

**IN THE MATTER OF AN OPPOSITION
by Cosaco Inc. to application No. 873,133
for the trade-mark NAKED KISS in the
name of Diane Green**

On March 23, 1998, Diane Green (the “Applicant”) filed an application to register the trade-mark NAKED KISS (the “Mark”) based upon proposed use of the Mark in Canada. The current statement of wares and services reads as follows:

Wares:

- (1) Bags, namely sport, gym, school, travel, knapsack, book bags.
- (2) Purses, key rings, money clips, and sunglasses.
- (3) Clothing patches, sleepers, shirts, blazers, raincoats, umbrellas, capes, jumpers, Bermuda shorts, athletic sweat suits, skirts, jackets, jeans, jerseys, jewelry, jock straps, jogging suits, knitted and woven tops and bottoms, leggings, leotards, lingerie, robes, dressing gowns, housecoats, peignoir sets, night shirts, nightgowns, overcoats, pajamas, pants, pantsuits, panty girdles, panty hose, parkas, polo shirts, pullovers, scarves, scuffs, shawls, shirts, shorts, skirts, sleeping bags, slippers, socks, sports bras, sports coats, suits, suspenders, sweaters, sweatpants, sweatshirts, swimwear, tank tops, teddies, thermal underwear, ties, tops, trousers, T-shirts, turtlenecks, undergarment thongs, undergarments, undergarment supports namely girdles, undershirts, unitards, vests, warm-up suits, wind socks for decorative purposes, footwear namely boots, dress shoes, running shoes, and sandals, workout gloves, bandannas, bathing suits, bathing trunks, bathrobes, beach blankets, beach thongs, beach towels, bed jackets, belts for clothing, bike shirts, bike shorts, blouses, bodybriefers, boleros, boots, boxer shorts, bras, bustiers, camisoles, camp shirts, cardigans, chemises, coats, mittens, corsets, crop tops, decorative ribbons, namely, laces, ribbons, shoe laces, dresses, gloves, headbands, headwear, namely, hats, caps and visors, hosiery, anoraks, zippers both plastic and metal, tags of zippers, buckles, buttons, namely ornamental novelty buttons and buttons for clothing.

Services:

- (1) Marketing, promotion and sales services for department store-type merchandise and other services over the Internet and other communication means; namely, electronic mail and messaging services; access to bulletin boards containing information and to chat lines.
- (2) Broadcasting-transmission of interactive and non-interactive messages or programs through all available commercial means, namely, films, video tapes, discs, cassettes, television and the Internet.
- (3) Distribution of visual, audio and audio visual programming through all available commercial means, namely CD ROMS, films, video tapes, discs, cassettes, television and the Internet.
- (4) Internet services, namely chat-line services and downloading of music.
- (5) Providing interactive and non-interactive multimedia services offered by way of multimedia applications, namely CD ROMS, databases, the Internet, computers, television.
- (6) Providing advertising services over the Internet.

(7) Providing links between various worldwide web pages and sites.

The application was advertised for opposition purposes in the Trade-marks Journal of February 4, 2004.

On June 30, 2004, Cosaco Inc. (the “Opponent”) filed a statement of opposition against the application.

The Applicant filed and served a counter statement. The Opponent submitted in its written argument that the counter statement does not constitute a denial of each of the grounds of opposition but withdrew this submission at the oral hearing. However, the Opponent also objected that the counter statement improperly attempts to introduce evidence and raise argument. I agree and so I have disregarded such portions of the counter statement.

In support of its opposition, the Opponent filed a certified copy of its Canadian trade-mark registration No. 239,841 for KISS & Design for ladies’, men’s and children’s sportswear namely, T-shirts, blouses, sweaters, pullovers, cardigans, pants, shirts, jackets and underwear. KISS & Design (the “Opponent’s Mark”) is shown below:



In support of its application, the Applicant filed an affidavit of Dianne Green, sworn June 1, 2005.

In reply, the Opponent filed an affidavit of Elias J. Elias, an articling student. He simply provides a copy of a Statement of Claim filed by the Opponent in an action to expunge Canadian trade-mark registration No. 520,606 for HOT KISS, which is owned by a third party. The Statement of Claim sets out the plaintiff’s alleged rights. In its written argument, the Opponent attempted to

rely on these allegations as evidence of its activities in Canada but Mr. Elias' evidence is merely evidence that the Statement of Claim exists; it is not evidence of the facts alleged therein. At the oral hearing, I understood the Opponent's agent to agree that this is the case.

