

**IN THE MATTER OF AN OPPOSITION by
Anglo Canadian Housewares L.P. to Application
No. 1100107 for the Trade-mark LEONARDO &
Design filed by Glaskoch B. Koch Jr. GmbH &
Co. KG**

I The Pleadings

On June 14, 2001 Glaskoch B. Koch Jr. GmbH & Co. KG (the “Applicant”) filed an application to register the following trade-mark:



with a claim for the colours white for the word LEONARDO and the clouds design and dark blue for the rectangular background as part of the trade-mark (the “Mark”).

The application, as amended, covers the following wares:

Technical devices and apparatuses with glass case made of glass namely oil burner, table lantern, iron and structured clear glass candleholders, lamps, indoor fountains; lighting appliances namely lamps, beside lamps, ceiling lights; watches and timekeepers; pieces of equipment and containers for household and kitchen (not of precious metal or plated) namely pots, raw or partly worked and plain glass (except construction glass); household products, gift articles and objects of industrial art made of glass, china, ceramics, namely tea, coffee and table services, drinking glasses, mugs, carafes, trays, saucers, candleholders, candlesticks with protection against wind, champagne coolers, ice buckets, receptacles for spiced wine; Christmas tree decorations; games and toys namely board games, toy figures, bath toys, balloons, ash-trays made of glass, china, stoneware or ceramics.

(2) Household products, gift articles and objects of industrial art made of glass, ceramics, metal or plastics, namely tea, coffee and table services, drinking glasses, mugs, carafes, trays, saucers, candleholders, candlesticks with protection against wind, pictures and figures for hanging in windows, champagne coolers, ice buckets, receptacles for spiced wine; ash-trays made of glass, ceramics, metal or plastics. (wares (1) and (2) collectively referred to as the “Wares”)

The application is based on use in Canada since 1995 for the wares (1). The Applicant claims having filed on December 14, 1987 in its country of origin, namely in Germany, an application

number 113271 to register the Mark in association with wares (2). The present application was advertised on June 11, 2003 in the Trade-marks Journal for opposition purposes.

Anglo Canadian Housewares L.P. (the “Opponent”) filed on November 7, 2003 a statement of opposition that was forwarded by the Registrar to the Applicant on January 6, 2004. The grounds of opposition are:

- (1) The application does not comply with the provisions of s. 30(a) of the Trade-marks Act R.S.C. 1985 c. T-13 (the “Act”) in that the Wares are not described in ordinary commercial terms;
- (2) The application does not comply with the provisions of s. 30(b) of the Act in that the Applicant did not use the Mark in Canada in relation to each of the wares and services described in the application since the alleged date of first use namely 1995 or at any relevant time or, alternatively, has abandoned same by way of non continuous use;
- (3) The application does not comply with the provisions of s. 30(d) of the Act in that the Applicant did not register and use the Mark in Germany in relation with each of the wares and services described in the application since the alleged dates of registration or use in Germany or at any relevant time or, alternatively, has abandoned same by way of non continuous use in Germany;
- (4) The Mark is not registrable in that pursuant to the provisions of s. 12(1)(a) of the Act, it is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years and was not distinctive at the date of filing of the application;
- (5) The Mark is not distinctive within the meaning of s. 2 of the Act as it does not actually distinguish and is not adapted to distinguish nor capable of distinguishing the wares and services of the Applicant, as set out in the application, from the wares and services of others.

In a counter statement filed on January 23, 2004, the Applicant denied all grounds of opposition.

The Opponent filed the affidavit of Ms. Caroline Charette while the Applicant filed the affidavits of Mr. Oliver Kleine and Mrs. Carole Delisle. Only the Applicant filed written submissions and an oral hearing was held during which both parties made representations.

II Analysis of the various grounds of opposition

The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus on the Opponent to establish the facts

relied upon by it in support of each ground of opposition. Once this initial onus is met, the Applicant still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

At the outset of the hearing the Opponent withdrew its first ground of opposition. As for the third ground of opposition, the Opponent failed to meet its initial evidential onus. The content of Mrs. Charette's affidavit consisting of various Canadian telephone listing directories and results of searches performed on the Web has no relevancy whatsoever with respect to the third ground of opposition as drafted. I therefore dismiss such ground of opposition.

