

IN THE MATTER OF TWO OPPOSITIONS
by The Southland Corporation
to application serial Nos. 597,654 and 597,655
for the marks 7TH HEAVEN EXPRESS and 7TH HEAVEN, respectively,
filed by Blackcomb Skiing Enterprises, Limited Partnership

On December 18, 1987, Blackcomb Skiing Enterprises Ltd., predecessor in title to the present applicant Blackcomb Skiing Enterprises, Limited Partnership, filed applications to register two trade-marks, namely 7TH HEAVEN and 7TH HEAVEN EXPRESS. Each application covers the following services,

- (1) operation of a ski resort, ski lifts, ski schools, and ski rental outlets,
- (2) operation of sporting goods stores, hotels, restaurants, premises providing bar services, and real estate development,

and each application covers a long list of wares including, for example,

tanning oil; spoons; video tapes; thermometers; watches; key chains; maps; posters; pens; stickers; travel bags; chinaware; flags; various specified items of clothing and headwear; sunglasses; goggles; various specified toys, games and sporting goods; and matches.

Each application is based on use in Canada since at least as early as April 1, 1987 with respect to the services denoted by (1), and is based on proposed use in Canada with respect to the wares and with respect to the services denoted by (2).

The applications were advertised for opposition purposes on January 25, 1989. The opponent filed statements of opposition on May 25, 1989, copies of which were forwarded to the applicant on June 12, 1989.

The grounds of opposition are summarized below:

(a) the applications do not comply with Section 30(e) of the Trade-Marks Act in that the applicant does not itself intend to use the applied for marks in association with the wares, or with the

services denoted by (2),

(b) the applications do not comply with Section 30(b) in that the applicant has not used the applied for marks since April 1, 1987 in association with the services denoted by (1),

(c) the applied for marks are not registrable, pursuant to Section 12(1)(d), because each is confusing with one or more of the opponent's registered trade-marks namely 7-11, 7-ELEVEN, 7 ELEVEN & Design (two design marks, illustrated below), and OH THANK HEAVEN FOR 7-ELEVEN, covering retail grocery store services, and with the opponent's registered mark 7 ELEVEN & Bicycle Design covering the operation of recreational cycling trails,

regn. No. 173,910

regn. No. 168,724

(d) the applicant is not the person entitled to registration, pursuant to Section 16(1), in respect of the services denoted by (1), because at the date the applicant first used the applied for the marks, namely April 1, 1987, each was confusing with

(i) the opponent's above mentioned registered marks used by the opponent and/or its registered user Southland Canada Inc.,

(ii) the opponent's trade-mark applications, filed February 25, 1987, for TODAY'S 7-ELEVEN. WHERE THE GOOD THINGS COME EASY (appln. No. 578,860) and GOOD THINGS COME EASY AT 7-ELEVEN (appln. No. 578,862), both covering
convenience store services,

(iii) the trade name and trade-mark 7-ELEVEN SKI HEAVEN used

in Canada by Southland Canada Inc. in association with ski school clinics for children.

(e) the applicant is not the person entitled to registration, pursuant to Section 16(3), in respect of the services denoted by (2), and in respect of the wares, because at the date the applicant filed its applications, namely December 18, 1987, each was confusing with

(i) the opponent's above mentioned registered marks used by the opponent and/or its registered user Southland Canada Inc.,

(ii) the opponent's trade-mark applications for TODAY'S 7-ELEVEN. WHERE THE GOOD THINGS COME EASY (appln. No. 578,860) and GOOD THINGS COME EASY AT 7-ELEVEN (appln. No. 578,862), both covering convenience store services,

(iii) the trade name and trade-mark 7-ELEVEN SKI HEAVEN used in Canada by Southland Canada Inc. in association with ski school clinics for children.

(f) The applied for marks are not distinctive of the applicant in view of the above and in view of the opponent's sponsorship of various sporting activities in Canada. In particular, the opponent has sponsored 7-ELEVEN SKI HEAVEN children's ski clinics at Whistler, British Columbia.

The applicant filed and served counter statements generally denying the grounds of opposition. Both parties filed affidavit evidence. Neither party cross-examined on the evidence. Both parties filed written arguments and both were represented at an oral hearing.

The opponent's evidence consists of the affidavit of Liz Rustad, Public Relations Manager for Southland Canada Inc. ("Southland"), and of certified copies of the various trade-mark registrations and applications relied on in the statement of

opposition. Southland is a subsidiary of the opponent company and is a registered user of the opponent's aforementioned registered marks. The certified copies of the opponent's applications establish that they were pending as of the date of advertisement of the applicant's applications, as required by Section 16(4).

