



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

**Citation: 2011 TMOB 232**  
**Date of Decision: 2011-11-29**

**IN THE MATTER OF AN OPPOSITION  
by Wenger S.A. to application  
No. 1,384,390 for the trade-mark Swiss  
Wear in the name of Candragon  
Enterprises Inc.**

[1] On February 21, 2008, Candragon Entreprises Inc. (the Applicant), filed an application to register the trade-mark Swiss Wear (the Mark) on the basis of use in Canada since May 15, 2006. The Mark has been applied for registration in association with “luggage, athletic bags, garment bags, travel bags, suitcases, attache and briefcases, carry-alls”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 13, 2009.

[3] Wenger S.A. (the Opponent) filed a statement of opposition on July 9, 2009. The grounds of opposition allege, in summary, that:

- the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) since it is confusing with the Opponent’s trade-mark SWISSGEAR & Design of registration No. TMA694,549;
- the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a) of the Act;
- the application does not conform to the requirements of s. 30(i) of the Act; and
- the Mark is not distinctive pursuant to s. 2 of the Act.

[4] The Applicant filed a counter statement essentially denying each ground of opposition.

[5] In support of its opposition, the Opponent filed an affidavit of Peter Hug, sworn on December 4, 2009, an affidavit of Raymond Durocher, sworn on December 8, 2009, and a Certificate of Authenticity of registration No. TMA694,549. Mr. Hug is the Chief Executive Officer of the Opponent. Mr. Durocher is President of Holiday Group Inc. (Holiday), an authorized distributor of the Opponent's products in Canada. The affiants were not cross-examined by the Applicant.

[6] The Applicant elected to file no evidence in support of its application.

[7] Both parties filed written arguments and were represented at an oral hearing.

#### Onus

[8] 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

#### Material Dates

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

- s. 38(2)(a) / s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b) / s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c) / s. 16(1)(a) – the date of first use claimed in the application [s. 16(1)(a) of the Act]; and

- s. 38(2)(d) / non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Analysis of the Grounds of Opposition

[10] From the outset, I dismiss the ground of opposition based upon non-conformity to s. 30(i) of the Act since the pleading does not support such a ground of opposition. Section 30(i) of the Act only requires that an applicant declares itself satisfied that it is entitled to use the applied-for mark. Such statement is included in the application for the Mark. I would add that the mere knowledge of an opponent's rights is not sufficient to succeed under a s. 30(i) ground of opposition. Section 30(i) of the Act can sometimes be the basis of a ground of opposition in specific cases, such as where fraud by the applicant is alleged and established or if specific statutory provisions prevent the registration of the applied-for mark [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221 (F.C.T.D.)].

[11] All of the remaining grounds of opposition are based upon allegations that the Mark is confusing with the Opponent's trade-mark SWISSGEAR & Design, shown hereafter (the Opponent's Mark):



[12] I will analyze the remaining ground of opposition with relation to the evidence of record.

### Preliminary Remarks

[13] I am disregarding Mr. Hug's statements seemingly directed to the likelihood of confusion between the trade-marks at issue [par. 10] because they go to the questions of facts and law to be determined by the Registrar in the present proceeding. Further, since the Opponent conceded at

the oral hearing that the Hug affidavit does no more than provide background information on the Opponent, I will review the Opponent's evidence by focussing on the affidavit of Mr. Durocher.

[14] I am disregarding Mr. Durocher's evidence as to the backpack that was purchased by an employee of Holiday at a store in Vancouver in May 2009, which purports to show that the Applicant uses the Mark together with a cross design, with "Swiss" and "wear" stitched in contrasting colours [pars. 15 and 16, Exhibit 16]. I agree with the Applicant that it constitutes inadmissible hearsay evidence. Further, no reasons were given as to why the employee could not have provided the intended evidence [see *R. v. Khan* [1990] 2 S.C.R. 531]. In oral argument, the Opponent submitted that Mr. Durocher's observations as to the manner of use of the Mark are admissible because he affirms having personally seen the backpack. In reply, the Applicant submitted that the evidence does not establish that the backpack originates from the Applicant. Again, I agree with the Applicant. I wish to add that had the evidence been admissible and reliable, it would not have furthered the Opponent's case in any way. In view of the Mark as applied for, the "contrasting colours" used for the words "Swiss" and "wear", and the use of those words together with a cross design, are irrelevant to my considerations [see *Rockport Co. v. Sales* (2000), 2000 CarswellNat 3970 (T.M.O.B.)].

