

IN THE MATTER OF AN OPPOSITION
by Canadian Tire Corporation, Limited
to application No. 697, 382
for the trade-mark **TOW GUIDE**
filed by Valley Industries Inc., a Delaware Corporation

On January 21, 1991, Valley Industries Inc., a Delaware Corporation filed an application to register the trade-mark **TOW GUIDE**, for the wares “flip charts for selecting appropriate hitches and selecting towing accessories”. The trade-mark was filed based upon proposed use in Canada, and was advertised for the purposes of opposition on March 23, 1994.

The opponent, Canadian Tire Corporation, Limited filed a statement of opposition on May 24, 1994, which was forwarded to the applicant on August 5, 1994. The first ground of opposition is under Section 30(i) of the Trade-marks Act (hereinafter, the “Act”), the opponent alleging that the applicant could not have been satisfied that it was entitled to use its mark in Canada in association with “flip charts for selecting appropriate hitches and selecting towing accessories”. The second ground of opposition is that the trade-mark is not registrable pursuant to the provisions of Section 12(1)(b) of the Act as it is clearly descriptive of the character or quality of the wares in association with which it is proposed to be used. The third ground of opposition is that the trade-mark is not registrable pursuant to Section 12(1)(c) of the Act as it is the name of the wares in association with which it is proposed to be used. The fourth ground of opposition is that the mark is not distinctive of the wares of the applicant, in that it is not adapted to distinguish the wares of the applicant from the wares of the opponent and others. The applicant filed and served a counter statement on August 31, 1994 denying the opponent’s allegations.

The opponent filed as evidence the affidavit of Richard Raymond Goulet, the merchandising director of automotive marketing of Canadian Tire Corporation, Limited, and the affidavit of Linda J. Elford, a trade-mark searcher. Mr. Goulet was cross-examined on his affidavit, and the transcript from that cross-examination forms part of the record in this proceeding. The applicant filed no evidence. Both parties filed written arguments, and were represented at the oral hearing. At the oral hearing the opponent withdrew the first and third grounds of opposition. The first and third grounds are therefore unsuccessful.

The second ground of opposition is based on Section 12(1)(b) of the Act, the

opponent alleging that the applicant's trade-mark **TOW GUIDE** is not registrable in that it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the applicant's wares. The material date for considering a ground of opposition based on Section 12(1)(b) of the Act is the date of my decision (see Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers, (1992) 41 C.P.R. (3d) 243 (F.C.A.)). The issue as to whether the trade-mark **TOW GUIDE** is clearly descriptive must be considered from the point of view of the average purchaser of these wares. Also, in determining whether the trade-mark **TOW GUIDE** is clearly descriptive of the character or quality of the applicant's wares, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression (see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks, 40 C.P.R. (2d) 25 (F.C.T.D.) at pp. 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks, 2 C.P.R. (3d) 183 (F.C.T.D.) at p. 186).

While the legal burden is upon the applicant to show that its trade-mark **TOW GUIDE** is registrable, there is an initial evidential burden upon the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegation that the trade-mark **TOW GUIDE** is clearly descriptive of the character or quality of the applicant's wares.

The Goulet affidavit introduces evidence of several dictionary definitions for the words 'tow' and 'guide'. The Oxford Concise Dictionary defines the word 'tow' as: "(of vehicle) pull another running behind it" and as "towing or being towed". The word 'guide' is defined as "book of rudiments, manual". My review of the Webster's Third New International Dictionary concurs, as 'tow' is defined as "to drag or pull along"; and as "the act or an instance of towing". The word 'guide' is defined as "something (as a guide book, signpost or instruction manual) that provides a person with guiding information" .

Appended to the Elford affidavit is a certified copy of the "flip chart" and cover letter dated February 4, 1993, filed in response to an Examiner's objection during the prosecution of this trade-mark. The applicant's wares are described on the cover of the "flip chart" as a "*Towing Selection Guide* for Trucks, Vans and Cars" (emphasis mine). The applicant submits that there is no evidence that the "flip chart" has been used or will be used in Canada, and that this evidence should be disregarded. However, the cover letter dated

February 3, 1993 filed with this “flip chart” states:

It is believed that this information will probably be sufficient for the Examiner to see how the trade mark is used. As can be seen, the flip charts are attached to a towing product display allowing a customer to view the flip charts and select the particular towing equipment necessary for the particular towing application.

In my opinion, an applicant should not file a specimen at one stage in the prosecution of a trade-mark, stating that the specimen can be relied upon to show how the mark is intended to be used, and then to later state that as there is no evidence of use of the previously filed specimen in Canada, that specimen should not be relied upon to show how the mark is used. Materials filed showing proposed use of a mark may be relevant, even if the product is not yet marketed in Canada (see Berry Bros. & Rudd Ltd. v. Planta Tabak-Manufactur Dr. Manfred Oberman (1980), 53 C.P.R. (2d) 130 (F.C.T.D.) at p. 143).

