

**IN THE MATTER OF AN OPPOSITION
by Cluett, Peabody Canada, Inc. to
application no. 886,418 for the trade-mark
BLU AERO BY SEASONS & Design
filed by Aero Garment Limited**

On August 4, 1998, the applicant Aero Garment Limited filed an application to register the trade-mark BLU AERO BY SEASONS & Design, shown below:



The application is based on proposed use in Canada in association with the following wares:
ladies pants, jeans, shirts, blouses, skirts, dresses, T-shirts,
jumpers, overalls and socks.

The Examination Branch of the Trade-marks Office required the applicant to submit a revised application to include (1) a drawing clearly showing all the elements of the mark, and (2) a disclaimer to the exclusive use of the term BLU apart from the mark as a whole. The applicant complied with the Office requests which resulted in advertisement of the mark for opposition purposes in the *Trade-marks Journal* issue dated October 27, 1999. The subject application was opposed by Cluett, Peabody Canada, Inc. on March 4, 2000. On March 28, 2000 the Registrar forwarded a copy of the statement of opposition to the applicant. On April 28, 2000 the applicant responded by filing and serving its counter statement.

In its statement of opposition, the opponent pleads that it is the owner of many trade-mark

registrations, for use in association with shirts and other articles of clothing, which feature the component ARROW (hereinafter “the opponent’s ARROW marks”) including the marks ARROW, ARROW NATURALS, ARROW RUGGED WEAR, BRADSTREET BY ARROW, GOLDEN ARROW and THE ARROW COMPANY. The grounds of opposition allege that (i) the applied for mark BLU AERO BY SEASONS & Design is not registrable pursuant to Section 12(1)(d) of the *Trade-marks Act* because it is confusing with the opponent’s ARROW marks, (ii) the applicant is not entitled to registration pursuant to Section 16(3)(a) of the *Act* because the applied for mark is confusing with the opponent’s ARROW marks previously used in Canada by the opponent, and (iii) in view of confusion between the parties’ marks, the applied for mark BLU AERO BY SEASONS & Design is not distinctive of the applicant.

The opponent’s evidence consists of the affidavit of MaryAnne Lefebvre, legal secretary. The applicant’s evidence consists of the affidavit of Bob Kent, Vice-President of the applicant company. Ms. Lefebvre’s affidavit serves merely to introduce into evidence copies of the trade-marks registrations relied on by the opponent in the statement of opposition. Both parties filed a written argument, however, only the opponent was represented at the oral hearing.

Mr. Kent’s affidavit evidence may be summarized as follows. The applicant is a British Columbia company, located in Vancouver, which has carried on the business of manufacturing and marketing sportswear since the early 1920’s. The applicant has used the trade-name Aero Garment Limited since 1952 and has used the abbreviated trade-name Aero Garment since the late 1940’s. The applicant sells its sportswear across Canada, in the U.S. and in foreign markets. Annual sales,

at the wholesale level, are in the range of \$7 - \$12 million. Retail customers include the Hudson's Bay Company, Sears and Cleo. The applicant has used a number of marks that include the word AERO for particular lines of clothing and for defined periods of time, as is common in the clothing industry. Some marks were registered but if the mark was not in use when it came time to renew, the applicant would permit the registration to lapse. Such marks include AERO (used in the 1940's to 1970's), AG'S BY AERO (used in the late 1980's and early 1990's), PULSE BY AERO (used from about 1970 to 1985), AERO PRESSED FOR LIFE (used from 1965 to about 1980), and TYME BY AERO (used from about 1976 to about 1991).

The applied for mark BLU AERO BY SEASONS & Design was first used in late 1998. Sales under the mark have increased from \$1 million annually in 1999 to over \$2.5 million in 2001. Mr. Kent's assertions are supported by exhibit material which form part of his affidavit evidence.

