



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

Citation: 2014 TMOB 129
Date of Decision: 2014-06-25

**IN THE MATTER OF AN OPPOSITION
by Maurices Incorporated to application
No. 1,477,758 for the trade-mark
MAURICE in the name of Dollarama L.P.**

[1] Maurices Incorporated opposes registration of the trade-mark MAURICE applied for registration under serial No. 1,477,758 in association with a variety of products for storing and hanging various types of items, such as clothing, clothing accessories, footwear, jewellery and bedding.

[2] The application was filed by Dollarama L.P. (the Applicant) on April 21, 2010. It is based upon proposed use of the trade-mark MAURICE (the Mark) in Canada.

[3] Maurices Incorporated (the Opponent) brought the opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by statement of opposition filed on March 21, 2011.

[4] Each party filed evidence and a written argument, and was represented at a hearing.

[5] The determinative issue in this proceeding is whether the Mark is confusing with the Opponent's trade-mark MAURICES of registration No. TMA776,138 for cosmetics, jewellery, bags, clothing and footwear as well as retail store services specializing in women's fashion clothing and footwear. The particulars of the registration are reproduced in annex.

[6] For the reasons that follow, I find that the opposition ought to be rejected.

Grounds of Opposition

[7] The statement of opposition, as originally filed, alleged seven grounds of opposition. However, at paragraph 18 of its written argument, the Opponent indicated withdrawing four grounds of opposition, namely those based upon non-compliance of the application with sections 30(b), (e) and (i) of the Act and non-entitlement based upon section 16(3)(c) of the Act. The latter was premised on an allegation of confusion between the Mark and the Opponent's trade-name MAURICES.

[8] The three remaining grounds of opposition are premised on allegations of confusion between the Mark and the Opponent's trade-mark MAURICES. They raise the following issues:

1. Is the Mark registrable?
2. Was the Applicant the person entitled to registration of the Mark at the filing date of the application?
3. Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

Evidence of Record

[9] The Opponent's evidence consists of the affidavits of Brian Thun, Vice-President and Controller of the Opponent, sworn November 18, 2011, and Giuseppe Anzuino, a paralegal employed by the Opponent's trade-marks agent, sworn November 24, 2011. Mr. Thun and Mr. Anzuino were not cross-examined.

[10] On February 20, 2013, the Opponent requested leave to file further evidence consisting in a second affidavit of Mr. Thun and an affidavit of Thomas J. Karis. As the Opponent's request was pending when the Opponent filed its written argument, these affidavits are referenced in the Opponent's written argument. However, the Opponent's request was refused by the Registrar on March 12, 2013; this was acknowledged by the Opponent at the hearing. Thus, I have disregarded these two affidavits as well as any references to them in the Opponent's written argument.

[11] The Applicant's evidence consists of the affidavits of Geoffrey Robillard, Senior Vice-President-Import Division of the Applicant, sworn March 21, 2012, and Celine Wong, a legal secretary employed by the Applicant's trade-marks agent, sworn March 1, 2012. Mr. Robillard and Ms. Wong were not cross-examined.

Legal Onus and Evidential Burden

[12] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Analysis of the Issues

[13] I will analyse in turn the issues that arise from the three remaining grounds of opposition.

Is the Mark registrable?

[14] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-mark MAURICES of registration No. TMA776,138.

[15] The material date for considering the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[16] Having exercised the Registrar's discretion, I confirm that registration No. TMA776,138 is extant. Thus, the Opponent has met its evidential burden. The question becomes whether the

Applicant has met its legal onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's registered trade-mark MAURICES.

[17] 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.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[19] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis by considering that factor. Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the marks.

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

[20] The Applicant does not dispute that the trade-marks are essentially identical and that this factor clearly favours the Opponent.

Section 6(5)(a) - The inherent distinctiveness of the trade-marks and the extent to which they have become known

[21] I find that the Mark has little inherent distinctive character since it consists in the forename Maurice [see by analogy the comment of Justice Binnie in *Mattel, Inc., supra*, at para. 3, to the effect that the forename Barbie, in fact a regular diminutive of the forename Barbara, does not have as such an inherent distinctive character]. I would add that the weakness of the Mark as a forename has been acknowledged by the Applicant at the hearing.

[22] At the hearing, the Opponent acknowledged that its trade-mark MAURICES, although ending with the letter “s”, could be perceived as the forename Maurice.

[23] In the end, I consider that the trade-marks at issue are not inherently strong.

[24] A trade-mark may acquire distinctiveness by means of it becoming known through use or promotion in Canada. Thus, I shall now consider the evidence of record concerning the promotion and use of the parties’ trade-marks, starting with the Opponent’s evidence.

Affidavit of Brian Thun

[25] From the outset, I note that the Opponent acknowledged at the hearing that the evidence it filed through the affidavit of Mr. Thun does not establish use of the trade-mark MAURICES in Canada in association with its wares and services. The Opponent submits, however, that its evidence supports a finding that the trade-mark MAURICES has become well known in Canada because of its use in the United States and extensive advertisement in Canada.

