

**IN THE MATTER OF AN OPPOSITION by
PREVENTION-INCENDIE SAFETY FIRST INC./SAFETY
FIRST FIRE PREVENTION INC. to application No. 820,706 for
the trade-mark SAFETY 1ST & Design filed by HUCK GLOVE
GROOPCO LTD.**

On August 15, 1996, the applicant, HUCK GLOVE GROOPCO LTD., filed an application to register the trade-mark SAFETY 1ST & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada by the applicant itself and/or through a licensee in association with

“Eyeglasses and replacement lenses, protective eye goggles for domestic and industrial use, face shields, lens cleaning solutions, disposable hearing protection, re-usable silicone hearing protection, protective hearing and cap muffs, protective respiratory systems namely, disposable and reusable dust and mist respirators for industrial, agricultural and domestic use to filter dust, mist, paint fumes, organic vapours and the like disposable protective clothing namely, coveralls, lab coats, aprons, sleeves, rainwear namely, outerwear three-piece rain suits, hard hats, hair and beard nets, knee pads, steel toe covers, waste cans; body harnesses and safety lifelines, lanyards, safety belts all for fall prevention in the construction and roofing industries; barricade tapes for use in the construction industry; safety signs; face-eye wash and shower stations, burn blankets; cervical collars, wool blankets, therapeutic body support braces, rubber elastic body support braces, rubber elastic body support bandages, disposable latex finger cots and gloves”.

The applicant disclaimed the right to the exclusive use of the word SAFETY apart from its trade-mark.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of May 20, 1998 and the opponent, PREVENTION-INCENDIE SAFETY FIRST INC./SAFETY FIRST FIRE PREVENTION INC., filed a statement of opposition on June 8, 1998, a copy of which was forwarded to the applicant on June 15, 1998. The applicant served and filed a counter statement in response to the statement of opposition on July 15, 1998. The opponent submitted as its evidence a certified copy of registration No. 421,741 for the trade-mark SAFETY FIRST & Design, together with a certified copy of the Certificate of Compliance for Prevention-Incendie Safety First Inc. The applicant filed as its evidence a certified copy of registration No. 392,051 for the trade-mark SAFETY 1ST. The applicant alone submitted a written argument and neither party requested an oral

hearing.

The first ground of opposition is based on subsection 30(i) of the *Trade-marks Act*. While the legal burden is on the applicant to show that its application complies with section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. Further, the material time for considering the section 30 ground is the applicant's filing date [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

No evidence or written argument has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark SAFETY 1ST & Design in Canada. Furthermore, to the extent that the subsection 30(i) ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the applicant's trade-mark is not registrable or not distinctive, or that the applicant is not the person entitled to registration of the trade-mark SAFETY 1ST & Design, 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.

The third and fourth grounds of opposition relate to the applicant's entitlement to registration, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark SAFETY 1ST & Design in that, as of the filing date of the present application, the applicant's trade-mark was confusing with its trade-name, PREVENTION-INCENDIE SAFETY FIRST INC./SAFETY FIRST FIRE PREVENTION INC., and with its trade-mark SF SAFETY FIRST & Design which had been previously used in Canada in association with the following wares:

“Systèmes de prévention des incendies pour résidences, commerces et restaurants, incluant cuisines de restaurants, nommément systèmes d'alarme incendie, avertisseur de fumée et matériel contre la propagation des flammes et de la chaleur nommément: CO2, poudre chimique, halon et agents liquides; systèmes de protection contre les incendies pour résidences, commerces et restaurants, incluant cuisines de restaurants et systèmes de protection contre les incendies pour risques industriels et risques spéciaux, nommément: mécanismes complets visant à réaliser l'extinction des feux

avant la dégénérescence en incendie et conçus pour installation dans des bâtiments ou structures fixes ayant des risques d'incendie localisés et dont les composantes principales sont la détection et le contrôle des incendies; le mécanisme d'actuation, réservoirs et agents d'extinction, nommément: CO2, poudre chimique, halon, et agents liquides, et le réseau de distribution des agents d'extinction; systèmes de protection contre les incendies pour véhicules, nommément: systèmes à poudre chimique spécialement conçus pour résister aux vibrations et adaptés aux limites d'espace des blocs moteurs; systèmes d'alarme; extincteurs d'incendie; détecteurs de feu et détecteurs de fumée; éclairage d'urgence; systèmes de gicleurs; produits de sécurité, nommément: trousse de premiers soins, trousse d'urgence pour véhicule, affiches, échelles de sécurité, extincteurs portatifs, extincteurs sur roues”

as well as the following services:

“Exploitation d'une entreprise traitant de la vente, de l'installation et de l'entretien de systèmes de prévention des incendies, de systèmes de protection contre les incendies pour les résidences, les commerces, les restaurants et les véhicules; de systèmes de protection contre les incendies pour risques industriels et risques spéciaux; de systèmes d'alarme, de systèmes de gicleurs, d'extincteurs d'incendie, de détecteurs de feu et de détecteurs de fumée, d'éclairage d'urgence et de produits de sécurité”.