Ms. Rustad's evidence is that her company Southland began using the opponent's 7-ELEVEN mark in association with convenience store services in 1969. By 1978, there were 150 stores operating under the mark 7-ELEVEN in the four western provinces. By 1985 there were 400 stores in Ontario and in the western provinces, serving 400,000 people each day of the week. By 1990, there were 525 stores. Most of the 7-ELEVEN stores are open 24 hours a day, selling a 3,000 item mix which includes groceries, soft drinks, health and beauty aids, magazines, tobacco and house wares.

Southland's 7-ELEVEN stores take part in supporting charities and in community and public service programs across Canada, via product donations, cash contributions, promotional assistance and fund raising. Southland sponsored a 19 kilometre bicycle trail in support of EXPO 86 at Vancouver, British Columbia. There are more than 200 signs along the trail prominently displaying the 7-ELEVEN mark.

Southland began sponsoring an amputee ski clinic at Whistler and Blackcomb Mountains in January 9-12, 1984. The opponent's 7-ELEVEN mark was prominently featured on brochures promoting the event as well as on banners, buttons/crests, awards, and certificates at the clinic. The clinic was repeated at both mountains in 1985; since then, the clinic has been limited to Whistler. Whistler Mountain is adjacent to Blackcomb Mountain, the site of the applicant's activities. Southland's promotion of the 7-ELEVEN mark at the amputee ski clinic has continued, at Whistler, along the lines described above.

Southland began sponsoring 7-ELEVEN SKI SCAMPS, a ski program for children, at Whistler, in the 1983-84 ski season. The ski program continued at least to the date of Ms. Rustad's affidavit, namely 1990. The opponent's 7-ELEVEN mark is prominently featured in all aspects of the program, along the same lines as described for Southland's amputee ski clinics.

In the 1986/87 ski season, Southland extended its 7-ELEVEN SKI HEAVEN program to six ski resorts in British Columbia. As before, the opponent's 7-ELEVEN marks are prominently displayed in all aspects of the program operation.

Since January, 1990, 7-ELEVEN stores in the Vancouver region have been selling ski passes for the Whistler Mountain Ski Resort.

Ms. Rustad's affidavit establishes extensive use of the opponent's registered marks 7-ELEVEN and 7-ELEVEN & Design (registration No. 173,910), but only minimal use of OH THANK HEAVEN FOR 7-ELEVEN, for convenience store services. Her evidence also establishes use of the opponent's mark 7 ELEVEN & Bicycle Design, for the operation of a recreational bicycle trail, in the area of Vancouver. The opponent has not established use of its mark 7-ELEVEN & Design (regn. No. 168,724, unless it is considered a variant of regn. No. 173,910), or of its applied for marks TODAY'S 7-ELEVEN. WHERE THE GOOD THINGS COME EASY and GOOD THINGS COME EASY AT 7-ELEVEN.

The applicant's evidence consists of the affidavit of Hugh Smyth, President of the applicant's predecessor in title. His evidence is that the development of Blackcomb Mountain into a skiing resort began in 1978 when the facilities and ski trails were first planned. The mountain opened in 1981 with 146 hectares of ski trails. A second phase of expansion in 1982 added 24 hectares of ski terrain.

In 1985, a new high alpine T-bar opened to service additional ski trails. The area opened up by the new lift was called 7TH HEAVEN. The addition of this section tripled the size of Blackcomb's skiable area.

In 1987, three high speed quad chairs were completed, providing chair lift services under the names WIZARD, SOLAR COASTER, and 7TH HEAVEN EXPRESS. The 7TH HEAVEN EXPRESS lifts skiers to the top of the 7TH HEAVEN ski area; the lift service is advertised in the applicant's 1987/88 winter season brochure, presumably available some time in advance of the 87/88 ski season. The 7TH HEAVEN ski area is the most heavily advertised and highest profile ski area of Blackcomb Mountain. Skier visits to Blackcomb numbered 54,200 in 1981, 205,881 in 1982, and since then have gradually increased to 568,235 in 1988. Since 1987, the applicant's mark 7TH HEAVEN has appeared on signs and stationery in the applicant's ski school and ski rental outlets, and has been advertised on radio and television, and in transit shelters and bill boards throughout Canada. As of the date of Mr. Smyth's affidavit, namely September 11, 1990, the applicant's mark 7TH HEAVEN has appeared on T-shirts, sweatshirts, and pins sold at the applicant's retail outlets. Advertising expenses for services and wares sold under the marks 7TH HEAVEN and 7TH HEAVEN EXPRESS were about \$500,000 for each of the years 1988 to 1990.