[26] The testimony of Mr. Thun about the Opponent’s business may be summarized as follows [para. 5 to 11 of the affidavit]:

- the Opponent is a U.S. based company operating in the retail clothing and clothing accessories industry since approximately 1931. It started out as a small women’s fashion shop in Duluth, Minnesota, and has grown to 783 women’s apparel store in 44 states across the United States;

- in addition to clothing, the Opponent sells a variety of wares including cosmetics, jewellery, bag and footwear under its house brand MAURICES;
- the Opponent has an active website at *www.maurices.com* since at least as early as 2004. The website features an e-commerce boutique, which allows customers to place orders online, since at least as early as October 2009 [Exhibit BHT-1]. The Opponent's website would have been visited by 180,991 Canadians between September 22, 2009 and September 30, 2011 [Exhibit BHT-2];
- the Opponent has more than 200,000 followers on the social media *Facebook* [Exhibi BHT-3]; and
- the Opponent incorporated an Ontario company under the name Maurices Canada Stores Limited on October 26, 2010. The incorporation date is the only information provided by the affiant about this company.

[27] Mr. Thun provides a summary of the Opponent's gross sales "(including sales that have been made to Canadians) of wares bearing the trade-mark MAURICES" for each of the years 2002 to 2011. These went from US\$354,562,028 to US\$776,485,373 [para. 17 of the affidavit]. According to the Opponent's customer relations records, approximately 14,000 Canadians would have shopped in the Opponent's stores; this number represents only the Canadians who accepted to give their coordinates [para. 19 of the affidavit].

[28] Mr. Thun also provides a summary of the Opponent's advertisement expenditures for the promotion in North America of the wares and services associated with the trade-mark MAURICES. These expenditures "include direct mailer costs, photo shoots expenses, in-store signage costs, store grand opening costs, social media services, CRM professional services and system's outsourcing, payroll and benefits for the area, special events costs (contest in store), travel, advertisement placed in magazines, etc.". The expenditures provided for each of the years 2002 to 2011 went from US\$3,715,544 to US\$15,983,401 [para. 25 of the affidavit].

[29] Finally, the documentary evidence furnished by Mr. Thun in support of his testimony about the use and advertisement of the Opponent's trade-mark MAURICES includes:

- photographs of slippers and belts hangers bearing the trade-mark MAURICES [Exhibit BHT-7]. These hangers are given to customers as part of their purchase [para. 16 of the affidavit];
- copies of photographs of the Opponent's stores, which illustrate use of the trade-mark MAURICES on exterior signage [Exhibit BHT-8];
- examples of hang tags which appear on or are attached to the wares sold in the Opponent's stores [Exhibit BHT-9];
- copies of photographs to show typical use of the trade-mark MAURICES on different wares sold by the Opponent [Exhibit BHT-10];
- photograph of a jewelry organizer sold by the Opponent [Exhibit BHT-11]; and
- excerpts of magazines provided as "typical examples of magazines distributed in Canada which have made mention" of the Opponent's trade-mark and wares, namely: *Cosmopolitan*, May 2009; *O The Oprah Magazine*, January 2010; *Glamour*, April 2010; *Seventeen*, August 2011; *All you*, June 2011; and *Redbook*, July 2011 [Exhibit BHT-12];
- copy of an advertisement in the September 2010 issue of *InStyle* magazine [Exhibit BHT-13]; and
- a list of publications in which "advertising literature" regarding the wares and services offered under the Opponent's trade-mark has been published [Exhibit BHT-14].

[30] For the reasons that follow, I do not agree with the Opponent that its evidence establishes that the trade-mark MAURICES is well known in Canada.

[31] I am not affording any weight to the evidence about the presence of the Opponent on the social media *Facebook*. Suffice it to say that we do not know the number of “followers” from Canada.

[32] Insofar as the Opponent’s website is concerned, I stress that the Opponent does not dispute not having provided evidence of Canadians purchasing wares through the e-commerce boutique featured on its website since October 2009. Also, there is no clear statement from Mr. Thun that the trade-mark MAURICES depicted at the top left corner of the print-outs is consistent with the manner in which the trade-mark would have been depicted on the Opponent’s website since 2004. In any event, there is no evidence about Canadians having accessed the Opponent’s website prior to September 22, 2009. Finally, I afford limited weight to Mr. Thun’s statement that the website would have been visited by 180,991 Canadian visitors between September 22, 2009 and September 30, 2011. Aside from the fact that Exhibit BHT-2, which is the basis of Mr. Thun’s statement, apparently originates from a third party, there is no indication that these were 180,991 unique Canadian visitors. In other words, the number provided may include Internet users located in Canada who “visited” the website multiple times.

[33] I should also note that I can see a description beneath each of the items illustrated on the e-commerce boutique, but I cannot read any of these descriptions due to the quality of reproduction. Thus, I cannot ascertain whether all of the items are solely associated with the trade-mark MAURICES or with any other trade-marks.

[34] Now turning to the gross sales figures, it should be noted that they are not broken down by wares or, at the very least, by category of wares, such as cosmetics, jewellery, bags, clothing and footwear. In addition, there is no indication as to which portion of the gross sales of wares bearing the trade-mark MAURICES were made to Canadians in each of the years 2002 to 2011. Thus, I am left with Mr. Thun’s evidence about Canadians who would have shopped in the Opponent’s stores in the United States.

