



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 64
Date of Decision: 2012-03-29

**IN THE MATTER OF AN OPPOSITION
by Aether, LLC to application
No. 1,379,305 for the trade-mark Aether
Design in the name of Alexander Medow**

[1] On January 15, 2008, Alexander Medow (the Applicant) filed an application to register the trade-mark Aether Design set out below (the Mark).

The application was filed on the basis of both use and proposed use in Canada, as set out below:

The Aether trade-mark is used to recognize articles of clothing and accessories designed and/or manufactured by the 'legendary Aether clothing gods'; including but not limited to t-shirts, sweatshirts, hoodies, jeans, sweatshirts, jackets, shoes, socks, scarves, underwear, belts, bracelets, rings and apparel; furthermore the brand is used in the production of artwork on canvas, including oil, acrylic and digital print; furthermore the brand is to be used in the production of electronic stereos, boom boxes and ghetto blasters.

The Aether trade-mark will be associated with any services provided by the 'legendary Aether clothing gods' including but not limited to graphic design, clothing design, art design, pattern design, and prototyping.

[2] The application was subsequently amended to t-shirts, sweat shirts based on use since January 1, 2008 (Wares 1) and hooded shirts, jeans, jackets, shoes, socks, scarves, underwear, belts, bracelets, rings; artwork reproductions based on proposed use (Wares 2). The services were deleted.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 6, 2009.

[4] On October 5, 2009, Aether, LLC (the Opponent) filed a statement of opposition pleading the following grounds:

- 1 The application does not conform to the requirements of Section 30 of the [*Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act)]. More particularly, the Opponent states and the fact is that the application does not contain a statement in ordinary commercial terms of the specific wares in association with which the [Mark] has been claimed to have been used and is proposed to be used. More particularly, the Opponent states and the fact is that the Applicant has not used the [Mark] in Canada in association with [Wares 1] since at least as early as January 1, 2008 and has no intention to use the [Mark] in association with [Wares 2] in Canada.
- 2 The application does not conform to the requirements of Section 30 of the [Act]. More particularly, the Opponent states and the fact is that the application does not contain a date from which the Applicant has so used the [Mark] in Canada in association with [Wares 1] or at all.
- 3 The application does not conform to the requirements of Section 30 of the [Act]. More particularly, the Opponent states and the fact is that the application does not contain a statement that the Applicant, by itself or through a licensee or by itself and through a licensee, intends to use the [Mark] in Canada in association with [Wares 2] since the Applicant does not intend to use the [Mark] in Canada with these wares.
- 4 The application does not conform to the requirements of Section 30 of the [Act]. More particularly, the Opponent states and the fact is that the Applicant could not have been satisfied that it was entitled to use the [Mark] in Canada in association with the wares described in the application since the Applicant has not used the [Mark] since the claimed date of first use and has no intention to use the [Mark] in association with [Wares 2].
- 5 The application does not conform to the requirements of Section 30 of the [Act]. More particularly, the Opponent states and the fact is that the application as published contains a statement of wares which are broader than the statement of wares contained in the application at the time the application was filed pursuant to Section 30 of the

[Act] and accordingly, contravenes the provision of Section 31(e) of the [*Trade-marks Regulations*, SOR/96-195 (the Regulations)] and thus the application is void.

- 6 The Applicant is not the person entitled to registration of the [Mark]. More particularly, the Opponent states and the fact is that at the date of filing the application, the [Mark] was not used in Canada in association with [Wares 1].
- 7 The Applicant is not the person entitled to registration of the [Mark]. More particularly, the Opponent states and the fact is that at the date of filing of the application, the Applicant had no intention to use the [Mark] in association with [Wares 2].

[5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed an affidavit of Karen Blau. In support of its application, the Applicant filed his own affidavit. No cross-examinations were conducted.

