

**IN THE MATTER OF AN OPPOSITION by J. Brian
Enterprises (Vancouver) Ltd. to application No. 794,244 for the
trade-mark KIM-JOHN filed by Haeyoon Enterprises Ltd.**

On October 5, 1995, the applicant, Haeyoon Enterprises Ltd., filed an application to register the trade-mark KIM-JOHN based on use of the trade-mark in Canada by the applicant or its predecessors-in-title, Kim-John Enterprises Ltd. and/or Noon Soon Kim, since at least as early as 1980 in association with “retail china, crystal ware and giftware store services”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 11, 1996 and the opponent, J. Brian Enterprises (Vancouver) Ltd., filed a statement of opposition on May 12, 1997, a copy of which was forwarded to the applicant on June 4, 1997. The applicant served and filed a counter statement in response to the statement of opposition on July 3, 1997. The opponent submitted as its evidence the affidavits of Brian J. Kim and Doran John Ingalls while the applicant filed as its evidence the affidavit of Ki J. Park. The applicant alone submitted a written argument and neither party requested an oral hearing.

The opponent has alleged the following grounds of opposition in its statement of opposition:

- a) As of the filing date of the present application, the applicant had not used its trade-mark KIM-JOHN as alleged, contrary to Subsection 30(b) of the *Trade-marks Act*;
- b) As of the filing date of the present application, the applicant could not have been satisfied that it was entitled to use the trade-mark KIM-JOHN in Canada in association with the services covered in the present application since the mark was used by the applicant only under license, which use enured to the benefit of third parties, namely, Mr. N. S. Kim and Kim-John Enterprises Ltd.;
- c) The applied for trade-mark is not registrable in view of Paragraph 12(1)(a) of the *Trade-marks Act* in that the words KIM-JOHN is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years, namely, at least those individuals listed in Schedule “A” to the statement of opposition;
- d) The applicant is not the person entitled to registration of the trade-mark KIM-JOHN in view of Paragraph 16(1)(a) of the *Trade-marks Act* in that, at the date on which the applicant allegedly used its trade-mark, the applied for mark was confusing with the trade-marks KIM-JOHN and KIM JOHN which Korcan Enterprises (Surrey) Ltd. and Korcan Enterprises (Coquitlam) Ltd. (collectively the “KORCAN” companies) had previously used and made known in Canada through their predecessors-in-title Kim-John Enterprises Ltd. and Mr. N. S. Kim in association with the operation of retail stores selling fine gifts and china;
- e) The applicant is not the person entitled to registration of the trade-mark KIM-

JOHN in view of Paragraph 16(1)(c) of the *Trade-marks Act* in that, at the date on which the applicant or its predecessor-in-title first used the trade-mark KIM-JOHN, the applied for mark was confusing with the trade-names KIM-JOHN, KIM JOHN, KIM-JOHN GIFTS AND CHINA, KIM JOHN GIFTS AND CHINA, KIM-JOHN GIFTS & CHINA and KIM JOHN GIFTS & CHINA which the KORCAN companies had previously used in Canada through their predecessors-in-title, Kim-John Enterprises Ltd. and Mr. N. S. Kim, in association with the operation of retail stores selling fine gifts and china, and with the trade-name KIM-JOHN ENTERPRISES LTD. that had been used in Canada by Mr. N. S. Kim in association with the operation of retail stores selling fine gifts and china since at least as early as the incorporation of that entity in June, 1976;

f) The trade-mark KIM-JOHN is not distinctive because it is not capable of distinguishing the applicant's services from the wares and services of others, particularly, the wares sold and services offered by the KORCAN companies under the trade-marks KIM-JOHN and KIM JOHN and the trade-names KIM-JOHN, KIM JOHN, KIM-JOHN GIFTS AND CHINA, KIM JOHN GIFTS AND CHINA, KIM-JOHN GIFTS & CHINA and KIM JOHN GIFTS & CHINA and particularly the wares sold and services offered by another business operating as KIM-JOHN GIFTS & CHINA in Kelowna, British Columbia, nor is it adapted to distinguish them;

g) The trade-mark KIM-JOHN is not distinctive because the applied for mark is used or intended to be used outside the scope of permitted use provided for by Section 50 of the *Trade-marks Act*;

h) The trade-mark KIM-JOHN is not distinctive because, as a result of the transfer of the rights in the applied for trade-mark, there subsists in two or more entities the right to use the trade-mark and those rights were exercised by such entities, contrary to Subsection 48(2) of the *Trade-marks Act*.

With respect to the first two grounds, the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*. There is, however, an initial evidential burden on the opponent to adduce sufficient evidence which, if believed, would support the truth of the allegations relating to the Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp.329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p.298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the present applications [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p.475].

