

**IN THE MATTER OF AN OPPOSITION by CALVIN KLEIN
TRADEMARK TRUST to application No. 801,275 for the trade-
mark CALVIN & Design filed by CALVIN CORPORATION
LIMITED**

On January 9, 1996, the applicant, CALVIN CORPORATION LIMITED, filed an application to register the trade-mark CALVIN & Design, a representation of which appears below, based on proposed use of the trade-mark in Canada in association with “Footwear, namely boots, shoes, running shoes, hiking boots and sandals.”



The present application was advertised for opposition purposes in the *Trade-marks Journal* of January 29, 1997 and the opponent, CALVIN KLEIN TRADEMARK TRUST, filed a statement of opposition on June 13, 1997, a copy of which was forwarded to the applicant on July 10, 1997. The applicant served and filed a counter statement in response to the statement of opposition on November 10, 1997. The opponent subsequently requested and was granted leave on June 21, 1999 to amend its statement of opposition pursuant to Rule 40 of the *Trade-marks Regulations*. The opponent submitted as its evidence the affidavits of Deidre Miles-Graeter, Meredith Brill and Robert White, together with certified copies of the following registered trade-marks: CALVIN, registration No. 339,967; CALVIN KLEIN, registration No. 382,519; CALVIN KLEIN, registration No. 307,161; CK/CALVIN KLEIN, registration No. 448,010; and CALVIN KLEIN, registration No. 480,665, which issued from application No. 793,442. The applicant filed as its evidence the affidavit of Paisarn Kijkarnlerd-udom. The opponent alone filed a written argument and an oral hearing was not requested by either party.

The following are the grounds of opposition relied upon by the opponent in its amended statement of opposition:

- a) The present application does not comply with Subsection 30(b) of the *Trade-marks Act* in that the trade-mark CALVIN & Design was used prior to January 9, 1996, the filing date

of the present application;

b) The trade-mark CALVIN & Design is not registrable in view of 12(1)(d) of the *Trade-marks Act* because it is confusing with the opponent's following registered trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares/Services</u>
CALVIN	339,967	Fragrances. Wearing apparel namely, shorts, blouses, sweaters, pants, skirts and jeans.
CALVIN KLEIN	382,519	Perfume, cologne, bath oil, eye shadow, eye colour pencil, brow colour pencil, skin conditioning cream, mascara, blusher, face and body powder, foundation makeup, skin moisturizers, lipstick, lip gloss, lip contour pencil, nail enamel, nail polish, soap for personal use, night cream, hand cream, cosmetic masques, and makeup remover; patterns for sewing; children's wearing apparel, namely dresses, skirts, jeans and shirts. Watches. Fragrances. Patterns for sewing, namely paper patterns. Shoes and boots. Hosiery. Underwear.
CALVIN KLEIN	480,665	Wearing apparel, namely jump suits, blouses, coats, jackets, ponchos, capes, raincoats, furs, bathing suits, pants, shorts, warm-up suits, suits, ties, socks, stockings, tights, hats, sweaters, vests, t-shirts, tennis and golf dresses, shorts, beach and swimming cover-ups, tank tops, slippers, handkerchiefs, belts, gloves, scarves, shawls; men's and boy's underwear, namely briefs, boxers, athletic underwear, sport knits, t-shirts, tank tops, undershirts, sleepwear and loungewear, namely robes, sleep shirts, pajama tops, pajama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, namely lounging pants and tops, lounge jackets; women's and girls' underwear and bodywear, namely intimate apparel, namely foundations, bras, girdles, garter belts, all-in-ones, corselettes, body stockings, control briefs, control hipsters, control bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, daywear, namely culottes, bikinis, hipsters, briefs, slips, chemises, teddies, camisoles, sleepwear and loungewear, namely nightgowns, nightshirts, pajamas, french maid sleepers, hostess culottes, lounging pajamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bathrobes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, cocoons, dusters, robes, bra tops, crop tops, and leggings. Briefs, boxer shorts, athletic shirts and bottoms, T-shirts and tank tops, undershirts, underpants, and undershirts, robes, knitted and woven sleepwear, namely sleep shirts, pajama tops, pajama bottoms, breakfast jackets, smoking jackets, bed jackets and cover-ups, knitted and woven loungewear, namely lounging pants and tops, and lounge jackets. Women's and girls' intimate apparel, sleepwear and loungewear, daywear and bodywear, namely foundations, bras, girdles, garter belts, all-in-ones, corselettes, body stockings, control briefs, control hipsters, control bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, culottes, bikinis, hipsters, briefs, slips, blouse-slips, camisole-slips, chemise slips, culotte slips, evening slips, maternity slips, panty