The Applicant takes the position that the fifth ground of opposition is insufficiently pleaded and should therefore be dismissed. The Opponent has simply repeated the wording of the Act with respect to distinctiveness and this has been ruled insufficient. [See *Standard Knickerbocker Ltd. v. Majdell Manufacturing Co.* (1985) 5 C.P.R. (3d) 185 (TMOB)] The Federal Court of Appeal in *Novopharm Ltd. v. AstraZeneca AB et al.* (2002) 21 C.P.R. (4th) 289 has ruled that the evidence filed by the Opponent must be considered when determining the sufficiency of a ground of opposition at the hearing stage. The content of Mrs. Charette's affidavit is aimed to support the fourth ground of opposition. It does establish that there are entries in telephone directories for the surname LEONARDO. The results of searches performed on the web filed in the record reveal that there are listings with the component LEONARDO. However there is no evidence that those entities were using at the relevant date (date of filing of the statement of opposition) a trade-name with such component and if they did so, in association with which type of wares or services. Such information is crucial to assess the lack of distinctiveness of the Mark. For these reasons I am left with no other alternative but to dismiss the fifth ground of opposition.

i) Is the Mark registrable?

I shall now discuss the fourth ground of opposition (s. 12(1)(a) of the Act) in relation with the evidence filed by the Opponent. First, I must determine the relevant date under which this ground of opposition must be assessed. In the past, the courts and the Board have adopted the date of the decision as the relevant date for any grounds of opposition under s. 12 of the Act. In fact, in 1991, the Federal Court of Appeal in *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al* (1991), 37 C.P.R. (3d) 413 enunciated the general rule that, when the relevant date is not identified in the Act, the date of the decision should be used as the relevant date. It should be noted that in *Park Avenue supra* the Court did not have to deal specifically with the various grounds of opposition described in s. 12 of the Act. The Federal Court, trial division, in *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60, ruled that the relevant date under s. 12(1)(b) of the Act should be the filing date of the application. The Registrar has since then followed that approach. [See *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4th) 541 and *Eloyalty Corporation v. Loyalty Management Group Canada Inc* re application No. 860,274, decision rendered on May 28, 2004]. To further justify the use of the filing date of the application as the relevant date when s. 12(1)(b) is raised as a ground of opposition, the Board has noted the relationship between such section and s. 12(2). It is therein provided that a trade-mark not registrable under 12(1)(b) could still be registrable if the applicant can demonstrate to the Registrar that, as of the filing date of its application, the trade-mark applied for has become distinctive because of its use in Canada.

Section 12(2) of the Act equally applies to trade-marks not registrable under s. 12(1)(a). Therefore the Board has recently adopted, as the relevant date, the filing date of the application when s. 12(1)(a) is raised as a ground of opposition. [See *Calvin Klein Trademark Trust v. Wertex Hosiery Inc.* (2005), 41 C.P.R. (4th) 552]. In any event should I be wrong in concluding that the relevant date is the filing date of the application such that this ground of opposition ought to have been determined as of the date of my decision, the difference in the relevant date would not have any impact on my decision.

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of Trade-marks) v. Coles Book Stores Limited* [1974] S.C.R. 438, *Gerhard Horn Investments Ltd. v. Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 and *Standard Oil Company v. The Registrar of trade-marks*, (1968) 2 Ex. C. R. 523. As set out in those cases the test under s. 12(1) (a) is two fold:

- 1) the first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died;
- 2) if the answer to the first question is affirmative, then the Registrar must determine if the Mark is “primarily merely” a name or surname rather than something else.

The Opponent’s evidence does establish that LEONARDO is the surname of individuals living in Canada. There are at least over two hundred people living in Canada and having the surname LEONARDO listed in the telephone directory Canada 411 on the web. Therefore the Opponent has met the first part of the test. However is the Mark “primarily merely” the name or surname rather than something else?

There is no survey in the file that would show what perception the average Canadian consumer has of the Mark. But is the absence of such survey fatal to the Opponent? I do not think so. In *Standard Oil supra*, and cited in *Gerhard Horn supra*, Mr. Justice Jackett phrased, on page 532, the second part of the two-fold test in the following terms:

“The test must be what, in the opinion of the respondent [i.e., the Registrar of Trade-marks] or the Court, as the case may be, would be the response of the general public of Canada to the word.”

