

IN THE MATTER OF AN OPPOSITION by Prouvost S.A. and
Lainière de Roubaix to application No. 545,546 for the trade-mark
Penguin Design filed by Munsingwear, Inc.

On June 28, 1985, the applicant, Munsingwear, Inc., filed an application to register the trade-mark Penguin Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as 1982 by the applicant's predecessor-in-title, Stanfield's Limited, in association with "clothing, namely, sport shirts, socks and sweaters".

The applicant's application was advertised for opposition purposes in the Trade-marks Journal on February 19, 1986 and the opponents, Prouvost S.A., Lainière de Roubaix, and Promafil Canada Ltée, filed a statement of opposition on January 13, 1987. In their statement of opposition, the opponents alleged the following grounds of opposition:

(a) that the applicant's application does not comply with Section 29 (now Section 30) of the Trade-marks Act in that:

- (i) the mark has not been used in Canada since the claimed date in association with each of the wares identified in the application;
- (ii) the applicant has not indicated the names of its designated predecessors-in-title, including STENFIELDS (sic.);
- (iii) it is false that the applicant has said that it is satisfied that it is entitled to use the mark in Canada;

(b) that the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark is confusing with the following registered trade-marks of the opponent, Prouvost S.A., of which the opponents, Lainière de Roubaix and Promafil Canada Ltée, are registered users:

<u>Trade-mark</u>	<u>Registration No.</u>
MAÎTRE PINGOUIN	200,404
PINGOUIN SUR BALLES DE LAINE	UCA 35408
LAINES DU PINGOUIN	UCA 6813
PINGOLUXE	157,648
PINGOREX	157,975
PINGOFRANCE	294,727
PINGOSTAR	286,246
Pingouin Design	317,618

(c) that the applicant is not the person entitled to registration of the trade-mark in that, as of the claimed date of first use, the applicant's trade-mark was confusing with one or more of the trade-marks PINGOUIN, QUATRE PINGOUINS, PINGOUIN CHASSEUR, PINGOUIN SKIEUR, PINGOUIN ALPIN, PINGOUIN SUPERBÉBÉ, PINGOUIN (representation with hat and cane); MAÎTRE PINGOUIN, PINGOUIN SUR BALLES DE LAINE, LAINES DU PINGOUIN, PINGOLUXE, PINGOREX, PINGOFRANCE, PINGOSTAR, PINGOUIN Design, PINGOUIN, PINGOUIN Design and PINGOUIN & Design previously used and made known in Canada by the

opponents and their predecessors-in-title in association with clothing-type wares since at least as early as 1936 and October 1973 in relation to clothing-type services;

(d) that the applicant is not the person entitled to registration in that, as of the claimed date of first use, the applicant's trade-mark was confusing with a trade-name of the type PINGOUIN that had previously been used by the opponents and their predecessors-in-title in association with articles of clothing and their distribution since as early as October 1973;

(e) that the applicant's trade-mark is not distinctive in that the applicant's trade-mark is confusing with the trade-marks and trade-names previously adopted, used, made known and registered by the opponents and their predecessors-in-title.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 30 of the Trade-marks Act, that its trade-mark Penguin Design is registrable and distinctive, and that it is the person entitled to its registration. The applicant further claimed that its trade-mark is "an updated version of the trade mark PENGUIN design, registered by the Applicant under Serial No. 261,104, which has been used in Canada by the Applicant's registered user for wares closely related to those listed in this application for over twenty-five years". As well, the applicant asserted that the ground of opposition relating to the applicant's entitlement of registration based on prior use of the opponents' trade-marks is not set out in sufficient detail to enable the applicant to reply thereto.

The opponents filed as their evidence photocopies of what appear to be certificates of registration for the registered trade-marks identified by the opponents in their second ground of opposition, together with a photocopy of what appears to be a certificate of registration for the trade-mark ETINCELLE, registration No. 148,264. The applicant filed as its evidence the affidavit of Aubrey Hughes. The opponents requested and were issued an order for the cross-examination under oath of Aubrey Hughes on his affidavit. However, the opponents did not pursue the cross-examination in a timely manner and the Opposition Board subsequently withdrew the order.

The opponents submitted as reply evidence the affidavit of Pascale Goyer which purports to introduce into evidence a photocopy of an affidavit of Alain François which had been filed with the Federal Court, Trial Division in File No. T-328-88. However, the François affidavit is hearsay with respect to the affiant Goyer and, at most, is evidence of the fact that an affidavit of Alain François was filed as evidence in a proceeding before the Federal Court, Trial Division.

The applicant alone submitted a written argument and both parties were represented at an oral hearing.

Prior to the oral hearing, the opponent, Promafil Canada Ltée, advised that it was

withdrawing its opposition to the present application. As no objection has been raised by the applicant in respect of this matter, Promafil has been withdrawn as co-opponent in this opposition.

The opponents' first ground of opposition is based on Section 30 of the Trade-marks Act. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponents in respect of their Section 30 ground (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pp. 329-330).