The Applicant unsuccessfully requested leave to file a further affidavit of Dianne Green.

No cross-examinations were conducted.

Each party filed a written argument and was represented at an oral hearing.

At the oral hearing, the Opponent advised that it was withdrawing its opposition with respect to the services and the wares other than the following wares [hereinafter "the Opposed Wares"]:

Clothing patches, sleepers, shirts, blazers, raincoats, capes, jumpers, Bermuda shorts, athletic sweat suits, skirts, jackets, jeans, jerseys, jewelry, jock straps, jogging suits, knitted and woven tops and bottoms, leggings, leotards, lingerie, robes, dressing gowns, housecoats, night shirts, nightgowns, overcoats, pajamas, pants, pantsuits, panty girdles, panty hose, parkas, polo shirts, pullovers, scarves, scuffs, shawls, shirts, shorts, skirts, sleeping bags, slippers, socks, sports bras, sports coats, suits, suspenders, sweaters, sweatpants, sweatshirts, swimwear, tank tops, teddies, thermal underwear, ties, tops, trousers, T-shirts, turtlenecks, undergarment thongs, undergarments, undergarment supports namely girdles, undershirts, unitards, vests, warm-up suits, wind socks for decorative purposes, footwear namely boots, dress shoes, running shoes, and sandals, workout gloves, bandannas, bathing suits, bathing trunks, bathrobes, beach thongs, bed jackets, belts for clothing, bike shirts, bike shorts, blouses, bodybriefers, boleros, boots, boxer shorts, bras, bustiers, camisoles, camp shirts, cardigans, chemises, coats, mittens, corsets, crop tops, decorative ribbons, namely, laces, ribbons, shoe laces, dresses, gloves, headbands, headwear, namely, hats, caps and visors, hosiery, anoraks, zippers both plastic and metal, tags of zippers, buckles, buttons, namely buttons for clothing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"). There is however an initial 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. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th)

Grounds of Opposition

The Opponent has pleaded four grounds of opposition, each of which turns on the issue of the likelihood of confusion between the Applicant's Mark and marks owned by the Opponent, namely KISS and KISS & Design, which the Opponent pleads it has previously used and/or registered in Canada in association with wearing apparel and wearing apparel accessories.

The grounds of opposition are as follows:

1. non-compliance with s. 30(i) because the Applicant could not be and can still not be satisfied that it is entitled to use the Mark in Canada since at the date of filing of the application, the Applicant was well aware of the Opponent's trade-marks and the Opponent's continued use thereof;
2. non-registrability under s. 12(1)(d) in that the Applicant's Mark is confusing with the Opponent's registered KISS & Design mark;
3. non-entitlement under s. 16(3)(a) because the Applicant's Mark was at all material times confusing with the Opponent's previously used and made known marks, KISS and KISS & Design;
4. non-distinctiveness because the Mark does not actually distinguish, and is neither adapted to distinguish nor capable of distinguishing the Applicant's wares and services from the Opponent's KISS and KISS & Design wares.

The material date with respect to the registrability ground of opposition is the latest, being today's date [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)], and I will address it first.

Section 12(1)(d) Ground of Opposition

The evidence shows that the Opponent's registration is in good standing. Therefore, the Opponent has met its initial burden. Accordingly, I will assess whether there is a likelihood of confusion between NAKED KISS wearing apparel and KISS & Design wearing apparel.

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See in general *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401]

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Each mark has some degree of inherent distinctiveness. The word KISS is not in any way descriptive of wearing apparel.

There is no evidence that either mark has acquired distinctiveness through use or promotion.

s. 6(5)(b) - the length of time each trade-mark has been in use

Based on the Opponent's certified copy, there was *de minimus* use of its KISS & Design mark as of January 3, 1980 (the date when the Opponent filed its Declaration of Use). [See *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.).]