[35] We do not know the period covered by the Opponent's records purportedly showing that approximately 14,000 Canadians would have shopped in the Opponent's stores. Also, we do not know how this number was arrived at. Does it reflect 14,000 different Canadians? Is there any possibility that the number reflects repeated Canadian shoppers? Even if am to accept it as the approximate minimum number of different Canadians having shopped in the Opponent's stores in the United States over the years up to the date of Mr. Thun's affidavit, I am not ready to conclude that this number by itself is sufficient to establish that the trade-mark MAURICES has become well known in Canada in association with the Opponent's wares and services.

[36] While the advertisement expenditures for North America are substantial, there are too many deficiencies attaching to this evidence in general to draw any conclusion favourable to the Opponent. For one thing, with due respect for the Opponent, in my view the advertisement expenditures are distorted by the inclusion of expenditures that may not reasonably be associated to advertisement, such as "payroll and benefits for the area" and "travel". In addition, we do not know which portion of the "advertisement expenditures" encompasses advertising in Canada, be it direct or spill-over advertising. In any event, given the evidence of record, it must be concluded that "in-store signage costs", "store grand opening costs" and "special events costs (contest in store)" would not apply to Canada. Finally, since the Opponent did not provide a breakdown of the expenditures for the different types of advertising, we do not know the amount of money spent for advertising that may be relevant, such as advertisement placed in magazines having a Canadian circulation. This leads me to turn to Exhibits BHT-12 to BHT-14 of the Thun affidavit.

[37] I note that I am permitted to take judicial notice of the fact that certain magazines have some degree of circulation in Canada [see by way of analogy *Timberland Co v Wrangler Apparel Corp* (2004), 38 CPR (4th) 178 (TMOB)]. Even if I accept to take judicial notice of Canadian circulation of the magazines *Cosmopolitan*, *O The Oprah Magazine*, *Glamour*, *Seventeen* and *InStyle*, I find the evidence insufficient to establish any reputation for the Opponent's trade-mark MAURICES in Canada. Suffice it to say that we do not have any evidence about the volume or value of advertisements in these magazines over the years; all that we have is one specimen of advertisement in each magazine [Exhibits BHT-12 and BHT-13]. I would add that the advertisements in *Cosmopolitan* and *O The Oprah Magazine* mention

“maurices.com”; not the trade-mark. Also, the advertisement in *Cosmopolitan* is for FANTAS-EYES branded eyewear. Finally, in addition to the absence of specimens of “advertising literature” published in the publications listed under Exhibit BHT-14, there is no evidence establishing that these publications were circulated in Canada or made accessible to Canadians.

[38] Even if I accept that the Opponent’s evidence may be sufficient to establish that the trade-mark MAURICES has become known to some extent in Canada, I find it is insufficient to establish that the trade-mark has become known to a significant extent. In any event, in view of the Applicant’s evidence, which I discuss below, I definitely do not accept the Opponent’s evidence as establishing that the trade-mark MAURICES has become known to a greater extent than the Mark.

Affidavit of Geoffrey Robillard

[39] The testimony of Mr. Robillard about the Applicant’s business and use of the Mark may be summarized as follows [para. 3 to 5, 8 to 10 of the affidavit]:

- the Applicant operates retail discount stores across Canada under the trade-name Dollarama;
- the Applicant is the largest retailer in Canada of items for \$2.00 or less. A listing of all of the Dollarama retail outlets in Canada is attached as Exhibit 1;
- in late January 2010, the Applicant adopted the Mark to identify a line of storage products to be sold in its retail outlets;
- since the filing of the application, the Applicant has begun selling the storage products in association with the Mark in all of its Dollarama retail outlets across Canada; the Mark appears on the packaging and/or header cards for each of the storage products.
- Mr. Robillard files samples of each of the storage products sold in association with the Mark, namely: metal hangers; wood hangers; over the door hooks; pants

hangers; closet organizer; plastic shoe box; under bed storage bag; over-the-door hook rack; jumbo blanket bag; hanging vacuum bag; multi-purpose double hook; metal wall hook; swivel coat hanger; all-purpose hanger clips; smart hangers; plastic hangers, press pant hangers, velvet pant hanger; and towel ring [Exhibits 2 to 20]. I note that in all cases, the sample shows the Mark displayed either on the packaging or a header card; and

- an approximate total of 2,667,477 units of storage products associated with the Mark were sold in the Dollarama retail outlets from April 22, 2010 to February 29, 2012.

[40] In the end, I agree with the Applicant that its evidence enables me to conclude that the Mark has become known in Canada to a greater extent than the Opponent's trade-mark.

Conclusion on the section 6(5)(a) factor

[41] I assess the inherent distinctiveness of the parties' trade-marks as about the same; neither trade-mark is inherently strong. However, the evidence leads me to find that the Mark is known to a greater extent in Canada than the Opponent's trade-mark. Thus, I conclude that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, lends support to the Applicant's case.