[15] I am not affording any significance to the fact that an objection based upon the Opponent's alleged registration has been successfully overcome by the Applicant during the prosecution of the application. Decisions by the Examination Section of the Canadian Intellectual Property Office are not binding and have no precedential value in determining the registrability of a trade-mark in an opposition proceeding. The Examination Section does not have before it evidence that is filed by parties in opposition proceedings [see *Chanel S. de R. L. v. Marcon* (2010), 85 C.P.R. (4th) 399 (T.M.O.B.)].

[16] Finally, I am disregarding submissions made by the Applicant based on the Opponent's application No. 1,411,198 for the word mark SWISSGEAR allegedly filed on September 16, 2008. Besides the fact that the alleged application has not been introduced in evidence, none of the Opponent's pleadings involves the word mark SWISSGEAR and/or a corresponding trade-mark application.

[17] I shall now turn to the analysis of the remaining grounds of opposition.

Registrability / Section 12(1)(d) of the Act

[18] I have exercised the Registrar's discretion to confirm that registration No. TMA694,549 for the Opponent's Mark is in good standing as of today's date. Since the registration is extant, the Opponent has discharged its evidential burden with respect to the registrability ground of opposition. Therefore, the question becomes whether the Applicant has met the legal onus that lies on it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Mark.

[19] 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.

[20] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have 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 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

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

[21] I remark that the Applicant made several submissions as to the weakness of the Opponent's Mark, but did not really expand on the inherent distinctiveness of the Mark. Obviously, the Applicant's submission that "Swiss" "refers to the country of Switzerland and its people" also applies to the Mark. The Applicant's submission that "gear" is an ordinary dictionary word equally applies to "wear".

[22] In the end, considering the marks at issue in their totality, I find that each possesses some measure of inherent distinctiveness. In my view, the design features of the Opponent's Mark do not significantly increase its inherent distinctiveness. For one thing, the lettering employed for the word SWISSGEAR, namely bold black lettering for "Swiss" and plain white lettering for "gear", cannot be dissociated from the word itself [see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961), 37 C.P.R. 89 (Ex. C.)]. Also, as I consider it proper for me to take judicial notice of the national flag of Switzerland, I agree with the Applicant that the cross found in the Opponent's Mark is similar to the one displayed on the Swiss flag.

[23] A trade-mark may acquire distinctiveness through use or promotion. Yet, the Applicant has not filed evidence directed to the extent of use or promotion of the Mark in Canada.

[24] As rightly noted by the Applicant, Mr. Durocher introduces the evidence of use and promotion of the Opponent's Mark by referring to the products sold by Holiday as being associated with the Opponent's trade-marks "SWISSGEAR and cross design, SWISSGEAR (word), and SWISSGEAR by Wenger (word)" [par. 6]. In my review of his affidavit, I will use the terms "SWISSGEAR Marks" to reflect Mr. Durocher's collective reference to the three aforesaid marks.

[25] Mr. Durocher attests that Holiday has been distributing a wide range of luggage, bags, backpacks, small personal leather goods, umbrellas and related products in association with the SWISSGEAR Marks across Canada on a continuous basis since July, 2003. He identifies specific wares sold in Canada, such as luggage, backpacks, briefcases, attaché cases, duffel bags, shoulder bags, travel bags and garment bags [par. 7]. He files photographs of "a random sampling of products sold in Canada" bearing the SWISSGEAR Marks [par. 9, Exhibits 1 to 7] as well as a sample hang-tag "typically attached to luggage sold by Holiday to its customers in Canada" [par. 10, Exhibit 8].

