

**IN THE MATTER OF AN OPPOSITION by  
Hearst Holdings, Inc. to  
application No. 898,649  
for the trade-mark POPEYE'S SAILORS EXCHANGE  
in the name of J.B.C. (John) Wallstrom, Johan Wallstrom, Julia Chalmers Wallstrom  
trading as Popeye's Sailors Exchange**

**On December 8, 1998, the applicant, J.B.C. (John) Wallstrom, Johan Wallstrom, Julia Chalmers Wallstrom trading as Popeye's Sailors Exchange, filed an application to register the trade-mark POPEYE'S SAILORS EXCHANGE. The application is based upon use of the trade-mark in Canada in association with the following services since January 15, 1989:**

- 1. retail selling of marine equipment and supplies;**
- 2. retail consignment store featuring marine equipment and supplies;**
- 3. auctioning.**

**The applicant has disclaimed the right to the exclusive use of the words SAILORS EXCHANGE apart from the trade-mark.**

**The application was advertised for opposition purposes in the Trade-marks Journal of March 8, 2000. The opponent, Hearst Holdings, Inc., filed a statement of opposition on August 8, 2000. The applicant filed and served a counter statement, which it entitled Statement of Defence. In this document, the applicant denied each of the pleaded grounds of opposition and attached certified copies of "Declaration for Partnership and Business Name" documents and a Statutory Declaration of J.B.C. John Wallstrom.**

**The opponent filed the affidavit of Ronald J. Doerfler and certified copies of Canadian Trade-**

**mark Registrations Nos. 248,151 and 303,560 pursuant to rule 41 of the *Trade-marks Regulations*.**

**The applicant filed an affidavit of J.B.C. John Wallstrom pursuant to rule 42. The opponent obtained an order for the cross-examination of Mr. Wallstrom and the transcript of cross-examination forms part of the record.**

**Each party filed a written argument and an oral hearing was held at which both parties were represented.**

***The Evidence***

***Doerfler***

**Mr. Doerfler is the opponent's Senior Vice-President, Chief Financial Officer and Treasurer. He is also the Senior Vice-President, Chief Financial Officer and Treasurer of The Hearst Corporation and Vice-President of King Features Syndicate, Inc. The opponent is a wholly owned, direct subsidiary of The Hearst Corporation.**

**The opponent is the owner of the trade-mark POPEYE which is registered in Canada under No. 248,151 in association with a cartoon strip and under No. 303,560 in association with pharmaceuticals, namely multi-vitamin supplements. It acquired these rights from The Hearst Corporation effective December 31, 1997.**

**Mr. Doerfler discusses the history of a comic strip character called “Popeye”. He attests that since December 3, 1967, the POPEYE comic strip has been published in the Canadian newspaper “Progress Du Saguenay” in the City of Chicoutimi, Quebec. Copies of issues of the “POPEYE comic strip” for the weeks ending January 22, 2000, August 19, 2000 and April 21, 2001 have been provided.**

**Mr. Doerfler explains that King Features Syndicate, Inc. is a wholly owned, indirect subsidiary of The Hearst Corporation and that it distributes the POPEYE comic strip to newspapers and “licenses its comic character trade marks to more than 300 manufacturers, advertisers and promotional partners worldwide.” The POPEYE trade-mark has been licensed elsewhere in the world for toys, apparel, decorative accessories, gifts, electronics, drinks, strollers, and children’s shows.**

**The opponent’s net revenues from publishing, merchandising, licensing and usage of the POPEYE characters attributable to the Canadian market exceeded one million dollars U.S. in each of the years 1996 through 2000. However, these revenues relate to the POPEYE characters, not the POPEYE trade-mark. Mr. Doerfler does not define “POPEYE characters” but he does say that the characters in the comic strip include “Popeye”, “Olive Oyl”, “Wimpey”, “Swee’pea” and “Bluto”.**

**Mr. Doerfler states that the trade-mark POPEYE was licensed for use in Canada under strict quality control provisions for gift boxes between January 1, 1998 through December 1, 2002 and for candy sticks during the year 2001. However, being licensed and being sold is not the same**

thing. He also states that the Campbell Soup Company was running a full media campaign starring the POPEYE character for Chunky Soup at the time of his affidavit but no examples of such use or further details have been provided.

