

IN THE MATTER OF AN OPPOSITION  
by Market Square Investments Ltd.  
and Blueagle Estates Ltd. to  
application No. 614,463 for the  
trade mark MARKET SQUARE & Design  
filed by The Governor and Company  
of Adventurers of England trading  
into Hudson's Bay, also known as  
Hudson's Bay Company

On September 1, 1988, the applicant, The Governor and Company of Adventurers of England trading into Hudson's Bay, also known as Hudson's Bay Company, filed an application to register the trade-mark MARKET SQUARE & Design (illustrated below) based on proposed use in Canada with the following services:

the operation of a department store selling  
foods, housewares, linens, bedding accessories,  
bath accessories, china, and kitchen accessories.

The application was amended to include a disclaimer to the words MARKET and CANADA'S FIRST DEPARTMENT STORE. The application was subsequently advertised for opposition purposes on December 13, 1989.

The first opponent, Market Square Investments Ltd., filed a statement of opposition on January 15, 1990, a copy of which was forwarded to the applicant on February 15, 1990. Leave was granted to amend the statement of opposition pursuant to Rule 42 of the Trade-marks Regulations on April 30, 1991. One of the amendments to the statement of opposition effected at that time was the addition of a second opponent, Blueagle Estates Ltd.

The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(i) of the Trade-marks Act because the applicant was aware of the prior use by the opponents or their predecessors in title of the trade-marks MARKET SQUARE and MARKET SQUARE & Design and the trade-name Market Square and therefore could not have been satisfied that it was entitled to use the applied for trade-mark.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the opponents' trade-marks and their trade-name previously used in Canada by the opponents and their predecessors in title in association with the following services:

operation and management of a public market and  
a retail shopping mall, leasing of retail and  
office premises.

The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the trade-mark MARKET SQUARE & Design (illustrated below) registered under No. 249,285 for the "operation of a commercial development." The registered trade-mark is lined for the

colors blue green, orange and yellow and includes a disclaimer to the words MARKET SQUARE.

The fourth ground of opposition reads as follows:

(d) The Applicant's Trade-mark is not distinctive because at the date hereof:  
(i) it does not distinguish and is not adapted to distinguish the services described in the Application because MARKET SQUARE is distinctive of the services and business of the Opponents;  
(ii) it does not actually distinguish the wares or services of the Applicant described in the Application because it is confusingly similar to the Opponents' Trade-marks and the Opponents' Trade Name, which have been used extensively by the Opponents and their predecessors in title in Canada, since at least as early as 1974 to the present time.

The applicant filed and served a counter statement. As their evidence, the opponents filed certified copies of the affidavits of Robert Tidquist and Valerie Braunschweig from another opposition proceeding, two affidavits of Darcy L. Wray and the affidavits of Max Tomaszewski, Jeffrey S. Thomas, Robert A. Fashler and Mohan Singh Jawl. As its evidence, the applicant filed certified copies of four trade-mark registrations including registration No. 249,285 standing in the name of the first opponent. The applicant also filed two affidavits of Kevin L. Wright and the affidavits of Helene Yarenko-Jarvis, Richard J. Langmead and Joseph A. Day. Only the applicant filed a written argument and no oral hearing was conducted.

As a preliminary matter, it should be noted that the certified copies of affidavits from another opposition proceeding filed by the opponents do not assist their case. Those certified copies can only be relied on to show that the affidavits were, in fact, filed in the other proceeding. In the absence of agreement between the parties, they cannot be relied on for the truth of their contents.

As for the first ground of opposition, the material time for considering the applicant's compliance with Section 30(i) of the Act is as of the filing date of the application. Furthermore, although the legal burden is on the applicant to show its compliance with Section 30(i), there is an evidential burden on the opponents to prove the allegations in support of their first ground. In the present case, I do not consider that the opponents have even raised a proper ground of non-compliance with Section 30(i). In my view, whether or not the applicant was aware of the prior use of the opponents' trade-marks and trade-names is irrelevant respecting the applicant's ability to be satisfied that it was entitled to use its mark in Canada. The opponents' did not even allege that the applicant was aware that its mark was confusing with the opponents' marks and name. Thus, the first ground of opposition is unsuccessful.