[26] Mr. Durocher states that since July 2003, the wholesale value of products sold by Holiday in Canada in association with the SWISSGEAR Marks exceeds one hundred million Canadian dollars [par. 14]. However, he does not breakdown the value of sales by year, by product nor does he provide separate amounts for each of the SWISSGEAR Marks.

[27] According to Mr. Durocher's statements, since 2003 Holiday has advertised and promoted the products associated with the SWISSGEAR Marks by "distributing catalogues to the trade, promoting the products at numerous trade shows, and co-op advertisements with many major customers, such as Costco, the Bay and Sears" [par. 13]. Mr. Durocher files photocopies of catalogues provided to Holiday's customers since 2003 [par. 11, Exhibits 9 to 15]. While the catalogues cover the years 2003 through 2009, Mr. Durocher does not indicate the number of catalogues distributed each year. However, he indicates that there are over 5,700 points of sale across Canada - independent retailers, mass merchants and department stores - for Holiday's products [par. 5].

[28] I agree with the Applicant that the Durocher affidavit is not without deficiencies. That being said, while a more complete picture of sales and advertising of products associated with the Opponent's Mark in and of itself could have been elicited by cross-examination, the Applicant elected to not cross-examine the affiant. In the absence of internal inconsistencies in the Durocher affidavit and based a fair reading of the latter, including its Exhibits showing the Opponent's Mark displayed on the wares themselves and/or on hang-tags and the like, I am satisfied that the affidavit establishes use of the Opponent's Mark in Canada since July 2003 in association with wares, such as luggage, bags, backpacks and related products. Also based on a fair reading of the Durocher affidavit, I am satisfied that the Opponent's Mark has become known to a significant extent in Canada. In other words, the Applicant did not convince me that the Durocher affidavit does not establish acquired distinctiveness of the Opponent's Mark as of the material date under the registrability ground of opposition.

*The length of time each trade-mark has been in use*

[29] The Applicant has not filed any evidence showing continuous use of the Mark since May 15, 2006, as claimed in the application. By contrast, I am satisfied that the evidence establishes continuous use of the Opponent's Mark in Canada since July 2003.

*The nature of the wares, services or business; and the nature of the trade*

[30] It is the statement of wares in the application and the statement of wares in the registration that must be taken into consideration when assessing the factors set forth at s. 6(5)(c)

and (d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[31] Since the Mark is associated with “luggage, athletic bags, garment bags, travel bags, suitcases, attaché and briefcases, carry-alls”, I note that the Opponent’s registration covers, *inter alia*, the following wares:

[...] (3) All-purpose dry bags, luggage, backpacks, daypacks, duffel bags, utility bags, shoulder bags, casual bags, briefcases, non-motorized wheeled packs, cosmetic cases sold empty, toiletry cases sold empty, small personal leather goods, namely, money pouches, wallets, and shaving bags sold empty, umbrellas and briefcase-type portfolios; catalog cases, name and calling card cases, non-motorized collapsible luggage carts, waistpacks, shopping bags, bags worn on the body, business cases, shoe bags for travel, travel packing cubes, travel bags, travel pouches, all-purpose personal care bags; small personal leather goods, namely, billfolds, coin purses, credit card cases, neck and necklace wallets, opera wallets; unfitted bags for handheld electronic devices; waistpacks for holding electronic devices. [...].

[32] Obviously, the wares identified in the application are identical, similar or related to the above-identified registered wares.

[33] There is no evidence with respect to the Applicant’s channels of trade and no restriction in its application. Since the parties’ wares are of the same nature, I find it reasonable to infer that the Applicant’s channels of trade are the same or overlap with the Opponent’s channels of trade.

*The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them*

[34] It is trite law that when assessing the degree of resemblance between two marks they are to be looked at in their entirety and not dissected [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 56 (Can. Ex. Ct.), affirmed (1946), 5 C.P.R. 71 (S.C.C.)]. Also, this factor “is often likely to have the greatest effect on the confusion analysis” [see *Masterpiece, supra*].

