



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

Reference: 2014 TMOB 89
Date of Decision: 2014-04-25
TRANSLATION

IN THE MATTER OF AN OPPOSITION by La Maison Simons Inc. against applications Nos. 1,485,157 and 1,485,162 for the figurative trade-marks 'Pantone green leaf (TMA 187116) Pantone 110 grey outline 362 and 'leaf without inside colour Pantone grey outline (TMA187116) 110' in the name of 4145275 Canada inc.

Introduction

1. On June 15, 2010, 4145275 Canada inc. (the Applicant) filed applications to register the following trade-marks:

‘Pantone green leaf (TMA187116) 362 Pantone 110 grey outline’ as illustrated:



application No. 1,485,157 (hereinafter sometimes called Mark1); and

'leaf without inside colour Pantone grey outline (TMA187116) 110' as illustrated:



application No. 1,485,162 (hereinafter sometimes called Mark2)

2. Both applications are based on a planned use in association with:

clothing for men, women and children, specifically: camisoles, sweaters, T-shirts, polo shirts, shorts, jackets, pants, dresses, shirts, blouses, capris, lightweight insulated overcoats, cardigans, lightweight insulated sports coats, sports undergarments, highly technical layered coats, waterproof and semi-waterproof coats, insulated pants, sports pants, sports underwear, lingerie and boxers; - Footwear for women, men and children, specifically boots, booties and insulated and non-insulated dress shoes, dress sandals and sports and walking sandals, dress mules and sports and walking mules; - Accessories for women, men and children, specifically: scarves, hats, headbands, mufflers, gloves, mittens, glasses, belts, belt buckles, collars, stockings, socks, leggings, anoraks, backpacks, handbags, caps, hats, visors; - Outdoor items: canvas covers, walking sticks, aluminum bottles (the Wares); and

Sale of clothing, shoes, outdoor items and ready-to-wear (the Services).

3. These applications were published on October 5, 2011 in the *Trade-Marks Journal* for the purposes of opposition.

4. On March 5, 2012, La Maison Simons Inc. (the Opponent) filed a statement of opposition in each of these files. The grounds of opposition raised in both oppositions are based on sections 30(i), 30(b), 30(e), 12(1)(d), 16(3)(a) and 2 of the *Trade-marks Act*, RSC (1985), ch T-13 (the Act). They are described in greater detail in Appendix A of this decision. In each of these files, the Applicant filed an identical counter-statement of opposition rejecting each and every ground of opposition.

5. In each of these files:

- The Opponent filed an affidavit by Isabelle Gagné.
- The Applicant filed no evidence;
- Only the Opponent filed a written pleading; and
- A hearing was not held.

6. I will first have to determine whether the Opponent has filed sufficient evidence to support its grounds of opposition. If such is the case, I must then decide whether or not each of them is well-founded.

7. In each of these files, and for reasons more amply described below, I believe that the Opponent has not met its initial burden of proof in regard to the grounds of opposition based on sections 30(i), 30(b) and 30(e) of the Act. It has, however, met its initial burden of proof in regard to the other grounds of opposition. The latter are partially accepted, since the Applicant was unable to show, according to the balance of probabilities, that the use of Mark1 and Mark2 did not risk creating confusion with the Opponent's leaf Design mark (as defined below), except for the outdoor items: tarpaulins, walking sticks, aluminum bottles; and the sale of outdoor items.

Evidentiary burden

8. Under the procedure in the matter of opposition to the registration of a trade-mark, the Opponent must present sufficient elements of evidence concerning the grounds of opposition that it raises in order that it is apparent that there exist facts that can support these grounds of opposition. If the Opponent is in compliance with this requirement, the Applicant would then have to convince the registrar, according to the balance of evidence, that the trade-mark is registrable [see *Joseph Seagram & Sons Ltd v. Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325(TMOB) and *John Labatt Ltd v. Molson Companies Limited* (1990), 30 CPR (3d) 293(CF 1st inst)].

Preliminary comments

9. Since the Applicant filed no evidence and no written pleading, I will analyze each ground of opposition on the basis of the evidence filed by the Opponent, while drawing on its written pleading. This does not necessarily mean to say that I must fully concur with the Opponent's claims in the absence of arguments able to support the contrary position.

10. The grounds of opposition, the evidence and the written pleadings are near-identical in both files. In order to facilitate the writing and reading of this decision, I will refer to both registration applications in using the term 'the application;' to both opposition procedures in using the term 'opposition;' and to Mark1 and Mark2 in using the term 'Mark,' except where indicated otherwise.

Grounds of opposition rejected for lack of evidence

11. The Opponent filed no evidence able to support the grounds of opposition based on sections 30(b) and (e) of the Act. Accordingly, they are rejected as the Opponent has not met its initial burden of proof.

