IN THE MATTER OF AN OPPOSITION by Spacemaker Limited to application No. 636,010 for the trade-mark SPACEMASTER filed Plan Hold Canada Inc.

On July 7, 1989, Plan Hold Canada Inc. filed an application to register the trade-mark SPACEMASTER based upon proposed use of the trade-mark in Canada in association with "mobile filing shelving systems". The present application was advertised for opposition purposes in the Trade-marks Journal on May 2, 1990.

The opponent, Spacemaker Limited, filed a statement of opposition on June 1, 1990 in which it alleged the following grounds:

(a) That the applicant's trade-mark is not registrable in view of Section 12(1)(d) of the Trade-marks Act in that it is confusing with the registered trade-marks: SPACEMAKER, registration No. 167,690; SPACEMAKER Design, registration No. 246,440; and SPACEMAKER STORETTE, registration No. 316,968;

(b) That the applicant is not the person entitled to registration in view of Section 16(3)(a) of the Trade-marks Act in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-mark SPACEMAKER that had been previously used in Canada in association with racks and shelving, adjustable shelving, work benches, tool carrier and stools, tool stands, and prefabricated buildings including storage and garden sheds;

(c) That the applicant is not the person entitled to registration in view of Section 16(3)(b) of the Trade-marks Act in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-marks in respect of which applications had been previously filed in Canada by the opponent under application Nos. 316,678 (filed October 4, 1968), 448,674 (filed January 10, 1980) and 435,231 (filed January 31, 1979);

(d) That the applicant is not the person entitled to registration of the trade-mark SPACEMASTER in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-name Spacemaker that had previously been used by the opponent in Canada;

(e) That the applicant's trade-mark is not distinctive in that it is not adapted to distinguish the applicant's wares from the opponent's racks, shelving, adjustable shelving, work benches, and garbage can houses, when sold or offered for sale in association with the opponent's marks SPACEMAKER, SPACEMAKER Design and SPACEMAKER STORETTE, identified above.

The applicant served and filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Patrick Minshall while the applicant submitted the affidavits of William C. Fletcher and Michael W. Cormier.

Both parties filed written arguments and neither party requested an oral hearing.

With respect to the third ground of opposition, the opponent's evidence fails to establish that its trade-mark applications were pending as of the date of advertisement of the present application

in the Trade-marks Journal. As a result, the opponent has failed to meet the initial burden upon it under Section 16(4) of the Trade-marks Act in respect of the third ground which I have therefore dismissed.

Considering the second and fourth grounds, there is a burden on the opponent under Sections 16(5) and 17(1) of the Trade-marks Act to establish its prior use of its trade-mark SPACEMAKER and trade-name Spacemaker, as well as establishing its non-abandonment of the trade-mark and trade-name as of May 2, 1990, the date of advertisement of the present application in the Trade-marks Journal. As the opponent has met the burden of establishing its prior use and non-abandonment of the trade-mark and trade-name SPACEMAKER, these grounds remain to be decided on the basis of confusion between the applicant's trade-mark SPACEMASTER and the opponent's trade-mark and trade-name.

The first ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent alleging that there would be a reasonable likelihood of confusion between the applicant's trade-mark SPACEMASTER as applied to the wares covered in the present application and its registered trade-marks identified above. 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 those 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, the material date in relation to the Section 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 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

With respect to the inherent distinctiveness of the trade-marks at issue, neither the applicant's trade-mark SPACEMASTER nor the opponent's trade-marks SPACEMAKER and SPACEMAKER Design possess much inherent distinctiveness. In this regard, the element SPACE in each of the marks suggests that the wares of the parties provide storage space and therefore adds little inherent distinctiveness to the trade-marks at issue.

The extent to which the trade-marks at issue have become known favours the opponent in this opposition, the Minshall affidavit attesting to sales of more than $10,000,000 annually of all the

opponent's SPACEMAKER products in Canada including in excess of $2,000,000 in sales annually of SPACEMAKER shelving alone. On the other hand, there is no evidence that the applicant has even commenced use of its proposed trade-mark SPACEMASTER in Canada. Likewise, the length of time that the trade-marks at issue have been in use weighs in the opponent's favour, the opponent having used its SPACEMAKER trade-mark in Canada in association with shelving since 1970.