Therefore the Registrar must determine if, in his opinion, the general public of Canada would think first that the Mark is the name of a living individual. In making his decision, the evidence provided by the parties may assist the Registrar.

The affidavit of Ms. Carole Delisle consists of searches performed on the web to locate any references with respect to the word LEONARDO. Without concluding that such searches would replace a proper survey on the perspective of the average Canadian when confronted with the

word LEONARDO, it is interesting to note that the majority of the first three hundred hits refer to LEONARDO as the first name of individuals with numerous references to the famous artist Leonardo Da Vinci and the actor Leonardo DiCaprio. To use the wording of the Supreme Court of Canada in *Coles supra*, I conclude that the average Canadian, on a balance of probabilities, would not perceive the word LEONARDO as primarily (first in importance) merely (nothing more than) a surname or name of an individual but rather as a first name. I therefore dismiss the Opponent's fourth ground of opposition.

ii) Compliance with the provisions of s. 30(b)

The critical date for assessing the issue of non-compliance with the provisions of s. 30 of the Act is the filing date of the application [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263].

The Opponent has an evidential onus but it has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant itself. However such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in its application. [See *Tune Masters c. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. c. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) *et Williams Telecommunications Corp. c. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)].

The Opponent is relying on the evidence filed by the Applicant to substantiate such ground of opposition. Mr. Kleine has been the Applicant's managing director since December 27, 2000. He alleges being well informed of the Applicant's day-to-day operations across Canada in association with the Mark. The relevant evidence with respect to the issue raised by the Opponent may be summarized as follow:

- There is an allegation of use of the Mark extensively and without interruption in Canada since at least 1995 in connection with the Wares (paragraph 8 of his affidavit);
- He alleges that the Mark is affixed in a variety of manners in Canada and he has filed samples of labels (exhibit N) and point of purchase signs (exhibit G);

- He has provided two invoices (exhibit O) going back to November 1995 to establish the sale in Canada of Wares bearing the Mark during such year;
- He has furnished the sales figures for the sale of the Wares in Canada in association with the Mark between 1995 and 2003 inclusive (the affidavit having been executed in June 2004);
- He has also filed sample illustrations of the Wares that are sold in Canada in association with the Mark.

The Opponent's arguments are that the evidence does not establish continuous use of the Mark in Canada since the claimed date of first use and that the Applicant has not established that it had not abandoned the use of the Mark in Canada at the filing date of the application. To substantiate such position the Opponent argues:

- That only two invoices going back to 1995 have been filed and thus there is no evidence of continuous use of the Mark in Canada up to the filing date of the application;
- Most of the material filed by the Applicant is written in German or are photographs of stores located in Germany and thus of no assistance to establish the use of the mark in Canada by the Applicant;
- Vagueness of some of the allegations contained in Mr. Kleine's affidavit and in particular the use of the expression "...since the last years" in paragraph 17 where the affiant is providing the details of the appearance of the Mark in advertisements, on labels and promotional material.

The content of Mr. Kleine's affidavit must be viewed as a whole. He has filed samples of invoices to establish the claimed date of first use of the Mark in Canada. He has stated that the Mark has been continuously used since then in Canada in association with the Wares and has provided the yearly sales figures between 1995 and 2003. He has filed samples of labels used over the last years. The affiant could have been more precise as to when they were used but I do not consider such situation causing a serious doubt on the continuous use of the Mark in Canada since 1995 when reviewing the entire evidence filed. The same conclusion holds true with respect to the language appearing on some of the material filed. There are advertisements written in English and the description of some of the Wares is written in German, English and French on

the same page. Therefore such material could have been used in Canada to promote the sale of those wares.

Taking into consideration the evidence in the record as a whole, I conclude that the Opponent failed to discharge its initial onus to establish facts supporting its second ground of opposition. It is therefore dismissed.

IV CONCLUSION

The Applicant has discharged its burden to prove, on a balance of probabilities, that the Mark is registrable and the Opponent failed to meet its initial onus to establish facts that would support the other grounds of opposition. Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition of the Opponent, the whole pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 19 DAY OF DECEMBER 2006.

Jean Carrière,
Member, Trade-marks Opposition Board