12. In regard to the ground of opposition based on section 30(i), the Act requires only that the Applicant declares being convinced of having the right to use the Mark. The statement is included in the application. The so-called knowledge of the Opponent's marks due to their use over the years is insufficient in itself to support a ground of opposition based on section 30(i) of the Act. This section of the Act could be raised in very specific cases, including when the Applicant's statement had been made in bad faith [see *Sapodilla Co Ltd v. Bristol Myers Co.* (1974) 15 CPR (2d) 152 (TMOB)]. This has neither been claimed nor proven in these files. Accordingly, this ground of opposition is also rejected.

Ground of opposition based on section 12(1)d) of the Act

13. The Relevant date for analyzing this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413, on page 424 (FCA)].

14. The affidavit of Isabelle Gagné, the Opponent's advertising manager for 15 years, contains certificates of authenticity for the following trade-marks:



Registration certificate TMA232936 in association with a long list of wares including, clothing for men and women, mules for men and women, scarves and gloves for men and women, hats for men and women, caps, headbands, jewelry, belts for men and women, sunglasses, stockings, purses



Registration certificate TMA660718 (leaf Design) in association with a long list of wares including clothing for men and women, shoes, slippers, moccasins, running shoes, sports shoes, snowboarding glasses, shoulder bags, and services, including retail store operations for the sale of clothing for men and women children, and their accessories;



simons

Registration certificate TMA747064 (SIMONS & Design) in association with a long list of wares, including clothing for men and women, shoes, slippers, moccasins, sports shoes, hats, caps, headbands, stockings, jewelry, purses, and services, including retail store operations for the sale of clothing for men and women children, and their accessories. The colour is claimed as being characteristic of this trade-mark. The leaf is green and the word SIMONS is black.

15. I checked the register and these registrations are still in effect. The Opponent has therefore fulfilled its initial burden of proof.

16. I believe that the Opponent has a better chance of success in comparing the Mark with its leaf Design mark, registration TMA660718. If it cannot win its case with this registration, it would scarcely have a better chance of success with the other registrations. Accordingly, I will focus my analysis on this registration, except where indicated otherwise.

17. It is therefore incumbent on the Applicant to prove, according to the balance of probabilities, that the use of the Mark in association with the Wares and Services does not risk creating confusion with the leaf Design mark. The test to be applied to rule on this issue is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather confusion regarding the source of the wares and services. Accordingly, I have to determine whether a consumer who sees the Wares and Services in association with the Mark would believe they originate from the Opponent or are authorized by the latter.

18. I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctive character of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of wares, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest. This list is not exhaustive, and it is not necessary to grant the same weight to each of these factors.

19. In its ruling on *Masterpiece Inc v. Alavida Lifestyles Inc et al* 2011, SCC 27, the Supreme Court of Canada interpreted section 6(2) of the Act and enlightened us as to the scope of the various criteria listed in section 6(5) of the Act.

The inherent distinctiveness of trade-marks and the extent to which they have become known

20. The Mark consists in a Design having no relationship to the Wares and Services to which it is associated. The same remarks apply to the Opponent's leaf Design mark.

21. The distinctiveness of a mark can be enhanced by its use and the extent to which it has become known in Canada. However, there is no evidence of use of the Mark in Canada.

22. However, Ms. Gagné filed the following evidence concerning use of the SIMONS & Design mark:

- Photos of clothing and accessories bearing a label displaying the SIMONS & Design mark, i.e. T-shirts, camisoles, jackets, shirts, suit jackets, stockings, underwear, sweaters, shoes, moccasins, jewelry, sunglasses, hats, scarves, gloves and mittens (exhibits 2, 3 and 4 of her affidavit);
- Photos of fabric labels and packaging displaying the SIMONS & Design mark used by the Opponent;
- Photos of reusable bags sold in the store and displaying the SIMONS & Design mark;
- Photo of coat hangers displaying the SIMONS & Design mark used to hang a large number wares sold in the store and which are given to consumers on request when purchasing wares;
- Photo of a gift box displaying the SIMONS & Design mark given on request when purchasing wares during the Holidays; and
- Photo of a credit card and an envelope displaying the SIMONS & Design mark.

23. Ms. Gagné confirms that these photos are a good illustration of how the SIMONS & Design mark has been used by the Opponent since as early as at least 1990 in association with these wares.

24. There is also some evidence of use of the leaf Design mark:

- Photo of tissue paper bearing the leaf Design mark;
- Photos of the Opponent's indoor business signs showing the leaf Design mark;
- Photo of the Opponent's indoor business carpet showing the leaf Design mark;
- Photo of a business card bearing the leaf Design mark;
- Photo of wares packing paper showing the leaf Design mark; and
- Photos of bags showing the leaf Design mark.

