

**IN THE MATTER OF AN OPPOSITION  
by Groupe International Travelway Inc. to  
application No. 642,702 for the trade-mark  
TRAVELER filed by Berkshere Fashions, Inc.**

**On October 17, 1989, Berkshire Fashions Inc. filed an application to register the trade-mark TRAVELER for the wares**

**luggage, travelling bags, tote bags, umbrellas, and travel pouches based on proposed use of the mark in Canada. The application was advertised for opposition purposes on July 25, 1990 and opposed by Groupe International Travelway Inc. on November 23, 1990. A copy of the statement of opposition was forwarded to the applicant on January 7, 1991.**

**The first ground of opposition is that the applied for mark is not registrable because it is clearly descriptive of the character or quality of the wares. In this regard, the opponent alleges that the wares specified in the subject application are meant for travel, and that the dictionary definition of the word "traveler" is "a thing that travels".**

**The next ground of opposition is that the applicant is not entitled to register the applied for mark because, at the filing date of the application, the mark TRAVELER was confusing with (i) the opponent's trade-marks namely, TRAVELWAY and TRAVELWAY & Design (illustrated below) previously used in Canada in association with luggage, (ii) the opponent's trade-name Groupe International Travelway Inc., and confusing with (iii) the opponent's trade-mark application No. 630,154 for the mark TRAVELWAY & Design covering, among other things, luggage and handbags [application No. 630,154 was registered on January 25, 1991 under No. 378,785; however, the opponent did not request leave to amend its pleadings to rely on its newly registered mark].**

**The final ground of opposition is that the applied for mark TRAVELER is not adapted to distinguish the applicant's wares in view of the above.**

**The applicant filed and served a counter statement generally denying the allegations in the statement of opposition.**

**The opponent's evidence consists of the affidavit of Gerry Shadeed, Vice-President of the opponent company. The applicant did not cross-examine Mr. Shadeed on his affidavit nor did the applicant file any evidence in support of its application. The applicant filed a written argument, and was represented at an oral hearing. The opponent defaulted in filing a written argument (see the Office ruling dated February 5, 1993) and advised that it would not be represented at the scheduled hearing.**

**Mr. Shadeed's evidence may be summarized as follows. The opponent was formed by amalgamation in 1989; one of the amalgamating companies was Travelway Luggage Ltd., incorporated in 1976. The opponent began using its mark TRAVELWAY in 1976 and, according to Mr. Shadeed, the opponent has become one of Canada's leading importers and distributors of luggage and related items. The opponent's luggage and related wares are manufactured by third parties to the opponent's standards and specifications. Each item that is shipped to retailers is individually labelled as a TRAVELWAY product and bears a hangtag in the form shown below (see Exhibit A to Mr. Shadeed's affidavit) displaying the mark TRAVELWAY.**

**In this regard, I consider that use of the above composite mark constitutes use of the mark TRAVELWAY *per se*: see Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2**

C.P.R.(3d) 535 at 538, under the heading *Principle 1* (TMOB). The opponent has exclusive rights in Canada to distribute third party luggage and sports bags sold bearing the marks VUARNET, RICARDO, JORDACHE, JETSTREAM and KODIAK. In such cases, the opponent's mark TRAVELWAY appears in conjunction with the third party mark, either together with the third party mark on the same hangtag, or by itself on a separate hangtag. The opponent supplies tote bags, athletic and sports bags, garment bags, and tourist travel bags to a number of corporate clients: see exhibit C attached to Mr. Shadeed's affidavit. Sales of luggage sold under the mark TRAVELWAY (presumably inclusive of sales in conjunction with third party marks) have averaged about \$25 million per year for the three year period 1989-1991. Advertising and promotional expenses for wares sold under the opponent's mark were in excess of \$41,000 for the two year period 1990-1991.

With respect to the last 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 wares from those of others throughout Canada: see Muffin Houses Inc. v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal burden means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the statement of opposition, in this case November 23, 1990: see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Further, I am permitted to take into account evidence of all the surrounding circumstances including, for example, the parties' sales and advertising under their respective marks and trade-names, up to the material date: see Castle & Cooke, Inc. v. Popsicle Industries Ltd. (1990), 30 C.P.R.(3d) 158 (TMOB).

I am satisfied from Mr. Shadeed's unchallenged and uncontradicted evidence that the opponent's mark TRAVELWAY acquired a substantial reputation in Canada in association with luggage, both with retailers and with the general public, by the material date November 23, 1990. Considering the reputation acquired by the opponent's marks and trade-name and the resemblance between the parties' marks

**TRAVELWAY and TRAVELER, and considering that the parties' wares are essentially the same (aside from umbrellas), I find that the public would likely assume that the applicant's wares sold under the mark TRAVELER were approved, licensed, or sponsored by the opponent. It follows that the mark TRAVELER is not adapted to distinguish the applicant's wares namely luggage, travelling bags, tote bags, and travel pouches: see Glen-Warren Productions Ltd. v. Gertex Hosiery Ltd. (1990), 29 C.P.R.(3d) 7 at 12 (F.C.T.D.). However, there is no evidence to suggest that there is any connection between luggage and umbrellas, and the opponent has not made out a sufficient case to extend the ambit of protection accorded to its marks and trade-name to include the wares umbrellas. The considerations respecting the issue of confusion raised in the second ground of opposition are, in the instant case, essentially the same as those regarding the issue of distinctiveness (but as of the material date October 17, 1989). I find that the parties' marks are confusing with respect to the wares luggage, travelling bags, tote bags and travel pouches but not confusing with respect to the wares umbrellas.**

**The opponent did not submit any evidence in support of its first ground of opposition. From my own review of standard reference dictionaries, it appears that the word "traveler" refers to a person who travels rather than to a thing that travels. I have therefore concluded that the mark TRAVELER may be suggestive of luggage and other wares specified in the application, but that the mark is not clearly descriptive of any of the wares.**

**In view of the above, the opposition is rejected with respect to the wares "umbrellas" and the application is refused with respect to the wares "luggage, travelling bags, tote bags, and travel pouches". Thus, the opponent's opposition is successful in part. Authority for a divided decision is found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Scherf GmbH (1986), 10 C.P.R.(3d) 482 (F.C.T.D.).**

**There are two further matters that I would mention. First, attached to the applicant's written argument is what appears to be state of the register evidence. That evidence is inadmissible because it was not filed or served in a timely manner or**

**pursuant to leave under Rule 46 of the Trade-marks Regulations. In any event, the outcome of this proceeding would not have been any different even if I did have regard to that evidence. Secondly, about forty-five pages of the applicant's written argument is taken up with copies of headnotes of various cases. Headnotes of cases do nothing to further a party's case because headnotes are not jurisprudence. In any event, it is almost always more advantageous for a party to focus on just a few cases rather than to dilute a line of argument by referring to a plethora of cases.**

**DATED AT HULL, QUEBEC, THIS 30<sup>TH</sup> DAY OF NOVEMBER ,1994.**

**Myer Herzig,  
Member,  
Trade-marks Opposition Board**