The opponent has not submitted any evidence to support its grounds of opposition denoted by (a) and (b) above. There is some evidence submitted by the applicant supporting its claimed date of first use, and its stated intention to use the marks, as asserted in the applications. Although the applicant's evidence is vague as to the exact date when it first advertised or operated its 7TH HEAVEN EXPRESS ski lift service, there is nothing in the applicant's evidence that contradicts its claimed date of first use, or its claims to intended use. In view of the above, I find that the opponent has not met its evidential burden with respect to

the allegations underlying the grounds of opposition based on Sections 30(e) and (b), and therefore those grounds need not be considered - see John Labatt Ltd. v. Molson Companies Ltd. (1990) 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.).

With respect to the grounds of opposition denoted by d(iii) and e(iii), the opponent is relying on use of the mark 7-ELEVEN SKI HEAVEN by Southland in association with ski school programs for children. However, as there is no evidence that 7-ELEVEN or SKI HEAVEN or 7-ELEVEN SKI HEAVEN are registered marks covering ski programs, such use by Southland cannot accrue to the benefit of the opponent by the operation of the registered user provisions of the Act. Accordingly, the above noted grounds of opposition need not be considered because the opponent has not demonstrated that it used the mark 7-ELEVEN SKI HEAVEN in association with ski programs, as required by Section 17(1). Neither is it clear that Southland itself actually operated the ski programs rather than merely providing funds so that others could run the program. However, in the circumstances of this case, where the opponent has established that it promotes its mark 7-ELEVEN through various charitable, community, and sports programs, I can readily accept that the public would perceive that the opponent's convenience store services were being promoted by Southland's sponsorship of the 7-ELEVEN SKI HEAVEN program. The same applies to Southland's sponsorship of the 7-ELEVEN SKI SCAMPS program.

I would also note that in the instant case, the opponent's ground of opposition alleging non-distinctiveness is pleaded broadly enough to be supported by Southland's use of 7-ELEVEN SKI HEAVEN as alleged in paragraphs d(iii) and e(iii) of the statement of opposition. Further, Southland's sponsorship of the 7-ELEVEN SKI HEAVEN and 7-ELEVEN SKI SCAMPS programs are surrounding circumstances relevant to other grounds of opposition raised by the opponent.

I will first consider the opponent's ground of opposition denoted by (d), namely that the applicant's use of the marks 7TH HEAVEN and 7TH HEAVEN EXPRESS (the "7TH HEAVEN marks") in association with ski operations would be confusing with the opponent's registered and applied for marks.

In considering the issue of confusion, I am required to consider all the surrounding circumstances, including those enumerated in Section 6(5). The legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion, as defined in Section 6(2), between its marks and any of the opponent's marks. The material date to consider the issue of confusion is the date of first use claimed in the application, namely April 1, 1987, in accordance with the clear wording in Section 16(1).

With respect to Section 6(5)(a), the combination 7-ELEVEN, albeit in numerical and word form, is a numerical sequence and as such does not possess much inherent distinctiveness. Neither do any of the other marks relied on by the opponent possess much inherent distinctiveness. The applied for 7TH HEAVEN marks have laudatory or suggestive connotations which detract from their inherent distinctiveness. For example, 7TH HEAVEN EXPRESS, when used in association with a ski lift service, suggests fast, direct delivery to an exceptionally wonderful ski area. I infer from the opponent's evidence that its marks 7-ELEVEN and 7-ELEVEN & Design (reg. No. 173,910) were well known in the western provinces, and in Ontario, in association with convenience store services, at the material date April 1, 1987. The mark 7TH HEAVEN would have been known to some extent in association with ski resort services at the material date, while there is no evidence that the mark 7TH HEAVEN EXPRESS would have been known to any more than a minimal extent at the material time.

The length of time that the marks have been in use favours the

opponent, as it began to use its marks as early as 1969.

As for Sections 6(5)(c) and (d), the nature of the parties' services and the nature of their trades are different. The applicant offers ski resort and related services, while the opponent offers convenience store services. However, as discussed previously, the opponent's 7-ELEVEN mark would have been known to the public, to some extent, in connection with the sponsorship of ski programs.

With respect to Section 6(5)(e), I consider that when the parties' marks are considered in their totalities, there is some resemblance between the applied for marks and the opponent's marks aurally, less resemblance visually, and no resemblance at all in ideas suggested.

