

**IN THE MATTER OF AN OPPOSITION
by Canadian Tire Corporation Limited to
application No. 711,304 for the trade-mark THE
RIGHT CHOICE filed by Max Rittenbaum, Inc.**

On August 19, 1992, the applicant, Max Rittenbaum, Inc., filed an application to register the trade-mark THE RIGHT CHOICE based on proposed use in Canada with the following wares:

automobile cleaning accessories, namely cloths, brushes, chamois, liquid cleaner and related products, namely sponges, squeegees, cleaning pads, brooms, washing mitts and towels.

The application claimed priority based on the applicant's corresponding United States application No. 74/286,261 and the effective filing date of the present application is therefore June 19, 1992. The application was advertised for opposition purposes on January 3, 1996.

The opponent, Canadian Tire Corporation Limited, filed a statement of opposition on May 23, 1996, a copy of which was forwarded to the applicant on June 4, 1996. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-marks THE RIGHT CHOICE HAS NEVER BEEN SO CLEAR. CANADIAN TIRE and CANADIAN TIRE. THE RIGHT CHOICE HAS NEVER BEEN SO CLEAR. registered under Nos. 312,472 and 312,522 for the following services:

selling of vehicular parts, tools and accessories of others; the selling of maintenance and service supplies of others; the selling of garden equipment, tools, supplies and accessories of others; the selling of hardware of others; the selling of housewares of others; the selling of household goods of others; the selling of sporting goods of others; the servicing and maintenance of vehicles.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with the two registered trade-marks noted above and the trade-mark THE RIGHT CHOICE previously used in Canada by the opponent with the above-noted services. The third ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its Brand Manager, Daniel McVeigh. The applicant did not submit evidence. Only the opponent filed a written argument and an oral hearing was conducted at which only the opponent was represented.

Initially, I have considered the decision in Imperial Tobacco Ltd. v. Benson & Hedges (Canada) Inc. (1983), 75 C.P.R.(2d) 115 (F.C.T.D.); revg. (1983), 75 C.P.R.(2d) 20 (T.M.O.B.) in which Mr. Justice Cattanach held that the trade-mark RIGHT was clearly descriptive or deceptively misdescriptive of the character or quality of cigarettes. At page 117 of the reported decision, Mr. Justice Cattanach states as follows:

Thus, the word “right”.....has the laudatory connotation that wares modified thereby meet a specified standard and are desirable and satisfactory.

At page 118, he goes on to state that

Words having a laudatory connotation from their very nature have an implied ellipse which is the wares with which they are associated or are to be associated with.

If, as Mr. Justice Cattanach found, the trade-mark RIGHT is laudatory when used with any wares, then the trade-mark THE RIGHT CHOICE is clearly so since it more directly points to the associated wares. Thus, the trade-mark THE RIGHT CHOICE is clearly descriptive or deceptively misdescriptive of the character or quality of any associated wares. However, that fact does not preclude the registration of the applied for trade-mark since the opponent did not raise a ground of opposition based on Section 12(1)(b) of the Act.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in

Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, as discussed, the trade-mark THE RIGHT CHOICE offends Section 12(1)(b) of the Act. Thus, the applicant's mark is inherently very weak. Since the applicant failed to submit evidence, I must conclude that its mark has not become known at all in Canada.

The opponent's two registered marks are also inherently weak since they both include a descriptive slogan and the descriptive component CANADIAN TIRE. However, the combination of these two elements does impart some measure of inherent distinctiveness to each mark. Thus, the opponent's two marks are inherently stronger than the applicant's proposed mark.

In his affidavit, Mr. McVeigh indicates that the opponent began using its two registered trade-marks in 1986 but that such use diminished after 1989. Mr. McVeigh appended a number of photocopied excerpts from the opponent's catalogues distributed during the period 1986-89. Those excerpts do not show any use of the opponent's first registered mark but they do show three minor references to the trade-mark CANADIAN TIRE. THE RIGHT CHOICE HAS NEVER BEEN SO CLEAR., one in a 1986 catalogue and two in a 1987 catalogue. Notwithstanding the wide distribution of those catalogues throughout Canada, it appears that neither registered mark has been used for the last ten years. Thus, I doubt that either mark has any reputation among Canadian consumers today.

Given the long period of non-use of the opponent's two registered marks, the length of time the marks have been in use is not a material circumstance in the present case. As for the wares, services and trades of the parties, it is the applicant's statement of wares and the opponent's statement of services in its two registrations that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss

Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The opponent's statement of services includes the selling of vehicular accessories and household goods which would presumably include the automobile cleaning accessories listed in the present application. In fact, the McVeigh affidavit confirms that the opponent has sold and continues to sell the very automobile cleaning accessories listed in the applicant's application through its chain of over 400 associate stores. Thus, there is a direct overlap in the trades of the parties.

As for Section 6(5)(e) of the Act, I consider that there is a fairly high degree of resemblance between the marks at issue in all respects since both of the opponent's registered marks include the entirety of the applicant's mark THE RIGHT CHOICE.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, services, trades and marks of the parties and the applicant's apparent lack of interest in this proceeding, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark is not confusing with the opponent's two registered marks. Thus, the first ground of opposition is successful.

As for the second ground of opposition, the opponent has failed to evidence use of its first registered trade-mark prior to the applicant's effective filing date. Thus, that aspect of the second ground is unsuccessful.

The opponent has evidenced prior use of its second registered mark. However, it did not evidence non-abandonment of that mark as of the applicant's advertisement date as

required by Section 16(5) of the Act. Thus, that aspect of the second ground is also unsuccessful.

As for the unregistered mark THE RIGHT CHOICE, the materials appended as exhibits to the McVeigh affidavit show many instances of the use of the words “the right choice” in the opponent’s catalogues, signage and advertising flyers. Many of those instances do not support a finding that the words are used as a trade-mark. Often the words are simply used as part of a non-distinctive advertising slogan. However, there are at least a few examples of use of the words THE RIGHT CHOICE in a design format separate from other wording. Thus, the opponent has shown prior use of THE RIGHT CHOICE as a trade-mark. Exhibit D to the McVeigh affidavit shows non-abandonment of the opponent’s mark as of the applicant’s advertisement date.

In view of the above, the third aspect of the second ground remains to be decided on the issue of confusion. The material time for considering the circumstances respecting that issue is as of the applicant’s effective filing date of June 19, 1992. My conclusions above respecting the first ground of opposition are equally applicable respecting the second ground. In fact, the opponent’s case is even stronger respecting its second ground since the marks at issue are identical. Thus, the second ground based on prior use of the opponent’s trade-mark THE RIGHT CHOICE is successful.

As for the third 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 the wares and services 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. - May 23, 1996): 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 discussed, the opponent's two registered marks have not been in use since 1989. Thus, whatever reputation those marks might have had ten years ago had disappeared as of the filing of the present opposition. On the other hand, the opponent has evidenced continuing use of its trade-mark THE RIGHT CHOICE although the manner and extent of that use is not particularly remarkable. However, given that the onus is on the applicant and given that it has done nothing to advance its case, I find that I am left in a state of doubt respecting the issue of distinctiveness. I must therefore resolve that doubt against the applicant and find the third ground to also be successful. Had the opponent also based its ground of opposition on an allegation of descriptiveness, there would have been no doubt about the result.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 25th DAY OF NOVEMBER, 1998.

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