



OPPOSITION BOARD HANDS DOWN SPLIT DECISION IN DISPUTE OVER WINNIE THE POOH TRADE-MARK

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A recent decision by the Opposition Board of Canada's Trade-marks Office has dismissed part of a trade-mark application filed by Disney Enterprises, Inc. for the trade-mark WINNIE THE POOH further to the opposition brought by Stephen Slesinger, Inc. on the basis of alleged non compliance with section 30 of Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter the "Act"). Section 30 of the Act describes some technical grounds of opposition: for example, in a case where a trade-mark has been filed on a "proposed use" basis, it should not already be in use with any of the wares mentioned in the application; if it has already been used with some wares, the trade-mark can be refused for those wares. This opposition was decided on such a ground of opposition. (*Stephen Slesinger, Inc. v. Disney Enterprises, Inc.*, 2012 TMOB 89 (T.M.O.B.), Jill W. Bradbury, May 2, 2012; decision released May 24, 2012).

On January 4, 2007, Disney Enterprises, Inc. (hereafter "Disney") filed an application to register in Canada the trade-mark WINNIE THE POOH in association with a long list of wares (from sleeping bags to spaghetti sauce and other wares such as staplers, stickers and statuettes) on the basis of proposed use of the trade-mark with those wares in Canada. Disney's WINNIE THE POOH application was published for opposition purposes on November 21, 2007 and on April 21, 2008, Stephen Slesinger, Inc. (hereafter "Slesinger") filed a statement of opposition raising various grounds of opposition.

In its statement of opposition, Slesinger alleged, *inter alia*, that the application did not conform to the requirements of section 30(i) of the Act because Disney could not have been satisfied that it was entitled to use the mark in Canada in association with the wares described in the application in view of the fact that the mark is owned by Slesinger. Additionally, Slesinger further alleged that the application did not conform to the requirements of section 30(e) of the Act because Disney "never intended to use the trade-mark in Canada in association with the wares set forth in the application".

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In support of its grounds of opposition, Slesinger filed the affidavit of Patricia Slesinger, its President, who introduced in evidence a series of documents dating back to the 1920's purporting to show Slesinger's rights over the trade-mark WINNIE THE POOH.

According to the evidence and the record, British author A.A. Milne created several characters for his children's books that include the character known as WINNIE THE POOH (the Pooh Works). Around 1929-1930, Mr. Milne granted rights to Stephen Slesinger, an American, to commercialize these characters in the United States and Canada. The agreement provided that Mr. Slesinger "shall organize a corporation under the laws of the State of New York which shall have the right to grant licenses for the use of the trade-marks".

Further to the agreement between A.A. Milne and Stephen Slesinger, the opponent was incorporated to carry out the commercialization of these characters in the United States and Canada. Part of Slesinger's evidence revealed the existence of a 1961 agreement between it and Walt Disney Productions (one of Disney's predecessors).

The agreement stated, *inter alia*, that Slesinger "assigns, grants, and sets over unto the purchaser" the sole and exclusive right in the U.S. and Canada regarding "various Winnie-the-Pooh works of Mr. Milne", subject to existing licenses and payments to be made to the seller. In turn, Disney's predecessor thereafter licensed marks associated with the Pooh Works to third parties; it also proceeded to register some trade-marks, including WINNIE THE POOH, in its own name. The parties' relationship was apparently without problems until approximately the early 1980's when new agreements were put into place between the parties to resolve disagreements between them.

Up until 2008, Disney (or its predecessor) continued to register trade-marks associated with the Pooh Works. However, in 2008, Slesinger challenged the more recent trade-mark applications filed by Disney (such as the one in the present case). In support of its opposition, through Patricia Slesinger's testimony, it filed a series of agreements, letters, releases and reports spanning several decades and also more recent documents such as pages from deposition transcripts and various court documents relating to litigation between the parties in the United States.

As part of its evidence, Disney filed certified copies for various registrations for the trade-mark WINNIE THE POOH, obtained in Canada by it or its predecessor, as far back as 1965 and as recently as 2008. All these registrations currently stand in the name of Disney and cover a wide variety of wares.

