



TRANSLATION
THE REGISTRAR OF TRADE-MARKS

Reference: 2016 TMOB 188
Date of Decision: 2016-12-12
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Guru Denim Inc.

Opponent

and

OMEGA SA (OMEGA AG) (OMEGA LTD.)

Applicant

1,607,513 for DOUBLE OMEGA SYMBOL

Application

I Introduction

[1] Guru Denim Inc. (the Opponent) opposes registration of the DOUBLE OMEGA SYMBOL figurative trade-mark (the Mark) covered by application No. 1,607,513 in the name of OMEGA SA (OMEGA AG) (OMEGA LTD.). (the Applicant).



[2] The registration application was filed on December 20, 2012 and claims the priority of a corresponding application filed in Switzerland on July 10, 2012. The registration application is

based on the registration and use of the Mark in Switzerland and on the proposed use of the Mark in Canada in association with the following goods:

Products made of leather, namely personal planners, wallets, coin purses, business card holders, credit card holders, key holders, pouches, handbags, shoulder bags, backpacks, cases for portable telephones, cases for digital tablets.

[3] The determining question in the case at bar is the likelihood of confusion between the mark and the figurative trade-mark illustrated below, identified by the Opponent under *U Design* (in French, *U Dessin*), which is the subject of registration No. TMA763,227 and application No. 1,409,837-01 in view of extending the statement of goods and services of the registration:



[4] In general, the registration covers swimwear and bathing suits, and the registration application covers body and beauty care preparations, eyewear, leather and imitations of leather, precious metals and their alloys and goods in precious metals or coated therewith, as well as advertising and promotional services.

[5] Even though they are not related or affiliated companies, the parties are not strangers to each other. Indeed, by a decision dated May 27, 2015, the Registrar rejected the Applicant's opposition to the Opponent's registration application No. 1,409,837-01 [see *Omega SA v Guru Denim Inc*, 2015 TMOB 97, 135 CPR (4th) 287]. This decision is currently under appeal before the Federal Court [Case No. T-1359-15].

[6] The Opponent and the Applicant have not filed any evidence, or any written argument. Only the Applicant was represented at the hearing.

[7] For the following reasons, I consider it appropriate to reject the opposition.

II The grounds of opposition

[8] The statement of opposition was filed on February 4, 2014.

[9] As a preamble to the grounds of opposition raised pursuant to subsection 38(2) of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act), the Opponent alleges, in particular:

- the ownership of registrations Nos. TMA729,199 and TMA763,227, as well as registration application No. 1,409,837-01 for the U Design marks;
- the use of the U Design marks since at least the alleged registration dates and the claimed dates of first use therein; and
- the use of the U Design mark of application No. 1,409,837-01 since April 15, 2008 in association with products made of leather and imitations of leather.

[10] A table containing the details of the alleged registrations and registration applications is attached to the statement of opposition. It is reproduced in Appendix A of my decision.

[11] Thus, most of the grounds of opposition should be read in the context of the above-mentioned allegations. In summary, these are grounds of opposition according to which:

- the registration application does not satisfy the requirements of section 30(*i*) of the Act, in that the Applicant could not state it was satisfied that it was entitled to use the Mark in Canada, considering: (i) the prohibition set out in section 7(*b*) of the Act; and (ii) the previous use of the alleged marks by the Opponent;
- the Mark is not registrable according to section 12(1)(*d*) of the Act;
- the Applicant is not the person entitled to registration of the Mark according to sections 16(2)(*a*), 16(2)(*b*), 16(3)(*a*) and 16(3)(*b*) of the Act; and
- the Mark is not distinctive according to section 2 of the Act.

[12] The other grounds of opposition raised allege that the registration application does not satisfy the requirements set out in section 30 of the Act because:

- contrary to section 30(*d*) of the Act, the Mark was not used in Switzerland before the filing date of the application; and

- contrary to section 30(e) of the Act: (i) the Mark was used in Canada before the filing date of the application; and (ii) the Applicant did not intend to use the Mark in Canada in association with the goods identified in the registration application.

