



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

Citation: 2014 TMOB 133
Date of Decision: 2014-06-25

**IN THE MATTER OF AN OPPOSITION
by ERREA' SPORT S.p.A. to application
No. 1495933 for the trade-mark HAND
Design in the name of Kombi Sports Inc.**

[1] Kombi Sports Inc. has applied to register the trade-mark HAND Design, shown below, based upon proposed use in Canada in association with winter ski and other types of clothing for men, women and children.



[2] ERREA' SPORT S.p.A. has opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and the Opponent's previous use and making known of its registered marks ERREA and Design for, *inter alia*, travel bags, sports clothing and gymnastic and sporting articles and ERREA REPUBLIC and Design for, *inter alia*, various types of stationery, bags, sportswear and leisurewear for men, women and children, both shown below.



[3] For the reasons that follow, I have found that this opposition should be rejected.

Background

[4] On September 14, 2010, Kombi Sports Inc. (the Applicant) filed application No. 1,495,933 for registration of the applied-for mark HAND Design (the Mark) based on proposed use in association with the following wares:

Men's, women's and children's overcoats, sport coats, jackets, slacks, parkas, hats, ski hats, ski caps, gloves, mittens, ski gloves, ski mittens, sports gloves, driving gloves, snowmobile mittens, snowmobile gloves, dress gloves and work gloves; Men's, women's and children's turtlenecks, underwear, sweaters, socks, sweatsuits, bathing suits, shirts, blouses, skirts, shorts, sweatpants, T-shirts, ski jackets, ski pants and vests.

[5] The application was advertised on March 16, 2011, and Errea Sport S.p.A. (the Opponent) filed a statement of opposition on May 13, 2011. The Opponent was granted leave to file an amended statement of opposition on March 7, 2013. Each of the grounds of opposition turn on the issue of likelihood of confusion between the Mark and either the Opponent's ERREA and Design mark, the Opponent's ERREA REPUBLIC and Design mark and/or the Opponent's common law double diamond design mark. In its statement of opposition the Opponent states that its marks have become very well known in Canada and internationally through their use and promotion, including promotion by the Opponent's sponsorship of professional sports teams, including football, basketball, volleyball and rugby teams, in many countries.

[6] In support of its opposition, the Opponent filed the affidavits of Jeannine Summers and Rosanna Fabbianni. In view of Ms. Fabbianni's failure to attend cross-examination, her affidavit is no longer part of the record pursuant to section 44(5) of the *Trade-marks Regulations*. Ms.

Summers was not cross-examined. The Opponent also requested and was granted leave to file a certified copy of its registration No. TMA820,009.

[7] As its evidence, the Applicant filed the statutory declarations of Edward Pascal and Janet Dell'Orto. Neither declarant was cross-examined.

[8] Only the Applicant filed a written argument.

[9] An oral hearing was held at which both parties were represented.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, RSC 1985, c T-13. There is however an initial 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 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(b)/Section 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 CPR (3d) 413 (FCA)];
- Section 38(2)(c)decision/Section 16(3)(a) and (b) – the filing date of the application [see section 16]; and
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issues

[12] Ms. Dell'Orto identifies herself as an in house translator and trade-mark agent with the Applicant's agent. Part of her evidence includes her opinion on the likelihood of confusion

between the Mark and the Opponent's trade-marks. I agree with the Opponent's agent that this portion of her affidavit should be disregarded because that is the issue that is to be ultimately determined by me and Ms. Dell'Orto has not been qualified as an expert on the issue of confusion.

[13] Ms. Dell'Orto also presented state of the register and state of the marketplace evidence. At the oral hearing the Opponent's agent pointed to various deficiencies in this evidence. In view that the Applicant has not relied on this evidence in its oral or written argument, I will not be commenting further on it.