I acknowledge that Ms. Green attested that she had no knowledge of the Opponent's KISS & Design mark being in use as of June 1, 2005. However, there is no obligation on the Opponent to evidence use of its registered mark. In this regard, the Opponent relies on *Consumers Distributing Co. v. United Consumers Club Inc.* (1991), 35 C.P.R. (3d) 259 (F.C.T.D.) where

Mr. Justice McKay stated at page 272, “It is also the case, which I note, that it is not an issue in considering the issue of confusion in an opposition proceeding, whether the registered mark of an opponent is in use or not.” [But see *Park Avenue Furniture v. Wickes/Simmons Bedding Ltd.*, *supra.*]

There is no evidence that the Applicant’s Mark has been used to date.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

Both parties’ marks are associated with wearing apparel. There is no evidence of the nature of either party’s business or trade. Nevertheless, given that both parties sell wearing apparel, it is fair to conclude that their channels of trade could overlap.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

It is the Applicant’s position that the term NAKED results in its Mark adequately conveying a different commercial impression from that conveyed by KISS & Design. In support, dictionary meanings have been provided for “naked” from the Merriam Webster Online Dictionary: not covered by clothing...; devoid of customary or natural covering...; scantily supplied or furnished... lacking embellishment. [I note that I am entitled to take judicial notice of dictionary definitions, including those on the Internet: *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446.]

The Applicant submits that the word NAKED is highly distinctive with respect to wearing apparel since it suggests the opposite of clothing.

The Opponent submits that the key component of its mark is KISS and that the Applicant’s Mark has incorporated this key component into its Mark in its entirety. It also points out that NAKED is an adjective that defines the noun KISS and that there are romantic connotations associated with both NAKED and KISS.

The Applicant has correctly cited case law that says that the first component of a mark is typically the dominant portion and that marks must be considered in their totality, not dissected. [See for example, *Park Avenue Furniture v. Wickes/Simmons Bedding Ltd., supra.*] Nevertheless, having considered the two marks as a whole, I find that there is a fair degree of resemblance between them, in part because “naked” is an adjective which puts the emphasis on the word “kiss” in the Applicant’s Mark.

Further, I note that at paragraph 29 of *Park Avenue*, where the two marks at issue were POSTURE-BEAUTY and BABYBEAUTY, the Court made the following comment concerning the overlapping word BEAUTY: “BEAUTY is a common English word descriptive of a state of being. Being a weak mark, it is entitled to a narrower range of protection than an invented or unique word.” While the overlapping word here (KISS) is an ordinary dictionary word, it is not weak because it does not have any descriptive meaning with respect to wearing apparel. The present case is therefore distinguishable from *Park Avenue* both on that basis and on the basis that in *Park Avenue* the applicant’s mark did not incorporate all of the words of the opponent’s mark.

other surrounding circumstances

i) *third party marks*

Ms. Green has provided details of the following third party KISS marks:

1. HOT KISS registered by Hot Kiss, Inc. for women’s clothing
2. HOT KISS & Design applied for by Hot Kiss, Inc. for clothing
3. FIRST KISS & Design applied for by Hot Kiss, Inc. for clothing.

Evidence of the above three marks does not assist the Applicant for several reasons. First, there is no evidence that these marks have coexisted in the marketplace with the Opponent’s Mark. Second, there is evidence that the Opponent has commenced an expungement action against the registration and opposed both applications. Third, since all three marks are owned by the same party, they do not support a conclusion that it is common to adopt marks that incorporate the word KISS in the clothing field. Fourth, three marks are insufficient to reach any conclusion concerning the state of the marketplace. [*Ports International Ltd. v. Dunlop Ltd. (1992)*, 41

C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]

The Applicant's evidence therefore falls far short of supporting its submission that the word KISS is generic.

The Opponent has asked that I take notice of the current status of the above three applications/registration. Although the Registrar will exercise her discretion to check the Register in certain limited situations, this is not one of them. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.) and *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at 529.]

ii) *failure of Opponent to oppose application for HOT KISS*

Ms. Green submits in her affidavit that the "Opponent clearly rejected the notion of any potential conflict or confusion of interested parties; including consumers, by allowing the registration of the Trade-mark HOT KISS TMA520606; marked EXHIBIT A, without commencing an Opposition proceeding". Such a conclusion is clearly unsupported; in any event, it is apparent that regardless of why an opposition was not pursued, an expungement action was commenced on January 28, 2003.

iii) *family of marks*

The Applicant alleges that it has a family of marks. However, the identity of the other alleged family members (PLANET NAKED, NAKED BEAUTY and NAKED LOVE) suggest that this would be a family of NAKED marks, not a family of KISS marks, making it irrelevant to the case at hand. In any event, a family can only be found to exist where evidence is put forward of use of each of the family members, which has not been done here. [*McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)]

iv) *expungement of other registrations owned by the Opponent*

Ms. Green has provided evidence that three Canadian trade-mark registrations owned by the Opponent for KISS BY-PAR COSACO & Design and two KISS Designs were expunged for non-use in 2002. However, as those marks have not been relied upon in the present proceedings, their expungement is irrelevant.

conclusion re likelihood of confusion

As stated by the Federal Court of Appeal in *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 at 160-163:

Simply put, the trier of fact must find that "the existence of the contested fact is more probable than its nonexistence."¹¹¹ Conversely, where a party must prove the negative of an issue, the proponent must prove its absence is more probable than its existence.

