

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

**Citation: 2015 TMOB 209**  
**Date of Decision: 2015-11-26**

**IN THE MATTER OF AN OPPOSITION**

**Levi Strauss & Co. and Levi Strauss &  
Co. (Canada) Inc.**

**Opponents**

**and**

**WAREHOUSE ONE CLOTHING LTD.**

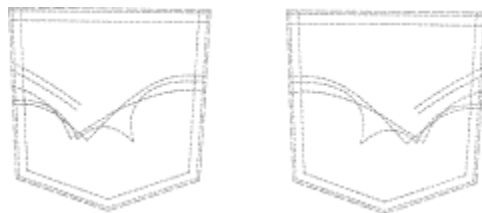
**Applicant**

**1, 517,504 for Pocket Stitching Design  
(ladies option)**

**Application**

I. Background

[1] On March 3, 2011, the Applicant filed application no. 1,517,504 for the trade-mark Pocket Stitching Design (ladies option) (the Mark), as shown below.

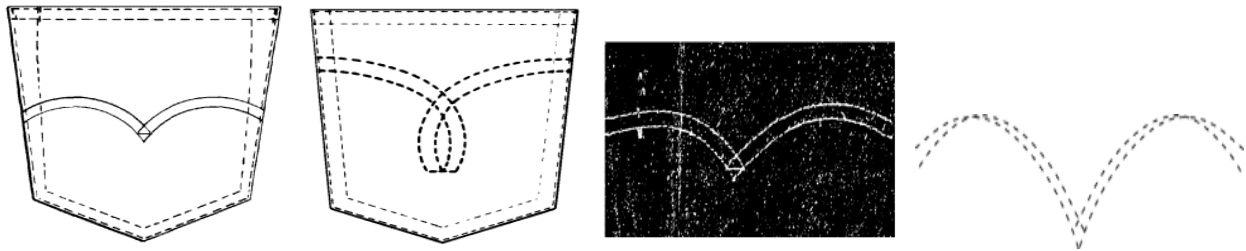


[2] The application for the Mark contains the following description:

The trade-mark consists of a two-dimensional stitching design as applied to the pockets. The representation of the pockets shown in dotted outline does not form part of the trade-mark, but merely shows the position of the mark.

[3] The application for the Mark is based upon use in Canada since at least as early as November 2009 for “jeans” and proposed use in association with “capris”, “shorts”, “skirts” and “pants”.

[4] The Opponent, Levi Strauss & Co., is the owner of the design trade-marks which are the subject of registration Nos. UCA39879 (for “garments, namely overalls”, TMA142,607 (for “garments, namely, jeans”), TMA517,605 (for “pants, bib overalls, coveralls, shorts, skirts, jackets and shirts”) and TMA814,704 (for “pants”), as shown below, respectively.



[5] The Opponent, Levi Strauss & Co. (Canada) Inc., is a wholly owned subsidiary and licensee of Levi Strauss & Co. Both of the aforementioned entities are hereinafter collectively referred to as the “Opponent”, unless otherwise stated.

[6] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of July 4, 2012 and on September 4, 2012, the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 12(1)(d), 16(1) and 2 (distinctiveness) of the Act. All three grounds turn on the issue of whether there is a likelihood of confusion between the parties’ trade-marks.

[7] The Applicant filed a counterstatement on November 13, 2012, denying each of the allegations set out in the statement of opposition.

[8] As evidence in support of its opposition, the Opponent filed the affidavit of Donna Keon, sworn March 13, 2013. Ms. Keon was not cross-examined.

[9] As evidence in support of its application, the Applicant filed the affidavit of Neil Armstrong, sworn July 10, 2013 (the Armstrong affidavit), the affidavit of Barbara Gallagher, sworn July 15, 2013 (the Gallagher affidavit), the affidavit of Jane Buckingham, sworn

July 9, 2013 (the Buckingham affidavit) and the affidavit of Generosa Castiglione, sworn July 5, 2013 (the Castiglione affidavit). Only Mr. Armstrong was cross-examined and the transcript of his cross-examination, including answers to outstanding questions has been made of record.