25. Ms. Gagné states that the Opponent had promoted its leaf Design and its SIMONS & Design marks. Accordingly, the Opponent had invested some \$90 million in the period 2000 to

2011. Ms. Gagné provided the annual amount invested during these years. She filed a sample of ads published in daily newspapers, including *La Presse*, *The Gazette* and *Le Soleil*. I am prepared to take legal notice that *La Presse* and *The Gazette* newspapers are distributed in Montreal and that *Le Soleil* is distributed in Quebec City, but nothing more [see *Carling O'Keefe Breweries of Canada Ltd- Les Brasseries Carling O'Keefe du Canada ltée-Trading as Carling O'Keefe Breweries v. Anheuser Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB)]. Each of the ads was to promote SIMONS clothing and stores in association with the SIMONS & Design mark.

26. Ms. Gagné also filed catalogues printed in over 630,000 copies per shipment that were mailed to the Opponent's clientele since 1993. The catalogues filed date back to the period 2003 to 2012.

27. Lastly, Ms. Gagné states that since 2004, the Opponent had also promoted its stores and its wares on its website. She filed excerpts from this website dated March 26, 2010 and September 6, 2012. The SIMONS & Design mark appears on each of the pages filed.

28. All this evidence leads me to conclude that the leaf Design mark is intimately associated with the Opponent as is the SIMONS & Design mark. In effect, wares displaying labels on which is found the SIMONS & Design mark are wrapped in silk paper or packing showing the leaf Design mark and placed in bags showing the leaf Design mark.

29. Accordingly, I believe that a consumer would associate the source of wares showing the SIMONS & Design mark with the same source as that of wares showing the leaf Design mark. Moreover, the graphic portion of the SIMONS & Design mark corresponds to the leaf Design mark. Due to the principles stated in the ruling of *Registrar of Trade Marks v. Compagnie L'informatique CII Honeywell Bull, Société Anonyme et al* (1985), 4 CPR (3d) 523 (FCA), I believe therefore that use of the SIMONS & Design mark in association with the wares as use of the leaf Design mark.

30. Accordingly, in the light of all this evidence, I believe that the leaf Design mark is known in Canada in association with clothing for men and women and accessories and with the operating services of stores selling these wares.

31. Consequently, the combinations of inherent and acquired features of distinctiveness of the marks in question clearly favour the Opponent.

The period during which the trade-marks have been in use

32. The evidence shows that the Opponent used the leaf Design mark in association with clothing for men and women and accessories, and with the operating services of retail stores for these wares since at least 1990, whereas I have no evidence of use of the Mark in Canada. This factor therefore favours the Opponent.

The type of wares and the nature of the business

33. In considering the type of wares and services, and the nature of the business, I must compare the statement of wares and services covered by the application being opposed with the statement of wares and services covered by the registration(s) claimed in the statement of opposition [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v. Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

34. It is clear from the description of the Wares and Services that there is some overlap between the latter and the wares and services described on registration certificate TMA660718, except in regard to the Applicant's outdoor items: tarpaulins, walking sticks, aluminum bottles and the sale of outdoor accessories.

35. I have no evidence of the nature of the Applicant's business. I can presume that the nature of its business is the same or similar to that of the Opponent due to the overlap that exists between the Wares and Services and those of the Opponent.

36. These factors also therefore favour the Opponent, except for the wares and services related to the outdoor activities mentioned above.

The degree of similarity between the trade-marks

37. I recall that the Supreme Court of Canada, in its *Masterpiece ruling, supra* clearly indicated that the degree of similarity between the marks is the most important factor among those listed in section 6(5) of the Act.

38. The two marks consist in representations of leaves expanded at the pointed end having the same shape. There are therefore enough visual similarities between the Mark and the leaf Design mark. There are also similarities in the ideas these marks suggest, i.e. a vague reference to the environment or flora.

39. This factor therefore also favours the Opponent.

Conclusion on the likelihood of confusion

40. The registrar must place him/herself in the position of a regular consumer having a vague recollection of the Opponent's leaf Design mark and who sees the Mark at a subsequent date. He/she must determine, on the basis of a first impression whether the consumer risks believing that the Wares and Services associated with the Mark come from the same source or are otherwise related or associated with the wares and services sold in association with the leaf Design mark.

41. In light of the analysis of the factors listed in section 6(5) of the Act, I conclude that the Applicant has not fulfilled its burden of proof, according to the balance of probabilities, that the Mark does not risk creating confusion with the Opponent's leaf Design mark when the Mark is used in association with the Wares and Services, with the exception of outdoor items, tarpaulins, walking sticks, aluminum bottles and the sale of outdoor accessories.