Section 6(5)(b) - The length of time the trade-marks have been in use

[42] The Opponent's registration issued on the basis of registration and use of the trade-mark MAURICES in the United States and there is no evidence establishing use of the trade-mark in Canada. By contrast, the Applicant's evidence establishes use of the Mark in Canada further to the filing of the application.

[43] Accordingly, the length of time the Mark has been in use in Canada does weigh in the Applicant's favour.

Section 6(5)(c) - The nature of the wares, services or business

Section 6(5)(d) - The nature of the trade

[44] It is the statement of wares in the application for the Mark and the statement of wares and services in the Opponent's registration that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. This was recently reiterated by the Federal Court in *Bridgestone Corporation v Campagnolo SRL*, 2014 FC 37 where the Court stated the following at paragraphs 55 and 56:

[55] Further clarification was given recently by the Federal Court of Appeal in *Movenpick Holdings AG v Exxon Mobil Corp*, 2013 FCA 6, at para 6, where the Court cited with approval the Registrar's comments: "The parties' respective statements of services must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording (see *McDonald's Corp v. Coffee Hut Stores Ltd.* (1994), 55 C.P.R. (3d) 463 (FCTD)".

[56] I find that the Registrar followed the instructions of the Court of Appeal by considering all of the predictable and usual channels of trade in which products would be sold in rather than all hypothetical channels.

[45] The statement of wares of the application for the Mark, as amended on September 15, 2010, reads as follows:

Over-the-door hook racks, hangers with clips, storage racks, hanger hampers, self-adhesive and screw-in hooks, drawer separators/organizers, sock hangers, tie/belt racks, under bed storage bags, over-the-door hanger hooks, clothes hangers, pant/shirt press hangers, garment hangers, blanket bags, under shelf racks, foldaway clothes hangers, metal hangers, shoulder shapers, hook hanger support, wire shelf, cedar hangers, wood hangers, storage organizer, hanging mesh organizer, wall rack with hooks, shoe racks, storage containers, jewellery organizers and coat racks.

[46] The Opponent's registration No. TMA776,138 covers cosmetics, jewellery, bags, clothing and footwear, and retail stores services specializing in women's fashion clothing and footwear [see annex of my decision].

[47] It should be noted that the parties devoted a large part of their submissions to the consideration of the section 6(5)(c) and (d) factors, especially at the hearing, to review the evidence of record and case law purportedly supporting their respective cases.

[48] For the purposes of the analysis of the section 6(5)(c) and (d) factors, I will summarize in turn the Opponent's submissions, the Anzuino affidavit, the Applicant's submissions and the Wong affidavit. I will conclude with my discussion of these factors.

Submissions of the Opponent

[49] Although lengthy, I believe the best way to summarize the Opponent's submissions is to reproduce the following excerpts of its written argument:

90. The parties' respective wares are intimately related by nature and the parties [*sic*] respective wares bearing the trade-marks MAURICES and MAURICE will undoubtedly be perceived by the relevant consumer as having the same source. At the very least, in the consumer's mind, it is certainly a natural extension for a clothing and footwear retailer to offer storage products for clothing and footwear such as those listed in the Applicant's Application;
 91. The relevant consumer would expect to find the parties' respective wares in the same stores, i.e. stores offering specializing clothing and footwear, and both parties evidence shows that this is the case;
 92. More particularly, the Opponent's evidence clearly demonstrates that it is common for retailers operating stores similar to the Opponent's retail stores to offer a variety of wares, including various housewares such as storage items, in addition to clothing.
- [...]
99. In [the decision *ERA Display Co Ltd v Global Upholstery Co Ltd* (1994), 58 CPR (3d) 429] the Trade-Marks Opposition Board expressed the opinion that it would seem reasonable to assume that a manufacturer of hangers, display racks and shelving and the like would also be involved in supplying items such as tables and chairs for use in the retail area where clothing is sold.
 100. In the same way, in the present opposition proceeding, the Opponent submits that a Canadian consumer would naturally assume that a manufacturer and retailer of clothing, footwear and related accessories is also involved in the supply of sale and clothes hangers and storage products, which are all of the same general class and are in fact accessories related to clothing and footwear.

[50] I note in passing that the Opponent in its written argument stated that it failed to see the relevance and usefulness of the Wong affidavit, which I discuss later on. The Opponent stated that it “shall comment on [the affidavit] more fully, if required, at the oral hearing after having taken cognizance of the Applicant’s written arguments pertaining to this affidavit” [para. 56 of the written argument]. Yet, the Opponent did not comment on the Wong affidavit at the hearing.