[10] As evidence in reply, the Opponent filed the affidavit of Alessandra Ocampo, sworn April 10, 2014 (the Ocampo affidavit) and the affidavit of Thomas M. Onda, sworn May 5, 2014 (the Onda affidavit). Neither was cross-examined.

[11] Both parties filed written arguments and attended a hearing on July 2, 2015.

## II. Onus and Material Dates

[12] 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].

[13] The material dates with respect to the grounds of opposition are as follows:

-sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*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(1) of the Act – the claimed date of first use in the application for “jeans”; and

- sections 38(2)(d)/2 of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## III. Analysis

[14] As the parties have both pointed out, all three issues in this case turn on whether there is a likelihood of confusion between the Mark and the Opponent’s trade-marks. Further, as acknowledged by both parties in their written arguments, nothing in this case turns on the material date at which confusion is assessed.

[15] I will begin by assessing the Opponent's section 12(1)(d) ground of opposition.

Registrability - Section 12(1)(d)

[16] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the design trade-marks which are the subject of registration Nos. UCA39879; TMA142,607; TMA517,605; and TMA814,704.

[17] The Applicant submits that the Opponent's best chance of success is with registered trade-marks UCA39879, TMA517,605 and TMA814,704, as most of the Opponent's evidence is centered around these marks. The Opponent agreed with this at the hearing. I also agree with it and accordingly, I will focus my analysis on the likelihood of confusion between the Mark and these marks.

[18] I have exercised my discretion to check the register and note that each of these registrations is extant. Therefore the Opponent has met its initial burden with respect to this ground of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

*Test for Confusion*

[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 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.

[20] 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 the trade-marks have been in use; c) the nature of the goods, 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), 2006 SCC 22 (CanLII),

49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v. Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

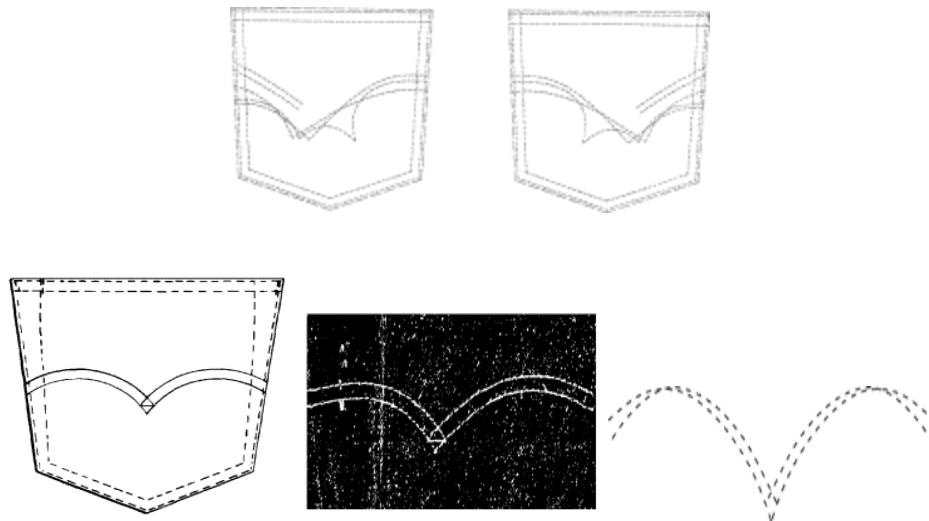
[21] In *Masterpiece, supra*, at para 49, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis. The other factors become significant only once the marks are found to be identical or very similar. If the marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors set out in section 6(5) of the Act would lead to a likelihood of confusion. For this reason, I will begin my analysis by considering the degree of resemblance between the parties' trade-marks.