Grounds of Opposition Summarily Dismissed

[14] Under the section 16(3)(a) ground there is an initial onus on the Opponent to show that at least one of its trade-marks had been used or made known in Canada prior to Applicant's filing date (i.e. September 14, 2010) and had not been abandoned at the date of advertisement of the application for the Mark (i.e. March 16, 2011) [section 16(4) of the Act]. Under the section 38(2)(d) ground the Opponent must show that at least one of its marks had become known sufficiently to negate the distinctiveness of the Mark as of the filing date of the statement of opposition (i.e. May 13, 2011).

[15] The section 16(3)(a) and section 2 grounds are dismissed because the Opponent has not met its initial burden. There is no evidence of record of any use or reputation of either of the Opponent's registered marks or its common law mark. While the Opponent has filed certified copies of its registration Nos. TMA820,009 and TMA567,191, the fact that both registrations refer to use is not sufficient for the Opponent to meet its burden for these grounds of opposition [see *Rooxs Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

Section 12(1)(d) Ground of Opposition

[16] The Opponent has also pleaded that the Mark is not registrable because it is confusing with the Opponent's ERREA and Double Diamond Design and ERREA REPUBLIC and Double Diamond Design trade-marks.

[17] As noted, the Opponent's evidence includes certified copies of both of its registered marks. I have exercised my discretion and checked the register to confirm that each of the registrations is extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[18] The Opponent's trade-marks are registered for use in association with the following wares:

ERREA and Design, registration No. TMA567,191:

- (1) Purses, handbags, trunks for traveling; suitcases, rucksacks, all purpose athletic and sport bags, duffel bags, overnight bags, tote bags, travel bags; briefcases, wallets.
- (2) Sports clothing namely hats, caps, muffs, dressing gowns; clothing accessory namely belts; hosiery; antiperspiration hosiery, socks, tights, shorts, leisure suits; track suits, track training suits.
- (3) Gymnastic and sporting articles namely sports ball, goalkeeper's gloves, shin guards for athletic use; abdominal belts and weight lifting belts.

ERREA REPUBLIC and Design, registration No. TMA820,009:

Adhesive tapes for stationery purposes, stationery, namely ball-point pens and fountain pens, pen cases for typewriters, calendars, rubber erasers, rulers, diaries, note books, paint brushes, pencils, greeting cards, computer mouse pads, writing and photocopy paper, cardboard; multipurpose sports bags, handbags, gentlemen's handbags; canvas bags, bags for balls, bags for campers, beach bags, travelling bags; key holders; beach bags; bum-bags; cosmetic bags; school satchels, trunks, travelling bags, suitcases, rucksacks; umbrellas, walking sticks, parasols; briefcases; leather and imitation leather; satchels; business cards cases; purses; notecases; sportswear and leisurewear for men, women and children, namely jumpers, T-shirts, vests, sweatshirts, pullovers, polo shirts, shirts, skirts, trousers, shorts, Bermuda shorts, jackets, coats, jeans, jerseys, neckties, suits, jump suits (clothing), full tracksuits for sports teams, training suits, sports kits for football, five-a-side football, volleyball, rugby and basketball, namely, shirts, shorts, pants and socks; clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, and running, namely, shirts, shorts, pants and socks; belts (clothing), belts for sports; shoes, sports shoes, namely shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise; ski boots, swimshoes, slippers; headgear, namely hats, berets, bonnets, ear muffs, headbands and sweatbands, hats and berets for sport, bandanas; gloves (clothing), scarves, wristbands; stockings, socks, sweat-absorbent stockings, slippers, tights; underwear, namely briefs, bras, camisoles, underpants, boxers, thongs, leg warmers, Bermuda shorts, elasticated T- shirts,

nightwear; beachwear and swimwear, namely swimming costumes, swimming trunks, beach robes; rainwear, namely raincoats, rainproof jackets, boots; decorative ribbons and braid; shoe laces; clothing buttons, hooks and eyes, pins and needles.