[35] The Applicant submits that none of the design elements of the Opponent’s Mark is replicated in the Mark. It also submits that “gear” is phonetically very different from “wear”. By contrast, the Opponent submits that the Mark and the word portion of the Opponent’s Mark “are virtually identical in sound and appearance” because both begin with the word “Swiss” and the



only difference is the change of the first letter in the second word. On one hand, and considering the marks in their entirety, I agree with the Applicant that their respective endings, i.e. “wear” versus “gear”, result in differences in sound. On the other hand, I agree with the Opponent that the Mark is virtually identical in appearance to the word portion of the Opponent’s Mark. Further, even though the lettering for its word portion does not increase the inherent distinctiveness of the Opponent’s Mark, it still results in SWISSGEAR being perceived as two words, which arguably increases the degree of resemblance in appearance between the marks at issue.

[36] Neither the Applicant nor the Opponent has made submissions directed to the degree of resemblance between the ideas suggested by the marks at issue. That being said, both marks undoubtedly suggest that the wares associated therewith are of Swiss origin.

[37] In the end, when considered in their totality, I find that the resemblance in the visual perception of the marks coupled with the resemblance between the ideas they suggest outweigh their differences in sound.

*Additional circumstance –Effect of disclaimer*

[38] The Applicant submits that by disclaiming to the right to the exclusive use of the words “Swiss” and “gear” in registration No. TMA694,549, the Opponent has recognized that both words are descriptive. The Applicant also submits that the disclaimer for the word “Swiss” should lead to a finding of no confusion. In that regard, as I understand the submissions made by the Applicant at the oral hearing, it contends that since the *only* similarity between the marks is the word “Swiss”, the opposition should not succeed because the purpose of the disclaimer is to otherwise permit other persons to use such independently non-registrable matter.

[39] With respect to the cases cited by the Applicant at the oral hearing, I note that *Canadian Parking Equipment v. Canada (Registrar of Trade Marks)* (1990), 34 C.P.R. (3d) 154 (F.C.T.D.) is distinguishable from the present proceeding as it deals with a decision during examination to refuse an application under s. 12(1)(b) of the Act. Further, and besides the fact that each case must be decided based upon its own merit, I do not read the other cases cited by the Applicant as supporting its contention that the disclaimer for the word “Swiss” in the Opponent’s registration

prevents a finding of confusion. To conclude, I make mine the following comment of Member Bradbury in *Canadian Tire Corp. v. Hunter Douglas Inc.* (2010), 81 C.P.R. (4th) 304 (T.M.O.B.), at par. 36, cited by the Opponent: “Overall, when dealing with a s. 12(1)(d) ground of opposition, a disclaimer in either the Applicant's application or the Opponent's registration is of little, if any, consequence.”

*Conclusion on the likelihood of confusion*

[40] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Considering the acquired distinctiveness of the Opponent's Mark and the length of time it has been in use, the nature of the parties' wares and trade as well as the degree of resemblance between the parties' trade-marks, I arrive at the conclusion that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the trade-mark SWISSGEAR & Design of registration No. TMA694,549.

[41] Having regard to the foregoing, the ground of opposition based upon s. 12(1)(d) of the Act is successful.

Non-Entitlement / Section 16(1)(a) of the Act

[42] I am satisfied that the Opponent has discharged its initial evidential burden of showing that the Opponent's Mark was used prior to May 15, 2006 and had not been abandoned at the date of advertisement of the application for the Mark [s. 16(5) of the Act].

[43] In view of the evidence or record, assessing each of the s. 6(5) factors as of the date of first use claimed in the application rather than at the date of my decision does not significantly impact my previous analysis of the surrounding circumstances; the main difference is that of the acquired distinctiveness of the Opponent's Mark as of the material dates. Considering the length of time the Opponent's Mark has been in use, the nature of the parties' wares and trade as well as the degree of resemblance between the trade-marks, I still conclude that the Applicant has not discharged its onus to establish, on a balance of probabilities, that the Mark was not confusing with the Opponent's Mark as of May 15, 2006.

[44] Having regard to the foregoing, the ground of opposition based upon s. 16(1)(a) of the Act is successful.

Non-Distinctiveness

[45] As I have already found in favour of the Opponent under two separate grounds of opposition, I will not discuss the last ground of opposition.

Disposition

[46] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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