slips, princess slips, shadow panel slips, strapless slips, suite slips, tailored slips, half-slips, petti-slips, bra-slips, chemises, teddies, camisoles, bra top camisoles, bralettes, tap pants, and petti-pants, nightgowns, toga nightgowns, night shirts, pajamas, shortie pajamas, baby-doll pajamas, T-shirt pajamas, Chinese pajamas, coat-style pajamas, cossack pajamas, culotte pajamas, French maid sleepers, harem pajamas, hostess culottes, lounging pajamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bathrobes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, cocoons, dusters, hostess robes, kabuki robes, lounging robes and monk's robes, bra tops, crop tops and leggings, excluding women's hosiery.

CALVIN KLEIN. 307,161

Women's wearing apparel, namely, skirts, shirts, blouses, jackets, pants, coats, fur-trimmed coats, vests, dresses, sweaters, bathing suits, robes, beach and swim coverups, T-shirts, tennis and golf dresses, shorts, warm-up suits, raincoats and rainjackets, capes, ponchos, hats, shawls, robes, walking shorts, tank tops and jump suits. Men's wearing apparel, namely, suits, sports jackets, pants, sports shirts, dress shirts, sweaters, top coats, raincoats, trench coats, jackets, insulated jackets, leather pants, lined and unlined leather jackets, leather top coats, leather sport coats, ties, belts. Women's denim jeans. Sheets, towels, pillow cases. Women's handbags and belts. Women's scarves. Women's wearing apparel, namely skirts, shirts, blouses, jackets, pants, coats, fur-trimmed coats, furs, vests, dresses, sweaters, bathing suits, robes, beach and swimming cover-ups, T-shirts, tennis and golf dresses, shorts, warm-up suits, raincoats and rainjackets, capes, ponchos, hats, scarves, shawls, belts, walking shorts, tank tops and jump suits. Sheets, towels, pillow cases, comforters and bedspreads, men's wearing apparel, namely suits, sport jackets, blazers, dinner jackets, pants, jeans, outer coats, namely top coats, trench coats, jackets, insulated jackets, lined and unlined leather jackets, leather top coats, leather sport coats; raincoats, shirts, vests, sweaters, ties, belts, women's wearing apparel, namely jeans and gloves.

448,010



Wearing apparel, namely jumpsuits, shirts, blouses, sweaters, jackets, bathing suits, pants, dresses, shorts, skirts, warm-up suits, capes, walking shorts, jeans, gloves, suits, sports jackets, ties, belts, suspenders, socks, underwear, stockings, tights, hats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, vests, t-shirts, tennis and golf dresses, beach and swimming cover-ups, raincoats and rain jackets, ponchos, tank tops, blazers, pants, handkerchiefs, bras, nightgowns, robes, scarves and shawls; and footwear, namely shoes, boots and slippers.

c) The applicant is not the person entitled to secure registration of the trade-mark CALVIN & Design in view of Paragraph 16(3)(a) of the *Trade-marks Act* because, at the filing date of the present application, the applicant's trade-mark was confusing with the trade-marks CALVIN, CALVIN KLEIN and CK/CALVIN KLEIN & Design, previously used in Canada by authorized licensees of the opponent in association with the wares identified above.

d) The applicant's trade-mark CALVIN & Design is not distinctive and is not adapted to distinguish the wares of the applicant from the wares and services of others, and more particularly those of the opponent herein.

