

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

**Citation: 2012 TMOB 133**  
**Date of Decision: 2012-07-20**

**IN THE MATTER OF AN  
OPPOSITION by Major League  
Lacrosse LLC to application  
No. 1,408,289 and 1,408,288 for the  
trade-marks HORS LA LOI &  
Dessin in the name of Effigi Inc.**

[1] On August 22, 2008, Effigi Inc. (the Applicant) filed an application to register the two design trade-marks shown below (the Marks):



[2] The applications are based on proposed use in Canada in association with the following wares and services (the Wares and Services):

Wares: [translation] Clothing, namely urban wear, business wear, loungewear, clothing for gymnastics, exercise clothing, sports clothing, evening wear, sleepwear, swimwear, beachwear, rainwear, winter outerwear, skiwear, clothing for children, babies and newborns, underwear; headwear, namely hats, head coverings, berets, headbands, kerchiefs, ear muffs, toques, caps; fashion accessories, namely belts, suspenders, ties, scarves, bandanas; shoes, namely town shoes, leisure footwear, sports footwear, beach footwear, children's footwear, evening footwear, exercise footwear, fishing footwear, golf footwear, winter footwear, rain footwear, ski boots. Bags, namely sports bags, gym bags, beach bags, diaper bags, backpacks, handbags, travel bags, school bags, shoe bags,

fanny packs, hiking bags, shoulder bags, tote bags, baby carriers. Eyeglasses, sunglasses, sports glasses. Perfume; watches; jewellery. Synthetic fabric and textile materials for use in the manufacture of clothing, waterproof and breathable coatings for fabric items, insulating fibers for clothing. Household linen, namely bedding, bath and bathroom linen, table linen, kitchen linen. Pillows, bolsters, mattresses, boxsprings, bed frames. Kitchen utensils, cutlery, dishes, cookware. Bathroom items, namely soap holders, soap dispensers, toothbrush holders, facial tissue dispensers, bathroom tissue dispensers, drinking glasses, glass holders, napkin holders, decorative wastebaskets, decorative laundry baskets, decorative wicker baskets, shower curtains, bath mats, mirrors. Decorative accessories, namely candlesticks, vases.

Services: [translation] Retail, distribution, and importation of clothing, footwear, fashion accessories and housewares.

[3] The applications were advertised for opposition purposes in the *Trade-marks Journal* of September 9, 2009.

[4] On February 8, 2010, Major League Lacrosse LLC (the Opponent) filed a statement of opposition against both applications pleading essentially identical grounds of opposition. Following an interlocutory ruling on the sufficiency of the pleadings, the grounds of opposition, as accepted by the Registrar are summarized below:


- Pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the application does not comply with section 30(b) of the Act as the Applicant had used the Marks prior to the filing date but has failed to identify the date from which the Applicant or its predecessors in title, if any, have so used the Marks in association with the Wares and Services.
- Pursuant to sections 38(2)(a) and 30(e) of the Act, the Applicant, by itself and/or through a licensee, did not intend to use the Marks in Canada in association with the Wares and Services.
- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Marks are not registrable because they are confusing with the following registered trade-marks: OUTLAW (TMA410,902), OUTLAW (TMA742,686), OUTLAW & Design (TMA414,243) all owned by Maple Leaf Consumer Foods Inc. for use in association with “various food products”, whereas the subject applications include “food-related products such as ‘kitchen utensils, cutlery, dishes, cookware, drinking glasses, glass holders, napkin holders’”.
- Pursuant to sections 38(2)(c) and 16(3)(b) of the Act, the Applicant is not the person entitled to registration of the Marks because at the date of filing the

applications for the Marks, namely August 22, 2008, the Marks were confusing with a trade-mark in respect of which an application for registration had previously been filed in Canada by any other person, namely the trade-mark OUTLAW & Design (1,390,693) owned by Maple Leaf Consumer Foods Inc. (the Cited Pending Application) for use in association with “various food products”, whereas the subject applications include “food-related products such as ‘kitchen utensils, cutlery, dishes, cookware, drinking glasses, glass holders, napkin holders’”.


- Pursuant to sections 38(2)(d) and 2 of the Act, the Marks are not distinctive, in that they do not actually distinguish the Wares and Services from the wares or services of others, nor are they adapted to. In particular the Marks do not actually distinguish the Wares and Services in light of the marks outlined in the 12(1)(d) and 16(3)(b) grounds of opposition.

