

IN THE MATTER OF AN OPPOSITION
by Federal-Mogul Corporation to
application No. 548,557 for the
trade-mark STERLING filed by Austin
Rover Group Limited (and subsequently
assigned to Rover Group Limited)

On September 3, 1985, Austin Rover Group Limited filed an application to register the trade-mark STERLING based on proposed use in Canada. The application claimed priority based on the June 18, 1985 filing date of the applicant's corresponding application in the United Kingdom. In response to the Examiner's citation of registration No. 103,464 for the trade-mark STERLING, the applicant amended its statement of wares to read as follows:

automobiles and structural parts thereof,
excluding pistons for internal combustion
engines.

The application was subsequently advertised for opposition purposes on August 17, 1988 and Federal-Mogul Corporation (as owner of registration No. 103,464) was notified of that advertisement pursuant to Section 37(3) of the Trade-marks Act. The application was later assigned to Rover Group Limited, the present applicant of record.

The opponent, Federal-Mogul Corporation, filed a statement of opposition on December 15, 1988, a copy of which was forwarded to the applicant on January 12, 1989. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark STERLING registered under No. 103,464 for

permanent mold-cast aluminum alloy pistons
for internal combustion engines.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Lawrence J. Shurupoff. The applicant did not file evidence. Only the opponent filed a written argument and no oral hearing was conducted.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks of both parties possess some measure of inherent distinctiveness although neither is particularly strong in view of the somewhat laudatory connotation associated with the word "sterling." There being no evidence from the applicant, I must conclude that its mark has not become known at all in Canada. By way of contrast, the opponent has evidenced fairly substantial sales and advertising in association with its mark STERLING. Thus, I am able to conclude that the opponent's mark has become known in Canada in relation to pistons.

The length of time the marks have been in use favors the opponent. The wares of the parties do not actually overlap since the applicant has specifically excluded pistons from its statement of wares. However, the opponent's evidence shows that its pistons are made as a replacement part for various domestic and foreign automobiles. Thus, the wares of the parties are similar since the present application covers automobiles and automobile parts. Presumably the trades of the parties could also be similar. This is confirmed to some extent by the Shurupoff affidavit which shows that the opponent sells a variety of automobile parts in addition to its STERLING pistons. Mr. Shurupoff also makes reference to the sale of automobiles and pistons in association with the trade-mark STERLING in the United States by one or more companies possibly related to the applicant.

The marks of the parties are identical in all respects.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the wares and trades of the parties, the identity between the marks at issue, the reputation associated with the opponent's mark and the applicant's apparent lack of interest in this proceeding, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's registered mark. The ground of opposition based on Section 12(1)(d) of the Act is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF DECEMBER 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.