

**IN THE MATTER OF AN OPPOSITION by Jaguar Cars Limited and The Jaguar Collection Limited to application No. 693,313 for the trade-mark JAGUAR filed by Manufacture des Montres Jaguar S.A.**

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On November 7, 1991, the applicant, Manufacture des Montres Jaguar S.A., filed an application to register the trade-mark JAGUAR based upon use of the trade-mark in Canada since at least as early as July 6, 1990 in association with “montres et parties de montres”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of June 9, 1993 and the opponents, Jaguar Cars Limited and The Jaguar Collection Limited, filed a statement of opposition on August 9, 1993, a copy of which was forwarded to the applicant on September 15, 1993. The applicant served and filed a counter statement on October 15, 1993. During the opposition, the opponents requested and were granted leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend their statement of opposition. Likewise, the applicant requested and was granted leave pursuant to Rule 40 to amend its counter statement. As their evidence, the opponents submitted the affidavits of Kim Brulé, Anthony Brian Curdy, Victor W. Hendrickson, Teresa Carmel Friend, and Lynda M. Palmer, together with certified copies of registration Nos. 378,643 and 378,644. The applicant was granted an order to cross-examine the opponents’ affiants on their affidavits but did not proceed with the order for cross-examination in a timely manner. The applicant filed as its evidence the affidavit of Jose Antonio Hernandez. Both parties filed written arguments and both were represented at an oral hearing.

The first two grounds of opposition set forth in the amended statement of opposition are based on Subsection 30(b) of the *Trade-marks Act*, the opponents asserting that the trade-mark JAGUAR has not been used and/or used continuously since July 6, 1990, the claimed date of first use, in association with the wares covered in the present application. Further, the opponents allege that any use of the trade-mark JAGUAR in Canada in association with watches and watch parts has been by a person other than the applicant, namely, the manufacturer and/or distributor of the applicant’s JAGUAR watches and watch parts, and such use has not been a licensed use within the meaning of Subsection 50(1) of the *Trade-marks Act*.

While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidentiary burden on the opponents in respect of the Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidentiary burden upon them in relation of a particular issue, the opponents must either adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist or rely upon the applicant's evidence to meet their evidentiary burden. In the present case, the opponents have relied upon the Hernandez affidavit which evidences four transactions involving the sale of watches and watch parts to one Canadian customer between July and November of 1990 as meeting their initial evidentiary burden. In particular, the opponents argue that these sales, which amounted to approximately \$8,500, were merely token sales and that the applicant subsequently abandoned its trade-mark JAGUAR in Canada.

Since no evidence was furnished by the opponents in support of their Subsection 30(b) ground, there was no need for the applicant to have adduced evidence in support of either its claimed date of first use or its subsequent use of its trade-mark JAGUAR in Canada. In any event, the Hernandez affidavit is not inconsistent with the applicant's claim that it has used its trade-mark JAGUAR in Canada since July 6, 1990. Moreover, abandonment is not an issue under Subsection 30(b) of the *Trade-marks Act* [see *Labatt Brewing co. Ltd. v. Benson & Hedges (Canada) Ltd. et al*, 67 C.P.R. (3d) 258, at p. 262]. As a result, I have rejected the Subsection 30(b) grounds of opposition.

As their third ground, the opponents allege that, as of the filing date of the present application, the applicant could not truthfully have stated that it was satisfied that it was entitled to use the trade-mark JAGUAR in Canada in association with watches and watch parts since it was aware of the opponents' earlier and continuous use of the trade-mark JAGUAR in Canada and internationally in association with watches. While the legal burden is upon the applicant to show that its application complies with Subsection 30(I) of the *Trade-marks Act*, there is again an initial evidentiary burden on the opponents in respect of its Section 30 ground. There is no evidence pointing to the applicant's awareness of the opponents' use of their trade-mark JAGUAR in Canada

in association with watches prior to the applicant's claimed date of first use. Moreover, even were the applicant aware of the opponents' use of the JAGUAR trade-mark internationally in association with watches, it could still have been satisfied that it was entitled to use its trade-mark JAGUAR in Canada on the basis *inter alia* that the opponents' use of the trade-mark JAGUAR in association with watches in countries other than Canada is of no relevance to it using its trade-mark JAGUAR in Canada. I have therefore dismissed this ground of opposition.

The fourth ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponents asserting that the applicant's trade-mark is not registrable in that it is confusing with each and all of the family of registered trade-marks of the opponent, Jaguar Cars Limited, set out below.