In assessing the likelihood of confusion between the trade-marks at issue in respect of a Section 12(1)(d) ground of opposition, the Registrar must have regard to the wares set forth in the opponent's registrations and to the statement of wares in the present application, as well as the channels of trade which the average consumer would consider as being normally associated with those wares, bearing in mind that it is the statement of wares covered in the present application which determines the scope of the monopoly to be accorded to the applicant should its trade-mark proceed to registration (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pages 10-12 (F.C.A.)). In the present case, the applicant's statement of wares covers "mobile filing shelving systems" whereas the opponent's registrations for the trade-marks SPACEMAKER and SPACEMAKER Design cover: "Racks and shelving none for use as display units for carpets and various goods in retail and wholesale trade". It would appear that the opponent's "shelving" could include mobile filing shelving as the applicant's statement of wares is not restricted to display units, the latter being types of shelving which are specifically excluded from the opponent's registrations. As a result, I must assume for the purposes of deciding the Section 12(1)(d) ground that there is some overlap in the wares of the parties. Likewise, in the absence of any evidence to the contrary, I must conclude that there could be a potential overlap in the respective channels of trade of the parties.

As for the degree of resemblance between the trade-marks at issue, the marks SPACEMAKER and SPACEMASTER when considered in their entireties are similar both in appearance and in sounding. Further, the opponent's mark suggests the providing of space while the applicant's trade-mark suggests the idea of some type of expertise in relation to the concept of space.

As a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of the state of the register by way of the Cormier affidavit. However, such evidence is only of relevance to the extent that inferences can be made based on it concerning the state of the marketplace (see Del Monte Corporation v. Welch Foods Inc., 44 C.P.R. (3d) 205 (F.C.T.D.)). Further, such inferences concerning the state of the marketplace based on state of the register evidence can only by drawn when a significant number of pertinent registrations are located

(see, in this regard, Kellogg Salada Canada Inc. v. Maximum Nutrition Inc., 43 C.P.R. (3d) 349 (F.C.A.)). In the present case, Mr. Cormier has annexed to his affidavit photocopies of five registrations for the trade-marks SPACELINE, SPACE BUILDER, SPACE MAXIMIZER, SPACE ORGANIZER and SPACE AGE SHELVING all of which cover either shelving or storage systems. In view of the limited number of registrations for trade-marks including the word SPACE, together with the absence of any evidence of use of any of these marks in the marketplace, relatively little weight can be accorded the opponent's evidence of the state of the register. At most, such evidence supports the conclusion which I have already reached that the word SPACE adds little inherent distinctiveness to either of the trade-marks at issue. Further, I would note in passing that none of the trade-marks identified in the registrations annexed to the Cormier affidavit bear the same degree of similarity to the applicant's trade-mark SPACEMASTER as does the opponent's mark SPACEMAKER.

In his affidavit, William C. Fletcher, President of the applicant, states that he is aware of a company called Spacesaver Corporation which uses the trade-mark SPACESAVER in Canada. Mr. Fletcher has annexed two brochures of this company to his affidavit, these brochures disclosing that Spacesaver Corporation has applied the trade-mark SPACESAVER to shelving. While the applicant has not provided evidence as to the extent of use of the SPACESAVER trade-mark in Canada, the applicant has provided at least some evidence of the adoption and use in Canada by a third party of a trade-mark including the initial component SPACE as applied to shelving.

Having regard to the degree of resemblance between the trade-marks at issue when considered in their entireties as a matter of immediate impression and imperfect recollection as applied to wares which fall within the scope of the wares covered in the opponent's registration Nos. 167,690 and 246,440, and bearing in mind that the opponent has established that it has had relatively significant use of its trade-marks SPACEMAKER and SPACEMAKER Design in Canada while the present application is based upon proposed use of the trade-mark SPACEMASTER, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. Accordingly, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS __31st_____ DAY OF ___January______, 1994.

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