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

[22] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality and that it is not correct to lay them side by side and carefully compare and observe the similarities or differences among their elements.

[23] In *Masterpiece*, at para 64, the Court stated that a preferable approach in assessing the degree of resemblance between trade-marks, is to first consider whether there is an aspect of the marks that is particularly striking or unique.

[24] In the present case, the marks at issue consist solely of a design component and I don't find that any one aspect of any of the designs is more dominant than others in the designs. I consider it appropriate to focus on the marks as a whole. I have reproduced the parties' marks below for ease of reference. However, I reiterate that a side by side comparison is not the approach to be taken when assessing the degree of resemblance between them.



[25] The parties' marks consist solely of designs which cannot be sounded and I do not find that any of them suggest any particular idea. Neither of the parties provided any detailed submissions with respect to the ideas suggested by their respective marks either. In view of this, I consider the section 6(5)(e) factor to turn on the degree of resemblance between the marks in appearance.

[26] Overall, I do not find there to be a particularly high degree of resemblance between the parties' trade-marks. I find the Mark, when viewed in its totality, to be fairly complex looking, with its offset and somewhat overlapping pattern of several partial and complete stitching lines and its disjointed and broken appearance. At the hearing, the Applicant described the Mark as being sort of "haphazard" or "messy" looking and I tend to agree with this visual characterization.

[27] By contrast, the Opponent's trade-marks are relatively simple in nature. They primarily consist of only two simple, continuous lines of solid or dashed stitching which come to a diamond point in the centre and they are symmetrical in appearance. The Opponent refers to and describes its marks as being "double arcuate" and I consider this to be an apt description of how they would be perceived visually. I would not characterize the Mark in the same way.

[28] I am of the view that the overall visual impression which is created by the parties' respective trade-marks is quite different and I find the marks to be more dissimilar than they are

similar. I therefore consider there to be a fairly low degree of resemblance between the parties' trade-marks.

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

[29] The Mark and the Opponent's registered trade-marks possess some inherent distinctiveness as they essentially consist of artistic renditions and there is no apparent connection between the designs and the parties' respective goods. However both parties' trade-marks are also decorative in nature and comprise line designs. Therefore they are not inherently strong marks [see *Levi Strauss & Co v Vivant Holdings Ltd* (2003), 34 CPR (4th) 53 (TMOB); and *Levi Strauss & Co v Abercrombie & Fitch Trading Co* 2013 TMOB 163].]

[30] The distinctiveness of a trade-mark can be enhanced through its use or promotion.

[31] Information pertaining to the parties' use of their respective trade-marks can be found in the Armstrong affidavit (for the Applicant) and in the Keon affidavit (for the Opponent). I will discuss some of the more pertinent contents of both of these affidavits below.

*Armstrong affidavit*

[32] Mr. Armstrong is the President and CFO of the Applicant. According to Mr. Armstrong, the Mark has been used in Canada in association with "jeans" since at least as early as November 2009 [para 9]. Attached as Exhibit C to Mr. Armstrong's affidavit are photographs of ladies' jeans bearing the Mark which Mr. Armstrong states are representative of how the Mark has been used on jeans sold in Canada by the Applicant since at least as early as 2009 through to the time his affidavit was sworn [paras 10 and 11]. In paragraphs 12 and 13, Mr. Armstrong provides details pertaining to other jean styles which the Applicant has sold in Canada or has recently introduced for sale which feature the Mark with minor deviations. Representative photographs showing jeans sold in Canada featuring these deviations of the Mark are attached as Exhibit D.

[33] According to Mr. Armstrong, the Applicant's jeans featuring the Mark are sold exclusively through its own retail outlets and on its website [paras 15-18]. At the time that Mr.

Armstrong swore his affidavit, the Applicant had 119 retail store locations in Canada and over 5,000,000 customers had visited its stores each year since it began selling its jeans in association with the Mark [para 16].