[5] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[6] As its evidence, the Opponent filed certified copies of registration Nos. TMA410,902; TMA742,686; TMA414,243 for the following trade-marks:

<b>Trade-mark</b>	<b>Owner</b>	<b>Wares/Services</b>
OUTLAW (TMA410,902)	Maple Leaf Foods Inc.	Food products namely beef jerky
OUTLAW (TMA742,686)	Maple Leaf Foods Inc.	Boxed meats and burgers, namely cooked and/or uncooked beef, pork, turkey or chicken burgers, nuggets, meatballs, strips, fingers
OUTLAW & DESIGN  (TMA414,243)	Maple Leaf Foods Inc.	Food products namely beef jerky

[7] As its evidence, the Applicant filed certified copies of registrations Nos. TMA685,339; TMA376,697 and application No. 1,146,692, for the following trade-marks:

Trade-mark	Owner	Wares/Services
HORS LA LOI (TMA685,339)	The Applicant	[Summary] clothing; headwear; bags; eyewear; perfume; watches; jewellery; footwear; textiles; household linen; bathroom linen; table linen; kitchen utensils; dishes; operation of a retail store selling clothing, footwear and accessories
HORS LA LOI & DESSIN   HORS LA LOI  (TMA376,697)	The Applicant	[Summary] clothing; bags
OUTLAW (1,146,692 – status allowed)	The Applicant	[Summary] clothing; headwear; bags; eyewear; perfume; watches; jewellery; footwear; textiles; household linen; bathroom linen; table linen; kitchen utensils; dishes; operation of a retail store selling clothing, footwear and accessories

[8] Only the Applicant filed a written argument which is essentially a reiteration of the counter statement. An oral hearing was held at which only the Applicant was represented.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which

it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(b) and (e) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(d) - 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)].
- sections 38(2)(c)/16(3)(b) - the date the application was filed [see section 16(3) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

#### Summary Dismissal of Grounds of Opposition

[11] As submitted by the Applicant at the oral hearing, the Opponent has not filed any evidence in support of the grounds of opposition based on sections 38(2)(a) and 30(b) and (e) of the Act. As such the Opponent has failed to meet its evidential burden and accordingly these grounds are dismissed.

[12] As submitted by the Applicant at the oral hearing, the Opponent has not filed any evidence of use of the marks cited in support of the non-distinctiveness ground of opposition. The mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Furthermore, *de minimis* use does not support a finding that the Opponent's marks had become known to any significant extent. The Opponent has thus failed to meet its evidential burden with respect to the non-distinctiveness ground of opposition based on sections 38(2)(d) and 2 of the Act which requires the Opponent to establish that the marks cited were known to some extent at least in Canada as of February 8, 2010 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48

CPR (4th) 427 (FC) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 CPR (2d) 44 (FCTD)]. The non-distinctiveness ground of opposition is accordingly dismissed.

#### Section 12(1)(d) Ground

[13] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registrations for the marks cited remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[14] 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.

[15] 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, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (SCC).]

[16] The Opponent's case is strongest with respect to the two word marks subject to registration Nos. TMA410,902; TMA742,686 as the design elements associated with

registration No. TMA414,243 share very little similarity with the Marks. As a result, I will assess the ground of opposition based on section 12(1)(d) of the Act with respect to these two word marks (the Cited Marks).

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

[17] The Marks include the word element HORS LA LOI, which literally translated into English means “outlaw”. The word elements have no particular meaning with regard to the Wares and Services. The Marks also feature design elements. I find that the Marks possess a high degree of inherent distinctiveness.

[18] The Cited Marks are made up of the word OUTLAW which has no particular meaning in association with the wares with which they are registered. I find that the Cited Marks also possess a high degree of inherent distinctiveness.

[19] Ultimately, I assess the inherent distinctiveness of the Marks and the Cited Marks as being about the same, and as being relatively high.

[20] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks. While it is true that registration No.TMA742,686 claims use since at least as early as 2000 and a declaration of use was filed on February 19, 1993 with respect to registration No. TMA410,902, at most this entitles me to assume *de minimis* use of the Cited Marks [see *Entre Computer, supra*]. *De minimis* use does not support a conclusion that the Cited Marks had become known to any significant extent.