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares/Services</u>
JAGUAR	UCA 21618	Motor land vehicles
	156,352	Motor land vehicles and parts thereof, namely, steering wheels, hub caps and radiator grille badges, and accessories therefor, namely, license holders.
	156,265	Motor land vehicles
	347,855	Spectacles, sunglasses, spectacle frames and parts of these goods; spectacle casings.
	353,037	Automobiles and parts and fittings therefor
JAGUAR	368,409	Automobile maintenance and repair services

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	378,643	Cleaning and polishing preparations for motor land vehicles; hand tools; jewellery, other than watches, and parts of and fittings for such jewellery; books, periodicals, magazines and newspapers; printed publications relating to automotive subjects namely spare parts lists and maintenance manuals; playing cards; driving licence cases, wallet cases, business card holders, belts, credit card holders, key cases, address books, note books, passport holders, beauty cases, document cases, pocket wallets, parasols, umbrellas; tennis rackets, badminton rackets, squash rackets, golf balls, golf tees; ashtrays.
JAGUAR	378,644	Cleaning and polishing preparations for motor land vehicles; hand tools; jewellery, other than watches, and parts of and fittings for such jewellery; books, periodicals, magazines and newspapers; printed publications relating to automotive subjects namely spare parts lists and maintenance manuals; playing cards; driving licence cases, wallet cases, business card holders, belts, credit card holders, key cases, address books, note books, passport holders, beauty cases, document cases, pocket wallets, parasols, umbrellas; tennis rackets, badminton rackets, squash rackets, golf balls, golf tees; ashtrays.
	399,480	Spectacles, spectacle frames and parts of these goods

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the *Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision, the

material date in relation to the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

With respect to the inherent distinctiveness of the trade-marks at issue [*Para. 6(5)(a)*], the applicant's trade-mark JAGUAR and the opponents' registered trade-marks JAGUAR, JAGUAR & Design and Jaguar Design are inherently distinctive as applied to the respective wares and services of the parties. As for the extent to which the trade-marks at issue have become known [*Para. 6(5)(a)*], the applicant has not demonstrated that its mark has become known to any measurable extent in Canada. While the Hernandez affidavit establishes that the applicant has sold its JAGUAR watches and watch parts to a customer in Canada, there is no evidence relating to the subsequent distribution of any of these wares in this country. On the other hand, the opponents' evidence establishes that their registered trade-marks identified above have become known in association with automotive services and have become known to some extent in respect of certain of their non-automotive wares identified in their various registrations. As well, the opponents' evidence establishes that their trade-marks JAGUAR and Jaguar Design have become well known in Canada in the automotive field. Consequently, the extent to which the trade-marks at issue have become known clearly favours the opponents, particularly in respect of their automobiles. Likewise, the length of time the trade-marks have been in use [*Para. 6(5)(b)*] is a further factor weighing in the opponents' favour, particularly in relation to automobiles.

The opponents have submitted that their JAGUAR trade-mark is famous and should therefore be accorded a very broad ambit of protection. To be considered a 'famous' trade-mark, I would expect that a mark must be generally recognized throughout Canada, as well as by most, if not all, segments of the population. In the present instance, I have my doubts as to whether the opponents' JAGUAR trade-mark would be generally recognized by most segments of the population, and especially those having little, if any, knowledge of automobiles. I am therefore not prepared to conclude that the opponents' mark qualifies as a 'famous' trade-mark in Canada.

Next, the Registrar must have regard to the nature and the wares and services of the parties [*Para. 6(5)(c)*] and the nature of the trade associated with their wares and services [*Para. 6(5)(d)*].

In this regard, the applicant's watches bear no similarity to the opponents' automobiles and parts therefor, automotive services, cleaning and polishing preparations for motor land vehicles, hand tools, printed publications relating to automotive subjects namely spare parts lists and maintenance manuals. Furthermore, there would be no overlap in the channels of trade associated with these wares and services. As well, I consider there to be little, if any, similarity between the applicant's wares and the following non-automotive wares covered in registration Nos. 378,643, 378,644, 347,855 and 399,480: books, periodicals, magazines and newspapers; playing cards; driving licence cases, wallet cases, business card holders, belts, credit card holders, key cases, address books, note books, passport holders, beauty cases, document cases, pocket wallets, parasols, umbrellas; tennis rackets, badminton rackets, squash rackets, golf balls, golf tees; ashtrays; sunglasses, spectacles and spectacle frames and casings. Moreover, I consider there to be little potential for overlap in the channels of trade associated with the applicant's watches and any of these wares.

