

**IN THE MATTER OF AN OPPOSITION by
Trevor Magee and Reid Flemons, conducting business as a
partnership to application No. 813,776
for the trade-mark MAYDAY MALONES
in the name of Three Jay Holdings Ltd.**

On May 29, 1996, the applicant, Three Jay Holdings Ltd., filed an application to register the trade-mark MAYDAY MALONES based upon proposed use of the trade-mark in Canada in association with restaurant and bar services and management of restaurants. The applicant disclaimed the right to the exclusive use of the word MALONES apart from the trade-mark.

The application was advertised for opposition purposes in the *Trade-marks Journal* of June 25, 1997 and the opponent, Trevor Magee and Reid Flemons, conducting business as a partnership, filed a statement of opposition on November 25, 1997. The applicant filed its counter statement on April 9, 1998.

Neither party filed evidence. Only the opponent filed a written argument. By letter dated June 16, 2000, the applicant did request leave to file a written argument. The Board responded on August 2, 2000 by advising that the correct approach would be to request a retroactive extension of time; no such request was ever received.

An oral hearing was held at which both parties were represented.

The statement of opposition pleads many grounds of opposition, the majority of which were abandoned by the opponent at the oral hearing. The outstanding grounds of opposition are as follows:

The applicant did not comply with the provisions of Section 30(i), in that the applicant was not, and could not have been, satisfied that it was entitled to use and/or register the subject mark in Canada in view of the applicant's knowledge of the lack of distinctiveness of the subject mark and of the existence and use of prior rights of the opponent and other parties in one or more confusingly similar marks and trade names, used and/or made known, as set out or referred to further in this statement of opposition.

The applicant is not the person entitled to registration of the subject mark on the basis of proposed use, as provided by Sections 38(2)(c) and 16(3) of the *Trade-marks Act*. At the date on which the applicant filed the application for registration of the subject mark namely March 18, 1997 [sic], the subject mark was confusing with one or more trade mark(s) in respect of which application(s) for registration had been previously filed, and are currently pending, in Canada, namely the trade-mark MALONE'S SPORTS GRILL application No. 776, 128 filed February 22, 1995 for clothing, restaurant and bar services.

The subject mark was not at the date of commencement of these proceedings and currently is not distinctive of the services of the applicant as required by Sections 38(2)(d) and 2 of the *Trade-marks Act*. The subject mark has never actually distinguished, has not been used for the purpose of distinguishing, is not capable of distinguishing, and has not been adapted to distinguish, the services referred to in the application in association with which it is proposed to be used by the applicant, from the services of others, within the meaning of Section 2 of the *Trade-marks Act*. Specifically, the subject mark was not and is not distinctive of the applicant's services in Canada, being descriptive, and considering the prior and continuing use and/or making known of certain trade-names and trade-marks including without limitation, those previously referred to herein.

The opponent's agent agreed at the oral hearing that, in light of the absence of evidence, these three grounds of opposition are to be decided based solely on the likelihood of confusion between the applied-for mark and the mark that is the subject of application No. 776,128.

I reject the first and third of these grounds because the opponent has not met its evidential burden with respect to them. With respect to the Section 30 ground, there was an evidential burden on the opponent to prove those allegations on which it relied [see *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. With respect to the distinctiveness ground, the mere existence of a trade-mark application cannot satisfy the opponent's evidential burden [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

Having regard to the potential public interest in assessing a Paragraph 16(3)(b) ground, the Registrar will exercise his discretion to check the Trade-marks Office

records to confirm the existence of a pending application being relied upon in support of such a ground [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.*, 32 C.P.R. (3d) 525 (T.M.O.B.) at p. 529]. I have therefore checked the Register and confirmed that application No. 776,128 was pending on May 29, 1996 when the present application was filed and on June 25, 1997 when the present application was advertised. I note however that the mark that is the subject of application No. 776,128 is a design mark and that each of the words MALONE'S, SPORTS and GRILL have been disclaimed apart from the trade-mark. The mark is shown below:

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

Each of the marks is inherently distinctive. The inherent distinctiveness of the opponent's mark derives from its design features. The inherent distinctiveness of the applicant's mark derives from the word MAYDAY. The word MALONE'S/MALONES is a surname and both parties have disclaimed the right to the exclusive use of such surname. [A disclaimer may be considered to be tantamount to an admission that the word is a surname, *Molson Companies Ltd. v. John Labatt Ltd. et al.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.) at p. 159.] The opponent submits that MAYDAY is a common English word. I agree that it is a dictionary term but it is an odd word to chose for restaurant and bar services and therefore is inherently distinctive in relation to the applicant's services. [MAYDAY is defined as "an international radio-telephone signal word used as a distress call" and MAY DAY as "May 1 celebrated as a springtime festival and in some countries as Labour Day".]

I do not consider the extent to which the marks have become known or the length of time each of the marks has been used to favour either party. Although I must assume that the applicant's mark has not been used or made known, there is also no evidence that the mark that is the subject of application No. 776,128 had been used or made known as of May 29, 1996. All we have is a statement in such application that as of February 22, 1995, the applicant (Trevor Alan Magee & Reid Gordon Flemons, a partnership) had used its mark since at least as early as February 1992. There is no reason to conclude that the MALONE'S SPORTS GRILL & Design trade-mark was still being using as of May 29, 1996 and no reason to conclude that the use referred to was significant. In *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.), the filing of a certified copy of a registration was held to only support an assumption of *de minimus* use of the registered trade-mark and here we have not even been provided with a certified copy. [see also *Holland Imports Inc. v. Groupe Val Royal Inc.* (1990), 31 C.P.R. (3d) 238 (T.M.O.B.), at p. 241]

The natures of the parties' services appear to be identical and one can only assume that the natures of their trades might also be identical.

The deciding factor in this case is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. In appearance, I consider the opponent's mark to be dominated by the circular shape, the word

MALONE'S, the stars and the human figure. The applicant's mark on the other hand would be dominated by the word MAYDAY, not only because on first principles this would appear to be an unusual word for restaurant and bar services but also because the first word in a trade-mark is traditionally considered to be the most dominant. In sound, the opponent's mark would be MALONE'S SPORTS GRILL, possibly abbreviated to MALONE'S. The applicant's mark would be MAYDAY MALONES, possibly abbreviated to MAYDAY.

In general, we distinguish individuals having the same surname by reference to their first names. In the present case, the word MAYDAY is similar to a first name, in that it may be used to distinguish one restaurant or bar associated with the surname MALONES from another associated with the same surname. Overall, I consider the first word MAYDAY to be sufficient to distinguish the applicant's mark from that of the opponent and to make confusion between the marks unlikely.

The opponent has argued that the existence of a disclaimer is not to be considered with respect to the issue of confusion. I agree that a disclaimed word is not to be disregarded in the consideration of a mark as a whole. In considering the two marks as a whole, I am cognizant of the fact that they both include the word MALONES/MALONE'S. However, one ought not to focus on the common features of two marks but rather on the marks as a whole and I am satisfied that the impressions left by the two marks in their entireties are sufficiently distinct that confusion is not likely.

Being cognizant of the fact that the onus is on the applicant, I find that the marks MAYDAY MALONES and MALONE'S SPORTS GRILL & Design are not likely to be confused. Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to Subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 8th DAY OF DECEMBER, 2001.

**Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board**