Mr. Doerfler attaches photocopies of a book entitled Popeye – The First Fifty Years by Bud Sagendorf. Mr. Doerfler states, “My understanding is that Mr. Sagendorf worked with Elzie Segar, the creator of the POPEYE character, and is and has been for many years the cartoonist creating POPEYE comic strips. Therefore, I believe this book accurately details the history of the POPEYE comic strip and comic strip character including reference to the theme song for animated movies of the POPEYE character”, which begins with the words, “I’m Popeye the Sailor Man”.

*Wallstrom*

Mr. Wallstrom states that he has been a partner of Popeye’s Sailors Exchange since about January 15, 1989 and that Popeye’s Sailors Exchange has been registered since November 19, 1988 with the Province of British Columbia. Mr. Wallstrom attests that the applicant is a legal entity.

Mr. Wallstrom states, “POPEYE’S SAILORS EXCHANGE as the name indicates is a place where sailors can sell and purchase items for their boats.” The applicant’s nets sales in each of the years 1996 through 2000 are stated to range between \$60,000 and \$75,000. He attests that the applicant “is not using the Popeye cartoon figure or vitamins in their adverts or in any other way.” The applicant does have a website ([www.popeyesailorsexchange.com](http://www.popeyesailorsexchange.com)) with a daily updated database of the products it sells.

**Mr. Wallstrom states that the opponent is not the only one that has registered trade-marks containing the word POPEYE and sets out the details of five Canadian registrations in the name of AFC Enterprises, Inc. for marks beginning with POPEYES and more than a dozen “current phone listings of businesses in Canada that use the word POPEYE in their names”.**

**In his statutory declaration, Mr. Wallstrom has provided copies of newspaper advertisements that display the trade-mark POPEYE’S SAILORS EXCHANGE dating from January 19, 1989, March 17, 1989 and April 1990.**

**During cross-examination, Mr. Wallstrom was asked if the applicant is a partnership. He answered in the affirmative and further responded that it is registered as a partnership in British Columbia. In the course of his questions, counsel for the opponent referred Mr. Wallstrom to the “Declaration for Partnership and Business Name” documents that accompanied the applicant’s counter statement.**

**In response to questioning, Mr. Wallstrom also advised that at the time that the applicant adopted the name POPEYE’S SAILORS EXCHANGE, he was not familiar with the opponent’s POPEYE character since he grew up in Sweden where the character uses a different name. However, his wife, one of the partners, would have known about the POPEYE character.**

*Grounds of Opposition*

**Although the ultimate legal burden lies on the applicant in opposition proceedings, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations.**

***Paragraph 38(2)(a)***

**The opponent has pleaded that the application does not comply with section 30 of the *Trade-marks Act* because the applicant is not a legal entity. In its written argument, the opponent sets out its case as follows:**

**...the proper legal entity of the three individuals listed as the applicant is a partnership. A trading style alone does not fall within the definition of ‘person’ in the *Trade-marks Act*. Since there is no reference in the Applicant’s name as a partnership, the Application does not comply with Section 30 because the named applicant could not have the requisite use of the trade mark as required by Sections 30(b) and 30(i).**

**In support of its position, the opponent relies upon the decision in *Compagnie Des Montres Longines Francillon S.A. v. Pinto Trading Co.* (1983), 75 C.P.R. (2d) 283 (T.M.O.B.). In that case, the evidence showed that an individual carried on business under the trading style Pinto Trading Co. As the application only identified the applicant as Pinto Trading Co., the Registrar refused the application on the basis that it was not in the name of a proper applicant. An applicant must qualify as a “person” within the meaning of the Act, which means that it must be capable of suing and being sued in its own name, capable of entering into contracts and capable of holding title to real and personal property. Since an individual trading under a firm name cannot sue under that name, Pinto Trading Co. was not a proper applicant. However, here we are not presented merely with a trading style as the applicant. Rather, we have been given the name of three individuals**

**trading as Popeye’s Sailors Exchange, which the evidence shows is in fact the name of a partnership.**

**The opponent has also pleaded that the application “does not comply with the requirements of Section 30(b), in that the trade mark has not been used in Canada by the Applicant in association with (1) retail selling of marine equipment and supplies; (2) retail consignment store featuring marine equipment and supplies; and (3) auctioning (collectively the ‘Applicant’s Services’), since January 15, 1989, as alleged in the application.”**