[34] In paragraph 19, Mr. Armstrong states that sales of the Applicant's jeans featuring the Mark (or the Mark with minor variations) in Canada have been in excess of \$7,400,000 from October 2009 to May 2013. Of those sales, \$2,796,115 (70,254 units) are attributable to jean styles featuring the Mark *per se* (i.e. without any deviations).

[35] In paragraph 21, Mr. Armstrong states that the Applicant's advertising spend in total has been 1.6%-1.9% of sales on average in recent years. Promotion and advertising of the Applicant's jeans in association with the Mark occurs on a national scale in the form of flyers, in-store displays and posters, newsletters and through prominent displays on the Applicant's website and social media sites, all accessible in Canada [para 22].

[36] Attached as Exhibit E is a representative sample of a promotional flyer dated December 2012 featuring the Mark as used on jeans. According to Mr. Armstrong, 1.5 million copies of this flyer were distributed in Canada in December 2012. Attached as Exhibit F is a copy of a Spring 2013 flyer featuring the Mark as used on jeans [para 23]. According to Mr. Armstrong, 1.2 million copies of this flyer were distributed in Canada in March 2013 [para 24].

[37] In paragraph 25, Mr. Armstrong states that the Mark has also received exposure through the Applicant's promotional events and activities, including charitable activities. By way of example, he indicates that in 2013, the Applicant donated \$40,200 to the Children's wish Foundation of Canada.

[38] The Mark and deviations of it are also displayed on the Applicant's website. According to Mr. Armstrong, for the period of June 1, 2012-May 31, 2013, there were 349,304 unique visitors originating from Canada to its website. Over the year prior to the swearing of his affidavit, Mr. Armstrong states that there were 50,532 unique page views of jean styles featuring the Mark or the Mark with minor deviations. A list of these styles and page views is provided at the end of paragraph 28 of Mr. Armstrong's affidavit. Representative print-outs of jean styles



featuring the Mark or the Mark with minor deviations are attached as Exhibit I. Exhibit J consists of print-outs of pages from various social media sites which are accessible in Canada.

[39] According to Mr. Armstrong the foregoing marketing and promotional materials and activities are representative of those featuring the Mark over each of the years 2009-2013 [para 31].

[40] Overall, I am able to conclude from Mr. Armstrong's affidavit that the Mark has been advertised and used in Canada for a few years and that it has become known to at least some extent in Canada.

*Keon affidavit*

[41] Ms. Keon is the Director of Finance of Levi Strauss & Co. (Canada) Inc. ("LSC"), which is a wholly owned subsidiary of Levi Strauss & Co. ("LS") [paras 1 to 3]. LS is the owner of Canadian trade-mark registration Nos. UCA 39879 and TMA517,605 for its "Double Arcuate Design", as well as TMA814,704, which is a slight variation of those marks [para 4]. According to Ms. Keon, these marks are used under license by LSC., in association with LEVI'S® brand products.

[42] LS is also the owner of Canadian trade-mark registration No. TMA142,607, which is used in association with GWG brand garments [para 5]. Ms. Keon states that since the LEVI'S® brand is the bigger and more famous brand, she has focused the discussion in her affidavit on that brand and its associated trade-marks (Nos. UCA 39879; TMA517,605; and TMA814,704), which she refers to as the "Arcuate Design trade-marks". It is for this reason that I have elected to focus my confusion analysis on these particular trade-marks.

[43] In paragraph 7, Ms. Keon notes that registration No. UCA39879 is registered for use in association with "garments, namely overalls" and she explains that at or around the time of its registration this term referred to various types of garments, including jeans, pants, coveralls, and what would currently be referred to as "overalls". This statement is supported by Exhibits B1-B3 of her affidavit and it is not disputed by the Applicant. I note that this issue has also been

addressed by the Federal Court in other proceedings involving the Opponent [*Levi Strauss & Co v Canada (Registrar of Trademarks)*, 2006 FC 654 at para 16].