[19] As the Opponent's evidentiary burden has been satisfied, I must now consider whether the Applicant has established on a balance of probabilities whether there is a reasonable likelihood of confusion between the trade-marks.

test for confusion

[20] 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. 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 each has 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.

[21] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) the Supreme Court of Canada indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[22] Both the Mark and the Opponent's marks are inherently distinctive.

[23] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Applicant's President, Mr. Pascal, provides the following information:

- the Mark is an update of an original HANDS design trade-mark that had been used since 1971 and had generated over \$40 million in sales (Pascal, paras. 3, 5, 6, 7 and 9);
- the Applicant began making widespread use of the Mark in August 2011 on a variety of products, namely ski jackets, ski pants, hats, underwear, gloves and mitts, socks, face masks, neck warmers, mitten clips and hand and foot warmers (the "products") and has continued such use since that date (Pascal, para 10);
- the Applicant's products have been sold in the winter section of a variety of retailers, including national retailers, regional retailers, local retailers, ski resorts nationwide, and through the websites of various retailers (Pascal, paras. 11 and 12; Exhibits D and E);
- total sales of the products to retailers has exceeded \$7 million since use commenced in August, 2011 (Pascal, para 13);
- the Mark appears on invoices issued by the Applicant to retailers, in product catalogues from which retailers order the products and in images of the products within the product catalogues (Pascal, paras 14 and 15);
- the Mark also appears on all hangtags attached to the products, is included directly on certain products, appears prominently on the Applicant's website and also appears on promotional bags given to the Applicant's consumers (Pascal, para 16 and Exhibit H); and
- in January and February of 2011 and 2012, the Applicant participated in trade shows across Canada and at each of these trade shows the Mark has been displayed on the Applicant's booth, sample products and catalogues distributed to attendees (Pascal, para 18 and Exhibit L).

[24] At the oral hearing, the Opponent made the following submissions regarding what it considered to be deficiencies in the Pascal affidavit:

- the goodwill attached to the Applicant's previous HANDS Design trade-mark cannot transfer to the new Mark because there are drastic differences between the two marks;
- Mr. Pascal fails to provide a breakdown of sales in Canada;
- many of the wares for which the Applicant has shown sales of are not the applied for wares – as a result we do not know what percentage of the sales are for the applied for wares; and
- some of the use that has been shown by the Applicant is not use of the Mark but rather use of a compound mark.

[25] The Opponent further submits that as a result of these deficiencies, it is not possible to infer the extent to which the Applicant's mark has become known in Canada. I disagree.

[26] First, Mr. Pascal's testimony was not challenged by way of cross-examination. In any event, there is some evidence of concurrent use of the original Hands Design trade-mark with the Mark which supports the Applicant's assertion that consumers would view the Mark as an evolution of the former mark.

[27] With respect to sales in Canada, I note that most of Mr. Pascal's evidence relates to use of the Mark in Canada, including the list of all the Canadian trade shows the Applicant has attended, the list of large national retailers where the Applicant sells its wares, and the invoices to Canadian retailers attached as Exhibit F to Mr. Pascal's affidavit.

[28] With respect to the nature of the wares that have been sold, I agree with the Applicant that all of the wares sold are in the same family of wares and are very similar to the applied for wares. For example, face masks are similar to ski hats. It is clear that the Mark has been made known in association with winter clothing and accessories.

[29] With respect to the Opponent's final argument, I agree that in the evidence the Mark often appears above, beside or close to the mark KOMBI (Pascal, Exhibit J). I disagree that the use that has been shown is use of a compound mark as opposed to use of the Mark *per se*. The Mark clearly stands out from the additional wording and design features that surround it. As there is nothing to prevent two trade-marks from being used at the same time [see *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)], this fact does not affect the acquired distinctiveness of the Mark. Even if it did, the Applicant has also shown more than enough use of the Mark by itself.