[51] In support of its submissions, the Opponent relies on:

- Mr. Thun’s statements that it is common for retail stores similar to the Opponent’s stores to offer a variety of wares in addition to clothing and that many clothing stores and department stores in Canada offer in their stores, in addition to clothing, home furniture and housewares, including the wares listed in the application for the Mark [para. 15 of the Thun affidavit]. In support of his statements, Mr. Thun filed extracts from the websites of the clothing stores Forever 21 and Urban Outfitters and the department store The Bay [Exhibit BHT-6]. At the hearing, the Opponent acknowledged that all prices indicated on the Urban Outfitters website are in pounds sterling, but the Opponent pointed out that the last extract references stores location in Québec City and Montreal;
- the fact that every clothing store owner uses hangers and racks to support and expose clothing and shoes offered for sale in their stores;
- Mr. Robillard’s admissions that footwear and clothing are sold in the Applicant’s retail outlets, in addition to storage products [para. 11 and 12 of the Robillard affidavit]. The Opponent points out that the “sandal” and “slippers” listed by Mr. Robillard among footwear sold in the Applicant’s retail outlets are covered by its registration as are most of the items listed by Mr. Robillard as clothing sold in the Applicant’s retail outlets; and
- the affidavit of Giuseppe Anzuino, which I discuss below. The Opponent submits that this affidavit establishes that it is common for at least some of the Opponent’s wares and some of the Applicant’s wares to overlap in the same trade-mark

registrations and applications, confirming that the parties' channels of trade overlap on the marketplace.

Affidavit of Giuseppe Anzuino

[52] Mr. Anzuino introduces into evidence the results of searches of the trade-marks register, which he conducted utilizing the search engine Onscope.

[53] Mr. Anzuino conducted a first search (search A) to locate trade-mark applications or active trade-mark registrations that include in the statement of wares at least one of the following terms, which I note are terms found in the statement of wares of the application for the Mark [para. 4 of the affidavit]:

Hook; racks; hangers; storage; racks; hanger; hampers; hooks; drawers; separators; organizers; hangers; storage; bags; shelf; shoulder [and] shapers; support; wall; rack; shoe [and] rack; storage [and] containers; jewellery [and] organizers.

[54] The search yielded 804 entries [para. 5 and Exhibit GA-1 of the affidavit].

[55] Mr. Anzuino conducted a second search (search B) to locate trade-mark applications or active trade-mark registrations that include in the statement of wares at least either one of the terms or a combination of terms found in the statement of wares of the Opponent's registration [para. 6 of the affidavit]. The search yielded 36,009 entries [para. 7 and Exhibit GA-1 of the affidavit].

[56] Combining the results of both searches, Mr. Anzuino located 568 entries for trade-mark applications or active trade-mark registrations that include in the statement of wares at least one of the terms of search A *and* at least one of the terms of search B (search C) [para. 8 and 9 and Exhibit GA-1 of the affidavit]. Mr. Anzuino files a CD containing a summary of the report of search C listing the 568 entries, along with extracts from the register for each of the corresponding trade-mark applications or registrations [para. 10 and Exhibit GA-2 of the affidavit].

Submissions of the Applicant

[57] The Applicant contends that there is no overlap whatsoever between the nature of the parties' respective wares and services. It also contends that the parties' respective nature of the trade is quite different.

[58] Having just discussed the Anzuino affidavit, I first note that the Applicant contends that the affidavit should be given very little weight, if any, as evidence establishing an overlap in the nature of the trade of the respective parties.

[59] The Applicant essentially submits that the results of search C does not accurately reflect the existence of trade-mark applications and registrations containing at least one of the wares found in the application for the Mark and at least one of the wares found in the Opponent's registration because the number of yielded entries has been inflated by the manner in which Mr. Anzuino conducted searches A and B. In that regard, the Applicant points out that:

- when conducting search A, in many instances the affiant used *terms* of the statement of wares covered by the application for the Mark *rather than* using *the exact wording for the wares*. For instance, the affiant used the term "hook" rather than the wares "over-the-door hook racks, screw-in hooks, hook hanger support and wall rack with hooks"; and
- when conducting search B, at times the affiant used *terms* of the statement of wares covered by the Opponent's registration, *rather than* using *the exact description of the wares*. For instance, the affiant used the term "gels" rather than the wares "eye treatment in the form of creams, gels and lotions".

[60] Alternatively, the Applicant submitted at the hearing that the trade-mark applications yielded by search C should be disregarded because we do not know what wares will be in the registrations to issue. The Applicant also reviewed a dozen of registrations to demonstrate that not all of the registrations yielded by search C cover at least one of the Applicant's wares and one of the Opponent's registered wares.

[61] In the same vein, the Applicant submits that the extracts of the websites of Forever 21, Urban Outfitters and The Bay do not substantiate the Opponent's contention that there is an overlap in the nature of the trade of the respective parties. Suffice it to say that the Applicant in its written argument thoroughly reviews the extracts of the websites, pointing out that not all of the wares shown are covered by its application or by the Opponent's registration. The Applicant also points out that some of the wares shown on the websites are associated with third party trade-marks; not with trade-marks of the retailers Forever 21, Urban Outfitters or The Bay.