[44] In paragraph 8, Ms. Keon states that most LEVI'S® brand pants (including overalls, coveralls and jeans) sold in Canada by LSC have been sold in association with the Arcuate Design trade-marks. Attached as Exhibit C1-C3 are photographs of representative garments of the type sold over the years in association with the Arcuate Design trade-marks. Ms. Keon states that some of the hang tags and flashers which are attached to LEVI'S® brand garments sold in Canada are also marked with the Arcuate Design trade-marks. Attached as Exhibits D1-D11 are copies of representative hang tags and flashers of the type used on garments sold by LSC in Canada since at least as early as 1984 [para 9].

[45] According to Ms. Keon, garments bearing the Arcuate Design trade-marks are sold extensively across Canada. In her estimation, between the years 1996 and 2012, over 58,000,000 LEVI'S® brand garments were sold in Canada by LSC, the majority bearing the Arcuate Design trade-marks. In her estimation, the wholesale value of these garments was more than \$1,500,000,000. Attached as Exhibit E are redacted versions of representative invoices from between 2008 to 2013 which show sales in Canada of LEVI'S® brand garments bearing the Arcuate Design trade-marks [para 10].

[46] In paragraph 11, Ms. Keon states that LEVI'S® brand garments bearing the Arcuate Design trade-marks are sold throughout Canada by: retail stores owned directly by LSC; retail stores operating in association with the trade-mark LEVI'S STORE® who primarily sell LEVI'S® brand garments; department stores such as THE BAY and SEARS; multi-brand specialty stores, including retail clothing chains such as MARK'S; and approximately 400-500 individual retail stores.

[47] With respect to advertising, Ms. Keon states that from 1973 to 2012, LSC spent more than \$225,000,000 on Canadian advertising and promotion of LEVI'S® brand products through television, cinema, radio, billboard and other media. According to Ms. Keon, the majority of LSC's expenditures relate to advertisements and promotions of LEVI'S® brand jeans bearing the Arcuate Design trade-marks [para 12].

[48] Ms. Keon points out that LSC also arranges and hosts promotional events aimed at advertising and promoting the LEVI'S® brand products bearing the Arcuate Design trade-marks [para 12]. Attached as Exhibit F1 are portions of representative media and marketing plans from between 1986 and 2006 showing the schedule and location of various media placements featuring the Arcuate Design trade-marks. Attached as Exhibits F2 and F3 are more recent representative media and marketing plans from 2010 and 2011.

[49] Further details pertaining to the promotion and advertising of LEVI'S® brand products in association with the Arcuate Design trade-marks is provided in paragraphs 13 to 21 and Exhibits G1-O of the Keon affidavit. Some of these exhibits include: a storyboard from a representative commercial broadcast (G1); representative television and theatre commercials and on-line videos from between 1986 and 2012 (G2); photographs of billboard, poster, transit and festival advertisements from 1993 to 2010 (H1-H9); copies of print advertisements from magazines from between 1977 and 2011 (I1-I7); copies of catalogue print advertisements from 1983 to 2013 (J1-J6); copies of newspaper, catalogue, door to door flyers, magazine and digital media advertisements by Canadian retailers of the Opponent's LEVI'S® brand garments published between 1976 and 2006 and 2012 to 2013 (K1-K4); and samples of a variety of point-of-sale advertisements dating as far back as 1979 (L1-L17). The Arcuate Design trade-marks are featured in many of these materials.

[50] I am satisfied from the Opponent's evidence that the Arcuate Design trade-marks have been promoted and used in Canada for a lengthy period of time and that their promotion and use has been extensive. Consequently, I find it reasonable to conclude that the Arcuate Design trade-marks have become quite well known in Canada.

[51] In view of the foregoing, I find that the section 6(5)(a) factor, which is an assessment of the combination of the inherent distinctiveness of the parties' trade-marks and the extent to which they have become known, favours the Opponent.

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

[52] This factor also favours the Opponent.

