 ground is accordingly dismissed on the basis that the Opponent has not met its initial burden.

Distinctiveness Ground of Opposition

[29] In order to meet its initial burden with respect to the third ground of opposition, the Opponent must show that as of June 6, 2007 its mark had become known sufficiently to negate the distinctiveness of the Applicant’s Mark [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *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.)]. The Opponent has met this initial onus through the evidence that it had sales in excess of \$35,600 as of that date.

[30] Overall, the evidence concerning the likelihood of confusion between the marks as of June 6, 2007 and today’s date does not differ sufficiently to result in there being a difference in the two grounds’ outcome. I appreciate that the Internet evidence provided by Ms. Buckingham does not predate the distinctiveness ground’s material date but such evidence was not key to my decision with respect to the s. 12(1)(d) ground.

[31] The distinctiveness ground is accordingly dismissed for reasons similar to those set out with respect to the s. 12(1)(d) ground.

Disposition

[32] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office