

IN THE MATTER OF AN OPPOSITION by Caitlin Financial Corporation NV and Sara Lee Corporation of Canada Ltd., also doing business under the divisional trading style Kiwi Canada, to application No. 619,631 for the trade-mark KIWI DESIGNER filed by Reginald P. Wilson

On November 21, 1988, Reginald P. Wilson filed an application to register the trade-mark KIWI DESIGNER based upon proposed use of the trade-mark in Canada in association with "ladies stockings".

The opponents, Caitlin Financial Corporation NV and Sara Lee Corporation of Canada Ltd., also doing business under the divisional trading style Kiwi Canada, filed a statement of opposition on September 11, 1989 in which they alleged the following grounds of opposition:

(a) That the present application does not comply with Section 30(i) of the Trade-marks Act in that the applicant was aware of the use and promotion of the family of KIWI trade-marks of Caitlin Financial Corporation NV throughout Canada by Caitlin Financial Corporation NV, its predecessors, and its approved registered user, in association with a variety of footwear and leather articles, such that the applicant could not properly have made the statement that he was satisfied that he was entitled to use the trade-mark KIWI DESIGNER in Canada;

(b) That the applicant's trade-mark is not registrable in that it is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Regn. No.</u>	<u>Wares</u>
KIWI & Design	TMDA 18227	shoe polish, saddle soap and other polishes
KIWI & Design	UCA 12595	boot polishes and all other cleaning and polishing preparations and materials and dressings for boots and shoes and canvas and leather goods, including dubbin and stains and inks for leather
KIWI WEATHER-GUARD	183,438	preparations for waterproofing, polishing and otherwise treating shoes and other leather articles
KIWI WETPRUF	104,014	polishing and waterproofing preparations for boots, shoes, and other leather goods and leather dressing

(c) That the applicant is not the person entitled to registration in that, as of the filing date of the present application, the applicant's trade-mark KIWI DESIGNER was confusing with the KIWI trade-marks of the opponent, Caitlin Financial Corporation NV which had been previously used and made known in Canada by the opponent, its

predecessors-in-title, and its approved registered users, in association with a variety of goods pertaining to the footwear field. The opponent, Caitlin Financial Corporation NV, also relies on its unregistered trade-marks KIWI and KIWI Design and KIWI composite marks as previously used and made known in Canada by it and its predecessors in association with footwear and related goods;

(d) That the trade-mark KIWI DESIGNER is not distinctive in light of the reputation and fame attaching to the KIWI family of trade-marks of Caitlin Financial Corporation NV, such that the applicant's trade-mark is not and cannot be adapted to distinguish the applicant's wares from the wares of the opponents.

The applicant filed a counter statement in response to the statement of opposition.

The opponents filed as their evidence the affidavits of J.A. Robert Bill, Susan Burkhardt, Fay Haakman and Antonella DeGiovanni. The applicant submitted as his evidence the affidavit of Melvin Sher who was cross-examined on his affidavit, the transcript of the cross-examination, together with the exhibits to the cross-examination, forming part of the opposition record. As evidence in reply, the opponents filed the affidavits of Mary Noonan and François Grenier.

The opponents alone submitted a written argument and neither party requested an oral hearing.

In their written argument, the opponents have alleged that the applicant's trade-mark is not distinctive in view of the use in Canada by two other entities of Kiwi Designer as part of their corporate names. Further, evidence was adduced by the opponents that ladies stockings labelled KIWI DESIGNER were on sale in a retail outlet in Pointe-Claire, Quebec in packages claiming that the mark is a trade-mark of Kiwi Designer International, Inc. However, the opponents in their statement of opposition have not pleaded that the applicant's trade-mark is not distinctive in view of such activities. Further, the opponents did not seek to amend their statement of opposition in order to allege that the applicant's trade-mark is not distinctive in view of such activities. As a result, this evidence and the related submissions of the opponents appear to be of no relevance to any of the grounds of opposition.

All of the grounds of opposition turn on the issue of confusion between the applicant's trade-mark KIWI DESIGNER and one, or more, of the opponents' trade-marks identified above. Considering initially the ground of opposition based on Section 12(1)(d) of the Act, the opponents have alleged that the applicant's trade-mark KIWI DESIGNER is not registrable in that the applicant's mark is confusing with the registered trade-marks: KIWI & Design, registration No. TMDA 18227; KIWI & Design, registration No. UCA 12595; KIWI WEATHER-GUARD, registration No. 183,438; and KIWI WETPRUF, registration No. 104,014.

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark KIWI DESIGNER and one, or more, of the registered trade-marks relied upon by the opponents, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that 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 my decision, the material date with respect to the Section 12(1)(d) ground (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark KIWI DESIGNER as applied to "ladies stockings" and the registered trade-marks KIWI & Design, KIWI WEATHER-GUARD and KIWI WETPRUF as applied to the wares covered in the registrations relied upon by the opponents are inherently distinctive.

No evidence has been furnished by the applicant that his trade-mark KIWI DESIGNER has become known to any extent in Canada. On the other hand, the opponents' evidence establishes that their KIWI & Design trade-marks have become known throughout Canada in association with shoe polish and shoe and boot care products since 1913. Thus, the extent to which the trade-marks at issue have become known, as well as the length of use of the trade-marks of the parties, both weigh in the opponents' favour in this proceeding.

The applicant's "ladies stockings" differ from the opponents' shoe and boot polish and shoe and boot care products, as well as the opponents' polishing and waterproofing preparations and materials and dressings for canvas and leather goods. On the other hand, Ms. Burkhardt in her affidavit provides evidence relating to the channels of trade associated with ladies stockings and the opponents' wares. Based on this evidence, which has not been challenged or contradicted by the applicant, I have concluded that the wares of the parties are often sold in close proximity to each other in various types of retail outlets.

The only remaining criterion for consideration under Section 6(5) of the Trade-marks Act is the degree of resemblance between the trade-marks at issue in appearance, sounding and ideas suggested. In this regard, the trade-marks KIWI DESIGNER and KIWI & Design are very similar in appearance and sounding, as well as in the ideas suggested by them.

Having regard to the degree of resemblance between the trade-marks at issue as applied to wares sold in close proximity to each other through various types of retail outlets, and to the fact that the opponents' marks have become known in Canada whereas the applicant's application is based upon proposed use and no evidence has been furnished by the applicant that he has commenced use of his proposed mark KIWI DESIGNER, I have concluded that the applicant has failed to meet the legal burden upon him of satisfying me that there would be no reasonable likelihood of confusion between his trade-mark KIWI DESIGNER and the registered trade-mark KIWI & Design. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF December, 1993.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.