Considering the above, and keeping in mind in particular the limited resemblance between the marks and the disparity in the services and trades of the parties, I find that, as a matter of first impression and imperfect recollection, the applied for marks are not confusing with any of the opponent's marks.

The ground of opposition denoted by (e) alleges that the portions of the subject applications based on proposed use, covering the operation of sporting good stores, hotels, restaurants, licensed premises, real estate services, and covering a long list of wares, are confusing with the applicant's marks. Essentially the same considerations as discussed above apply, but at the later material date December 18, 1987.

The portions of the applications based on proposed use in Canada are not related to or restricted as ancillary to the operation of a ski resort. Consequently, I must assume that there is some overlap in the parties' trades, that is, some of the applicant's wares would, or could, be sold through the opponent's

convenience stores - see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc. 2 C.P.R.(3d) 361 at 372 (F.C.T.D.), 12 C.P.R.(3d) 110 at 112 (F.C.A.); Mr. Submarine Ltd. v. Amandista Investments Ltd. 19 C.P.R.(3d) 3 at 10-11 (F.C.A.). However, there is no evidence that the opponent uses any of its marks as a "house brand" for any of the wares sold in its stores, nor is there any evidence that the opponent intends to use its marks in such a manner. Consequently, the applicant's wares would not be competing on a side by side basis with wares displaying the opponent's marks, nor would consumers be requesting specific items sold in the opponent's stores by the opponent's marks. Otherwise, the surrounding circumstances discussed previously in relation to ground (d) have not changed significantly at the later material date.

Considering the above, and the various factors set out in Section 6(5) as discussed in relation to ground (d), and keeping in mind the limited resemblance between the parties' marks and that the test for confusion is one of first impression and imperfect recollection, I do not find that the applied for marks are confusing with any of the opponent's marks.

The ground of opposition denoted by (f) is that the applied for marks are not distinctive of the applicant's wares or services. The legal onus is on the applicant to show that its marks are adapted to distinguish or actually distinguish its wares and services from others throughout Canada, and the material time to consider the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case May 25, 1989 - see Faber-Castell Canada Inc. v. Dixon Ticonderoga Inc. (1992) 41 C.P.R.(3d) 284 at 287 (TMOB). In deciding the issue of distinctiveness, I am permitted to consider the parties' sales and advertising under their marks, and other relevant surrounding circumstances, in the time period between the filing of the applications and the filing of the statements of opposition - see

As indicated above, the issue pursuant to ground (f) is not whether either of the applied for marks is confusing with one or more of the opponent's marks. The issue is whether the public, well familiar with the opponent's 7-ELEVEN mark for convenience store services, and also familiar with the promotion of the 7-ELEVEN mark through ski programs, would think that there is some connection between the applicant's wares and services, provided under the 7TH HEAVEN marks, and the opponent's convenience store services operating under the mark 7-ELEVEN. The various factors enumerated under Section 6(5), discussed above in relation to grounds (d) and (e), are also relevant to the issue of distinctiveness. The surrounding circumstances had changed somewhat at the later material date May 25, 1989. The applicant may now rely on significant use of its 7TH HEAVEN marks, at least in relation to ski resort and related services, over the two ski seasons 1987/88 and 1988/89. The applicant was using its marks in the same area as the opponent, and particularly on Blackcomb, the mountain adjacent to Whistler where the opponent was promoting its mark 7-ELEVEN through Southland's sponsorship of ski programs. In these circumstances, the fact that the opponent has not evidenced any instance where the public assumed a connection between the opposing parties' wares and services is a factor that weighs, to a limited extent, in the applicant's favour. It is far from a deciding or weighty factor, given that the legal onus is on the applicant to prove that its applied for marks are distinctive, but it is nevertheless a factor that should be taken into consideration.

Considering the above, and the various factors as discussed in relation to grounds (d) and (e), I am satisfied that the applied for marks are distinctive of the applicant's wares and services.

The material date to consider the remaining ground of opposition, pursuant to Section 12(1)(d), is the date of my decision - see Park Avenue Furniture Corp. v. Wickes Simmons Bedding Ltd. (1991) 37 C.P.R.(3d) 413 (F.C.T.D.). Essentially the same considerations as discussed above in relation to the grounds of opposition denoted by (d), (e), and (f) apply to the issue of confusion raised in ground (c). As there is no evidence that the surrounding circumstances changed significantly from those already discussed, I find that the applied for marks are not confusing with any of the opponent's registered marks.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 30th DAY OF NOVEMBER , 1992.

Myer Herzig,
Member,
Trade-marks Opposition Board