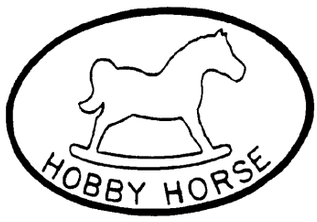
IN THE MATTER OF AN OPPOSITION by The Governor and Company of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Company to application No. 790,141 for the trade-mark HOBBY HORSE & Design filed by MICHAEL FRIEDMAN CORP.

On August 14, 1995, the applicant, MICHAEL FRIEDMAN CORP., filed an application to register the trade-mark, HOBBY HORSE & Design, a representation of which is set out below, based on proposed use of the trade-mark in Canada in association with:

> "Infants' and children's feeding bottles, bottle covers, cups, training cups, nipples, spoons, straws, feeding sets and accessories; infants' and children's toys, namely, rattles, teethers, squeeze toys, pacifiers, stuffed animals, blocks, balls, banks, mobiles, chimes and baby gift sets."



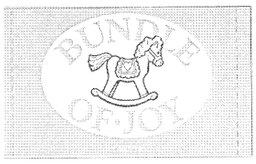
The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of March 6, 1996 and the opponent, The Governor and Company of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Company, filed a statement of opposition on July 26, 1996, a copy of which was forwarded to the applicant on August 12, 1996. During the opposition, the opponent requested and was granted leave to amend its statement of opposition pursuant to Rule 40 of the ***Trade-marks Regulations***. The opponent submitted as its evidence certified copies of registration Nos. 349,416 and 414,779, together with the affidavit of Debbie Ford which was subsequently replaced with the affidavit of Micheline Legault. Ms. Legault was cross-examined on her affidavit, the transcript of the cross-examination forming part of the opposition record. The applicant elected not to file any evidence. The opponent alone submitted a written argument and neither party attended the oral hearing which was scheduled by the Opposition Board at the request of the applicant.

The following are the grounds of opposition asserted by the opponent in its amended statement of opposition:

> **a)** The present application does not comply with subsection 30(i) of the ***Trade-marks Act*** in that the applicant could not have been satisfied that it was entitled to

use the applied for trade-mark in Canada in association with the wares covered in the present application in view of the prior use and registration of the trade-mark BUNDLE OF JOY & Design by the opponent and its predecessor-in-title, Simpsons Limited, as described in the following grounds of opposition.

b) The applicant's trade-mark is not registrable having regard to the provisions of paragraph 12(1)(d) of the ***Trade-marks Act*** in that the trade-mark HOBBY HORSE & Design is confusing with the following registered trade-mark of the opponent:

Trade-mark	*Registration No.*	*Wares*
	414,779	Children's wearing apparel namely, underwear, t-shirts, blouses, shirts, overalls, jumpers, dresses, summer playsets, jackets, pants and jean jackets.

c) The applicant is not the person entitled to registration of the applied for trade-mark having regard to the provisions of paragraph 16(3)(a) of the ***Trade-marks Act*** in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-mark identified in the second ground and in the following ground which had been previously used in Canada by the opponent or its predecessor-in-title, Simpsons Limited, in association with children's wearing apparel and toys.

d) The applicant is not the person entitled to registration of the applied for trade-mark having regard to the provisions of paragraph 16(3)(b) of the ***Trade-marks Act*** in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the following trade-mark for which an application had been previously filed in Canada by the opponent, in association with the wares set out below.

Trade-mark	*Application. No.*	*Wares*
	726,496	Toys, namely plush toys, infant toys and pre-school toys.

e) The applicant's trade-mark is not distinctive by reason of the fact that the applied for trade-mark does not actually distinguish the wares in association with which it is proposed to be used by the applicant from the wares of others, including the wares of the opponent and its predecessor-in-title, Simpsons Limited, nor is the applicant's mark adapted so as to distinguish the applicant's wares, by reason of the opponent's and its predecessor-in-title's, prior and continuing use of the trade-mark BUNDLE OF JOY & Design, as described above.

The first ground is based on Subsection 30(i) of the ***Trade-marks Act***, the opponent alleging that the applicant could not have stated that it was entitled to use the trade-mark HOBBY HORSE & Design in Canada in association with the wares covered in the present application in view of the prior use and registration of the trade-mark BUNDLE OF JOY & Design. No evidence has been furnished by the opponent to show that the applicant was aware of the opponent's trade-mark prior

to filing the present application or, even if the applicant were aware of the opponent's mark, that the applicant could not otherwise have been satisfied that it was entitled to use its trade-mark HOBBY HORSE & Design in Canada. Moreover, to the extent that the subsection 30(i) ground is founded upon allegations set forth in the remaining grounds of opposition, the success of the subsection 30(i) ground is contingent upon a finding that the applicant's trade-mark HOBBY HORSE & Design is not registrable or not distinctive, or that the applicant is not the person entitled to its registration, as alleged in those grounds [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p. 195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition.