[30] In my view, whether or not the Mark is viewed by the consumer as an evolution of its original HANDS Design trade-mark, the fact remains that the Applicant has shown over \$7M in sales in association with the Mark since it started using it in 2011. While not all of the wares for which it has shown use may be the exact same as the applied for wares, it is clear that the Mark has become known to a considerable extent in Canada in association with various types of winter clothing and accessories. I am therefore satisfied that the Mark has become known to a considerable extent in Canada in association with these types of wares.

[31] On the other hand, there is no evidence of any use of either of the Opponent's marks.

[32] Based on the foregoing information, I conclude that this factor favours the Applicant.

section 6(5)(b) - the length of time each trade-mark has been in use

[33] The length of time that each mark has been in use favours the Applicant for the same reasons as those set out above.

sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[34] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[35] The nature of the Applicant's business is that of winter clothing and accessories. These types of wares are not related to the Opponent's bags, gymnastics or sporting articles, stationery, umbrellas or other personal effects, footwear, underwear or decorative clothing accessories associated with its registration No. TMA567,191 for ERREA and Design. The only overlap with respect to this registration is between the applied for wares and the Opponent's sports clothing, namely hats, caps, muffs, track suits and track training suits.

[36] There is more overlap, however, between the applied for wares and the Opponent's clothing for skiing (including ski boots), sportswear and leisurewear for men, women and children, swimwear and other clothing wares associated with the Opponent's registration No. TMA820,009 for ERREA REPUBLIC and Design.

[37] With respect to the parties' channels of trade, the Applicant submits that it sells its wares in a variety of retail stores including large national retailers, regional retailers, local retailers, and major ski resorts. Its products are sold in the winter section of retail stores and at retailers that sell winter apparel and accessories exclusively. Relying on the evidence of Mr. Pascal, the Applicant submits that at those retailers where a wide variety of sports apparel is sold, winter apparel and accessories are often not in stock at the same time as summer apparel and, if they are, they are sold in distinct areas of such retailers and are not in close proximity [Pascal, paras 11, 25, 26].

[38] The Applicant also submits that the nature of the Opponent's trade is different from that of the Applicant. In this regard, the Applicant points to the copies of what appears to be the Opponent's website at *www.erre.it* (attached as Exhibit M to Mr. Pascal's statutory declaration) where it states that the Opponent has become a technical sponsor to a vast number of professional clubs in Italy and around the world not just in football (soccer) but also volleyball, basketball and rugby.

[39] Relying on the evidence of Ms. Summers, trade-mark paralegal with the Opponent's counsel, the Opponent submits that winter and summer clothing accessories are indeed sold by sports retailers at the same time of year, and even advertised in the same brochure. Arguing that Exhibit M to Mr. Pascal's affidavit is hearsay, the Opponent submits that there is no evidence of

record regarding what its channels of trade are. It further submits that, in any event, the Opponent's registered wares are not restricted to any particular sport.

[40] In my view, it is clear that the Applicant's products are associated primarily and foremost with winter apparel and accessories whereas the Opponent's registered wares include a wider variety of clothing wares including both summer and winter apparel. Even if I did not give much weight to the hearsay portion of Mr. Pascal's affidavit, I note that the Opponent stated itself in its statement of opposition that its marks have become very well known in Canada through the promotion by the Opponent's sponsorship of professional sports teams, including football, basketball, volleyball and rugby teams. While this may suggest that the nature of the Opponent's business is different than the Applicant, the fact remains that the Opponent's registrations are not restricted to specialized sports clothing or specialized sports clothing stores. I am therefore unable to conclude that there is a significant difference between the parties' channels of trade.

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

[41] As noted above, the Mark is a modernized and more abstract version of the Applicant's original HANDS Design trade-mark. For ease of reference, both are reproduced:



Registration No. TMA185,615



Application No. 1,495,933

[42] The Opponent's marks are also reproduced below for ease of reference:



[43] At the oral hearing, both parties went to some length in comparing and contrasting their respective designs. However, the test for confusion is a matter of first impression and imperfect recollection, not a side by side comparison of the marks. The law is clear that the trade-marks must be considered in their totality. Further, in *Masterpiece*, the SCC opined that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[44] Although both marks are comprised of what could be considered diamond designs, I do not find there to be a high degree of resemblance in appearance or sound between the marks because of their differences. In this regard, the Mark is dominated by the interlocking elements located at the center of the Mark whereas the dominant components of the Opponent's marks are their distinctive word components, namely ERREA and ERREA REPUBLIC.