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

[53] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registrations that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[54] 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. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[55] In the present case, there is direct overlap in the parties' goods.

[56] Insofar as the nature of the parties' businesses and trades are concerned, I note that the Keon affidavit establishes that the Opponent's goods are sold by various retailers, including department stores, multi-brand retail clothing chains and other individual retail stores [para 11]. As pointed out by the Applicant, there is no evidence that the Opponent's goods are available for sale in the Applicant's retail stores. Although, the Applicant does carry third party goods from time to time [Armstrong transcript, Q's 35-39].

[57] According to the Armstrong affidavit, the Applicant markets its goods in association with the Mark exclusively through its own network of retail stores and online through its website. Goods bearing the Mark are not available through any third party retailers [paras 4-5 and 15-18]. In view of the foregoing, the Applicant submits that there is no overlap in the parties' channels of trade.

[58] While the parties' goods may not currently be sold at the same retail store locations, the fact remains that they both sell their goods in the same types of stores (i.e. clothing retail stores). Thus, they essentially sell identical goods through the same channels of trade. There are no restrictions in the application for the Mark with respect to where the Applicant can sell its goods.

In view of this, although the parties may not currently sell their jeans and other garments at the same stores, there is nothing precluding them from doing so in the future [*Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539 at para 61; *Thymes, LLC v Reitmans Canada Limited*, 2013 FC 127 at paras 40-41].

[59] I therefore find that this factor favours the Opponent.

*Surrounding Circumstances*

*Actual Confusion*

[60] In paragraph 33 of his affidavit, Mr. Armstrong states that despite contemporaneous use of the parties' trade-marks since November 2009, he is not aware of any instances of actual confusion, nor has he been made aware of any instances of reported confusion between the parties' jeans or trade-marks. As the Opponent has pointed out, there can still be a likelihood of confusion between trade-marks, even if there hasn't been any actual confusion [*Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22 at para 55]. I also note that in this particular case, the absence of actual confusion can be explained by the fact that the parties do not currently sell their goods through any of the same stores. I am therefore not prepared to draw any adverse inference based on the lack of evidence of instances of actual confusion in this case.

*State of the Register and Marketplace*

[61] As state of the register and state of the marketplace evidence, the Applicant submitted the Buckingham and Gallagher affidavits, and in reply thereto, the Opponent submitted the Onda and Ocampo affidavits.

[62] Ms. Buckingham is a trade-mark searcher for the agent for the Applicant. She conducted a search and located 23 Canadian trade-mark registrations for marks composed of pocket stitching designs, not including the marks at issue [para 2]. I am not going to reproduce the results of Ms. Buckingham's search here. However, I will note that the trade-marks located in her search appear to stand in the name of many different owners. I also note that some of the marks are arguably more similar to the Opponent's trade-marks than the Mark is, and some are not.

[63] Ms. Gallagher is a law clerk employed by the agent for the Applicant. She accessed the internet and printed web pages featuring a number of different jean pocket stitching design marks. The webpages are listed in paragraph 2 of her affidavit. Attached as Exhibits A1-A17 are print-outs from these web pages. Although Ms. Gallagher has not explained how she selected these particular web pages, in some instances, she has identified the trade-marks, the registration numbers and the owners of the trade-marks associated with the web pages. It would appear from this information that at least some of the trade-marks shown in the web pages correspond to the registered trade-marks that were located in Ms. Buckingham's state of the register search, while others do not. While some of the webpages appear to be Canadian or associated with Canadian retailers (for example, sears.ca, thebay.com, loisjeans.ca, dickies.ca), it is not clear that this is the case for others.

[64] In the Onda affidavit, Mr. Onda states that in response to the Gallagher affidavit, the Opponent instructed counsel to take steps in respect of the garments listed at #14 and #17 in paragraph 2 of the Gallagher Affidavit, but that counsel for the Opponent was unable to locate any offering for sale of the garments in issue. The Ocampo affidavit was filed to provide further support for the assertion that these two marks are no longer in use [paras 2 to 15]. Notably, the Opponent did not provide evidence to suggest that any of the other marks located by Ms. Gallagher are no longer in use.