As its second ground, the opponent has asserted that the trade-mark HOBBY HORSE & Design is not registrable in that it is confusing with its registered trade-mark BUNDLE OF JOY & Design. In assessing whether there would be a reasonable likelihood of confusion between the applicant's trade-mark and the opponent's registered trade-mark within the scope of subsection 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 subsection 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 at issue as of the date of my decision, the material date in relation to the paragraph 12(1)(d) ground [see ***Park Avenue Furniture Corporation* v. *Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], both the applicant's trade-mark HOBBY HORSE & Design as applied to the wares covered in the present application and the opponent's registered trade-mark BUNDLE OF JOY & Design as applied to the wares covered in registration No. 414,779 possess some measure of inherent distinctiveness when considered in their entireties even though both marks may suggest to some consumers that the wares associated with the marks are intended for infants or young children.

With respect to the extent to which the trade-marks have become known [para.6(5)(a)] and

the length of time the marks have been is use [para.6(5)(b)], no evidence has been furnished by the applicant and its design trade-mark must be considered as not having become known to any extent in Canada. On the other hand, the Legault affidavit and the transcript of her cross-examination establish that the opponent's trade-mark BUNDLE OF JOY & Design has become known in Canada particularly in association with wearing apparel and sleepwear for infants. Thus, both the extent to which the trade-marks have become known and the length of time the marks have been in use both weigh in the opponent's favour.

As for the nature of the wares of the parties [para.6(5)(c)] and the nature of the trade associated with their respective wares [para.6(5)(d)], it is the applicant's statement of wares and the statement of wares covered in the opponent's registration which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground [see ***Mr. Submarine Ltd. v. Amandista Investments Ltd.***, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); ***Henkel Kommanditgesellschaft v. Super Dragon***, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and ***Miss Universe, Inc. v. Dale Bohna***, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties may be useful [see ***McDonald's Corporation v. Coffee Hut Stores Ltd.***, 68 C.P.R.(3d) 168, at p. 169 (F.C.A.)].

In the present case, the applicant's "Infants' and children's feeding bottles, bottle covers, cups, training cups, nipples, spoons, straws, feeding sets and accessories; infants' and children's toys, namely, rattles, teethers, squeeze toys, pacifiers, stuffed animals, blocks, balls, banks, mobiles, chimes and baby gift sets" differ specifically from the opponent's "Children's wearing apparel namely, underwear, t-shirts, blouses, shirts, overalls, jumpers, dresses, summer playsets, jackets, pants and jean jackets" covered in registration No. 414,779. However, the wares of both parties are related in that they are intended for infants or young children and could therefore travel through the same channels of trade.

With respect to the degree of resemblance between the trade-marks at issue [para.6(5)(e)],

I find that the applicant's trade-mark HOBBY HORSE & Design and the opponent's registered trade-mark BUNDLE OF JOY & Design bear a fair degree of similarity in appearance and in the ideas suggested although the marks bear no similarity in their sounding.

Having regard to the above and, in particular, to the degree of resemblance in appearance between the trade-marks at issue as applied to related wares which could travel through the same channels of trade, and bearing in mind that the applicant has not submitted any evidence or written argument in support of its application, I find that the applicant has not met the legal burden on it of satisfying me that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the paragraph 12(1)(d) ground. Consequently, the applicant's trade-mark is not registrable in view of the provisions of paragraph 12(1)(d) of the ***Trade-marks Act***.

The opponent also challenged the applicant's entitlement to registration of the trade-mark HOBBY HORSE & Design in view of its previously filed application for registration of the BUNDLE OF JOY & Design, application No. 726,496. As the opponent's application was filed April 6, 1993, that is, prior to the applicant's filing date, and was still pending as of the date of advertisement of the present application [March 6, 1996], the opponent has met its burden under subsection 16(4) of the ***Trade-marks Act***. Thus, this ground turns on the issue of confusion between the applicant's trade-mark and the opponent's trade-mark BUNDLE OF JOY & Design as applied to "Toys, namely plush toys, infant toys and pre-school toys".