[7] Only the Opponent filed a written argument. A hearing was not held.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[9] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 16 - the date of first use alleged in the application for Wares 1 [see s. 16(1) of the Act]; the filing date of the application for Wares 2 [see s. 16(3) of the Act];

Grounds of Opposition Which Can be Summarily Dismissed

[10] The first ground of opposition alleges in part that the application does not conform to the requirements of s. 30(a) of the Act as the application does not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under s. 30(a) is a light one and may be met simply through argument [see *McDonald's Corp. v. M.A. Comacho-Saldana International Trading Ltd.* (1984), 1 C.P.R. (3d) 101 (T.M.O.B.) at 104; *Air Miles International Trading B.V. v. Deutsche Lufthansa AG* (2010), 89 C.P.R. (4th) 230 (T.M.O.B.) at para. 30]. In this case, neither the Opponent's evidence nor its submissions meet its initial burden. The s. 30(a) ground is therefore dismissed.

[11] The fourth ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark since it did not have the intention to use the Mark in association with Wares 2. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances underlying the allegations in this pleading, the s. 30(i) ground is dismissed.

[12] The fifth ground of opposition alleges that the application does not conform to the requirements of s. 30 of the Act since it does not comply with r. 31(e) of the Regulations as the wares were amended so that they were broader than those filed. Similar to the s. 30(a) ground, neither the Opponent's evidence nor its submissions are sufficient to meet its initial burden. This ground of opposition is therefore dismissed.

[13] The sixth and seventh grounds of opposition allege that the Applicant is not the person entitled to registration since at the date of filing it did not use the Mark in association with Wares 1, nor intend to use it in association with Wares 2. Section 16 sets out that a person is not entitled to registration of a trade-mark if it is confusing with a previously used trade-mark or trade-name or previously applied-for trade-mark. As the pleaded grounds of opposition do not allege confusion, I dismiss these grounds of opposition [*R. Griggs Group Ltd. v. 359603 Canada Inc.* (2005), 47 C.P.R. (4th) 215 (T.M.O.B.) at 237].

Section 30(b) and (e) Grounds of Opposition

[14] The second and third grounds of opposition are based on contravention of s. 30(b) and s. 30(e). I note that these grounds are also referred to elsewhere in the statement of opposition.

Section 30(b) Ground of Opposition: No Use of the Mark Since Date Alleged

[15] The statement of opposition alleges that the Mark has not been used with t-shirts and sweat shirts since January 1, 2008, the date alleged in the application.

[16] The legal burden or onus is on the Applicant to show that its application complies with s. 30 of the Act. To meet the evidential burden upon it in relation to a particular issue, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt Ltd., supra*]. The Opponent's burden is, however, lighter with respect to the issue of non-compliance with s. 30(b) because the facts supporting no use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B) at 89]. While an Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application [*York Barbell Holdings Ltd. v. ICON Health & Fitness Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[17] The Opponent filed an affidavit of Karen Blau, an intelligence analyst, who reported on the results of an investigation requested on July 30, 2009 to determine whether or not the Applicant was using the Mark in association with t-shirts and sweatshirts. The relevant paragraphs of Ms. Blau's affidavit are set out below.

4. I checked news and trade journals, court records, company filings, business directories, telephone listings, conducted Internet searches and checked other sources and I found no evidence that there was any product currently manufactured or distributed in association with the trade-mark Aether Design as shown in Canada trade mark application serial no. 1,379,305.
5. I located the subject mark on a website owned by Alexander Medow, on his facebook page and on the website of an apparel manufacture of which he is an

executive.

[18] Given the vagueness of Ms. Blau's evidence with respect to the extent of her investigations, including the lack of information as to whether such investigations would have been likely to reveal the use of a design mark, I do not find that these investigations constitute evidence from which it could reasonably be concluded the facts alleged to support the s. 30(b) ground of opposition exist. Furthermore, the fact that Ms. Blau located the mark on the Applicant's website, Facebook page, and on the website of an apparel manufacturer of which the Applicant is an executive is not inconsistent with the use of the Mark on t-shirts and sweatshirts having been commenced on January 1, 2008. As such, the evidence of Ms. Blau is insufficient to meet the Opponent's burden.

