

IN THE MATTER OF AN OPPOSITION by Norfolk Southern Corporation and Triple Crown Services, Inc. to application No. 692,283 for the trade-mark ROYAL CROWN TRANSPORT & Design filed by Midland Transport Limited-Transport Midland Limitée, carrying on business as Royal Crown Transport

On October 25, 1991, the applicant, Midland Transport Limited-Transport Midland Limitée, carrying on business as Royal Crown Transport, filed an application to register the trade-mark ROYAL CROWN TRANSPORT & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as May 9, 1990 in association with the following services:

“Common and contract motor carrier transport services.”

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



The present application was advertised for opposition purposes in the *Trade-marks Journal* of August 26, 1992 and the opponents, Norfolk Southern Corporation and Triple Crown Services, Inc., filed a statement of opposition on January 26, 1993, a copy of which was forwarded to the applicant on February 16, 1993. The applicant filed and served a counter statement on March 16, 1993. The opponents elected not to file any evidence while the applicant submitted as its evidence the affidavit of James E. Longwell. Both parties submitted written arguments and neither party requested an oral hearing.

On June 11, 1997, the opponents requested leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend their statement of opposition. The opponents' request for leave was refused by the Opposition Board by way of the Office letter of August 21, 1997.

The first ground of opposition is based on Subsection 16(1) of the *Trade-marks Act*, the opponents alleging that the applicant is not the person entitled to registration of the trade-mark ROYAL CROWN TRANSPORT & Design in that, as of the applicant's claimed date of first use, the applicant's trade-mark was confusing with: (i) the trade-marks TRIPLE CROWN & Design and THOROUGHBRED & Design, and the representation of a horse or horse's head, which had been previously used or made known in Canada by the opponents; and (ii) the trade-names Triple Crown or Triple Crown Services, Inc. which had previously been used or made known in Canada by the opponent, Triple Crown Services, Inc.

Under Subsections 16(5) and 17(1) of the *Trade-marks Act*, there is a burden on the opponents to establish their alleged prior use and prior making known of their trade-marks and prior use of the trade-names Triple Crown or Triple Crown Services, Inc. as of the applicant's claimed date of first use. Further, the opponents must show that they had not abandoned their trade-marks and trade-names as of the date of advertisement for opposition purposes of the present application in the *Trade-marks Journal* [August 26, 1992]. In the present case, the opponents elected not to file any evidence and have therefore failed to meet the burden on them under Subsections 16(5) and 17(1) of the *Trade-marks Act*. As a result, the Section 16 grounds of opposition are unsuccessful.

As their final ground, the opponents alleged that the applicant's trade-mark is not distinctive in that it does not actually distinguish nor is it adapted to distinguish the services of the applicant from the services of the opponents. The material date for assessing this ground is as of the date of opposition [January 26, 1993]. While the legal burden is upon the applicant to show that its trade-mark is distinctive, there is an initial evidentiary burden upon the opponents to establish the facts relied upon by them in respect of this ground. Since no evidence has been submitted by the opponents, they have failed to meet the evidentiary burden upon them in relation to this ground. As a result, the non-distinctiveness ground of opposition is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Subsection 63(3) of the *Act*, I reject the opponents' opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 10th DAY OF MARCH, 1998.

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