Registration Nos. 378,643 and 378,644 also cover the following wares: "jewellery, other than watches, and parts of and fittings for such jewellery". According to Mr. Hendrickson, Jaguar Cars Limited specifically excluded "watches" at the prosecution stage of its applications in order to overcome Paragraph 12(1)(d) objections raised by the *Trade-marks Office* based on two registrations for the trade-mark JAGUAR standing in the name of Fashion Optics Inc. and covering *inter alia* watches. Mr. Hendrickson also states that the Fashion Optics registrations were subsequently expunged from the register pursuant to Subsection 45(5) of the *Trade-marks Act*. In any event, I am generally of the view that jewellery and watches are somewhat related and could potentially travel through the same channels of trade. However, having regard to the specific exclusion of "watches" in registration Nos. 378,643 and 378,644, I have concluded that a narrow ambit of protection should be accorded these registrations insofar as the type of jewellery intended to be covered by them. I have therefore determined that the type of jewellery intended to be covered by the Jaguar Cars registrations differs from watches and that the channels of trade associated with these wares would likewise differ.

Considering the degree of resemblance between the trade-marks at issue [*Para. 6(5)(e)*], the applicant's mark and the trade-marks covered by registration Nos. UCA21618, 368,409, 378,644 and

399,480 are identical in appearance, sounding and in the ideas suggested by them. Further, the applicant's trade-mark JAGUAR and the trade-marks covered by registration Nos. 156,352 and 378,643 bear a fair degree of similarity in appearance and are identical in sounding and in the ideas suggested while the opponents' design marks covered by registration Nos. 156,265, 347,855, 368,410 and 353,037 bear no similarity in appearance or in sounding to the applicant's trade-mark although the ideas suggested by the marks are the same to the extent that the opponents' design trade-marks would be identified as being representations of a jaguar.

As further surrounding circumstances in respect of the issue of confusion, both parties submitted evidence relating to the existence of registrations in other jurisdictions for their respective JAGUAR trade-marks. However, this evidence is of little relevance to the determination of the issues in this proceeding. Likewise, the evidence of the parties relating to litigation or administrative proceedings between the parties in jurisdictions outside of North America is of little assistance in assessing the likelihood of confusion between the trade-marks at issue in this opposition. Further, while the opponents argued that they were relying upon a family of marks, the only common element between the opponents' word marks and design marks is the idea or concept of a "jaguar" and I am not convinced that the average consumer would necessarily identify the opponents' design marks as representing a jaguar. I have therefore accorded little weight to the opponents' alleged family of trade-marks.

In view of the above and, having regard in particular to the differing wares and services and channels of trade of the parties, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in relation to the Paragraph 12(1)(d) grounds. I have therefore rejected the fourth ground of opposition.

As their fifth ground, the opponents alleged that the applicant is not the person entitled to registration of the trade-mark JAGUAR in that, as of the applicant's claimed date of first use, the applicant's trade-mark was confusing with the opponents' trade-marks JAGUAR, JAGUAR & Design (identical to the trade-mark covered by registration No. 378,643), and Jaguar Design (identical to the trade-mark covered by registration No. 368,410), which had previously been used

in Canada by the opponent, Jaguar Cars Limited, though its own use in Canada and through use by its wholly-owned subsidiary, The Jaguar Collection Limited, in association with watches. With respect to a ground of opposition based on Paragraph 16(1)(a) of the *Trade-marks Act*, there is an initial burden on the opponents to establish prior use of their trade-marks in Canada, as well as to show that they has not abandoned their trade-marks as of the date of advertisement of the present application in the *Trade-marks Journal* [June 9, 1993].

In his affidavit dated May 16, 1994, Victor W. Hendrickson, Vice-President, Finance and Administration, for Jaguar Canada Inc., states that his company is related to Jaguar Cars Limited and The Jaguar Collection Limited, and that he has access to the records of his company and Jaguar Cars Limited. Annexed as Exhibit B to his affidavit is a photocopy of an affidavit and accompanying exhibits sworn by Mr. Hendrickson on January 16, 1987 for filing in an unrelated trade-mark opposition proceeding. As Mr. Hendrickson states that he affirms the statements made in his previous affidavit and has annexed a copy of that affidavit to his present affidavit, I consider the contents of the January 16, 1987 affidavit to be admissible evidence in this opposition. Further, in paragraphs 12 and 13 of his affidavit of May 16, Mr. Hendrickson states as follows:

12. Jaguar Cars, through its licensee Jaguar Collection, commenced use of the trade-marks JAGUAR and JAGUAR & Design (as shown in Canadian trade-mark registration No. 378,644 and No. 378,643) in the United Kingdom in association with watches in 1985. Attached as Exhibit "M" are photocopies of Jaguar Collection catalogues for the years 1984/1985 and 1986/1987 showing their full line of products, including men's and lady's watches, for those years. Jaguar men's and lady's watches emanating from Jaguar Collection were first sold in Canada in 1989 in the manner described in paragraph 9 of my affidavit. Attached as Exhibit "N" are copies of portions of my company's 1988 catalogues showing Jaguar Collection watches available for purchase in Canada, together with my company's price lists including prices for such watches. Attached as Exhibit "O" are copies of portions of Jaguar Collection catalogues for the years 1990/1991, 1991/1992 and 1993/1994 showing Jaguar men's and lady's watches available for purchase, together with my company's price lists for such goods.