The first Section 30 ground is based on Subsection 30(b) of the *Act*, the opponent alleging that the applicant has not used the trade-mark KIM-JOHN as alleged. The opponent's evidential

burden respecting the issue of the applicant's non-compliance with Subsection 30(b) of the *Act* is a light one [see *Tune Masters v. Mr. P's Mastertune*, 10 C.P.R.(3d) 84, at p.89]. Furthermore, Subsection 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed [see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership*, 67 C.P.R.(3d) 258, at p.262 (F.C.T.D.)]. Finally, the opponent's evidential burden can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p.230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application.

In his affidavit, Ki J. Park, President of the applicant, states that the applicant acquired a retail china and giftware store located on Granville Street in the City of Vancouver from Mr. Noong Soon Kim who had operated the store since as early as 1980 under the mark KIM-JOHN. According to Mr. Park, the applicant acquired the store by way of an agreement dated July 29, 1986 although the applicant has not filed a copy of the agreement as evidence in this opposition. However, Exhibit "A" to the Kim affidavit purports to include a copy of a clause from the agreement between the applicant and its predecessors, that clause confirming the sale of the retail store in Vancouver to the applicant. The clause also provides that the applicant is restricted to use the name KIM-JOHN GIFTS & CHINA or any similar variation thereof at any time at only one store location in the City of Vancouver. While the clause is ambiguous as to the applicant's use of the name KIM-JOHN GIFTS & CHINA outside the city of Vancouver, the clause certainly does not establish a license agreement between the applicant and its predecessor(s) in relation to the applicant's use of the mark KIM-JOHN. Thus, I find that the evidence of record supports the applicant's claim that it or its predecessors-in-title has used the trade-mark KIM-JOHN in association with the operation of a retail china and giftware store continuously in Canada since the claimed date of first use. I have therefore dismissed the first ground of opposition.

The second Section 30 ground is based on Subsection 30(i) of the *Act*, the opponent alleging

that the applicant could not have been satisfied that it was entitled to use the trade-mark KIM-JOHN in Canada since the mark has been used by the applicant only under license, which use enured to the benefit of third parties, namely, Mr. N. S. Kim and Kim-John Enterprises Ltd. However, the evidence of record does not establish that the applicant's use of the trade-mark KIM-JOHN was under license or that either Mr. N. S. Kim or Kim-John Enterprises Ltd. had direct or indirect control over the character or quality of the services provided by the applicant under the KIM-JOHN mark. Consequently, any use of the trade-mark KIM-JOHN by the applicant did not accrue to either Mr. N. S. Kim or Kim-John Enterprises Ltd. Thus, this ground of opposition is also unsuccessful.

The third ground of opposition is based on Paragraph 12(1)(a) of the *Trade-marks Act* which reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :
a) elle est constituée d'un mot n'étant principalement que le nom ou le nom de famille d'un particulier vivant ou qui est décédé dans les trente années précédentes;

The material time for considering a Paragraph 12(1)(a) ground of opposition is the date of my decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R.(3d) 243]. Further, the onus or legal burden is on the applicant to show that its applied for trade-mark is registrable. In considering the Paragraph 12(1)(a) ground, I have had regard to the following comments of Mr. Justice Cattanach in *Gerhard Horn Investments Ltd. v. The Registrar of Trade Marks*, 73 C.P.R. (2d) 23, at p. 30:

"The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is "primarily merely" a name or surname rather than something else."

In the present case, the opponent has relied upon the affidavit of Doran J. Ingalls in support of its Paragraph 12(1)(a) ground. However, the Ingalls affidavit fails to establish that the mark KIM-JOHN is either the name or the surname of any person or family. Rather, the exhibits to Mr. Ingalls affidavit point to there being telephone listings for persons residing in Canada having the name John

Kim. Thus, the first consideration for determining whether or not a word or mark falls within the ambit of Paragraph 12(1)(a) of the *Act* has not been satisfied by the opponent. I have therefore dismissed this ground of opposition.

With respect to the fourth and fifth grounds, the opponent has relied on prior use and prior making known of trade-marks and trade-names in Canada by Korcan Enterprises (Surrey) Ltd. and Korcan Enterprises (Coquitlam) Ltd. (collectively the “KORCAN” companies) through their predecessors-in-title, Kim-John Enterprises Ltd. and Mr. N. S. Kim, in challenging the applicant’s entitlement to registration of the trade-mark KIM-JOHN. However, the opponent’s evidence fails to establish that it or its predecessors, Korcan Enterprises (Surrey) Ltd. and Korcan Enterprises (Coquitlam) Ltd., has either used or made known any of the trade-marks or trade-names identified in its statement of opposition prior to the applicant’s claimed date of first use. Furthermore, the opponent has failed to show that it acquired certain trade-mark or trade-name rights from Kim-John Enterprises Ltd. and Mr. N. S. Kim or that those rights which it may have acquired predate the applicant’s claimed date of first use. I have therefore rejected these grounds of opposition.