[21] This factor does not significantly favour either party.

*Section 6(5)(b) – the length of time each has been in use*

[22] While it may be true that *de minimis* use is more than no use, in the absence of evidence of continuous use of either party’s marks, this factor does not significantly favour either party.

*Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade*

[23] It is the Applicant's statement of wares and services as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 CPR (3d) 89 (TMOB)].

[24] As submitted by the Applicant at the oral hearing, the only area of potential overlap is with respect to the Applicant's "kitchen utensils, cutlery, dishes, cookware". The remainder of the Wares and Services are entirely distinct from the meat products associated with the Cited Marks.

[25] At the oral hearing, the Applicant submitted that I have not been provided with any evidence as to whether there is any overlap between the meat products associated with the Cited Marks and the Applicant's kitchen utensils, cutlery, dishes and cookware. For example, I have not been provided any evidence that meat products would be sold in close proximity to kitchen utensils, cutlery, dishes and/or cookware in the same stores. Furthermore, the Applicant submitted that this is not something that I should take judicial notice of. The Applicant submitted that the fact that kitchen utensils, cutlery, dishes and cookware may be used with food products is not sufficient to create an overlap between the parties' wares. I agree. Based on the foregoing, I do not find that the parties' wares share any particular degree of similarity or overlap.

[26] I have no evidence regarding the nature of the parties' trades, however, given the inherent differences in the nature of the parties' wares and services I consider it reasonable to infer that the parties' channels of trade would also likely not overlap. This is particularly true in light of the fact that the Applicant offers retail services.

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

[27] In this case, we have a French trade-mark versus an English trade-mark. Visually and aurally the marks differ. However, the test in these circumstances is not limited to a unilingual Francophone or Anglophone. One must also consider the bilingual consumer



[see *Pierre Fabre Medicament v. SmithKline Beecham Corp.* (2001), 11 CPR (4th) 1 (FCA.)].

[28] As discussed above in the analysis of the section 6(5)(a) factor, the words in the Marks (HORS LA LOI) can be translated into English as “outlaw” and thus, to the average bilingual consumer, the Marks and the Cited Marks suggest the same idea.

#### *Additional Surrounding Circumstance*

[29] At the oral hearing, the Applicant submitted that, while not determinative, it is relevant that the Applicant has already obtained two registrations for trade-marks including the HORS LA LOI element (TMA685,339 and TMA376,697), both obtained despite the presence of the Cited Marks on the Register.

[30] I note that section 19 of the Act does not give the owner of a registration the automatic right to obtain further registrations, no matter how closely they may be related to the original registration [see *Mister Coffee & Services Inc. v. Mr. Coffee, Inc.* (1999), 3 CPR (4th) 405 (TMOB) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 CPR (3d) 571 (TMOB) at 576].

[31] Based on the foregoing, I am not satisfied that this forms a relevant surrounding circumstance supporting the Applicant’s position.

#### *Conclusion*

[32] Having considered all of the surrounding circumstances, in particular the difference in the nature of the wares and services as between the Marks and the Cited Marks, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Marks.

[33] Having regard to the foregoing, I reject the ground of opposition based on section 12(1)(d) of the Act.

Section 16(3)(b) of the Act

[34] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Pending Application, the Opponent has the initial onus of proving that the Cited Pending Application was pending at the date of filing the application for the Mark (August 22, 2008), and remained pending at the date of advertisement of the application for the Mark, September 9, 2009 [section 16(5) of the Act]. The Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance*]. I have exercised my discretion to check the status of the application cited by the Opponent.

[35] The Cited Pending Application was abandoned on March 17, 2010, however, it was filed prior to the date of filing the applications for the Marks and remained pending at the date of advertisement for the applications for the Marks and thus the Opponent has met its burden with respect to this ground of opposition.

[36] The Cited Pending Application is identical to the Opponent's design mark which is subject to registration No. TMA414,243, which as mentioned above in the analysis of the section 12(1)(d) ground of opposition shares less similarity with the Marks than the Cited Marks do. The wares associated with the Cited Pending Application are very similar to those associated with the Cited Marks.

[37] The difference in material dates is not significant and as a result my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable here. As a result, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue. Having regard to the foregoing, I reject the ground of opposition based on section 16(3)(b) of the Act.

Disposition

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

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office