III The relevant dates

[13] The relevant dates for considering the circumstances in regard to the grounds of opposition are the following:

- sections 38(2)(a)/30 of the Act - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(b)/12(1)(d) of the Act - 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(2)(a) and (b)/16(3)(a) and (b) of the Act - the priority filing date of the application [see sections 16(2) and 16(3) of the Act]; and
- sections 38(2)(d)/2 of the Act - the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

IV The burden incumbent on the Parties

[14] The legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. 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, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidential burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

V Grounds of opposition summarily rejected

V.1 Grounds of opposition based on the requirements of section 30 of the Act

[15] In the absence of evidence of record, the Opponent was unable to discharge its initial burden. Consequently, since I cannot reasonably conclude the existence of the alleged facts, I summarily reject the grounds of opposition based on section 30(d), (e) and (i) of the Act.

[16] I will add that the mere knowledge of the existence of an opponent's trade-mark does not, in itself, substantiate an allegation that the applicant could not be satisfied it was entitled to use a mark [*Woot, Inc v WootRestaurants Inc/Les Restaurants Woot Inc* 2012 TMOB 197]. It is established by the case law that a ground of opposition based on non-compliance with article 30(i) of the Act should be accepted only in specific cases, in particular, when the applicant's bad faith is alleged and established or specific legislative provisions are an obstacle to the registration of the mark covered by the application [see *Sapodilla Co Ltd v BristolMyers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)].

V.2 Grounds of opposition based on sections 16(2)(a) and 16(3)(a) of the Act

[17] The grounds of opposition based on sections 16(2)(a) and 16(3)(a) of the Act are rejected because, in the absence of evidence, the Opponent did not discharge its initial burden of establishing that it used one of the alleged trade-marks in Canada, before the relevant date, namely July 10, 2012.

V.3 Ground of opposition based on the distinctiveness of the Mark within the meaning of section 2 of the Act

[18] Finally, the Opponent's absence of evidence means it did not discharge its initial burden of proving that one of its alleged trade-marks had become sufficiently known in Canada, as of February 4, 2014, to deny the distinctiveness of the Mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

VI Analysis of the remaining grounds of opposition

[19] The remaining grounds of opposition raise the following questions :

1. Is the Mark confusing with registrations Nos. TMA729,199 and TMA763,227?
2. As of July 10, 2012, was the Mark confusing with the trade-mark of registration application No. 1,409,837-01?

[20] I will analyze each of these questions in turn.

VI.1 Is the Mark confusing with registrations TMA729,199 and TMA763,227?

[21] This question arises from the ground of opposition whereby the Opponent alleges that the Mark is not registrable according to section 12(1)(d) of the Act because it is confusing with the Opponent's registrations Nos. TMA729,199 and TMA763,227.

[22] The exercise of the Registrar's discretionary authority allows me to confirm that the alleged registrations are in good standing. The Opponent has therefore fulfilled its initial burden. Thus, it is appropriate to determine whether the Applicant has discharged its legal onus of proving, according to the balance of probabilities, that there is no confusion between the trade-marks involved.

[23] The test for confusion is that of first impression and imperfect recollection. According to subsection 6(2) of the Act, 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[24] In deciding whether these trade-marks are confusing, the registrar shall have regard to all the surrounding circumstances, specifically those listed in subsection 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 goods, services or business; d) the nature of the trade; e) the degree of resemblance between the trade-

marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be given to each of these factors in a context-specific assessment. [See *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[25] I will concentrate my examination of the question on a comparison of the Mark with the figurative mark of registration No. TMA763,227 (the Cited Mark). If the Opponent does not prevail on the basis of this registration, it will not be any more successful on the basis of registration No. TMA729,199, which claims the colour red as a characteristic of the trade-mark.

[26] In the *Masterpiece* case, *supra*, the Supreme Court of Canada reminds us that the degree of resemblance between trade-marks in the presentation or sound, or in the ideas they suggest, is often the factor that can be the most important in the analysis regarding confusion; the Court decided to begin its analysis by examining this factor. Consequently, I begin with the examination of the degree of resemblance between the Mark and the Cited Mark.

[27] It is clearly established in case law that in the assessment of confusion, it is not appropriate to dissect trade-marks into their component parts. Trade-marks instead must be examined as a whole.

[28] For the following reasons, I find that significant differences exist between the trade-marks and, consequently, I conclude that the factor stated in section 6(5)(e) of the Act significantly favours the Applicant.

