

IN THE MATTER OF AN OPPOSITION  
by The Gillette Company  
to application No. 506,825  
for the trade-mark PENCIL-MATE  
filed by Esselte Pendaflex Canada Inc.

On July 15, 1983, the applicant Esselte Pendaflex Canada Inc. filed an application to register the trade-mark PENCIL-MATE, based on use in Canada since at least as early as December, 1967, for "desk accessories, namely pencil caddies".

The subject mark was advertised for opposition purposes on March 25, 1987, after the applicant had overcome various objections at the examination stage, and after the Registrar had, on January 5, 1987, advised the opponent (pursuant to Section 37(3) of The Trade-marks Act) of the scheduled advertisement for the subject mark PENCIL-MATE in view of the opponent's trade-mark registration No. 282,629 for PENCIL MATE covering the wares "pencils".

The opponent filed a statement of opposition on August 24, 1987, a copy of which was forwarded to the applicant on September 11, 1987.

The grounds of opposition are summarized below:

(a) as the present opponent was previously successful in opposing trade-mark application serial No. 384,370 for the mark PENCIL-MATE (also covering pencil caddies) filed by the present applicant's predecessor in title, the doctrine of **res judicata** should apply to refuse registration in the instant proceeding.

(b) & (c) pursuant to Sections 38(2)(b) and 12(1)(d) of the Trade-marks Act, the applied for mark is not registrable because it is confusing with one, or both, of the opponent's registered marks PAPER MATE covering "writing instruments and ink" (Regn. No. 112,769) and ERASERMATE covering "writing instruments and parts" (Regn. No. 263,748).

(d) pursuant to Sections 38(2)(c) and 16(1)(a), the applicant is not entitled to registration in view of the opponent's use of its above mentioned marks prior to the applicant's claimed date of first use namely December 31, 1967.

(e) pursuant to Section 38(2)(a), the subject application does not comply with Section 30(b) because

- (1) the application does not identify any predecessors in title,
- (2) the applicant did not use the mark since the date alleged in the application.

(f) the applied for mark is not distinctive of the applicant's wares.

The opponent did not rely on its trade-mark registration No. 282,629 for PENCIL MATE, cited in the above noted Office letter of January 5, 1987, to support any of its grounds of opposition.

The applicant filed, and served, a counter statement generally denying the allegations in the statement of opposition. The applicant in its counter statement also specifically denies confusion between its mark and the opponent's mark "PENCIL-MATE" [sic] although, as mentioned above, the opponent does not rely on its mark PENCIL MATE in the statement of opposition.

The opponent's evidence consists of the affidavit of Ross E. Murray, Manager, Administrative Services for Gillette Canada Inc. (a wholly owned subsidiary of the opponent herein and a registered user of the trade-marks PAPER MATE and ERASERMATE), and the affidavit of Barbara Dopierala, a secretary.

Ms. Dopierala's affidavit merely serves to introduce into evidence certified copies of trade-mark registration Nos. 112,769 for PAPER MATE and 263,748 for ERASERMATE, as well as a copies of

the file wrapper for application No. 384,370, and of the Opposition Board decision therein, namely The Gillette Company v. Oxford Pendaflex Canada Limited (October 25, 1979, unreported) - the case relied on in support of ground (a) of the statement of opposition. In Oxford Pendaflex the present applicant's predecessor in title was refused registration for the mark PENCIL-MATE on the basis that "the applicant has failed to discharge the onus upon it of establishing that there would be no inference of a likelihood of confusion between the applicant's trade mark PENCIL-MATE and the opponent's registered trade marks and, in particular, the opponent's PAPER MATE trade mark". The hearing officer in that case emphasised that in reaching his conclusion he found it significant that the opponent's mark PAPER MATE was very well known in Canada .

The applicant's evidence in the instant case consists of the affidavits of Christine Boon, Product Manager with the applicant company, and of Kim Brule, a registered trade-mark agent. Attached as exhibits to Ms. Boon's affidavit are two affidavits of Robert Fraser, National Sales Manager of the applicant company. Ms. Boon in her affidavit confirms the accuracy of the facts attested to by Mr. Fraser except as varied by her own testimony (see paragraph 3 of the Boon affidavit). Accordingly, I accept the statements in Mr. Fraser's affidavits for the truth of their contents in so far as his statements are incorporated into the Boon affidavit.

Ms. Brule's affidavit provides evidence concerning the state of the register by "updating and supplementing" a previous affidavit sworn by Ms. Brule.

On June 4, 1990 - after the parties had completed filing their evidence - the applicant amended its trade-mark application to name its predecessors in title, namely Starmark of Canada Ltd. and Oxford Pendaflex Canada Ltd.

The evidence shows that the applicant is a leading supplier of desk accessories and has held about 50% of the Canadian market since 1980. The applicant sells its desk accessories under its family of "MATE" marks which includes FILE-MATE, TAPE-MATE, MEMO-MATE, PENCIL-MATE, DATE-MATE, WALL-MATE, CLIP-MATE, BOOK-MATE, CARD-MATE, V-CARD-MATE, WASTE-MATE and DESK-MATE. The applicant's marks DESK-MATE, BOOK-MATE, TAPE-MATE, and -MATE are registered marks. Sales of desk accessories by the applicant under its family of MATE marks averaged about \$2 million per year from 1980 to 1988 inclusive. During the same time period sales of pencil caddies under the applied for mark averaged about \$200,000 per year. The applicant's uncontradicted evidence is that desk accessories are a distinct category within the stationery field and that this accounts for no instances of actual confusion between any of the applicant's family of MATE marks, including PENCIL-MATE, with any of the opponent's marks.