As for the second ground of opposition, there is an initial evidential burden on the opponents to prove use of their trade-marks and trade-name prior to the applicant's filing date. As noted by the applicant, it is difficult to determine the specifics of the opponents' second ground since they have alleged prior use of the trade-name and the

two trade-marks by both opponents with no further details. In any event, the opponents' evidence is insufficient to clearly establish use of the trade-name or either of the two marks prior to the applicant's filing date by anybody.

Mr. Tomaszewski, in his affidavit, identifies himself as the President of both opponents, a position that he has held since April 11, 1989. According to Mr. Tomaszewski, the opponents acquired a business complex in Victoria, British Columbia and the registered trade-mark MARKET SQUARE & Design on April 12, 1989. He attests to use of the registered trade-mark and the trade-mark MARKET SQUARE by the opponents since that date although none of the supporting materials appended to his affidavit associate either mark with either opponent.

Although Mr. Tomaszewski's affidavit arguably shows use of at least the opponent's trade-mark MARKET SQUARE from April 12, 1989 on (although it is unclear which opponent is using the mark), it does not clearly show use of either of the two marks relied on or the trade-name relied on prior to that date. Mr. Tomaszewski makes reference to activities by alleged predecessors in title but he does not indicate that he has personal knowledge of those activities nor does he indicate that such knowledge arose from corporate records or the like that his companies may have acquired from those predecessors in title.

The opponents also filed an affidavit of Mohan Singh Jawl who was apparently one of the members of the joint venture that owned the business complex acquired by the present opponents. Exhibit A to Mr. Jawl's affidavit is a photocopy of an affidavit of his filed in another opposition proceeding. Exhibit A to that photocopied affidavit is a photocopy of what appears to be an unsworn affidavit (without exhibits) of Max Tomaszewski filed in that other opposition. Mr. Jawl states that all of the facts in his earlier affidavit are true and in that earlier affidavit he states that all of the facts in Mr. Tomaszewski's unsworn affidavit are true.

Notwithstanding the confusing manner in which Mr. Jawl's affidavit has been constructed, I have considered it for what it is worth. It would appear that Mr. Jawl was a member of a joint venture which was the opponents' predecessor in title. That entity apparently acquired the business complex now owned by the opponents in 1983. However, Mr. Jawl did not give any basis upon which he could confirm Mr. Tomaszewski's statements about the operation of the complex prior to that date. (It appears that Mr. Jawl may have also had some connection with a previous owner of the complex, Abacus Cities Ltd., but he failed to confirm this.) Insofar as Mr. Jawl confirms Mr. Tomaszewski's statements covering the period 1983 to April 12, 1989, none of those statements clearly evidences use of the two trade-marks and the one trade-name in question by the opponents' predecessor in title. Thus, the opponents have failed to satisfy the initial evidential burden on them respecting the second ground of opposition and it is therefore unsuccessful.

The third ground of opposition is based on Section 12(1)(d) of the Act and 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. Although the statement of opposition indicates that the trade-mark registered under No. 249,285 is owned by both opponents, the registration shows that Market Square Investment [sic] Ltd. (the first opponent) is the owner.

The registered trade-mark is inherently very weak when used in association with the operation of a commercial development. The first Wright affidavit introduces into evidence selected dictionary definitions which show that the dominant portion of the first opponent's registered mark (namely, the words "market square") is descriptive in the context of the registered services. For example, The Oxford English Dictionary defines "market square" as "an open square in which a town market is held." From the descriptions of the opponents' business complex found in the evidence, it is apparent that this is the nature of their commercial development, namely a square featuring a number of stores comprising a market. Thus, any inherent distinctiveness that may reside in the registered mark resides in its minimal design component and its particular color scheme.

The opponents' evidence shows a number of references to a black and white version of the registered mark. However, the mark as registered claims various colors as a feature of the mark and there is no evidence that the colored version of the mark has been used. Thus, there is nothing in the evidence to suggest that the mark as registered has become known at all in Canada.