13. My company's sales records do not include product by product breakdown information for Jaguar Collection goods sold through Canadian JAGUAR dealerships prior to 1991. However, a review of my company's records show that in 1991 ten JAGUAR watches were sold in Canada through the JAGUAR dealerships. Attached as Exhibit "P" is a copy of my company's computer printout showing Jaguar Collection sales by product for 1991. The heading "intro" on such copy represents the year in which the specific product was introduced in Canada.

Further, in paragraph 15 of her affidavit, Teresa Carmel Friend, Company Secretary of The Jaguar Collection Limited and a solicitor employed by Jaguar Cars Limited, states that detailed



invoices identifying the products sold at retail and referred to in paragraphs 5 to 14 of her affidavit are not normally generated and therefore she is unable to produce as evidence in this opposition copies of such invoices. Rather, in paragraph 13, Ms. Friend has identified the number of watches sold annually in Canada for the years 1991 to 1993 through Jaguar Canada Inc., a company under the control of Jaguar Cars Limited, the total being 43 watches. Ms. Friend also provides details relating to sales of non-automotive products including watches through “employee stores” situated in the United Kingdom, as well as at a shop situated at Heathrow airport. However, this evidence is not of any relevance to the issues in this opposition as sales in the United Kingdom do not establish use of or any measure of a reputation for the opponents’ trade-marks in Canada.

In paragraph 12 of her affidavit, Ms. Friend refers to the distribution of JAGUAR trade-marked products under the control of Jaguar Cars Limited via The Jaguar Collection Limited by way of a licensing program. Under the program, third party companies are licensed by Jaguar Cars Limited and The Jaguar Collection Limited jointly to manufacture and/or distribute products bearing the JAGUAR mark so long as these products comply with quality standards and other specifications set by The Jaguar Collection Limited on behalf of Jaguar Cars Limited. The applicant has submitted that there is no evidence of direct or indirect control by Jaguar Cars Limited over Jaguar Watches SA, an entity identified by Ms. Friend as being a major licensee of the opponents for watches. However, the evidence of record would appear to suggest that there exists at least some form of indirect control over the quality of the watches manufactured by Jaguar Watches. In any event, it is the applicant’s entitlement to registration and the distinctiveness of the applicant’s trade-mark JAGUAR which are in issue in this opposition, and not the distinctiveness of the opponents’ marks.

As noted above, the burden is upon the opponents to satisfy the Registrar that Jaguar Cars Limited used the JAGUAR trade-marks in Canada in association with watches prior to the applicant’s claimed date of first use. I am mindful of the opponents’ evidence which explains the absence of invoice evidence and the inability of the opponents to identify the number of watches sold in Canada prior to 1991. However, the statement by Mr. Hendrickson that watches were sold in Canada in 1989, even when combined with evidence of catalogues for 1989 pointing to JAGUAR watches being available for purchase in Canada, do not clearly establish that Jaguar Cars Limited

used the JAGUAR trade-marks in Canada in association with watches within the scope of Subsection 4(1) of the *Trade-marks Act* prior to the applicant's claimed date of first use.

In this regard, I would note that only ten watches were sold in Canada in 1991 and that no sales figures were provided for 1990. Further, Ms. Friend is silent in her affidavit as to sales of watches in 1989 and, in fact, states that sales in Canada commenced approximately in 1991. As a result, I have dismissed the fifth ground of opposition.

The sixth ground is also based on Paragraph 16(1)(a) of the *Act*, the opponents asserting that the applicant is not the person entitled to registration of the trade-mark JAGUAR in that, as of the applicant's claimed date of first use, the applicant's trade-mark was confusing with the opponents' trade-marks identified in the above registrations, all of which had been previously used in Canada. However, the above comments concerning the issue of confusion between these trade-marks in relation to the Paragraph 12(1)(d) ground likewise apply in respect of this ground, even though the material date for assessing the issue of confusion in relation to the Paragraph 16(1)(a) ground is that applicant's claimed date of first use. As a result, this ground of opposition is also unsuccessful.