The material date with respect to the paragraph 16(3)(b) grounds is the filing date of the applicant's application [August 14, 1995]. Moreover, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark HOBBY HORSE & Design and the opponent's trade-mark BUNDLE OF JOY & Design, the Registrar must have regard to all the surrounding circumstances. As well, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the applicant's filing date.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's

trade-mark HOBBY HORSE & Design and the opponent's trade-mark BUNDLE OF JOY & Design as applied to "Toys, namely plush toys, infant toys and pre-school toys" possess some measure of inherent distinctiveness even though both marks may suggest that the respective wares of the parties are intended for infants or young children. As no evidence has been furnished by the applicant and as the Legault affidavit and the transcript of her cross-examination fail to show that the opponent's trade-mark has become known to any measurable extent in association with toys, I find that neither the extent to which the trade-marks at issue have become known nor the length of time the marks have been in use are relevant surrounding circumstances in assessing the likelihood of confusion between the trade-marks at issue in relation to the paragraph 16(3)(b) ground.

Considering next the nature of the wares of the parties and the nature of the trade associated with their wares, the applicant's "infants' and children's toys, namely, rattles, teethers, squeeze toys, pacifiers, stuffed animals, blocks, balls, banks, mobiles, chimes and baby gift sets" overlap the opponent's "Toys, namely plush toys, infant toys and pre-school toys" and I would expect that the channels of trade associated with these wares would or could be the same. Further, the applicant's trade-mark HOBBY HORSE & Design and the opponent's registered trade-mark BUNDLE OF JOY & Design bear a fair degree of similarity in appearance and in the ideas suggested although the marks bear no similarity in their sounding.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, I would note that the opponent's application for registration of the trade-mark BUNDLE OF JOY & Design was abandoned by the opponent. In this regard, I would note the following comments of Heald, D.J. in ***Molson Breweries, A Partnership v. Labatt Brewing Co. Ltd.***, 68 C.P.R. (3d) 202, at page 213:

> "The third surrounding circumstance put forth by Molson is the abandonment by Labatt of its application for registration of the trade-mark MANITOBA'S CLUB & Design. The difficulty encountered by Molson with respect to this submission, is that Molson is asking the Court to consider a surrounding circumstance that arose following the material date set out in subsection 16(3), being the date of the application. In my view, the circumstance of Labatt having abandoned its trade-mark application, although it arose after the material date, is intrinsically connected to a circumstance which existed at the material date. In view of this inherent connection and the anomalous circumstances of this case, I find this is an appropriate case to take into consideration the fact that Labatt's application for registration of MANITOBA'S CLUB & Design was abandoned. Accordingly, having taken into

> consideration this surrounding circumstance, I need not proceed further to consider the factors listed in paragraphs (a) through (e), as I am satisfied that confusion between the trade-marks is no longer an issue."

However, Ms. Legault does indicate during her cross-examination that the opponent carried stuffed animals under the BUNDLE OF JOY mark but that the opponent was not purchasing more stuffed toys for sale to the public as of the date of her cross-examination [see transcript, Questions 311-316 and responses thereto] .

Having regard to the foregoing and, in particular, to the degree of resemblance in appearance between the trade-marks at issue as applied to overlapping wares which could travel through the same channels of trade, and even considering that the opponent's abandonment of application No. 726,496 is a relevant surrounding circumstance, as is the fact that the applicant has not filed any evidence or written argument in support of its application, I find that the applicant has not met the legal burden on it of satisfying me that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the paragraph 16(3)(b) ground. As a result, this ground of opposition is also successful..

The opponent also challenged the applicant's entitlement to registration of the trade-mark HOBBY HORSE & Design under paragraph 16(3)(a) of the ***Trade-marks Act*** in view of its prior use of the trade-mark BUNDLE OF JOY & Design in Canada in association with children's wearing apparel and toys. Having regard to the Legault affidavit, I find that the opponent has met the burden on it under subsections 16(5) and 17(1) of the ***Trade-marks Act*** of establishing its use of the trade-mark BUNDLE OF JOY & Design in Canada prior to the applicant's filing date, as well as the non-abandonment of its mark as of the date of advertisement of the present application. Thus, the legal burden is upon the applicant to show that there would have been no reasonable likelihood of confusion between the trade-marks at issue as of the applicant's filing date. In this regard, most of my previous conclusions concerning the surrounding circumstances in assessing the likelihood of confusion between the trade-marks at issue in relation to the paragraph 12(1)(d) ground likewise apply to the determination of the issue of confusion as of the applicant's filing date. Consequently, the paragraph 16(3)(a) ground of opposition is also successful.

Having concluded that the applicant's trade-mark is not registrable and that the applicant is not the person entitled to registration of the trade-mark HOBBY HORSE & Design as applied to the wares covered in the present application, it follows that the applicant's trade-mark is not distinctive. Consequently, the final ground of opposition is also successful.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to subsection 63(3) of the ***Trade-marks Act***, I refuse the applicant's application pursuant to subsection 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC, THIS 18TH DAY OF DECEMBER, 2000.

G.W. Partington
Chairperson
Trade-marks Opposition Board.