[19] In its written submissions, the Opponent argued that the Applicant's own evidence is sufficient to meet the Opponent's burden. The Applicant provides the following in his affidavit:

- The Applicant initiated the creation of AETHER in May 2007 (page 1).
- In the fourth quarter of 2007, the first run of signature vintage style AETHER t-shirts and sweatshirts was completed (page 2, Exhibit 3). Each of photographs and depictions provided by the Applicant of t-shirts and sweatshirts manufactured prior to January 1, 2008 shows the Mark.
- In November/December 2007, the Applicant began sampling garments to prospective distributors and retailers (page 2).
- That sales through various marketing avenues including word of mouth, Kijiji, Craigslist, and eBay have taken place since late 2007 to the present (page 2).
- AETHER t-shirts were listed on eBay Canada on January 8, 2008 (page 2, Exhibit 5).
- At the date of filing (January 15, 2008) "an entire line was already made and marketed to both individuals and distributors" (page 2).

The Applicant also attaches to his affidavit two testimonials from customers who purchased among the first AETHER garments made. These testimonials are identified as "Exhibit 6 –

Sample 2007 Customer Sales References”. I agree with the Opponent that the testimonials are not admissible as evidence of the customers as to their purchases. I, however, find that the Applicant’s identification of the testimonials and the surrounding statements in the affidavit are evidence from the Applicant that purchases occurred in 2007. Furthermore, I note that the Opponent had the opportunity to cross-examine the Applicant but chose not to do so. While the Applicant’s evidence of use could be clearer, the Applicant’s evidence is not clearly inconsistent with a first use date of January 1, 2008 and the Opponent cannot rely on it to meet its burden.

[20] As the Opponent has failed to meet its burden with respect to s. 30(b), it is unnecessary to consider whether the Applicant has established that it has used the Mark with t-shirts and sweatshirts since the claimed date of first use. Consequently this ground of opposition is dismissed.

Section 30(e) Ground of Opposition: No Intention to Use the Mark

[21] The statement of opposition alleges that the application should be refused in respect of Wares 2 because the Applicant’s own evidence points to use of the Mark prior to the filing date. There is a series of decisions supporting the proposition that a proposed use application will be refused where the evidence points to use of the applied-for mark in advance of the filing date [*Tone-Craft Paints Ltd. v. Du-Chem Paint Co.* (1969), 62 C.P.R. 283 (T.M.O.B.), *Airwick Industries Inc. v. Metzner* (1982), 74 C.P.R. (2d) 55 (T.M.O.B.), *Société Nationale Elf Acquitaine v. Spex Design Inc.* (1988), 22 C.P.R. (3d) 189 (T.M.O.B.) and *Frisco-Findus S.A. v. Diners Delite Foods Ltd.* (1989), 26 C.P.R. (3d) 556 (T.M.O.B.)]. As in the case of the s. 30(b) ground of opposition, the Opponent may rely on the Applicant's evidence to meet its initial burden in relation to this ground but the Applicant’s evidence must be clearly inconsistent with the proposed use basis [*Calvin Klein Trademark Trust v. Calvin Corp.* (2000), 8 C.P.R. (4th) 397 (T.M.O.B.) at 405].

[22] The Opponent submits that the Applicant’s evidence is clearly inconsistent with the filing of the application on the basis of proposed use for various garments, jewelry and sculptures since the Applicant states the following in his affidavit (page 2):

I also completed numerous sales to private individuals through various marketing avenues including word-of-mouth, Kijiji, Craigslist, eBay and personalized custom creations throughout late 2007 to the present for various garments, jewelry, and sculptures; products all trade-marked under the Aether name.

[23] I disagree with the Opponent that a “fair reading” of Mr. Medow’s statement supports that the Applicant did in fact sell various garments, jewelry and sculptures with the Mark from “late 2007 to the present”. I note that later on in his affidavit, the Applicant states that he expanded into “Aether branded jewelry in late 2008” (page 3). As such, it appears that this paragraph when read in conjunction with the affidavit as a whole indicates that from 2007 to the present there have been sales of the items listed although sales of each item did not necessarily commence in 2007. Furthermore, this paragraph of the affidavit refers to the “Aether name” and there is no evidence that the design mark which is the subject of this opposition was associated with Wares 2 at the material date. I note that the Opponent had the opportunity to scrutinize the Applicant’s evidence through cross-examination but did not. For the reasons above, I do not consider that the Applicant’s own evidence is clearly inconsistent with his intention to use the Mark with Wares 2 at the filing date. Accordingly, this ground of opposition is dismissed.

Disposition

[24] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office