[29] The Mark seems to be composed of two symbols Ω , which refer to the letter of the Greek alphabet "omega", one being reversed and superimposed on the other. In evaluating the Mark as a whole, I find there is little resemblance with the Cited Mark, whether in presentation or in the ideas suggested.

[30] I find that an evaluation of the marks in terms of sound has little relevance in the case at bar, due to the fact that, as wordless designs, the Mark and the Cited Mark are unlikely to be pronounced. Even if I accepted the premise that the Cited Mark is a representation of the

letter "U", I could not accept that it resembles the Mark in terms of sound, considering the absence of the particularities of pronunciation of the Mark.

[31] Given the importance of the factor stated in 6(5)(e) of the Act, I find that the differences between the marks are sufficient in themselves to conclude, according to the balance of probabilities, that a consumer with an imperfect recollection of the Cited Mark would not be likely to believe that the goods associated with the Mark come from the same source or are otherwise related to or associated with the Opponent's goods. Accordingly, I conclude that the Applicant has not met its legal onus of establishing, according to the balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's registration No. TMA763,227.

[32] Indeed, in my opinion, there is no reason in the case at bar to conclude that one of the other factors enumerated in section 6(5)(a) to (d) of the Act, or a combination of these factors, can counterbalance the factor of section 6(5)(e), which significantly favours the Applicant.

[33] Moreover, in the absence of the Opponent's representations, I do not intend to proceed with an exhaustive analysis of the other factors. I will be satisfied to state that the mere existence of registration No. TMA763,227 cannot establish anything more than a minimal use of the Cited Mark in Canada and does not allow the conclusion of a continuous major use thereof [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Moreover, a comparison between the statement of goods covered by the application under opposition with the statement of goods covered by the Opponent's registration reveals differences between the type of goods associated with the parties' marks, namely products made of leather, on the one hand, and swimwear and bathing suits, on the other hand.

[34] I recall having indicated that if the Opponent does not prevail on the basis of registration No. TMA763,227, it will not be any more successful on the basis of registration No. TMA729,199. I thereby must determine whether the Applicant has met its ultimate onus of establishing, according to the balance of probabilities, that there was no likelihood of confusion between the Mark and registration No. TMA729,199.

[35] In view the above, I reject the ground of opposition based on paragraph 12(1)(d) of the Act.

VI.2 As of July 10, 2012, was the Mark confusing with the trade-mark of registration application No. 1,409,837-01?

[36] This question arises from the grounds of opposition alleging that the Applicant is not the person entitled to registration of the Mark within the meaning of sections 16(2)(b) and 16(3)(b) of the Act, due to the confusion created with the Cited Mark, which is the subject of registration application No. 1,409,837-01 filed previously by the Opponent.

[37] The exercise of the Registrar's discretionary authority allows me to confirm that the Opponent's registration application No. 1,409,837-01 was filed on November 8, 2010. I also confirm that the Opponent's application was pending on the date of the advertisement of the Applicant's application, namely September 4, 2013, in accordance with section 16(4) of the Act. The Opponent has therefore fulfilled its initial burden. Thus, it is incumbent on the Applicant to discharge its legal onus of proving, according to the balance of probabilities, that there was no confusion between the trade-marks as of July 10, 2012.

[38] In the examination of the question, I conclude an identity or an overlap between the products made of leather, as identified in the statement of the registration application of the Mark, and the goods "*Leather and imitations of leather, namely wallets, cases, key cases, bags, namely overnight bags, travelling bags, handbags, backpacks, purses, and clutches*", identified in the Opponent's registration application.

[39] Moreover, despite the absence of evidence establishing similarities between the nature of the trade of the parties, I find it is reasonable to conclude that the products made of leather associated with the marks in question may circulate in similar trade niches.

[40] Consequently, the factors set out in paragraphs 6(5)(c) and 6(5)(d) of the Act favour the Opponent.

[41] This having been said, for the reasons previously discussed, I find that significant differences exist between the trade-marks and, consequently, I conclude that the factor stated in

section 6(5)(e) of the Act significantly favours the Applicant. However, as mentioned previously, the Supreme Court of Canada declared in *Masterpiece*, supra, that the degree of resemblance between the marks is often likely to have the most importance in the analysis of confusion. In addition,

the Court declared:

[49] ...if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. These other factors become significant only once the marks are found to be identical or very similar...