42. I must stress that even if I had concluded that use of the SIMONS & Design mark was not equivalent to use of the leaf Design mark I would eventually have arrived at the same conclusion. In effect, there is some evidence in the file record of use of the leaf Design mark in association with wares, i.e. their packing (tissue paper, packaging and bags). My analysis of other criteria, all of which favour the Opponent, is not affected by this conclusion. This conclusion on use of the leaf Design mark affects only my analysis of the first criterion in section 6(5) of the Act.

43. Accordingly, I partially uphold the ground of opposition based on section 12(1)(d) of the Act.

Grounds of opposition based on section 16(3)(a) and the absence of distinctiveness of the Mark

44. Under the ground of opposition based on section 16(3)(a) of the Act, the Opponent had the initial burden of proving use of its marks before the filing date of the registration application (June 15, 2010) [see section 16(3) of the Act]. Regarding the ground of opposition based on the absence of distinctiveness of the Mark, the Opponent had to show that its marks were sufficiently known in Canada on the filing date of its statement of opposition (March 5, 2012) [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. The Opponent's evidence described above does not enable me to conclude that the Opponent has met its initial burden of evidence regarding these two grounds of opposition.

45. Although these grounds of opposition must be examined as at different dates than that associated with the ground of opposition based on section 12(1)(d), these differences in dates have no significant impact on the analysis of the various criteria listed under section 6(5) of the Act.

46. Except for outdoor items: tarpaulins, walking sticks, aluminum bottles and the sale of outdoor accessories, I conclude that, as at the relevant dates, the Applicant was not the person

entitled to registration of the Mark pursuant to section 16(3) of the Act and that the Mark was not distinctive within the meaning of section 2 of the Act.

47. I therefore also partially accept these two grounds of opposition.

Disposal

48. In exercising the authority delegated to me by the Registrar of Trade-marks pursuant to section 63(3) of the Act, I reject registration applications Nos. 1,485,157 and 1,484,162 for the Applicant's Mark1 and Mark2 in regard to:

Clothing for women, men and children, specifically: camisoles, sweaters, T-shirts, polo shirts, shorts, jackets, pants, dresses, shirts, blouses, capris, lightweight insulated overcoats, cardigans, lightweight insulated sports coats, sports underwear, highly technical layered coats, waterproof and semi-waterproof coats, insulated pants, sports pants, sports underwear, lingerie and boxers; - Footwear for men, women and children, specifically boots, bootees and insulated and non-insulated dress shoes, dress sandals and sports and walking sandals, dress mules and sports and walking mules; - Accessories for women, men and children, specifically: scarves, hats , headbands, mufflers, gloves, mittens, glasses, belts, belt buckles, collars, stockings, socks, leggings, anoraks, backpacks, purses, caps, hats, visors; and

Sale of clothing; shoes and ready-to-wear items.

and I reject the oppositions to registration applications nos. 1,485,157 and 1,484,162 for the Applicant's Mark1 and Mark2 in regard to:

Outdoor items: tarpaulins, walking sticks, aluminum bottles; and

Sale of outdoor accessories.

the whole pursuant to the provisions of section 38(8) of the Act [see *Produits Ménagers Coronet Inc v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (CF1st inst) as an example of authority for a shared decision].

Jean Carrière
Member of the Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers

Appendix A

The grounds of opposition can be summarized as follows:

1. The application for registration does not satisfy the requirements of section 30(i) of the *Trade-marks Act*, R.S.C. 1985, ch. T-13 ("Act") in that the Applicant had or should have had knowledge, when filing the registration application, of the Opponent's marks as well as the extent of the use by the Opponent and their recognition in Canada in association with the Opponent's wares and services which predate the registration application. The Applicant could not therefore be convinced of its right to use the Mark in Canada in association with the Wares and Services;
2. The registration application does not meet the requirements of section 30(e) of the Act in that the Applicant had, when filing registration application, no intention of using the Mark in Canada as a trade-mark;
3. The registration application does not meet the requirements of section 30(b) of the Act in that the Mark was used in Canada in the normal course of business prior to the filing date of the registration application and no date of first use was indicated;
4. The Mark was not registrable since it contravenes the provisions of section 12(1)(d) of the Act in that, at any relevant time, it creates confusion with the Opponent's following registered marks:
 - SIMONS and Design (TMA747064)
 - Leaf logo (TMA232936)
 - Leaf Design (TMA660718)
5. The Applicant is not the person entitled to registration of the Mark in regard to the provisions of section 16(3)(a) of the Act in that, at any relevant time, it creates confusion with the Opponent's marks which have been widely used and continue to be used in Canada by the Opponent in association with its wares and services;
6. The Mark is not and cannot be distinctive within the meaning of section 2 of the Act in that the Mark creates confusion with the Opponent's marks which have been widely used and displayed in Canada prior to the filing date of the registration application in association with the Opponent's wares and services.