Having regard to the provisions of subsections 16(5) and 17(1) of the *Trade-marks Act*, there is a burden on the opponent to establish its prior use and non-abandonment of its trade-mark SF SAFETY FIRST & Design and its trade-name in Canada. However, the opponent has failed to adduce any evidence relating to its use of either its trade-mark or its trade-name and has therefore failed to meet the burden on it under subsections 16(5) and 17(1) of the *Act*. I have therefore dismissed these grounds of opposition.

The fifth ground of opposition relates to the alleged non-distinctiveness of the applicant's trade-mark. As no evidence has been submitted by the opponent in support of the non-distinctiveness ground, the opponent has failed to meet its evidential burden in relation to this ground. Consequently, the non-distinctiveness ground is also unsuccessful.

The only remaining ground is based on paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark SAFETY 1ST & Design is not registrable in that it is confusing with the opponent's registered trade-mark SF SAFETY FIRST & Design, registration No. 421,741, a representation of which is set out below, covering the wares and services identified above.



Registration No. 421,741

With respect to the second ground, 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 date of decision, the material date with respect to the paragraph 12(1)(d) ground [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al*, 37 C.P.R. (3d) 413 (F.C.A.)]. Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark SAFETY 1ST & Design and the opponent's registered trade-mark SF SAFETY FIRST & Design, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in subsection 6(5) of the *Trade-marks Act*.

Considering initially the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], the applicant's trade-mark SAFETY 1ST & Design possesses some minor degree of inherent distinctiveness when considered in its entirety even though the word SAFETY is descriptive of the character of the applicant's wares which are intended to prevent injury, avert danger or provide assistance to those who have sustained injuries. Likewise, the opponent's registered trade-mark SF SAFETY FIRST & Design possesses some degree of inherent distinctiveness when considered in its entirety even though the words SAFETY FIRST are descriptive when applied to the wares and services covered in registration No. 421,741 and have been disclaimed by the opponent apart from its trade-mark.

Considering next the extent to which the trade-marks have become known [para.6(5)(a)] and the length of time the marks have been in use [para.6(5)(b)], no evidence of use of either of the trade-marks at issue has been adduced by the parties. As a result, these criteria do not favour either party.

As for the nature of the wares and services of the parties [para.6(5)(c)] and the nature of the

trade associated with the trade-marks at issue [para.6(5)(d)], the opponent's fire detectors and smoke detectors, portable extinguishers, first-aid kits and vehicle emergency kits are similar to the various safety products covered in the present application and, in the absence of any evidence to the contrary, I would expect that there would be an overlap in the channels of trade associated with these wares.

With respect to the degree of resemblance between the trade-marks at issue [para.6(5)(e)], the applicant's trade-mark SAFETY 1ST & Design bears some similarity in appearance and is very similar in sounding and in the ideas suggested to the opponent's registered trade-mark SF SAFETY FIRST & Design.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the applicant relied upon the existence of registration No. 392,051 for the trade-mark SAFETY 1ST, dated December 20, 1991, covering the following wares:

“Message bracelets; cabinet and door stops; latches and locks; toilet seat locks; and appliance latches; a gauge for establishing the minimum size of small objects that may safely be given to children; anti-slip bathtub decals; safety covers; plugs for electrical outlets; bath thermometer and light switch extenders; bottle attachments, namely nipples; inflatable vinyl headband eye protectors; pacifier clips; teethers; ice packs; medicine feeding spoons; bottle identification collars; dishwasher racks for nursing and teething accessories; thermal insulators for bottles; and baby feeding spoons, forks and sets; portable potty seats; bathtub spout protectors; night lights and bath seats; automobile clip-on rear view mirror and vinyl sheets used in vehicles for ultra-violet screening and upholstery protection; child restraining devices in the nature of webbing straps for toddlers; toy and laundry bags made of webbing; signs, decals, memo boards, switchplate covers and doorknob covers, soft furniture corner covers; vomiting-inducing syrup.”

The wares covered in the above registration differ from the wares covered in the present application and from the wares and services covered in the opponent's registration. In any event, the existence of one registration for a trade-mark similar to those at issue does not *per se* justify my concluding that there would be no reasonable likelihood of confusion between the trade-marks at issue. At most, the existence of registration No. 392,051 supports the conclusion that I have already reached that the trade-marks at issue possess relatively little inherent distinctiveness and therefore are weak marks which are not entitled to a wide ambit of protection.

Having regard to the foregoing, and even bearing in mind the inherent weakness of the opponent's trade-mark, I find that I am still in doubt in relation to the issue of confusion between the

applicant's trade-mark SAFETY 1ST & Design and the opponent's registered trade-mark SF SAFETY FIRST & Design which are similar in appearance and very similar in sounding and in the ideas suggested and are applied to wares which overlap and could therefore travel through the same channels of trade. I am therefore obliged to resolve that doubt against the applicant and have therefore concluded that the applicant has failed to meet the legal burden on it in respect of the issue of confusion in relation to the second ground. Thus, the applicant's trade-mark is not registrable in view of paragraph 12(1)(d) of the *Trade-marks Act*.

Having been delegated by the Registrar of Trade-marks by virtue of 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 16TH DAY OF JANUARY, 2001.

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