

IN THE MATTER OF AN OPPOSITION
by Faber-Castell Canada Inc. to
application No. 608,774 for the
trade-mark MY FIRST filed by
Binney & Smith Inc.

On June 8, 1988, the applicant, Binney & Smith Inc., filed an application to register the trade-mark MY FIRST based on proposed use in Canada with the following wares:

paint sets, pencil cases, soft dough, pencils,
erasers, activity kits, drop sheets, aprons,
lunch pails, rulers, scissors and colouring
books.

The application was advertised for opposition purposes on November 23, 1988.

The opponent, Faber-Castell Canada Inc., filed a statement of opposition on December 22, 1988, a revised statement of opposition on February 20, 1989 and a further revised statement of opposition on March 22, 1989. A copy of the further revised statement was forwarded to the applicant on April 7, 1989. The first ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Trade-marks Act because the applicant could not be satisfied that it was entitled to use the trade-mark because it is clearly descriptive and not distinctive.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares. In support of that ground, the opponent included the following allegation of fact:

The words "MY FIRST" denote that the wares
associated with these words are to be
purchased or owned by first-time users.

The third ground of opposition reads as follows:

The Trade Mark is not distinctive of the wares of the Applicant, nor is it adapted to so distinguish them from the wares of others because the words "MY FIRST" are clearly descriptive of the character or quality of the wares in association with which the Trade Mark is proposed to be used and because the Trade Mark is not distinctive having regard to the descriptive use in the marketplace in Canada of the words "MY FIRST". In the marketplace, the Applicant and others use the ordinary English meaning of the words "MY FIRST". The meaning of these words can be found in any English dictionary. The Applicant and others use these words on their wares and on their packaging to denote that the products associated with these words are to be purchased or owned by first-time users.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Sarah F. Llewellyn. The applicant did not file evidence. Each party filed a written argument and an oral hearing was conducted at which only the applicant was represented.

As for the first ground of opposition, its success or failure essentially rests on a determination of the ground arising pursuant to Section 12(1)(b) of the Act. As for the second ground, the onus or legal burden is on the applicant to show that its trade-mark is registrable. There is, however, an evidential burden on the applicant to adduce sufficient credible evidence from which it could be concluded that the applicant's mark offends the provisions of Section 12(1)(b) of the Act. Furthermore, the material time for considering the circumstances respecting this ground is the filing date of the application. Finally, the test to be applied is the immediate impression the mark creates

on an everyday user of the wares.

In her affidavit, Ms. Llewellyn identifies herself as a law clerk employed with the firm of trade-mark agents representing the opponent. Much of her affidavit relates to purchases made by her in Toronto in November of 1988. Most of those purchases were of children's books with titles that included the words "my" and "first" such as My First Wordbook and My Very First Things. Several purchases were of items for children on which the words "my first" appeared as part of a trade-mark or as part of a description of the goods. Although the purchases were made several months after the material time, I consider that they are likely fairly representative of the marketplace as of the earlier date.

The opponent contends that the foregoing helps to establish that the words "my first" used on different wares indicate that the wares are intended for young children. I agree with the opponent's contention, at least insofar as it applies to the mark and wares at issue in the present case. However, the fact that the trade-mark MY FIRST may indicate that the applied for wares are for young children does not establish that the mark offends Section 12(1) (b) of the Act.

The mark does not, in my view, describe any particular character or quality of the applied for wares. The fact that the various items listed in the statement of wares may be intended for young children does not provide the consumer with any additional information about the wares. Because the paint sets, pencil cases and the like are for young children does that mean that they are smaller or safer or cheaper? Or does it mean that they are more expensive since, being a child's first, they are intended to last a long time? The trade-mark may be suggestive of any number of characters or qualities but it does not describe any particular one. More importantly, it does not clearly describe any particular character or quality of the wares. Thus, I find that the first and second grounds are unsuccessful.

As for the third ground, the material time for considering the circumstances is as of the filing of the opposition. As can be seen from the wording of the third ground, it is restricted to allegations that the trade-mark MY FIRST is clearly descriptive of the character of the wares. In view of my conclusions above, it therefore follows that the third ground is also unsuccessful.

If a ground of opposition had been raised that the applicant's trade-mark is not distinctive because it is not adapted to distinguish the applicant's wares from those of other manufacturers and retailers using the words MY FIRST for children's wares, the Llewellyn affidavit might well have been sufficient to satisfy the evidential burden on the opponent. As noted above, most of the Llewellyn purchases were children's books having titles which include the words "my" and "first." As also noted above, several of the purchases were of items for children on which the words "my first" appeared as part of a trade-mark or as part of a description of the goods. Those items included a game, a doll and a dress. Some of the applicant's individual wares can be characterized as children's books, games, toys or clothes and the remaining wares are closely related.

Although the opponent has not evidenced the extent to which the third party marks and descriptions have been used, the number of items evidenced by Ms. Llewellyn suggests that the use of the words "my first" in the relevant market is not uncommon. Given that the onus would have been on the applicant to show that its mark is adapted to distinguish its wares from those of others, a ground of non-distinctiveness based on third party uses

of similar marks and product descriptions might well have been successful. However, as noted above, the opponent's ground of non-distinctiveness is restricted to a pleading that the applicant's mark is not distinctive because it is clearly descriptive.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MAY 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.