[62] Reverting to the Applicant's overall submissions, I summarize them as follows:

- the Mark has not been applied for registration in association with any of the Opponent's registered wares or services;
- given the significant differences between the parties' wares, it is not reasonable for the Opponent to submit that they fall within the same general class, nor was it reasonable for the Opponent to submit at the hearing that the "bags" covered by its registration, i.e. "clutch bags, shoulder bags and tote bags" correspond to storage products; there are clearly no commonalities between the bags covered by the Opponent's registration and the Applicant's wares "under bed storage bag", "jumbo blanket bag" and "hanging vacuum bag" [Exhibits 8, 10 and 11 to the Robillard affidavit];
- the Opponent is inappropriately seeking a monopoly into the trade-mark MAURICES for everything that has something to do with its clothing;
- the Applicant's business is the operation of retail discount stores in which it sells, among others, the storage products associated with the Mark. Although clothing and footwear are available in the Applicant's stores, they are found in sections of the stores which are separate and apart from the sections where the storage products associated with the Mark are sold [para. 14 of the Robillard affidavit];
- women do not go to retail discount stores such as those of the Applicant to look for fashion apparel;

- the Opponent is in the business of operating retail stores specializing in women's clothing and footwear, in which it sells cosmetics, lip products, jewellery, items of clothing and footwear in association with the trade-mark MAURICES; and
- the Wong affidavit shows that storage products of the type covered by the application for the Mark are not likely sold in women's clothing stores.

Affidavit of Celine Wong

[63] Ms. Wong introduces into evidence the results of several searches that she conducted according to instructions she received from counsel for the Applicant.

[64] Ms. Wong conducted searches of the Canadian trade-marks database to locate any registered trade-marks or pending trade-mark applications that cover at least one of the wares covered by the application for the Mark *and* one of the following services: women's clothing stores; women's retail clothing stores; retail women's clothing stores; women's shoe stores; women's retail shoe stores; retail women's shoe stores; women's apparel stores; women's fashion shop [para. 2 and 220 of the affidavit].

[65] According to Exhibits 2 to 286 to the affidavit, all of the searches that Ms. Wong conducted by combining each of the wares with each of the services did not turn up any entries [para. 5 to 219 and 222 to 291 of the affidavit].

[66] Ms. Wong also conducted different online searches to determine the owner of specific trade-marks for specific wares [paragraphs 292 to 306, Exhibits 287 to 297 of the affidavit]. Suffice it to say that the Applicant relies on the results of these searches in support of its submissions, which I have discussed above, that some of the wares shown on the extracts of the Forever 21, Urban Outfitters or The Bay websites are associated with third party trade-marks.

Discussion

[67] I note at the outset that the decisions cited by the Opponent at the hearing are of interest to the extent that they involve opposition proceedings and address the principles that govern the test for confusion. However, it is trite law that each case must be decided based upon its own

merit. For instance, the present proceeding is distinguishable from the decision *ERA Display Co Ltd, supra*, if only because the applicant had not filed evidence in that case; this was clearly taken into account by the Registrar [see page 432].

[68] Despite the Opponent's submissions, I am not prepared to conclude that the wares associated with the Mark and its registered wares are "of the same general class". That being said, I am mindful that section 6(2) of the Act states that a trade-mark may be confusing with another trade-mark "whether or not the wares or services are of the same general class".

[69] I obviously accept that hangers and racks are used to support and expose clothing and footwear offered for sale in retail stores. I also acknowledge that the Opponent has provided photographs of slippers and belts hangers bearing the trade-mark MAURICES that are given to consumers as part of their purchase [para. 16 and Exhibit BHT-7 of the Thun affidavit]. However, with due respect for the Opponent, I disagree with its oral argument that this evidences that "clothing" and "hangers" are one and the same. Furthermore, I believe that it is more likely than not that Canadians who saw the Opponent's trade-mark on these hangers associated the trade-mark with the slippers or belts that they purchased rather than with the hangers. It could also be that they would have associated the trade-mark MAURICES displayed on the hangers with the Opponent's retail stores services.

[70] I trust that by submitting that clothes hangers and storage products are in fact accessories related to clothing and footwear, the Opponent did not mean to suggest that they are clothing accessories. Clearly, they are not. In my view, clothing accessories are items contributing in a secondary manner to someone's outfit.

[71] That said, to the extent that the wares associated with the Mark are used to hang or store clothing and clothing accessories, it is reasonable to conclude that they are incidental to clothing and clothing accessories. For similar reasons, it is reasonable to conclude that "shoe racks" are incidental to footwear and "jewellery organizers" to jewellery. In other words, I am prepared to accept that some of the wares covered by the application for the Mark play a role in relation with the Opponent's registered wares. However, applying that logic, wares that are very different in nature could be considered incidental to the Opponent's wares. For instance, one could argue that laundry detergent is incidental to clothing as it is used to wash clothing.

[72] This leads me to comment on the parties' submissions concerning the evidentiary value of the results of Mr. Anzuino's searches of the trade-marks register.

[73] As mentioned previously, the Opponent contends that search C establishes an overlap between the parties' nature of trade given that it yielded trade-mark applications and registrations covering some of the wares listed in the application for the Mark *and* in the Opponent's registration. The Opponent in its written argument points out entries disclosed by search C by identifying the reference numbers from the summary of the search report, but it does not point out relevant parts of the statement of wares of these entries. However, at the hearing the Opponent did point out relevant parts of the statement of wares of 12 entries [ref. Nos. 9, 38, 54, 56, 107, 145, 151, 154, 218, 234, 246 and 327 in Exhibit GA-2]. These entries do cover *some* of the parties' wares.

[74] As mentioned previously, the Applicant contends that the terms used to conduct searches A and B inflated the number of entries yielded by search C; also the trade-mark applications should be disregarded. I tend to agree with the Applicant on both counts.