The opponent has also drawn my attention to the fact that the applicant has disclaimed the right to the exclusive use of the words TOW and GUIDE apart from the trade-mark. I am obliged to follow the reasoning of Board Member Martin in the decision Andres Wines Ltd. v. Les Vins La Salle Inc. (1984), 3 C.P.R. (3d) 272 (T.M.O.B) at p.275 where he stated:

A further consideration in the present case is the disclaimer entered by the applicant during the prosecution of the application before the Trade Marks Office. Such a disclaimer can arguably be taken to be an admission that the words in question are not independently registrable in respect of the applied for wares. The foregoing may constitute an admission that the words in question are either clearly descriptive or common to the trade.

By disclaiming these words, the applicant has effectively acknowledged that these words are, if not clearly descriptive, at least not distinctive of the applicant's wares.

Considering the mark in its entirety, it would appear that, as a matter of first impression, the trade-mark **TOW GUIDE** clearly describes the character of a particular type of guide, namely, one that is for determining the appropriate hitch to use to tow something. The average consumer would consider the trade-mark **TOW GUIDE** to clearly describe a character or quality of the applicant's wares. I have therefore concluded that the opponent has met the evidential burden upon it in respect of the second ground.

As the opponent has met the initial evidential burden upon it in respect of the Section 12(1)(b) ground, the applicant must establish that its trade-mark **TOW GUIDE** is

registrable in relation to the applicant's wares. The applicant has not filed any evidence. The applicant has stated that there are alternative interpretations of the mark **TOW GUIDE** in its entirety, such as a guide device for towing, or a manual with respect to the act of towing. In my view, the presence of other possible interpretations is not relevant. The decision in Mitel Corporation v. Registrar of Trade-mark (1984), 79 C.P.R. (2d) 202 (F.C.T.D.) at p. 208 supports this principle:

While the word "super" is clearly laudatory and descriptive, the word "set" is not as close to the mark; that word, by itself, does not necessarily focus the mind on a telephone set. The word "set" awakens many and diverse first impressions.

A reasonable man, reasonably conversant with the English language, passing by a tennis-court would normally relate the word "set" to the game of tennis. A customer in a furniture store would associate the word "set" with a bedroom set or a dining-room set, depending on his intentions or the area of the store that he is in. A person interested in the purchase of a telephone might not call the equipment a "set". He would most likely, in common parlance, call it a "telephone". But in a telephone store, or glancing at advertisements of telephone sales, a customer would probably link the mark SUPERSET to the telephone sets on display and form the impression that the telephones offered for sale are of a superior quality. Much as other people would link SUPERWASH to garments that wash superbly well, or SUPERSET (in association with tools) to tools that function in a superior way, or SUPER-WEAVE to superfine textile. In short, the mark is not to be considered in isolation; it must be perceived in connection with the wares to which it is associated.

In my view, the existence of other possible interpretations does not overcome the fact that the words TOW GUIDE are apt words to describe the wares "Flip charts for selecting appropriate hitches and selecting towing accessories". An everyday user of the wares would react to the mark as clearly describing the character of the wares, namely that the applicant's "flip chart" is a *guide* to determine the appropriate hitch to be used to *tow* something. Other users may wish to use these words to describe their guides with respect to towing. The purpose of Section 12(1)(b) is that no one person should be able to appropriate clearly descriptive words and place legitimate competition at an undue disadvantage in relation to language which should be available for all to use. As a result, I have concluded that the applicant has failed to meet the legal burden upon it of showing that its trade-mark **TOW GUIDE** is not clearly descriptive of the applicant's wares. Further, as the present application was filed on a proposed use basis, the applicant's mark could not have become distinctive in relation to its wares as of the filing date of the present application, within the scope of Section 12(2) of the Act. I refuse the applicant's application in view of the provisions of Section 12(1)(b) of the Act.

The fourth ground of opposition is in respect of the distinctiveness of the applicant's

mark. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, namely, May 24, 1994 (see **Re Andres Wines Ltd. and E. & J. Gallo Winery** (1975), 25 C.P.R. (2d) 126 (F.C.A.) at p. 130, **Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 412 (F.C.A) at 424, and **Cellular One Group, a partnership v. Brown, now standing in the name of Bell Mobility Cellular Inc.** (1996), 69 C.P.R. 236 (T.M.O.B.)). I find that as the mark was found to be clearly descriptive of the applicant's wares, it could not be distinctive of the applicant's wares. As a result, I have found that this ground of opposition is also successful.

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

DATED AT HULL, QUEBEC, THIS 2nd DAY OF OCTOBER, 1997.

Peter C. Cooke,
Member
Trade-marks Opposition Board