Therefore the question that I must answer is:

is it more probable than not that a Canadian consumer, with an imperfect recollection of the Opponent's KISS & Design mark as applied to wearing apparel, upon encountering wearing apparel branded with the NAKED KISS mark, is likely to conclude as a matter of first impression that the apparel share a common source?

Based on my analysis of the surrounding circumstances, I find that it is more probable than not that such a conclusion would be drawn.

The s. 12(1)(d) ground of opposition therefore succeeds with respect to the Opposed Wares.

Section 16(3) Ground of Opposition

With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16]. The Opponent has not met its initial burden and so this ground is dismissed.

Distinctiveness Ground of Opposition

In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

As the Opponent has not satisfied its initial burden, this ground is also dismissed.

Section 30(i) Ground of Opposition

This ground of opposition fails for two reasons: i) the Opponent has not evidenced that the Applicant was aware of the Opponent's alleged prior rights when it filed this application; and ii) 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. [See *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155.]

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I refuse the application but only with respect to the Opposed Wares, namely:

Clothing patches, sleepers, shirts, blazers, raincoats, capes, jumpers, Bermuda shorts, athletic sweat suits, skirts, jackets, jeans, jerseys, jewelry, jock straps, jogging suits, knitted and woven tops and bottoms, leggings, leotards, lingerie, robes, dressing gowns, housecoats, night shirts, nightgowns, overcoats, pajamas, pants, pantsuits, panty girdles, panty hose, parkas, polo shirts, pullovers, scarves, scuffs, shawls, shirts, shorts, skirts, sleeping bags, slippers, socks, sports bras, sports coats, suits, suspenders, sweaters, sweatpants, sweatshirts, swimwear, tank tops, teddies, thermal underwear, ties, tops, trousers, T-shirts, turtlenecks, undergarment thongs, undergarments, undergarment supports namely girdles, undershirts, unitards, vests, warm-up suits, wind socks for decorative purposes, footwear namely boots, dress shoes, running shoes, and sandals,

workout gloves, bandannas, bathing suits, bathing trunks, bathrobes, beach thongs, bed jackets, belts for clothing, bike shirts, bike shorts, blouses, bodybriefers, boleros, boots, boxer shorts, bras, bustiers, camisoles, camp shirts, cardigans, chemises, coats, mittens, corsets, crop tops, decorative ribbons, namely, laces, ribbons, shoe laces, dresses, gloves, headbands, headwear, namely, hats, caps and visors, hosiery, anoraks, zippers both plastic and metal, tags of zippers, buckles, buttons, namely buttons for clothing.

In other words, the application may proceed to allowance with respect to the following wares and services:

Wares:

- (1) Bags, namely sport, gym, school, travel, knapsack, book bags.
- (2) Purses, key rings, money clips, and sunglasses.
- (3) Umbrellas, peignoir sets, beach blankets, beach towels, buttons, namely ornamental novelty buttons.

Services:

- (1) Marketing, promotion and sales services for department store-type merchandise and other services over the Internet and other communication means; namely, electronic mail and messaging services; access to bulletin boards containing information and to chat lines.
- (2) Broadcasting-transmission of interactive and non-interactive messages or programs through all available commercial means, namely, films, video tapes, discs, cassettes, television and the Internet.
- (3) Distribution of visual, audio and audio visual programming through all available commercial means, namely CD ROMS, films, video tapes, discs, cassettes, television and the Internet.
- (4) Internet services, namely chat-line services and downloading of music.
- (5) Providing interactive and non-interactive multimedia services offered by way of multimedia applications, namely CD ROMS, databases, the Internet, computers, television.
- (6) Providing advertising services over the Internet.
- (7) Providing links between various worldwide web pages and sites.

DATED AT TORONTO, ONTARIO, THIS 1st DAY OF FEBRUARY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board