[75] I have chosen to focus on the five registrations and four *allowed* applications found in entries reviewed by the Opponent at the hearing to explain why I come to the conclusion, with due respect for the Opponent, that its contention based on the results of search C does not resist analysis.

[76] Besides covering a wide range of wares, each of the five registrations and four allowed applications covers a large number of wares that are not only significantly different from each other by nature, but are also significantly different by nature from the Opponent's registered wares. To illustrate this, I note the following non-exhaustive examples of the type of wares covered by the registrations:

- woodcraft products, toys, stationery [ref. No. 9];
- all terrain vehicles, painters' tools, meats [ref. No. 56];
- barbecue grill, electric fans, modular and prefabricated home log [ref. No. 145];
- furniture, electrical musical instrument, hardware [ref. No. 218]; and

- upholstery fabric, picnic baskets [ref. No. 246].

[77] Applying the Opponent's reasoning, one would have to conclude that search C necessarily establishes a relationship between its registered wares and far apart wares such as meats or all terrain vehicles. This is definitively too much of a stretch.

[78] I find it is not necessary to discuss the parties' submissions about the evidentiary value of the websites of Forever 21, Urban Outfitters and The Bay. For one thing, I am prepared to take judicial notice that a wide range of wares are offered for sale in a department retail store such as The Bay. Further, in attempting to establish confusion, it is not necessary to prove that the parties' wares are sold in the same outlets, as long as the parties are entitled to do so [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD)].

[79] Here, neither the statement of wares of the application for the Mark nor the statement of wares of the Opponent's registration restricts the parties' channels of trade to their respective stores. In other words, the parties have the right to go on and sell in competitive circumstances. However, given the evidence I conclude that this is unlikely.

[80] Indeed, it remains that the Applicant's evidence is that the storage products associated with the Mark are only sold in retail discount stores operated by the Applicant. By contrast, the Opponent's evidence is that since 1931 the wares associated with its trade-mark MAURICES have always been sold in the United States in the retail stores specializing in women's clothing and footwear that are operated by the Opponent in association with the trade-mark MAURICES. Since at least as early as October 2009, the Opponent's website features an e-commerce boutique allowing customers to place orders online.

[81] In the end, the Opponent's evidence is that at no time whatsoever since 1931 have the wares associated with its trade-mark been sold in third party's stores in the United States or through third party's websites. If in so many years of history, the Opponent in the United States has never sold its wares in other stores than those it operates, I find it is reasonable to infer that the wares associated with the Opponent's trade-mark would be sold in Canada in retail stores specializing in women's fashion clothing and footwear operated by or for the Opponent, especially in the absence of any evidence suggesting otherwise. To the contrary, the fact that

Mr. Thun in his affidavit references the incorporation of the company Maurices Canada Stores Limited lends support to this inference.

[82] Ultimately, the Opponent did not convince me that the section 6(5)(c) and (d) factors weigh in its favour in this case.

Additional surrounding circumstance – no instances of confusion

[83] Mr. Robillard states that he is not aware of any instances of confusion occurring between the line of storage products sold in association with the Mark in the Applicant's retail outlets and the products sold or the stores operated by the Opponent in the United States in association with the trade-mark MAURICES nor have any instances of confusion been brought to his attention by the Applicant's employees or consumers [para. 18 of his affidavit].

[84] An opponent needs not to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. Absence of evidence of confusion does not relieve an applicant from its burden of proof. Nevertheless, an adverse inference may be drawn from the lack of evidence of actual instances of confusion when there is evidence of extensive concurrent use of the marks [see *Mattel Inc*, *supra* at page 347].

[85] I find that the lack of actual instances of confusion is of no significance, if only because there is no evidence of concurrent use of the trade-marks in Canada.

Conclusion on the likelihood of confusion

[86] Section 6(2) of the Act is not concerned with confusion between the trade-marks themselves, but rather confusion as to the source of the wares or services.

[87] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the factors enumerated at section 6(5) of the Act and their relative importance, I am satisfied that the Applicant has discharged its legal onus to establish that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark MAURICES.

[88] Had the Opponent established that its trade-mark MAURICES has acquired a significant measure of reputation in Canada, it might arguably have convinced me that the overall consideration of the section 6(5) factors weighs in its favour or results in an even balance of probabilities. However, the outcome of an opposition is based on the evidence and pleadings of the parties and not on the unsupported submissions of the parties.

[89] Accordingly, I dismiss the ground of opposition based under section 12(1)(d) of the Act.

Was the Applicant the person entitled to registration of the Mark at the filing date of the application?

[90] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act owing to confusion with the Opponent's trade-mark MAURICES alleged to have been previously used and/or made known in Canada by the Opponent in association with the wares and services covered by registration No. TMA776,138.

[91] Despite the onus resting on the Applicant, the Opponent must establish that its trade-mark MAURICES had been used or made known in Canada at the filing date of the application for the Mark, i.e. April 21, 2010. The Opponent must also establish that its trade-mark had not been abandoned at the date of advertisement of the application for the Mark, i.e. January 19, 2011 [see section 16(5) of the Act].

