

**IN THE MATTER OF AN OPPOSITION  
by Superdollar Stores Ltd. to application No.  
756,061 for the trade-mark FAMILY DOLLAR  
STORES filed by Family Dollar Services Inc.**

**On May 26, 1994, the applicant, Family Dollar Services Inc., filed an application to register the trade-mark FAMILY DOLLAR STORES for “retail variety store services” based on proposed use in Canada and on use and registration (No. 950,085) in the United States. The application as filed contained a disclaimer to the word STORES. The application was advertised for opposition purposes on July 12, 1995.**

**The opponent, Superdollar Stores Ltd., filed a statement of opposition on December 12, 1995, a copy of which was forwarded to the applicant on January 11, 1996. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Trade-marks Act because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the applied for services. The second ground is that the applied for trade-mark is not distinctive of the applicant’s services because it is descriptive of retail variety store services and because the opponent and others have used the words FAMILY, DOLLAR and STORE separately or together in association with such services.**

**The third ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use its mark because the mark is non-distinctive and offends Section 12(1)(b) of the Act. The fourth ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(e) of the Act.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Angela Kim. The applicant chose not to submit evidence. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.**

The Kim affidavit establishes that there was an entry for “Family Dollar” in both the 1994-95 and the 1996-97 editions of the Toronto telephone directory (see Exhibit A). Exhibit B is a photocopy of an Ontario business name registration for Family Dollar which was provided to Ms. Kim by a firm identified as Dye & Durham. Exhibit C is a photocopy of a search report provided to Ms. Kim by a firm identified as CCNS which lists a business name “Family Dollar Sales and Service” in Carrot River, Saskatchewan. Ms. Kim telephoned both of these entities and was greeted with “Good afternoon, Family Dollar” in the first instance and with “Hello, Dollar store” in the second instance.

As for the opponent’s first ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). Furthermore, the issue is to be determined from the point of view of an everyday user of the services. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

Initially, it should be noted that the first ground of opposition as pleaded does not include any supporting allegations of fact. Furthermore, such allegations of fact are not self-evident in the present case. Thus, the first ground is not in compliance with Section 38(3)(a) of the Act and does not raise a proper ground of opposition. It is therefore unsuccessful.

The allegations of fact that should have appeared in the statement of opposition do appear in the opponent’s written argument, namely that the words FAMILY DOLLAR STORES clearly describe a type of store which sells a variety of discount merchandise for the family which costs about one dollar. However, even if the first ground had been adequately pleaded in this fashion, the opponent would not have met its evidential burden. The evidence is insufficient to even show that the words DOLLAR STORE(S) have any known meaning in

the trade, much less the words FAMILY DOLLAR STORES. The ordinary meanings of those words may suggest that the applicant's stores are discount stores selling family-oriented merchandise. Alternatively, they may suggest that the applicant operates a "family" of "dollar stores." In any event, they do not clearly describe any particular character or quality of those services - i.e. - it is not apparent what "family" products are. Thus, even if the first ground had been adequately pleaded, it would have been unsuccessful. A similar finding was made at pages 6-7 of the opposition decision in Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd. (S.N. 709,585; May 5, 1998).

As for the second ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - December 12, 1995): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

As for the second aspect of the second ground, it is unsuccessful for the reasons set forth above respecting the first ground of opposition. As for the first aspect of the second ground, the opponent has failed to meet its evidential burden. Initially, it should be noted that the materials appended to the Kim affidavit relating to alleged name registrations for two business entities are hearsay since the searches were conducted by firms unrelated to Ms. Kim's firm. Even if those materials are admissible, they do nothing more than establish that two such registrations exist. They do not evidence the extent, if any, to which the registered names were used in Canada. The Toronto telephone listings for an entity named Family Dollar suggest that there may have been a business operating under that name at a particular address in Toronto. However, that is far from the best evidence and does not allow me to infer any measurable reputation for that name among consumers. It was open to the opponent to

investigate the business carried on at that address, if any, but it did not do so. Thus, the second aspect of the second ground is also unsuccessful.

The third and fourth grounds of opposition are based on Sections 30(i) and 30(e) of the Act. While the legal burden is on the applicant to show that its application conforms to the requirements of Section 30, there is an initial evidential burden on the opponent to establish the facts relied on by it in support of its Section 30 grounds: see Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325 at 329-330 (T.M.O.B.) and John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). The material time for considering the circumstances respecting the issues of non-conformance with Section 30 of the Act is the filing date of the application: see the opposition decision in Georgia-Pacific Corp. v. Scott Paper Ltd. (1984), 3 C.P.R.(3d) 469 at 475.

As for the third ground, the opponent failed to show that the applicant's mark was non-distinctive or offended Section 12(1)(b) of the Act. Thus, the opponent has failed to meet its evidential burden to show that the application did not conform with Section 30(i) of the Act. The third ground is therefore unsuccessful. Even if the opponent had been able to show that the applicant's mark is non-distinctive or clearly descriptive, such a finding would not necessarily have precluded the applicant from being satisfied that it was the person entitled to use its mark in Canada.

The opponent's fourth ground of opposition is based on the provisions of Section 30(e) of the Act. The material time for assessing the applicant's conformance with Section 30(e) is the filing date of its application. As of that date, Section 30(e) read as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....
  - (e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada.

As noted, the onus or legal burden is on the applicant to show its conformance with Section 30(e). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(e) of the Act: see the opposition decisions in Canadian National Railway Co. v. Schwauss (1991), 35 C.P.R.(3d) 90 at 95 and Green Spot Co. v. J.B. Food Industries (1986), 13 C.P.R.(3d) 206 at 210-211.

The applicant's application formally complies with Section 30(e) of the Act since one of the required statements appears in the application, namely that the applicant intends to use the applied for mark. The issue then becomes whether or not the application substantially conforms with Section 30(e) - i.e. - is the applicant's statement that it intended to use the applied for trade-mark true?

In the present case, the opponent has filed no evidence directed to proving its allegation that the applicant did not intend itself to use the applied for mark in Canada. Thus, the opponent has failed to meet its evidential burden and the fourth ground of opposition is therefore also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 2nd DAY OF OCTOBER, 1998.

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