The remaining three ground of opposition relate to the alleged non-distinctiveness of the applicant’s trade-mark. While the legal burden is on the applicant to show that its trade-mark KIM-JOHN is adapted to distinguish or actually distinguishes its retail store services from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.*, 4 C.P.R.(3d) 272 (T.M.O.B.)], there is an initial evidential burden on the opponent to establish the facts being relied upon by it in support of this ground. Furthermore, the material time for considering the circumstances respecting this issue is as of May 12, 1997, the filing date of the statement of opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery*, 25 C.P.R.(2d) 126, at p. 130 (F.C.A.); *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.*, 37 C.P.R.(3d) 412, at p. 424 (F.C.A.); and *Merrill Lynch & Co. v. Bank of Montreal*, 66 C.P.R. (3d) 150, at p. 164 (F.C.T.D.)].

No evidence has been furnished by the opponent in support of its allegations that the applicant’s trade-mark KIM-JOHN either has been used or is intended to be used outside the scope

of permitted use provided for by Section 50 of the *Trade-marks Act* or that, as a result of the transfer of the rights in the applicant's trade-mark, there subsists in two or more entities the right to use the trade-mark and those rights were exercised by such entities, contrary to Subsection 48(2) of the *Trade-marks Act*. I have therefore dismissed these grounds.

The final ground relating to the alleged non-distinctiveness of the applicant's trade-mark is based on the allegations that the applicant's mark is not capable of distinguishing the applicant's services from the wares and services of others, particularly, the wares sold and services offered by the KORCAN companies under the trade-marks KIM-JOHN and KIM JOHN and the trade-names KIM-JOHN, KIM JOHN, KIM-JOHN GIFTS AND CHINA, KIM JOHN GIFTS AND CHINA, KIM-JOHN GIFTS & CHINA and KIM JOHN GIFTS & CHINA and particularly the wares sold and services offered by another business operating as KIM-JOHN GIFTS & CHINA in Kelowna, British Columbia, nor is it adapted to distinguish them.

The evidence of record establishes that from July of 1986 to the date of opposition, the applicant operated retail china and giftware stores in the City of Vancouver under the name KIM-JOHN. According to the Kim affidavit, some time in 1986, his father, Wayne Kim, acquired a retail store then being operated by Kim-John Enterprises Ltd. or Mr. N. S. Kim in Surrey, British Columbia under the name KIM-JOHN and was granted by Mr. N. S. Kim the right to the exclusive use of the trade-mark in the areas in Greater Vancouver outside of the City of Vancouver. However, no documents relating to this transaction have been filed by the opponent. In any event, Mr. Kim states in paragraph 8 of his affidavit:

8. The **KIM-JOHN** name was used by our family at various store locations in the Greater Vancouver area, outside of the City of Vancouver, for approximately ten years after we took over the businesses in 1986. The name was used in various incarnations including **KIM-JOHN, KIM JOHN, KIM-JOHN GIFTS AND CHINA, KIM JOHN GIFTS AND CHINA, KIM-JOHN GIFTS & CHINA** and **KIM JOHN GIFTS & CHINA**, by our family through various holding companies, including Korcan Enterprises (Surrey) Ltd. and Korcan Enterprises (Coquitlam) Ltd., which were companies owned and controlled primarily by my father and myself. We operated a total of four stores in the Greater Vancouver area with this trade-mark (the "**KIM JOHN** stores").

Further, in paragraph 17 of his affidavit, Mr. Kim states that all rights which have accrued to his family's various businesses through the holding companies Korcan Enterprises (Surrey) Ltd. and Korcan Enterprises (Coquitlam) Ltd. have been transferred to the opponent. As well, the evidence of record establishes that about September of 1995, the opponent changed the name of its stores to J. Brian Fine China & Crystal. Also, in paragraph 18 of his affidavit, Mr. Kim states that he is aware of a KIM-JOHN GIFTS & CHINA store in operation in Kelowna, British Columbia. However, there is no evidence that this business was in operation prior to the date of opposition (May 12, 1997), the material date for considering the non-distinctiveness ground.

Even though the use of the trade-mark KIM JOHN by the predecessors of the opponent ceased prior to the date of opposition, I am of the view that the use by the opponent's predecessors of the names KIM-JOHN and KIM JOHN in the same general area as the applicant and in association with the same type of retail outlet over a period of more than nine years is more than sufficient to meet the opponent's evidential burden in relation to this ground. In my view, the fact that the opponent's predecessors may have ceased use of the mark KIM JOHN about nineteen months prior to the date of opposition is not sufficient to offset the concurrent use of confusingly similar marks for essentially identical services by the applicant and the opponent's predecessors in the Greater Vancouver area over a nine year period of time. Thus, the final ground is successful in that the applicant has failed to meet the legal burden on it in relation to this ground.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 29th DAY OF JUNE, 2000.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.