[92] As indicated previously, the Opponent has acknowledged that its evidence does not establish use of the trade-mark MAURICES in Canada. Thus, the question becomes whether the Opponent's evidence establishes that its trade-mark MAURICES, as of April 21, 2010, had been made known in Canada by the specific means set out in section 5 of the Act, such that the trade-mark had become well known.

[93] Section 5 of the Act reads as follows:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with wares or services, and

- (a) the wares are distributed in association with it in Canada, or
- (b) the wares or services are advertised in association with it in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the wares or services, or
 - (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the wares or services,

and it has become well known in Canada by reason of the distribution or advertising.

[94] Accordingly, while the Opponent both in its written argument and at the hearing relied upon all of the evidence introduced by Mr. Thun, I am required by the Act to consider only the category of ways in which a trade-mark can be made well known in Canada, which in this case would be through advertisement in magazines.

[95] I have found under the section 12(1)(d) ground of opposition that the Opponent's evidence concerning advertisement in magazines circulated in Canada is insufficient to establish any reputation of the trade-mark MAURICES in Canada as of the date of my decision. I have no reasons to come to a different conclusion under the section 16(3)(a) ground of opposition. Thus, I find that the Opponent has not met its burden to establish making known of the trade-mark MAURICES in Canada prior to April 21, 2010.

[96] Accordingly, I dismiss the ground of opposition based on section 16(3)(a) of the Act.

Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

[97] This issue arises from the ground of opposition alleging that the Mark is not distinctive and does not actually distinguish the Applicant's wares from the Opponent's wares and services associated with the Opponent's trade-mark and trade-name MAURICES.

[98] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[99] The Opponent has the evidential burden to show that its alleged trade-mark and trade-name, as of March 21, 2011, had a substantial, significant or sufficient reputation in Canada in association with the Opponent's wares and services so as to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[100] While the Opponent withdrew the non-entitlement ground of opposition alleging prior use of its trade-name MAURICES, the Opponent did not explicitly amend the pleading of the distinctiveness ground of opposition to withdraw the reference to its trade-name. However, neither in its written argument nor at the oral hearing did the Opponent contend having discharged its evidential burden with respect to the trade-name MAURICES.

[101] In any event, to the extent that the ground of opposition is premised on an allegation of confusion between the Mark and the Opponent's alleged trade-name, it is dismissed for the Opponent's failure to meet its evidential burden. Thus, the question becomes whether the Opponent has met its evidential burden for the trade-mark MAURICES.

[102] When assessing the section 6(5)(a) factor under the section 12(1)(d) ground of opposition, I have found that the Opponent's evidence is insufficient to establish that the trade-mark MAURICES has become known to a significant extent in Canada, but may be sufficient to establish that the trade-mark has become known to some extent. However, the question remains whether the Thun affidavit is sufficient to establish that, as of March 21, 2011, the reputation of the trade-mark MAURICES in Canada was substantial, significant or sufficient as to negate the distinctiveness of the Mark.

[103] I find it is unnecessary to answer this question because even if I were to find that the Opponent has met its evidential burden, I would decide the distinctiveness ground of opposition in favour of the Applicant. Indeed, since the difference in material dates does not impact my previous analysis of the surrounding circumstances of this case, I would conclude that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark MAURICES as of March 21, 2011.

Disposition

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

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Annex

Particulars of Registration No. TMA776,138 for the trade-mark MAURICES

Registration date: September 1, 2010

Wares: Cosmetics namely, peels, exfoliates, moisturizers, foundation make up, face powder, pressed powder, loose powder, blush, cover up creams, concealers, eye shadows, eye liners, eye pencils, eye makeup, eye treatments in the form of creams, gels and lotions; lip products, namely lipsticks, lip colour, lip tint, lip gloss, lip glaze, lip pencils, lip liners, lip balms, lip shine, lip conditioner, mascara, lash tints, lash enhancers, lash primers, brow pencils; jewelry; clutch bags, wallets, shoulder bags and tote bags; clothing namely, dresses, denimwear, jeans, blouses, skirts, jumpers, slacks, pants, tank tops, shorts, bermuda shorts, sweaters, camisoles, t-shirts, sweatshirts, shirts, polo shirts, suits, jerseys, jackets, vests, cardigans, turtlenecks, blazers, coats, parkas, overcoats, anoraks, raincoats, rain slickers, boxer shorts, underwear, culottes, midriff tops, slips, halters, trousers, overalls, snowsuits, ski suits, ski coats, ski pants, pajamas, leotards, nightgowns, baby dolls, dressing gowns, bathrobes, uniforms, beachwear, namely bathing suits, swimwear and pareo, exercise clothing, socks, tights, leggings, hosiery; footwear namely, boots, sandals, shoes, slippers, athletic shoes, basketball shoes, water shoes, sports footwear, namely sneakers, running shoes, walking shoes, tennis shoes and golf shoes.

Services: Retail store services specializing in women's fashion clothing and footwear.

Claims: Used in United States of America. Registered in or for United States of America on February 19, 2008 under No. 3386467 on wares. Registered in or for United States of America on July 04, 1978 under No. 1095513 on services.