[42] Thus, in the case at bar, I find that the factor set out in section 6(5)(e) of the Act prevails over the factors set out in section 6(5)(c) and (d) of the Act. In other words, I find that the differences between the trade-marks are sufficient to conclude, according to the balance of probabilities, the absence of likelihood of confusion between the Mark and the Cited Mark of registration application No. 1,409,837-01 as of July 10, 2012.

[43] Given the above, I reject the ground of opposition based on sections 16(2)(b) and 16(3)(b) of the Act.

VII Decision

[44] In exercising the authority delegated to me pursuant to section 63(3) of the Act, I reject the opposition to registration application No. 1,607,513, in application of subsection 38(8) of the Act.

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

Certified true translation
Arnold Bennett

Appendix A

Trade-mark	Application / Registration No.	Application / Registration Date	Wares and Services and Claims
 (U Design)	TMA763227	March 31, 2010	<p>WARES: (1) Clothing, namely, men's, women's, and children's pants, jeans, shorts, shirts, T-shirts, blouses, vests, skirts, jackets, coats, sweaters, sweatshirts, sweatpants, hats, belts and shoes. (2) Swimwear.</p> <p>CLAIMS: Used in CANADA since at least as early as December 31, 2003 on wares (1). Used in CANADA since at least as early as October 29, 2007 on wares (2). Used in UNITED STATES OF AMERICA on wares (1). Registered in or for UNITED STATES OF AMERICA on August 05, 2008 under No. 3,482,001 on wares (1).</p>
 (U Design)	TMA729199	November 21, 2008	<p>WARES: (1) Clothing, namely pants, jeans, shorts, overalls, shirts, t-shirts, blouses, vests, skirts, jackets, coats, sweatshirts, sweatpants.</p> <p>CLAIMS: Priority Filing Date: November 14, 2006, Country: UNITED STATES OF AMERICA, Application No: 77/044,078 in association with the same kind of wares. Used in CANADA since at least as early as December 31, 2002. Used in UNITED STATES OF AMERICA. Registered in or for UNITED STATES OF AMERICA on March 18, 2008 under No. 3,397,067.</p>
(collectively, the wares described in the above registrations are referred to herein as the "Opponent's Wares")			
 (U Design)	1,409,837 - 01	November 8, 2010	<p>WARES: (1) Body and beauty care preparations, namely shower gel, bath gel, perfumery, colognes, bath oils, after shave lotions, deodorants, eau de toilette, eau de parfum, body lotions and creams, and non-medicated skin care preparations. (2) Eyewear, namely eyeglass frames, eyeglass lenses, eyeglass cases, eyeglasses, spectacle cases, spectacle frames, spectacle</p>

			<p>glasses, spectacles, sunglasses, and parts and fittings for all the aforesaid goods.</p> <p>(3) Leather and imitations of leather, namely wallets, cases, key cases, bags, namely overnight bags, travelling bags, handbags, backpacks, purses, and clutches.</p> <p>(4) Precious metals and their alloys and goods in precious metals or coated therewith, namely jewellery, bracelets, pins, rings, earrings, necklaces, brooches, cufflinks, pendants, anklets, precious stones, and watches.</p> <p>SERVICES:</p> <p>(1) Advertising and promotions of goods and services of others available by electronic mail order and the internet; advertising, marketing and sales promotional services of the goods and services of others via television and direct mail; providing home shopping services offering a wide variety of goods in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery via television; mail order and catalog services offering a wide variety of goods in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery via a global computer network; retail services, namely retail store services in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery; online retail services, namely on-line department store services; advertising the goods and services of others via a global computer network; business management; business administration.</p> <p>CLAIMS:</p> <p>Used in CANADA since at least as early as November 18, 2008 on wares (1).</p> <p>Used in CANADA since at least as early as December 15, 2009 on wares (2).</p> <p>Used in CANADA since at least as early as April 15, 2008 on wares (3).</p> <p>Used in CANADA since at least as early as May 21, 2005 on services.</p> <p>Proposed Use in CANADA on wares (4).</p>
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**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS REGISTERED IN THE CASE**

DATE OF HEARING: 2016-09-07

APPEARANCES

No one appearing

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