

**IN THE MATTER OF AN OPPOSITION by Fallyn Investments  
Inc. to application No. 769,464 for the trade-mark SHOPKO filed  
by Shopko Stores, Inc.**

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On November 25, 1994, the applicant, Shopko Stores, Inc., filed an application to register the trade-mark SHOPKO based upon use and registration of the trade-mark in the United States of America in association with:

“Pharmaceuticals; namely, allergy, analgesic, antipyretic, anti-inflammatory, antihistaminic, antacid, antibiotic and cough preparations, cold syrup, oral dosage night time over-the counter sleep medications, vitamins, minerals, vitamins with minerals, meal replacement powders, meal replacement liquids, meal replacement snacks, meal replacement candies, and, cod liver oils, fish oils, lecithin, lysines, gelatins, yeasts, enzymes, beta carotenes, alfalfas, bee polls, psyllium fibers, saline solutions for eye care, contact lens cleaning solutions; sanitary products; namely, sanitary napkins, adhesive bandages and dental floss wax.”

“Paper products; namely, disposable diapers, bathroom tissue, facial tissue, and napkins.”

“Unexposed photographic film.”

“Toothpaste, mouthwash, denture cleaning preparations, personal deodorant, deodorant body powders, skin lotions, skin creams, hair shampoo, hair spray, hair spritz, mousse, gel, baby shampoo, baby powder, baby oil, pre-moistened towlettes for use on babies, petroleum jelly for cosmetic purposes, cotton swans for cosmetic purposes, furniture polish, stripping preparations for stripping polish from furniture, all-purpose cleaning preparations, glass cleaning preparations, basin cleaning preparations, oven cleaning preparations, dishwashing detergents, and laundry detergents; aluminum foil; razors and razor blades; plastic trash bags; and pre-moistened towelettes not for cosmetic purposes and non-electric toothbrushes.”

and in association with the following services:

“Retail discount department store services.”

“Retail discount department store services, pharmacy services, optometry services and audiology/hearing testing services.”

“Retail liquor store services.”

The application is also based upon proposed use of the trade-mark in Canada in association with the following wares:

“Pharmaceuticals; namely, allergy, analgesic, antipyretic, anti-inflammatory, antihistaminic, antacid, antibiotic and cough preparations, cold syrup, oral dosage night time over-the-counter sleep medications, vitamins, minerals, vitamins with minerals, meal replacement powders, meal replacement liquids, meal replacement snacks, meal replacement candies, cod liver oil, fish oils, lecithin, lysines, gelatins, yeasts, enzymes, beta carotenes, alfalfas, bee polls, psyllium fibers, saline solutions for eye care, contact lens cleaning solutions; sanitary products; namely, sanitary napkins, adhesive bandages and dental floss wax; paper products; namely, disposable diapers, bathroom tissue, facial tissue, and napkins; unexposed photographic film; toothpaste, mouthwash, denture cleaning preparations, personal deodorant, deodorant body powders, skin lotions, skin creams, hair shampoo, hair spray, hair spritz, mousse, gel, baby shampoo, baby powder, baby oil, pre-moistened towelettes for use on babies, petroleum jelly for cosmetic purposes, cotton swans for cosmetic purposes, furniture polish, stripping preparations for stripping polish from furniture, all-purpose cleaning preparations, glass cleaning preparations, basin cleaning

preparations, oven cleaning preparations, dishwashing detergents, and laundry detergents; aluminum foil; razors and razor blades; plastic trash bags; and pre-moistened towelettes not for cosmetic purposes and non-electric toothbrushes.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 15, 1995 and the opponent, Fallyn Investments Inc., filed a statement of opposition on January 15, 1996, a copy of which was forwarded to the applicant on February 6, 1996. The applicant served and filed a counter statement on February 16, 1996. The opponent submitted as its evidence the affidavit of Norman Gaal. However, the Gaal affidavit was deemed not to form part of the opponent’s evidence in accordance with Rule 44(5) of the *Trade-marks Regulations* as Mr. Gaal failed to attend for cross-examination on his affidavit pursuant to the order for cross-examination of January 4, 1997. The applicant elected not to file any evidence in this proceeding. Both parties submitted a written argument and an oral hearing was not requested by either party.