**In the written argument, the opponent submits that the application is not in compliance with subsection 30(b) because the applicant has failed to prove use of its trade-mark since as early as January 15, 1989. However, the applicant is not required to do so unless there is evidence which casts doubt on the claimed date of first use.**

**At the oral hearing, the opponent took the position that the application is not in compliance with subsection 30(b) because the named applicant was not the user of the applied for trade-mark since the date claimed. In support of this position, the opponent pointed to two instances where the partnership Popeye’s Sailors Exchange is indicated as being comprised of different parties.**

**First, the opponent has noted that the applicant is set out as merely J.B.C. (John) Wallstrom trading as Popeye’s Sailors Exchange in an amended application filed during prosecution. This may have been simply the result of a typographical error as there was no request to record this**

change. The Examination Division did not comment on this discrepancy, but it may not have noticed it. In any event, given that this discrepancy occurred after the filing of the application, I do not see how it can support a subsection 30(b) ground of opposition.

Second, the opponent points to the cross-examination of Mr. Wallstrom where it referred him to the certified copies of two British Columbia Declarations for Partnership and Business Name for Popeye's Sailors Exchange, which accompanied the applicant's counter statement. The declaration dated 1989 lists only two individuals whereas the declaration dated 1992 indicates that there has been a change to three partners. Mr. Wallstrom explained in the cross-examination that his son became a partner in 1992. The opponent submits on this basis that the applicant named in the trade-mark application did not use the mark since January 15, 1989. However, it is unclear that the two person partnership would be considered a predecessor to the three person partnership and the *Trade-marks Act* only requires predecessors to be named. The change constitutes a change in membership of the partnership and it is the Examination Division's practice to not require that the individual partners be listed (see Practice Notices published 1985-01-02 and 1989-07-19). For these reasons, it appears to me that it was not necessary for the applicant to refer to the earlier constitution of the partnership in its application. I therefore find the application to be in compliance with subsection 30(b).

As an aside, I will mention that in order to have the issue of an unnamed predecessor considered, it would be best if opponents made it clear in their pleadings that they were raising that issue.



**The final ground of opposition under section 30 is that the applicant could not have been satisfied that it was entitled to use the trade-mark given the prior use and making known of the opponent's POPEYE trade-mark. The opponent has shown that at least one of the members of the applicant partnership was aware of the Popeye character when the application was filed. Nevertheless, this does not prevent the applicant from having been satisfied as to its entitlement because of its belief that confusion was not likely for the reasons that it has set out in its argument. In general, it is difficult to win an opposition based on a subsection 30(i) ground of opposition and such a ground does not succeed here.**

***Paragraph 12(1)(d) Ground of Opposition***

**The statement of opposition pleads that the applicant's mark is not registrable because it is confusing with the trade-mark POPEYE registered under Nos. 248,151 and 303,560. However, reliance on registration No. 303,560 was withdrawn in the opponent's written argument.**

**Registration No. 248,151 is for use of POPEYE in association with a cartoon strip and claims use of the mark in Canada since at least as early as September 22, 1930.**

**The material date with respect to paragraph 12(1)(d) is the date of my decision [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.)]. The opponent has satisfied its evidential burden through the filing of a certified copy of registration No. 248,151 and so the applicant must satisfy its legal burden by establishing, on a balance of probabilities, that there would be no reasonable likelihood of confusion between its**

mark and the registered mark.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I will now address each of the surrounding circumstances.

The dictionary definition of “popeye” is “a staring bulging eye, an exophthalmic condition of fishes due to infestation of the eye by larval trematode worms, a fish affected with this condition” [*Webster’s Third New International Dictionary*]. As this definition does not relate to cartoon strips, the opponent’s POPEYE trade-mark is an inherently strong trade-mark. POPEYE SAILOR’S EXCHANGE is inherently somewhat weaker as such mark contains words that describe the applicant’s services.