At the oral hearing, the opponents questioned the status of Stanfield's Limited as a predecessor-in-title of the applicant when Stanfield's is identified as a proposed registered user of the trade-mark in a registered user application which was filed with the Trade-marks Office at the same time as the filing of the present trade-mark application. Further, the opponents challenged the signing by the applicant's trade-mark agents of the registered user application on behalf of the applicant. However, these issues have not been pleaded by the opponents in relation to their Section 30 grounds of opposition and I have therefore dismissed these objections to the applicant's application.

In the statement of opposition, the opponents alleged that "la requérante n'a pas indiqué le nom de ses prédécesseurs en titre désignés, dont STENFIELDS". In this regard, Stanfield's Limited has, in fact, been identified as the applicant's predecessor-in-title. Further, paragraph 5 of the copy of the affidavit of Aubrey Hughes dated October 28, 1988 outlines in detail the circumstances relating to the identification of Munsingwear, Inc. as applicant and Stanfield's Limited as predecessor-in-title and proposed registered user of the trade-mark covered in the present application. Further, no evidence has been adduced by the opponents in relation to their Section 30 grounds, nor have any of the statements made by Mr. Hughes in his affidavit been challenged by cross-examination or contradicted by way of admissible evidence from the opponents. I have therefore rejected the Section 30 grounds of opposition.

No evidence has been adduced by the opponents relating to their alleged prior use of the trade-marks and trade-names identified in their statement of opposition. As a result, the opponents have not met the burden upon them under Section 16(5) and 17(1) of the Trade-marks Act of showing their prior use of their trade-marks and trade-names, as well as establishing non-abandonment of their marks and names as of the date of advertisement of the applicant's application in the Trade-marks Journal (February 19, 1986). I have therefore rejected the third and fourth

grounds of opposition.

The opponents submitted at the oral hearing that the applicant's trade-mark was not distinctive as of the filing date of the present application in view of the appointment of Stanfield's Limited as a proposed registered user in a registered user application signed by the applicant's trade-mark agents on behalf of the applicant, Munsingwear, Inc., and in view of the use by McGregor Hosiery Mills of the present trade-mark in association with socks. However, neither of these issues were pleaded by the opponents in respect of their non-distinctiveness grounds of opposition. In any event, I accept the explanation given by Mr. Hughes in paragraph 7 of the copy of his affidavit of October 28, 1988 which is annexed as Exhibit A to and incorporated by reference in the Hughes affidavit filed as evidence in this proceeding. As a result, I have rejected the fifth ground of opposition.

The only remaining ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponents asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark and one, or more, of the registered trade-marks identified in the statement of opposition. With respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538 (TMOB)).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the Trade-marks Act, the Registrar must have regard to all the surrounding circumstances, including, but not limited to, those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark and the opponent's registered trade-marks are inherently distinctive. As no evidence has been adduced by the opponents with respect to use or making known of any of their trade-marks, I must assume for the purposes of deciding the outcome of this opposition that their marks have not become known to any extent in Canada. On the other hand, the Hughes affidavit and accompanying exhibits establish that the applicant's Penguin Design trade-mark has become known in Canada in

association with sport shirts, socks and sweaters. Likewise, the length of time that the trade-marks have been in use clearly favours the applicant in this proceeding.

All but one of the opponent's registrations cover threads, yarns, and the like which bear no similarity to the applicant's sport shirts, socks and sweaters. Further, the average consumer would not normally expect the channels of trade associated with these wares to overlap. However, registration No. 317,618 covers various knitted clothing items including pullovers, cardigans, socks, jackets, vests and pants which are closely related to the applicant's wares. Further, the channels of trade associated with these wares must be considered as overlapping.

As for the degree of resemblance between the trade-marks at issue, I consider there to be little similarity in appearance or in sounding between the trade-marks of the parties. On the other hand, the applicant's trade-mark suggests the idea of a penguin as do the opponent's registered trade-marks LAINES DU PINGOUIN and MAÎTRE PINGOUIN and the opponents' design trade-mark covered by registration No. UCA35408. However, the opponents' registered trade-marks PINGOLUXE, PINGOREX, PINGOSTAR and PINGOFRANCE do not suggest any idea while the design trade-mark, registration No. 317,618, a representation of which appears below, might suggest to some consumers the representation of some type of bird. However, I do not consider that the average Canadian consumer would, as a matter of immediate impression, react to the design mark shown below as representing a penguin.

Registration No. 317,618

As a further surrounding circumstance in respect of the issue of confusion, the applicant pointed out that the opponent's registration for its design trade-mark shown above (registration No. 317,618) was granted registration over the previous registration standing in the name of the applicant for the trade-mark Penguin Design, registration No. 261,102, covering sports shirts and walking shorts, wares which are closely related to those set forth in the present application. This issue was considered by the Opposition Board in an opposition to registration of the Penguin Design, the trade-mark which matured to registration No. 261,102. At page 223 of the reported decision in La

Lainière de Roubaix v. Stanfield's Limited, 62 C.P.R. (2d) 217, I commented as follows:

In view of the above, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark Penguin Design and any of the registered trade-marks relied upon by the opponent.

I reject the opponents' opposition in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 23rd DAY OF DECEMBER 1992.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.