Initially, the opponent submitted that the document identified as the affidavit of Paisarn

Kijkarnlerd-udom, Managing Director of the applicant, filed by the applicant as its evidence under Rule 42(1) of the *Trade-marks Regulations*, is not admissible in that it does not constitute a proper affidavit or statutory declaration. The first paragraph of the purported affidavit provides as follows:

“I, MR. PAISARN KIJKARNLERD-UDOM, of the City of Bangkok, Thailand, MAKE
OATH AND SAY AS FOLLOWS: ”

Further, a reduced size photocopy of the last page of the purported affidavit following paragraph 10 thereof is set out below:

The opponent has submitted that the purported affidavit has not been sworn to by Paisarn Kijkarnlerd-udom, bearing in mind that the jurat is dated March 4, 1999 whereas the signature of Chavalit Uttasart is dated as of March 5, 1999. In my view, there is some ambiguity in the purported affidavit as to whether Paisarn Kijkarnlerd-udom was properly sworn. Despite the first paragraph of the purported affidavit and the jurat, Mr. Uttasart’s statement at the end of the purported affidavit points to the fact that Paisarn Kijkarnlerd-udom was not administered an oath by Chavalit Uttasart at the time that he signed the purported affidavit. Furthermore, the applicant has not established that the purported affidavit of Paisarn Kijkarnlerd-udom was validly made in the form prescribed by the laws of Thailand, the place where the affidavit was made and the domicile of Paisarn Kijkarnlerd-

udom. However, I am mindful of the fact that this issue appears to have been raised by the opponent for the first time in its written argument which was forwarded to the applicant's agent on January 25, 2000, thus leaving the applicant limited opportunity to satisfy the Registrar that Paisarn Kijkarnlerd-udom was properly sworn at the time of signing the purported affidavit or that the purported affidavit is a proper affidavit for the purposes of the laws of Thailand. As a result, and in view of my findings with respect to the grounds of opposition in this case, I am prepared to overlook this deficiency in the applicant's evidence.

The first ground of opposition is based on Subsection 30(e) of the *Trade-marks Act* rather than Subsection 30(b) as referred to in the amended statement of opposition, the present application being based on proposed use of the trade-mark CALVIN & Design in Canada. The legal burden is on the applicant to show that its application complies with Subsection 30(e) of the *Act*. This includes both the question as to whether or not the present application formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. However, to the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an initial evidential burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. Also, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the present application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

The evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(e) of the *Act* is a light one and can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application. Moreover, the opponent relied on the line of decisions of the Registrar of Trade-marks which refused proposed use applications where actual use of the trade-mark was evidenced prior to the filing date [see *Tone-Craft Paints Ltd. c. Du-Chem Paint Co. Ltd.*,

62 C.P.R. 283; *Airwick Industries Inc. c. Metzner*, 74 C.P.R.(2d) 55; *Société Nationale Elf Aquitaine c. Spex Design Inc.*, 22 C.P.R. (3d) 189; *Frisco-Findus S.A. c. Diners Delite Foods Ltd.*, 26 C.P.R. (3d) 556; *La Marca Leather Corp. c. Orol Jewellery Mfg. Co. Ltd.*, 28 C.P.R. (3d) 562; *Manifatture Casucci Di Caucci Ugo & C. S.a.s. c. Casucci Clothes Inc.*, 52 C.P.R. (3d) 250; and *Nabisco Brands Ltd. - Nabisco Brands Ltée (now Nabisco Ltd. - Nabisco Ltée) c. Cuda Consolidated Inc.*, 81 C.P.R. (3d) 537].

While no evidence has been furnished by the opponent in support of its first ground, the opponent has submitted that the applicant's evidence and, in particular, the affidavit of Paisarn Kijkarnlerd-udom, Managing Director of the applicant, is clearly inconsistent with the applicant's proposed use basis for registration of its trade-mark in that the applicant commenced use of its trade-mark CALVIN & Design in Canada prior to January 9, 1996, the filing date of the present application. Annexed as Exhibit "X" to the affidavit of Paisarn Kijkarnlerd-udom is a photocopy of an invoice dated July 5, 1995 from the applicant to A. LAMBERT INTERNATIONAL INC., of Montreal, Quebec, relating to the shipment and sale of 4,152 pairs of footwear, which the affiant states were associated with the trade-mark CALVIN & Design. Further, according to Paisarn Kijkarnlerd-udom, the applicant has sold goods under the trade-mark CALVIN & Design in Canada through A. LAMBERT INTERNATIONAL INC., a Canadian distributor of the applicant during the four years prior to the date of his affidavit [March 4, 1999]. As well, in paragraph 7 of the affidavit, the affiant provides the sales for 1995 in Canada which were \$200,428 (U.S.).