**Although the opponent claims that its mark has been used longer and to a greater extent than the applicant's mark, I do not accept that the notoriety of the opponent's trade-mark is as great as it claims for several reasons: use in Canada has been limited to one city in Quebec; sales figures have been provided for "Popeye characters", not the trade-mark POPEYE; Mr. Doerfler attests to there being a number of licenses in place but does not attest to such licensees having sold product in association with the POPEYE trade-mark in Canada pursuant to their licences.**

**The opponent claims use of POPEYE in Canada since at least as early as September 22, 1930 whereas the applicant claims use since January 15, 1989.**

**There are huge differences between the applicant's cartoon strip and the opponent's marine-related services, as well as between the nature of the associated trades.**

**The degree of resemblance between the marks is high in that the first word is essentially the same. The addition of the words SAILORS EXCHANGE do result in there being differences between the marks visually, aurally and in idea suggested.**

**As a further surrounding circumstance, I will consider the evidence of third party names in the marketplace that include the opponent's mark. These include:**

- 1. B Popeye's Gym in Ontario;**
- 2. Popeye Excavation in Quebec;**
- 3. Popeye Shoes Limited in Ontario;**

- 4. Popeye's Campground in British Columbia;**
- 5. Popeye's Catalog Shop in British Columbia;**
- 6. Popeye's Gym in Ontario;**
- 7. Popeye's Mobile Power Steam Cleaner Ltd. in British Columbia;**
- 8. Popeyes Fitness & Training Superstore in Alberta;**
- 9. Popeyes Fitness Shop in Alberta;**
- 10. Popeyes Movers in Manitoba;**
- 11. Popeyes Pizza in Manitoba;**
- 12. Popeyes Smoke & Gift in British Columbia;**
- 13. and twelve Popeye Chicken Restaurants.**

**The opponent had the opportunity to respond to this evidence by either demonstrating that such uses were in fact licensed by it or by demonstrating that it was objecting to such uses. As it did neither, I accept that the opponent is not the only party using POPEYE as part of a trade-mark or trade-name in Canada.**

**Another surrounding circumstance is the lack of confusion despite more than a decade of coexistence. It is of course not necessary for the opponent to evidence confusion in order for me to find that there is a likelihood of confusion but the absence of confusion may entitle one to draw a negative inference about the opponent's case [see *MonSport Inc. v. Vetements de Sport Bonnie (1978) Lteé (1988)*, 22 C.P.R. (3d) 356 (F.C.T.D.), *Mercedes-Benz A.G. v. Autostock Inc. (formerly Groupe T.C.G. (Québec) Inc.)*, 69 C.P.R. (3d) 518 (T.M.O.B.)].**

**A further surrounding circumstance is that there is a song about the comic strip character "Popeye" that identifies him as a sailor.**

**Having considered all of the surrounding circumstances, in particular the great differences between the applicant's services and the opponent's wares (including those wares that the opponent claims that it has licensed its trade-mark for) and the use by third parties of "Popeye" in various forms for diverse businesses, I conclude that the applicant has met its burden to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion as of today's date between POPEYE for use in association with cartoon strips and POPEYE'S SAILORS EXCHANGE for use in association with a retail consignment store featuring marine equipment and supplies, retail selling of marine equipment and supplies, and auctioning. The paragraph 12(1)(d) ground of opposition therefore fails.**

**Before proceeding to the next ground, I wish to point out that there is a distinction between the character Popeye and the POPEYE trade-mark and that this opposition is only based on the latter. I also want to address the case put forward by the applicant in support of its position, *Pink Panther Beauty Corporation v. United Artists Corporation* (1998), 80 C.P.R. (3d) 247 (F.C.A.). In that case, the Court of Appeal found the respondent's THE PINK PANTHER trade-mark to be famous but nevertheless held that the appellant's PINK PANTHER mark was not likely to result in confusion as to source. The respondent used its mark in association with motion pictures, while the appellant proposed to use its mark in association with hair care and beauty products and a business dealing in their distribution. In applying subsection 6(5) of the Act, the Court found the key factor to be "the gaping divergence in the nature of the wares and in the nature of the trade. It is not a fissure but a chasm." The Court went on to say, at pages 269-270,**

**United Artists produces movies. United Artists' products are not likely to be made available in the same places of trade as the appellant's products. Shampoo is not sold in movie theatres or video stores. Videos are not available in beauty parlours.**

...

