

IN THE MATTER OF AN OPPOSITION
by 162952 Canada Inc. carrying
on business as Quicksigns to
application No. 592,678 for the
trade-mark FASTSIGNS & Design
filed by Fast Signs, Inc. and
subsequently assigned to
American Fastsigns, Inc.

On October 1, 1987, Fast Signs, Inc. filed an application to register the trade-mark FASTSIGNS & Design (illustrated below) for "sign and banner painting and lettering services" based on proposed use in Canada. The application was advertised for opposition purposes on November 26, 1988. The application was subsequently assigned to American Fastsigns, Inc.

The opponent, 162952 Canada Inc. carrying on business as Quicksigns, filed a statement of opposition on March 23, 1989, a copy of which was forwarded to the applicant on April 10, 1989. On January 8, 1990, leave was granted to correct a misidentification of the opponent in the original statement of opposition.

The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks QUICKSIGNS and QUICKSIGNS & Design and the trade-name Quicksigns previously used and made known in Canada since April, 1987 by the opponent's predecessor in title in association with "signs, labels, decals and lettering" and with the "services of graphic design and sign layout." The second ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of A. David M. Taylor. As its evidence, the applicant filed the affidavit of Gary M. Salomon. Mr. Salomon was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record of this proceeding. As evidence in reply, the opponent filed the affidavit of Maureen Taylor. Only the opponent filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, the affidavit of Mr. Taylor establishes that the opponent's predecessor in title commenced performing the services of graphic design and sign layout in association with the trade-mark QUICKSIGNS in April of 1987, this date being prior to the applicant's filing date. Mr. Taylor's affidavit also establishes that the opponent had not abandoned its mark as of the applicant's advertisement date. Thus, the first ground of opposition insofar as it is based on prior use of the trade-mark QUICKSIGNS remains to be decided on the issue of confusion between the marks of the

parties. The material time for considering the circumstances respecting this issue is as of the applicants' filing date in accordance with the clear wording of Section 16(3) of the Act. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically listed in Section 6(5) of the Act.

The applicant's trade-mark FASTSIGNS & Design is an inherently weak trade-mark since it is suggestive of the nature of the applicant's services. The applicant's evidence fails to show any reputation for its trade-mark in Canada as of the material time.

The opponent's mark QUICKSIGNS is also inherently weak since it is suggestive of the opponent's services. Mr. Taylor's affidavit evidences some minor business activity in association with the trade-mark QUICKSIGNS prior to the applicant's filing date although it was limited to Toronto. Thus, I can only conclude that the opponent's trade-mark was known to a limited extent in Toronto as of the material time.

The length of time the marks have been in use favors the opponent although this is not a significant circumstance in the present case. The services of the parties are the same and the natures of the trades are also the same. In fact, both parties have shown that they are also involved in the franchising of their businesses.

As for Section 6(5) (e) of the Act, there is some visual and phonetic resemblance between the marks at issue. The visual resemblance is somewhat greater due to the fact that the opponent's trade-mark was used in a script style similar to that used in the applicant's trade-mark. The two marks at issue bear an even greater degree of resemblance with respect to the ideas suggested in that both marks suggest that one can obtain a sign quickly.

Without the benefit of a written argument from the applicant, it is difficult to divine its position on the issue of confusion. However, Mr. Salomon states that a number of the applicant's franchisees operate in Dallas, Texas in competition with a business called Quick Sign and that "...there seems to be no confusion of the two names in the eye of the public...." Apparently the applicant is of the view that since there "seems" to be no confusion in Dallas, Texas between the applicant's trade-mark and the trade-name Quick Sign then a similar conclusion should be reached respecting the applicant's mark and the opponent's mark in Canada.

Although in appropriate circumstances the absence of confusion between two trade-marks in the United States might be persuasive in a Canadian opposition, I cannot give much weight to Mr. Salomon's observation. First, the situation relied on by Mr. Salomon occurred mostly after the material time. Second, he does not unequivocally state that no instances of actual confusion were brought to his attention regarding the situation in Dallas, Texas. He simply states that it "seems" that there was no confusion. This is not surprising since Mr. Salomon's company (the applicant) is engaged in franchising its printing business and is not engaged in the day to day operations of the business

which is carried on by the applicant's franchisees.

Third, Mr. Salomon describes the "distinctive colour pattern" employed with the applicant's mark and the fact that it is always used with additional wording. He does not describe the particular manner in which the third party trade-name Quick Sign was used although it presumably could have been quite different from the applicant's mark. Thus, even if Mr. Salomon's conjecture about the absence of confusion in Dallas, Texas has some basis in fact, it may be due in large measure to the different styles and contexts in which the trade-mark and trade-name in question were used.

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 similarities between the services and trades of the parties and the resemblance between the marks (particularly in the ideas suggested), 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 mark. The first ground of opposition is therefore successful insofar as it is based on prior use of the opponent's trade-mark QUICKSIGNS and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MAY 1993.

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