The applicant's mark possesses a higher degree of inherent distinctiveness than the first opponent's registered mark although the words "market square" are also descriptive of the applicant's services. The words HUDSON'S BAY COMPANY and the significant design components lend a fair degree of inherent distinctiveness to the mark. The Langmead affidavit establishes that the applicant commenced use of its mark in late 1989. Since then, the applicant has made fairly extensive use of the mark in a number of locations throughout Canada. Thus, I am able to conclude that the applicant's mark has become known to some extent.

The length of time the marks have been in use is not a material circumstance in the present case. Although the first opponent's registration claims use of the mark since 1976, the opponents failed to evidence any use of the mark since that date.

The services of the parties are not identical but they are similar. The registered services are the "operation of a commercial development" which the evidence shows comprises a square of restored buildings housing various shops and restaurants. The applicant's services refer to the operation of a department store but the applicant's evidence shows that those services are performed by creating a separate area in its department stores where specialty booths or shops are arranged to simulate a market square. Thus, the trades of the parties are also related.

There is a fair degree of resemblance between the marks at issue in all respects. However, that resemblance is due almost exclusively to the common use of the words MARKET SQUARE, words which are descriptive of the services of both parties. The first opponent has already conceded this by disclaiming the words in its registration. As noted, dictionary definitions also point to the descriptive nature of those words in the context of this case. Furthermore, the applicant's evidence establishes, not surprisingly, that other businesses across Canada use the words "market square" to identify shopping complexes or shopping and office complexes. I can therefore conclude that consumers would not ascribe any proprietorial significance to the words "market square" when used in association with a shopping complex. They would therefore center on the other aspects

of any trade-marks incorporating those words in order to distinguish them. The other aspects of the applicant's mark would easily distinguish it from the registered mark: see the decision in Questor Commercial Inc. v. Discoverer Services Ltd. (1979), 46 C.P.R. (2d) 58 (F.C.T.D.).

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 fact that the words MARKET SQUARE are descriptive and common to the trade, I find that the applicant has satisfied the onus on it to show that its trade-mark is not confusing with the first opponent's registered mark. The third ground is therefore unsuccessful.

As for the fourth 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 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. -January 15, 1990): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Initially, it should be noted that the first allegation of fact in the opponents' fourth ground of opposition is inconsistent with the trade-mark MARKET SQUARE being distinctive of either of the two opponents. If, as alleged by the opponents, the mark is distinctive of the services and business of the opponents, this statement by itself suggests that the mark cannot be distinctive of any one trader. In any event, the evidence establishes that other parties have also used the words "market square" in association with enterprises similar to the opponents' shopping complex in Victoria. Thus, the trade-mark MARKET SQUARE cannot be distinctive of one particular trader in the field of shopping and office complexes.

As for the second allegation in the opponents' fourth ground, it essentially rests on an allegation of confusion between the applicant's mark and the trade-marks and trade-name of the opponents. The opponents have failed to evidence use of their trade-name and, as discussed, they have failed to evidence any use of their registered design mark. They have also failed to evidence use of the trade-mark MARKET SQUARE by any predecessors in title and the activities by the opponents subsequent to their acquisition of the shopping complex in Victoria in 1989 do not clearly point to either opponent having used the trade-mark MARKET SQUARE. In fact, the opponents' evidence is replete with descriptive uses of the words Market Square in referring to the shopping complex in Victoria or in referring to the address of that complex.

In any event, even if some of the opponents' evidence could be viewed as establishing use of the trade-mark MARKET SQUARE by one of the opponents, that does not assist the opponents' case. Given the descriptive nature of those words in the context of the services at issue, given the disclaimer of those words by the first opponent in its registration No. 249,285 and given the use by other traders of those words for similar services, no trader can claim exclusive rights to those words as a trade-mark for such services. Thus, the applicant's mark is not confusing with the trade-mark MARKET SQUARE and the applicant has satisfied the onus on it to show that its trade-mark is distinctive

in view of the significant additional wording and design components included in that mark.  
The fourth ground is therefore unsuccessful.

In view of the above, I reject the opponents' opposition.

DATED AT HULL, QUEBEC, THIS 29<sup>th</sup> DAY OF DECEMBER 1993.

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