**Just because they are well known, the whole world is not barred forever from using words found in the title of a Hollywood film to market unrelated goods.**

**Furthermore, we owe the average consumer a certain amount of credit... While the public might be confused by a product which used the name "Pink Panther" and simultaneously depicted a pink cat, the use of the words alone cannot be said to give rise to such confusion. Indeed one of the surrounding circumstances that the Trial Judge should have adverted to is the fact that much of the fame which this Court and the Court below attach to the respondent's mark stems not from the words "The Pink Panther" but from the associated music and cartoon images. In this case, words only are used. There is no accompanying design or music. It is reasonable to conclude that the average person, without being presented with these other hallmarks, would not confuse the source of the appellant's proposed mark.**

**Although no two cases are ever alike, the *United Artists* case does share certain similarities with the present case. Here, the applicant's services are in my view at least as different from the opponent's wares as shampoo is from motion pictures. The applicant has not adopted any character design or music that reinforces a connection with the opponent's Popeye character. In addition to those similarities, there are also two differences that favour the present applicant: the present opponent has not established that it has a famous mark and the applicant's mark is not a proposed use mark.**

**Subsection 6(2) of the Act sets out when trade-marks are confusing, as follows:**

**6 (2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. (underlining added)**

**However, the Court of Appeal in *United Artists* said, at page 258,**

**A trade-mark is a mark used by a person to distinguish his or her wares or services from those of others. The mark, therefore, cannot be considered in isolation, but only in connection with those wares or services. This is evident from the wording of subsection 6(2). The question posed by that subsection does not concern the confusion of marks, but the confusion of goods or services from one source as being from another source.**

The Court also pointed out that “the test to be met is *likelihood* of confusion (not possibility of confusion)”. [page 269]

*Paragraph 16(1)(a) Entitlement Ground of Opposition*

With respect to this ground of opposition, there is an initial burden on the opponent to evidence use of its trade-mark prior to the applicant’s date of first use by it or a licensee whose use satisfies the requirements of section 50 of the Act. I find that the opponent has not satisfied this burden. Although Mr. Doerfler states that the POPEYE comic strip has been published and is currently published in the Canadian newspaper “Progress Du Saguenay” in the City of Chicoutimi, Quebec, he does not provide an exhibit evidencing such use. He does provide copies of issues of the POPEYE comic strip for the weeks ending January 22, 2000, August 19, 2000 and April 21, 2001 but he does not say that these appeared in the Chicoutimi newspaper and given that the exhibits are English comic strips, it seems rather unlikely that they appeared in this French language newspaper.

I also have the following doubts concerning the opponent’s claim to have used POPEYE in association with comic strips in Canada. In Exhibit “C” to the Doerfler affidavit, the individual daily comic strips do not display the trade-mark POPEYE. Instead, in the left hand column of each

page there is the following wording: King Features 235 East 45<sup>th</sup> Street, New York, N.Y. 10017 POPEYE ® By Bud Sagendorf. This message (which may only be given to the newspapers, not the reading public) is ambiguous as to who the owner of the POPEYE trade-mark is, but suggests that it is either King Features or Bud Sagendorf. Mr. Doerfler sets out the relationship and role of the opponent and King Features Syndicate, Inc., as follows. The opponent owns the POPEYE trade-mark but King Features Syndicate, Inc. owns the copyright in the comic strip entitled “POPEYE”. King Features Syndicate, Inc. distributes the POPEYE comic strip to newspapers and licenses its comic character trade-marks. The opponent and King Features Syndicate, Inc. are wholly owned direct and indirect subsidiaries, respectively, of The Hearst Corporation. Bud Sagendorf worked with the creator of the Popeye character and has been for many years the cartoonist creating the POPEYE comic strips. The foregoing does not make it clear to me that the opponent controls the character and quality of the POPEYE cartoon strip.

“Use” is a conclusion of law and the opponent has not provided me with the materials or details necessary to conclude that there was use of POPEYE by the opponent as a trade-mark in Canada prior to January 15, 1989. This ground is accordingly dismissed.

*Paragraph 16(1)(b) Entitlement Ground of Opposition*

At the oral hearing, the opponent’s agent submitted that the July 16, 2004 decision in *Effigi Inc. v. Attorney General of Canada*, 2004 FC 1000 has altered the law in the following manner. To date, the Opposition Board has taken the position that a trade-mark application may not be relied upon under section 16 unless the application was still in the prosecution stage at the date of



advertisement of the opposed application [see for example *Golden Happiness Bakery Ltd. v. Guangdong Cereals & Oils Import & Export Corp.* (2001), 17 C.P.R. (4<sup>th</sup>) 134 (T.M.O.B.) at 143].