The seventh ground is based on Paragraph 16(1)(b) of the *Act*, the opponents asserting that the applicant is not the person entitled to registration in that the applicant's marks is confusing with the following pending applications of the opponent, Jaguar Cars Limited, which had previously been filed in Canada:

<u>Trade-mark</u>	<u>Application No.</u>	<u>Wares/Services</u>
	643,399	Men's toiletries and fragrances, namely, eau de toilette, after shave lotion, soap, deodorant stick and deodorant spray, shower gel, hair shampoo, foaming shave gel, after shave moisturizing balm.
	635,169	Motor land vehicles and parts and fittings therefor. Maintenance services, repair services, cleaning, painting and polishing; modification and tuning services, all for motor land vehicles and parts and fittings therefor.
	635,170	Motor land vehicles and parts and fittings therefor. Maintenance services, repair services, cleaning, painting and polishing;

modification and tuning services, all for motor land vehicles and parts and fittings therefor.

Each of the above applications was filed prior to the applicant's claimed date of first use and all three applications were pending as of the date of advertisement of the present application [June 9, 1993]. Since the opponents have met the burden upon them under Subsection 16(4) of the *Trade-marks Act*, the legal burden is upon the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark JAGUAR and the previously-filed applications of Jaguar Cars Limited. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the *Act*.

The trade-marks of the parties are inherently distinctive and there is a significant degree of resemblance between the trade-marks in appearance, sounding and in the ideas suggested by them. Furthermore, the extent to which the trade-marks have become known and the length of time the trade-marks have been in use favour the opponents in respect of the motor land vehicles and parts and fittings therefor, as well as the maintenance and repair services covered in the above applications. On the other hand, I have concluded that the extent to which the marks have become known and the length of time the marks at issue have been in use does not favour either party insofar as the opponents' toiletries and fragrances for men as covered in application No. 643,399 are concerned. The wares and services covered in the above applications differ from the applicant's watches and watch parties. Further, I would not expect there to be any overlap in the possible channels of trade associated with these wares and services.

Having regard to the differences in the wares, services and channels of trade of the parties, I have concluded that there would be no reasonable likelihood of confusion between the trade-mark JAGUAR covered in the present application and the trade-marks covered in the three pending applications standing in the name of Jaguar Cars Limited. I have therefore rejected this ground of opposition.

The final ground relates to the alleged non-distinctiveness of the applicant's trade-mark, the opponents asserting that the applicant's mark was "never adapted to distinguish, nor does it actually distinguish, the applicant's "watches and watch parts" from the wares and services of the opponent Jaguar Cars Limited because it is confusing with each and all of the opponent Jaguar Cars Limited's described herein". The material date for considering the non-distinctiveness ground is the date of opposition [August 9, 1993] and, while the legal burden is upon the applicant to satisfy the Registrar that its trade-mark is distinctive, there is an initial evidentiary burden on the opponents to establish the facts being relied upon by them in respect of this ground.

Apart from the sale of 25 watches in 1991 and 1992, and the further sale of 18 watches in 1993, some of which I would assume were sold prior to the material date, there is evidence that up to date brochures relating to the Jaguar Dealer Collection were included in documentation provided to every customer worldwide including Canada with every new JAGUAR motor car purchased [see Friend affidavit, para. 8] and such brochures included since 1988 Jaguar Collection watches bearing the trade-mark JAGUAR. As well, non-automotive products of the opponents are displayed in JAGUAR automobile dealerships in Canada whose premises include boutique or showcase facilities for the display and sale of such products, including watches. While sales, advertising and promotion of the opponents' JAGUAR watches in Canada has been very modest, I am of the view that they are sufficient to meet the evidentiary burden on the opponents in respect of the final ground. Accordingly, the legal burden is on the applicant to establish that its trade-mark JAGUAR is distinctive in Canada. However, no evidence has been furnished by the applicant to show that its trade-mark has become known to any measurable extent in Canada, apart from the four transactions involving the sale of JAGUAR watches and parts to a single Canadian customer between July and November of 1990 with no evidence relating to the subsequent distribution of these watches in Canada. Consequently, I find that the applicant has failed to meet the legal burden upon it of establishing that its trade-mark JAGUAR was distinctive of its wares in Canada as of the date of opposition.

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-*

*marks Act.*

DATED AT HULL, QUEBEC, THIS 31<sup>st</sup> DAY OF JULY, 1997.

G.W. Partington  
Chairman  
Trade Marks Opposition Board.