

IN THE MATTER OF AN OPPOSITION
by Afaganis Enterprises Ltd. to
application No. 609,929 for the
trade-mark PROTO filed by
Kastle Gesellschaft m.b.H.

On June 23, 1988, the applicant, Kastle Gesellschaft m.b.H., filed an application to register the trade-mark PROTO for "snow skis, ski poles, ski bags" based on use in Canada since September 1, 1981. The application was advertised for opposition purposes on November 30, 1988.

The opponent, Afaganis Enterprises Ltd., filed a statement of opposition on December 30, 1988, a copy of which was forwarded to the applicant on February 3, 1989. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(b) of the Trade-marks Act because the trade-mark PROTO had not been in continuous commercial use in association with the applied for wares since September 1, 1981 as claimed. The second ground is that, in view of the foregoing, the application does not comply with the provisions of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use the mark.

The applicant filed and served a counter statement. At the same time, the applicant filed a revised application in which the wares "ski bags" were deleted from the application and the basis for registration in respect of the wares "ski poles" was changed to proposed use. The application was initially accepted. However, in view of the subsequent decision in McDonald's Corporation v. The Registrar of Trade-marks (1989), 24 C.P.R. (3d) 463 (F.C.A.), the acceptance of the second part of the applicant's amendment was held to be incorrect in law. The applicant subsequently revised its application to remove the wares "ski poles." That amendment was accepted so that the only wares remaining are "snow skis."

The opponent was subsequently granted leave to amend its statement of opposition pursuant to Rule 42 of the Trade-marks Regulations. Neither party filed evidence although both filed a written argument. No oral hearing was conducted.

As for the first ground of opposition, the onus or legal burden is on the applicant to show its compliance with Section 30(b) of the Act. However, as stated in the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R. (3d) 325 at 329, there is an evidential burden on the opponent to adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support the ground of opposition exist.

In the present case, the opponent has filed no evidence. Instead, it takes the position that the actions taken by the applicant in revising its application should be sufficient to meet the opponent's evidential burden. In other words, the opponent contends that the applicant's tacit admission that it erred in claiming use of its mark since September 1, 1981 for "ski poles" and "ski bags" should be sufficient to cast doubt on the accuracy of its claimed date of first use for "snow skis."

I do not agree with the opponent's contention. The opponent has not filed any

evidence to bring into question the applicant's claimed date of first use for the wares "snow skis." And the mere fact that the applicant has removed other wares from the application does not, by itself, meet the opponent's evidential burden respecting the claimed date of first use for "snow skis." An applicant who seeks to correct legitimate errors in its application by removing particular wares should not, in the absence of additional evidence, be obliged to positively evidence its claimed date of first use in respect of other wares in the application. To hold otherwise could result in an anomalous and inequitable situation arising where an applicant who chose to leave false claims in his application would not have to answer a Section 30(b) attack whereas an applicant who, in good faith, sought to correct such errors would be held to a higher burden respecting the balance of his application.

In view of the above, I find that the opponent has failed to meet the evidential burden on it respecting the first ground. That ground is therefore unsuccessful. Since the second ground is dependent on the first ground, I find that it, too, is unsuccessful.

In view of the foregoing, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 31st DAY OF OCTOBER 1991.

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