The opponent's position is that an application should now be proper support for a section 16 ground regardless of when it issued to registration and should only be unacceptable if it was abandoned prior to the advertisement date. The relevant sections of the Act are reproduced below:

**16. (1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of those wares or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with**

- (a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;**
- (b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or**
- (c) a trade-name that had been previously used in Canada by any other person.**

...

**(4) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous filing of an application for registration of a confusing trade-mark by another person, unless the application for registration of the confusing trade-mark was pending at the date of advertisement of the applicant's application in accordance with section 37.**

**37. (1) The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that**

- (a) the application does not conform to the requirements of section 30,**
- (b) the trade-mark is not registrable, or**
- (c) the applicant is not the person entitled to registration of the trade-mark because it is confusing with another trade-mark for the registration of which an application is pending,**

and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.

In support of its position, the opponent directs me to paragraphs 25 and 44 of the *Effigi* decision, which discuss paragraph 37(1)(c) of the Act and read as follows:

[25] The respondent argues that the word “pending” does not specify that the application filed previously must be accepted and the one filed later must be rejected. The Court agrees with the respondent that the word “pending” does not specify how the Registrar should choose between two co-existing applications. The language of the paragraph is, therefore, ambiguous.

[44] In conclusion, the Court considers that the Court of Appeal determined, in *Unitel International Inc. C.A.*, that, pursuant to paragraph 37(1)(c), “The only issue is whether there is confusion between an applicant’s trade-mark and a trade-mark for which an application for registration is already pending.”

I do not see how the *Effigi* decision, or the cited paragraphs, lead to the conclusion that “pending” in subsection 16(4) should be interpreted to mean only “not abandoned” as opposed to both “not abandoned” and “not issued”. I note that *Black’s Law Dictionary* (Fifth Edition) contains the following definition for “pending”:

Begun, but not yet completed; during; before the conclusion of; prior to the completion of; unsettled; undetermined; in the process of settlement or adjustment. Thus, an action or suit is “pending” from its inception until the rendition of final judgment.

Pending means awaiting an occurrence or conclusion of action, period of continuance or indeterminacy. *Schull Const. Co. v. Board of Regents of Ed.*, 79 S.D. 487, 113 N.W.2d 663, 665.

Based on such definition, I believe that the Board’s past practice of interpreting “pending” in subsection 16(4) to exclude applications that have already issued to registration is maintainable.

I therefore dismiss the opponent’s paragraph 16(1)(b) ground of opposition on the basis that the applications on which it relies were not pending as of the advertisement of the applicant’s

application but rather had already issued to registration.

*Distinctiveness Grounds of Opposition*

The opponent has pled two reasons why it considers the applicant's mark to be non-distinctive. One is based on the allegation that the applicant is not a legal entity. Since the applicant is a legal entity, that arm of the ground cannot succeed.

The other arm pleads that "the applicant's proposed mark is not distinctive of the applicant because it does not actually distinguish and is not adapted to distinguish the applicant's services from the wares and services of others, including the opponent's cartoon strip and pharmaceuticals namely, multi-vitamin supplements, sold in association with the famous trademark POPEYE of the opponent."

In order to succeed, the opponent need only have shown that as of August 8, 2000, its POPEYE trade-mark had become known sufficiently in association with cartoon strips or multi-vitamin supplements to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]. I find that the opponent has failed to do so. Although it claims to have a famous mark, its evidence does not support such a conclusion. Rather, as of August 8, 2000, there is no evidence of use or advertisement of the opponent's POPEYE trade-mark in Canada. Yes, we have statements from the opponent's affiant that the mark was used but use is a question of law and the opponent has not provided me with any evidence from which I can conclude that the mark was in use in Canada in accordance with

**section 4 of the Act.**

**The distinctiveness ground of opposition therefore also fails.**

***Disposition***

**Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the Act.**

**DATED AT TORONTO, ONTARIO, THIS 9th DAY OF DECEMBER, 2004.**

**Jill W. Bradbury  
Member  
Trade-marks Opposition Board**