As there is no evidence of record from the opponent in support of its opposition, the only ground of opposition that need be considered is that based on paragraph 12(1)(d) of the *Trade-marks Act*, the opponent asserting that the applicant’s trade-mark SHOPKO is not registrable in that it is confusing with its registered trade-marks SHOPCO FOOD PROVISIONERS, registration Nos. 317,514 and 446,969. While the opponent has not filed copies of its registrations as evidence, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registrations relied upon by the opponent [see *Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410]. In doing so, I noted that registration No. 317,514 for the trade-mark SHOPCO FOOD PROVISIONERS is still in force and covers “Operation of a business which sells food in bulk by means of telephone solicitation of orders for food in bulk.” and that registration No. 446,969 for the trade-mark SHOPCO FOOD PROVISIONERS is also still in force and covers services identified as “Wholesale and retail sale and distribution of food products.”

In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue 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.)].

With respect to Paragraph 6(5)(a) of the *Act*, the applicant's SHOPKO trade-mark possesses some measure of inherent distinctiveness although the mark does suggest some association with shopping. Likewise, the opponent's registered trade-marks SHOPCO FOOD PROVISIONERS possess some measure of inherent distinctiveness when considered in their entirety even though the word SHOPCO suggests an association with shopping and the words FOOD PROVISIONERS are descriptive of the services covered in the opponent's registrations and have been disclaimed by the opponent in each of its registrations. As there is no evidence of record from either party, neither the extent to which the trade-marks 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 this proceeding.

The applicant's trade-mark SHOPKO and the dominant element of the opponent's registered trade-marks SHOPCO FOOD PROVISIONERS are identical in sounding and similar in appearance and in the ideas suggested. There is, therefore, a fair degree of resemblance between the applicant's mark and the opponent's trade-marks when considered in their entirety. The only remaining surrounding circumstances which need be considered in the present opposition are the nature of the wares and services of the parties and their respective channels of trade. In this regard, the present application covers an extensive list of both wares which differ from the services covered in the opponent's registrations. Likewise, the applicant's "Retail liquor store services" differ from the services covered in registration Nos. 317,514 and 446,969. On the other hand, the applicant's "Retail discount department store services" could include the sale and distribution of food products, as could the applicant's "Retail discount department store services, pharmacy services, optometry services and audiology/hearing testing services". Thus, there is a potential overlap in the applicant's retail discount department store services and the services covered in registration No. 446,969,

namely, the “Wholesale and retail sale and distribution of food products”. Consequently, there could also be a potential overlap in the channels of trade associated with these services.

Having regard to the foregoing and, in particular, to the overlap in the services of the parties and their respective channels of trade, and bearing in mind that there is some resemblance between the trade-marks at issue, I find that the applicant has failed to meet its legal burden of establishing that there would be no reasonable likelihood of confusion between its trade-mark SHOPKO as applied to its “Retail discount department store services” and its “Retail discount department store services, pharmacy services, optometry services and audiology/hearing testing services” and the opponent’s registered trade-mark SHOPCO FOOD PROVISIONERS, registration No. 446,969, covering “Wholesale and retail sale and distribution of food products.” On the other hand, I do not consider there to be any reasonable likelihood of confusion between the applicant’s trade-mark SHOPKO as applied to its “Retail liquor store services” and to its wares identified above and either of the opponent’s registered trade-marks. Thus, the applicant’s trade-mark SHOPKO is not registrable as applied to “Retail discount department store services” and “Retail discount department store services, pharmacy services, optometry services and audiology/hearing testing services”.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application pursuant to Subsection 38(8) of the *Trade-marks Act* as applied to “Retail discount department store services” and to “Retail discount department store services, pharmacy services, optometry services and audiology/hearing testing services” and otherwise reject the opponent's opposition to registration of the trade-mark SHOPKO as applied to the wares covered in the present application, as well as the applicant’s services identified as : “Retail liquor store services”. In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS 19<sup>th</sup> DAY OF APRIL, 1999.

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