[65] With respect to the Buckingham affidavit, the Opponent submits that this evidence is of little, if any assistance to the Applicant because only 23 marks were located, none of the marks located clearly evoke the idea of the Opponent's double Arcuate Design trade-marks, many do not include arcs at all and some include equally or more dominant other features. In addition, the Opponent notes that Ms. Buckingham has not provided any evidence with respect to the extent or duration of use of these marks in Canada.

[66] The Opponent raises similar objections to the Gallagher affidavit and also points out that merely attaching third party web pages does not establish truth of their contents, as they constitute hearsay, and the mere existence of the web pages does not establish the extent or duration of use of the marks or designs that may be displayed on them or even that the pages

have been accessed by relevant consumers [*ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056 at paras 21-22; aff'd 2005 FCA 96].

[67] I agree with the Opponent that Ms. Buckingham's search results and Ms. Gallagher's, for that matter, may have been of more assistance to the Applicant, had the marks located been greater in number and more similar in nature to the Opponent's trade-marks.

[68] At most, I find it reasonable to infer from these search results that pocket stitching design marks in general have some presence in the marketplace and that consumers have had at least some exposure to them. Mr. Onda confirmed as much in paragraphs 4-5 of his affidavit, wherein he states that many companies use different stitching designs on different styles of jeans.

*Position Taken by the Opponent in other Opposition Proceedings*

[69] As part of its evidence, the Applicant filed (by way of the Castiglione affidavit), a certified copy of the Opponent's written argument in another opposition proceeding involving the Opponent and a third party [paras 2 and 3]. The Applicant points out that in that proceeding, the Opponent argued that marks incorporating a triple arc design that resembles a "W", as does the Mark (according to the Applicant), should not be considered in an analysis in the state of the register because they "do not comprise any features that are similar to or resemble the Opponent's "double-arcuate design". I do not consider the position which was previously taken by the Opponent to be relevant to the case at hand. Each case must be decided on its own merit.

*Conclusion*

[70] As indicated above, section 6(2) of the Act is not concerned with confusion of the marks themselves, but confusion of the goods from one source as being goods from another source.

[71] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark on the Applicant's jeans or other garments, at a time when he or she has no more than an imperfect recollection of the Opponent's trade-marks in association with the same or similar goods and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20]. The

question posed is whether this individual would be likely to conclude that the Applicant's goods are manufactured or sold by the Opponent.

[72] In the present case, I would answer this question in the negative.

[73] It is true that the Opponent's trade-marks have been used in Canada for a very long time and that they have become quite well-known. It is also true that the parties' use their respective trade-marks on goods which are identical and which are typically sold through the same channels of trade. However, in view of the low degree of resemblance between the Mark and the Opponent's trade-marks, as a matter of first impression, I do not consider it likely that a consumer would confuse the source of the goods. Rather, I find that on a balance of probabilities it is not likely that a consumer would think that the goods associated with the Mark are sold by or sold under license by the Opponent, or are somehow otherwise affiliated with the Opponent. Accordingly, the section 12(1)(d) ground of opposition is rejected.

#### Entitlement - Section 16/ Distinctiveness - Section 2

[74] As previously mentioned, in the circumstances of this case, the date at which the issue of confusion is determined does not change the result of my analysis. To the extent that the Opponent has met its initial burden in respect of these grounds, they both fail for reasons similar to those set out above with respect to the section 12(1)(d) ground of opposition.



IV. Disposition

[75] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Hearing Date: 2015-07-02

Appearances

Brian P. Isaac

For the Opponents

Michael O'Neill

For the Applicant

Agents of Record

Smart & Biggar

For the Opponents

Gowling Lafleur Henderson LLP

For the Applicant