While the documents filed by Slesinger apparently purported to establish that Disney did not own rights to the trade-mark WINNIE THE POOH, Hearing Officer Bradbury concluded otherwise and wrote in her reasons: "... I accept that the best interpretation of the various agreements between the parties is that, prior to the dates that are material in the present proceeding, the Opponent assigned whatever rights it

owned in the Pooh Works, including the trade-marks, to the Applicant's predecessor in exchange for consideration that included the payment of "royalties". In other words, I find that the Opponent does not own the mark that is the subject of this application and did not own it at the time that the application was filed."

This finding had an important impact on the section 30(i) ground of opposition. On behalf of Slesinger, it was argued that Disney could not have been satisfied that it was entitled to use the mark since Slesinger alleged it owned the mark. However, Hearing Officer Bradbury concluded that Slesinger's evidence did not support this conclusion. Accordingly, this ground of opposition was dismissed.

Hearing Officer Bradbury then analyzed the section 30(e) ground of opposition. In this case, was Disney's statement that it intended to use the applied for mark in association with its long list of wares accurate?

Slesinger compared the statement of wares in Disney's existing registrations for the trade-mark WINNIE THE POOH (that were filed by Disney as part of its evidence in support of its right to the mark) against the wares in the opposed application. Some wares found in the previous WINNIE THE POOH registrations were claimed as being already in use while some of the same wares were subsequently presented as being "proposed use" wares in the opposed application.

According to Slesinger, this meant that Disney did not intend to use its WINNIE THE POOH trade-mark for those wares when it filed its application "because, as indicated in the existing registrations, WINNIE THE POOH had already been used as a trade-mark in association with such wares". By referring to Disney's own evidence, Slesinger argued that it had satisfied its evidential burden for its section 30(e) ground of opposition.

Such burden is usually described as "light" since the facts in support thereof are usually better known by the applicant who has filed the application rather than by the opponent who raises the issue.

Hearing Officer Bradbury agreed with Slesinger's argument: "The Opponent is entitled to rely upon the Applicant's evidence to meet its light evidential burden and the claims of use set out in the certified copies of the Applicant's existing registrations meet this initial burden. The Applicant therefore must meet the legal burden that lies on it to show that the proposed use claim in the pending application was appropriate because it had abandoned the use referred to in the earlier registrations for the same mark.

The Applicant has not filed any evidence to meet this legal burden. Accordingly, based on the line of decisions wherein the Registrar of Trade-marks refused proposed use applications where actual use of the trade-mark was evidenced prior to the filing date [see *Nabisco Brands Ltd v Cuda Consolidated Inc*, (1997), 81 CPR (3d) 537 (TMOB) at 540 and *Systèmes de Formation & de Gestion Perform Inc v*

Scissons, 2004 CarswellNat 1758 (TMOB)], the section 30(e) ground succeeds with respect to the specific wares that overlap, namely: clocks; jewelry; watches; address books; baby books; books; calendars; children's activity books; colouring books; diaries; greeting cards; photograph albums; postcards; posters; stickers; backpacks; diaper bags; overnight bags; tote bags; umbrellas; figurines; picture frames; toy chests; tumblers; bowls; cookie cutters; cups; dishes; lunch boxes; napkin holders; paper plates; soap dishes; waste baskets; biscuits; breakfast cereal; candies; chocolate; honey (collectively the WINNIE THE POOH Overlapping Wares)".

The opposition was therefore allowed with respect to the WINNIE THE POOH Overlapping Wares.

A similar finding was made regarding the trade-marks TIGGER and ROO that were also filed by Disney.

The interesting aspect of this decision is that the Hearing Officer decided several key points against each party on the basis of the evidence filed by that party. For those interested in various aspects of trade-mark law, this decision could be seen as a reminder that "less is sometimes better" when it comes to a party's own evidence in opposition cases. On this point, whenever a party files evidence in support of a particular issue, it should always be mindful that the evidence could be deemed relevant for a completely different issue and relied upon accordingly to decide that issue.



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