Further surrounding circumstances

Fame of the mark

[45] The Applicant submits that as a further surrounding circumstance I should consider the significant fame of the original HANDS Design trade-mark, and its association with the Applicant. While I am satisfied from the evidence furnished that the Mark has become known to a considerable extent in Canada, I am not satisfied from the evidence furnished that it is entitled to the status of a famous mark in association with its wares and services as a result of the Applicant's prior use in of the original HANDS Design mark in association with similar wares. I therefore do not consider this to be a relevant surrounding circumstance.

No evidence of actual confusion

[46] The Applicant further submits that another surrounding circumstance is the lack of any evidence of confusion despite more than two years of alleged co-existence of the parties' marks.

[47] It is of course not necessary for the Opponent to evidence confusion in order for me to find that there is a likelihood of confusion but the absence of confusion despite the overlap of the wares and channels of trade may result in a negative inference being drawn about the Opponent's case [see *Monsport Inc v Vetements de Sport Bonnie (1978) Ltée* (1988), 22 CPR (3d) 356 (FCTD); *Mercedes-Benz AG v Autostock Inc* (1996), 69 CPR (3d) 518 (TMOB)]. I am prevented from drawing a negative inference in the present case, however, because there is no evidence of record with respect to use of either of the Opponent's marks.

Examiner's failure to cite Opponent's registration

[48] The Applicant has asked me to consider that the Examiner did not cite the Opponent's registration for ERREA and Design or its pending application for ERREA REPUBLIC and Design during the prosecution of the Applicant's application. However, this Board is not in a position to explain findings by the examination section of the Trade-marks Office. Further, the examination section does not have before it evidence that is filed by parties in an opposition proceeding [see the Board decisions in *Thomas J Lipton Inc v Boyd Coffee co* (1991), 40 CPR (3d) 272 at 277 and *Proctor & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 at 386]. I therefore do not consider this to be a relevant surrounding circumstance.

Conclusion

[49] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view the absence of a high degree of resemblance between the marks (mostly because of the highly distinctive word portions of the Opponent's marks), the differences between most of the parties' wares (notwithstanding the possibility that they could travel through the same channels of trade) and the extent known of the Mark, I find that the Applicant has satisfied its onus to show that,

on a balance of probabilities, confusion between the marks in the present case is unlikely. This ground of opposition is therefore unsuccessful.

Section 16(3)(b) Ground of Opposition

[50] The Opponent has also pleaded that the Applicant is not the person entitled to registration because, as of the date of filing of the application, the Mark was confusing with the trade-mark ERREA REPUBLIC and Design, in respect of which application No. TMA820,009 had been previously filed in Canada by the Opponent on May 17, 2010. The Opponent has met its initial burden with respect to this ground as its application was pending when the Applicant's application was advertised, as required by section 16(4).

[51] The main difference between this ground and the section 12(1)(d) ground is that, at the date of filing of the application, the Mark had not become known in Canada. While I did find this to be an important factor under the section 12(1)(d) ground, I still consider that it is the degree of resemblance between the trade-marks that is the most crucial factor in determining the issue of confusion [*Masterpiece; Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70]. In the present case there is an absence of a high degree of resemblance between the marks as a whole, especially in view of the distinctive word components of the Opponent's mark. I therefore find that the Applicant has satisfied its onus to show that, as of its date of filing, confusion between the marks in the present case was unlikely. The section 16(3)(b) ground of opposition is therefore unsuccessful.

Disposition

[52] 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.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office