With respect to the second ground of opposition, Sections 16(3) and 16(5) of the *Act* require the opponent to evidence use of its trade-marks prior to the applicant's filing date and to show that its trade-mark was not abandoned as of the applicant's date of advertisement (i.e. - October 27, 1999). The opponent's registrations are in evidence and may be relied on to establish use of its marks on or around a point in time, that is, the date appearing on the Declaration of Use recorded in the registration. However, the registration by itself is not sufficient to establish continuous use of a mark or non-abandonment of the mark after the filing of the Declaration of Use. Thus, the second ground of opposition is rejected because the opponent has failed to satisfy the statutory requirements for alleging non-entitlement. The third ground of opposition alleging

non-distinctiveness is also rejected because the opponent has not evidenced any significant use of its marks: see, for example, *Heavy Duty Cycles Ltd. v. Harley-Davidson Inc.* (1997), 72 C.P.R.(3d) 527 at 532 (F.C.T.D.).

The determinative issue in this proceeding is whether the applied for mark is confusing with one or more of the opponent's ARROW marks. The material time to assess the issue of confusion, with respect to the first ground of opposition, is the date of my decision: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark BLU AERO BY SEASONS & Design and any of the opponent's registered marks. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The

weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D).

In the instant case, the parties' marks do not possess a high degree of inherent distinctiveness and neither party has evidenced any significant reputation for their marks at any material time.

However, the component AERO has been used by the applicant as a component of its trade-names and trade-marks since the 1940's. The public would therefore have some familiarity with such use of the component AERO by the applicant. Further, the applied for mark began to acquire some reputation through use of the mark commencing in late 1998. Many of the opponent's marks have been registered for decades preceding the filing of the subject application, however, such long registration gives no advantage if the opponent does not establish actual use of its registered marks in the marketplace. The nature of the parties' wares are essentially the same or closely related and presumably would be sold through the same channels of trade. In the instant case the most important factor bearing on the issue of confusion is the degree of resemblance between the parties' marks.

The principles for deciding whether trade-marks resemble one another are submitted at pages 4-5 of the applicant's written argument:

With respect to determining whether or not one trademark resembles another, the trademarks are not to be broken down in their component parts, but rather each trademark as a whole is

compared to the other. As explained by Thorson, P. in *Sealy Sleep Products Ltd. v. Simpsons Sears Ltd.* (1960), 33 C.P.R. 129 at 136 (Ex.Ct.):

Trade marks may be different from one another and, therefore, not confusing with one another when looked at in their totality, even if there are similarities in some of the elements when viewed separately. It is the combination of the elements that constitutes the trade mark and it is in effect of the trade mark as a whole, rather than that of any particular part in it, that must be considered.

The comparison is made from the point of view of a member of the public. This test was elaborated on by Justice Blair in *Cochrane-Dunlop Hardware Ltd. V. Capital Diversified Industries Ltd.* (1976), 30 C.P.R. (2d) 176 at 188 (Ont. C.A.):

In considering whether and to what extent the marks resemble each other, the Court must place itself in a position of a dealer or consumer who may have an imprecise recollection of one mark when he sees the other mark for the first time. It is the impression which is likely to be received from the view of the marks as totalities which is crucial. What must be avoided is any attempt to dissect the marks and to analyze their detailed points of similarity or dissimilarity. Such meticulous examination is unrealistic in the marketplace.

While the component ARROW comprising the opponent's marks bears a high aural resemblance to the component AERO comprising the applied for mark, there are no other features of resemblance between the parties' marks. The overall visual impression created by the applied for mark is quite distinct from the opponent's marks. The idea suggested by the component ARROW is a stick with a pointed head while the ideas suggested by the applied for mark BLU AERO BY SEASONS & Design are (i) the colour blue, (ii) flying, and (iii) seasons. When regarded in their entirety the parties' marks are different visually, aurally and in ideas suggested.

As a surrounding circumstance with respect to the issue of confusion, the opponent has relied on

the adoption and use of a family of ARROW trade-marks. However, in view of the decision in *McDonald's Corp. v. Yogi Yogurt Ltd.*, 66 C.P.R. (2d) 101, an opponent relying on a family or series of trade-marks must evidence use of those marks in the marketplace. In the present case the opponent has not evidenced such use and therefore its existing "family" of trade-mark registrations does not advance the opponent's cause.

In view of the above considerations, I find that the applied for mark is not confusing with any of the opponent's marks at any material date. Accordingly, the opponent's opposition is rejected.

DATED AT GATINEAU, QUEBEC, THIS 13th DAY OF SEPTEMBER, 2004.

Myer Herzig,
Member,
Trade-marks Opposition Board