Having regard to the foregoing, the applicant's evidence clearly establishes that it used its trade-mark CALVIN & Design in Canada prior to the filing date of the present application. That being the case, and having regard to the line of decisions of the Registrar of Trade-marks which refused proposed use applications where actual use of the trade-mark was evidenced prior to the filing date, I find that the first ground of opposition is successful

The second ground is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the trade-mark CALVIN & Design is confusing with its registered trade-marks identified above. In determining whether there would be a reasonable likelihood of confusion

between the trade-marks at issue, the Registrar must have regard to all of the surrounding circumstances including those specifically set forth in Subsection 6(5) of the *Trade-mark Act*. Further, the Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date with respect to the Paragraph 12(1)(d) ground of opposition [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para.6(5)(a)], the applicant's trade-mark CALVIN & Design possesses some degree of inherent distinctiveness when considered in its entirety as applied to "Footwear, namely boots, shoes, running shoes, hiking boots and sandals" even though the word CALVIN has both a given name and surname significance and therefore adds little to the inherent distinctiveness of the mark. Further, the opponent's registered trade-marks CALVIN, CALVIN KLEIN and CK/CALVIN KLEIN possess little inherent distinctiveness in view of the name significance associated with each of the opponent's marks, Calvin Klein being the name of a clothing designer residing in New York City [see paras. 4 and 7 - 9, Miles-Graeter affidavit].

As for the extent to which the trade-marks at issue have become known [Para.6(5)(a)] and the length of time the marks have been in use [Para.6(5)(b)], the affidavit of Deirdre Miles-Graeter establishes that the opponent's CALVIN KLEIN trade-marks have become fairly well known in Canada with sales of CALVIN KLEIN merchandise in this country in association with the opponent's marks from 1992 to September of 1997 exceeding \$287,000,000, including more than \$14,400,000 in sales of CALVIN KLEIN footwear, including shoes and socks, during this time. On the other hand, the affidavit of Paisarn Kijkarnlerd-udom evidences approximately \$720,000 (U.S.) in sales of footwear in Canada in association with the applicant's trade-mark. Thus, both extent to which the trade-marks at issue have become known and the length of time the marks have been in use clearly favour the opponent.

With respect to the nature of the wares of the parties [Para. 6(5)(c)] and the nature of the

trade [Para. 6(5)(d)] associated with their respective wares, it is the applicant's statement of wares and the statements of wares covered in the opponent's registrations which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. In the present opposition, registration Nos. 382,519 and 448,010 for the trade-marks CALVIN KLEIN and CK/CALVIN KLEIN & Design respectively cover, *inter alia*, shoes, boots and hosiery while registration Nos. 480,665 and 448,010 cover *inter alia* slippers, socks and stockings. Thus, the wares of the parties overlap. Consequently, the channels of trade associated with the respective wares of the parties either could or would overlap.

As for the degree of resemblance between the trade-marks at issue [Para.6(5)(e)], the applicant's trade-mark CALVIN & Design is very similar in appearance and is identical in sounding and in the ideas suggested to the opponent's registered trade-mark CALVIN, as well as being similar in appearance, sounding and in the ideas suggested to the opponent's registered CALVIN KLEIN trade-marks.

Having regard to the foregoing and, in particular, to the degree of resemblance between the applicant's trade-mark CALVIN & Design and the opponent's registered trade-marks CALVIN and CALVIN KLEIN, and bearing in mind that the wares of the parties overlap and could travel through the same channels of trade, and bearing in mind that the opponent's CALVIN KLEIN marks have become fairly well known in Canada, I find that the applicant has failed to meet the legal burden on it of satisfying the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue. As a result, the applicant's trade-mark CALVIN & Design is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

The third ground relates to the applicant's entitlement to registration of the trade-mark CALVIN & Design, the opponent relying on its use of its CALVIN and CALVIN KLEIN trade-marks in Canada. As the opponent has established its prior use and non-abandonments of its trade-

marks in Canada, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the applicant's filing date, the material date for considering this ground. Having regard to my previous comments concerning the surrounding circumstances in assessing the likelihood of confusion between the trade-marks at issue in relation to the Paragraph 12(1)(d) ground, I find that there would be a reasonable likelihood of confusion between these trade-marks as of the filing date of the present application. Thus, the third ground is also successful. Further, having regard to the foregoing, it follows that the applicant's trade-mark was not distinctive as of the date of opposition. Consequently, the final ground of opposition is also successful.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 27th DAY OF JULY, 2000.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.