The applicant admits that "the opponent sells very large quantities of writing instruments under the trade-marks PAPER MATE and ERASER MATE and that some of these are sold in the same stores as the applicant's PENCIL-MATE products".

The applicant has expended about \$100,000 advertising products under its family of MATE marks during the period 1980 to 1988. The applicant has also been diligent in opposing parties who applied to register marks incorporating the suffix MATE where the statement of wares could include desk accessories.

With respect to the ground of opposition denoted by (d), Section 16(1) (a) reads as follows:

Any applicant who has filed an application  
...for...a trade-mark...that he...has used  
in Canada...is entitled...to secure its  
registration...unless **at the date on which**  
**he...first so used it...**it was confusing  
with

(a) a trade-mark that had been  
**previously used** in Canada  
...by any other person;

The issue of confusion pursuant to Section 16(1)(a), with respect to the opponent's marks PAPER MATE and ERASERMATE relied on in the statement of opposition, is therefore to be determined at the date of first use claimed in the subject application namely December 31, 1967.

There is no evidence that the opponent used its mark ERASERMATE prior to the material date December 31, 1967. Rather, the record of registration filed by the opponent shows its first use as September 14, 1981. The opponent is therefore left to rely on its mark PAPER MATE in support of its ground of opposition pursuant to Section 16(1)(a). In deciding the issue of confusion, the Registrar is to have regard to all the surrounding circumstances **at the material date** December 31, 1967, including those circumstances enumerated in Section 6(5). The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), at the material date.

Neither the opponent's mark PAPER MATE nor the applicant's mark PENCIL-MATE possesses a great deal of inherent distinctiveness when applied to their respective wares. There is no evidence that the applicant's mark had become known to any more than a minimal extent, if at all, at the material time December 31, 1967. By contrast, the opponent has evidenced extensive sales ( about \$1.2 million in sales ,representing about 2 million units, per year from 1957 to 1967 inclusive) and substantial advertising during the 10 year period preceding the material date. Length of time in use - since at least 1957 - favours the opponent. The opponent's wares namely "writing instruments" and the applicant's wares namely "pencil caddies" are intrinsically different and are used for different purposes; however, the parties' wares are related in use

as pencil caddies are containers for writing instruments and both parties' wares fall within the same broad general category namely stationery. The parties channels of trade are overlapping if not essentially the same.

There is necessarily some resemblance between the marks PENCIL-MATE and PAPER MATE, visually and aurally, owing to the component MATE which is common to both marks. There is also some similarity in the ideas suggested by the marks, namely stationery supplies, to the extent that consumers view pen, pencil, and paper as an associated group of wares.

In oral argument the applicant stressed the importance of the state of the register, as evidenced by the Brule affidavit, to support its position that MATE is a common element of trade-marks in the office supplies trade. However, that evidence indicates only two such marks in use in 1967 (aside from marks belonging to the opponent) and is entirely inadequate for me to infer common adoption as of 1967.

I have also considered the applicant's evidence that there have been no instances of actual confusion between the applied for mark PENCIL-MATE and the opponent's mark PAPER MATE during the eight year period of contemporaneous use from 1980 to 1988. However, I am not willing to assume that the state of the marketplace, with respect to use of the trade-mark components PENCIL, PAPER, and MATE remained unchanged from 1967 to 1980 and beyond. Thus, the applicant's evidence is of little probative value for making inferences at the material date in 1967. Further, the applicant's evidence relates to a period when consumers may have become accustomed, to a certain extent, in distinguishing between the opponent's mark PAPER MATE and the applied for mark PENCIL-MATE as a result of the applicant's extensive use of its family of MATE marks (from 1980 on).

In view of the above, and particularly in view of the distinctiveness of the opponent's mark PAPER MATE at the material time December 31, 1967, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark is confusing with the opponent's mark at the material date.

It is, therefore, not necessary to consider the remaining grounds of opposition. I would, however, note that the ground of opposition denoted by e(1) above is not a valid ground of opposition as the applicant duly amended its application to name its predecessors in title - see Lancome Parfums et al. v. The House of Devonshire Limited, ( Opp. Bd., August 30, 1991, yet unreported). Also, with respect to the ground of opposition denoted by (a) above, even if I were to consider that the doctrine of res judicata applies to opposition proceedings (contra, see Sunny Crunch Foods v. Robin Hood Multifoods Inc. 70 C.P.R. (2d) 244 (Opp. Bd.)), I would not exercise that doctrine in the instant case because the Oxford Pendaflex decision relied on by the opponent is not entirely clear in its reasons as to which ground of opposition was being considered or as to which material date was being considered. Further, the test for confusion applied in Oxford Pendaflex has since been moderated - see Molnlycke Aktiebolag v. Kimberly-Clark of Canada Ltd., 61 C.P.R. (2d) 42 (F.C.T.D.).

In view of the above, the applicant's application is refused.

Dated at Hull, Quebec, this 31<sup>st</sup> day of OCTOBER ,1991.

Myer Herzig,  
Member,  
Trade-mark Opposition Board