



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

**Citation: 2013 TMOB 88**  
**Date of Decision: 2013-05-10**

**IN THE MATTER OF AN OPPOSITION  
by River Island Clothing Co. Limited to  
application No. 1,351,950 for the trade-  
mark RIVER ISLAND in the name of  
International Clothiers Inc.**

[1] On June 15, 2007, International Clothiers Inc. (the Applicant) filed an application to register the trade-mark RIVER ISLAND (the Mark) based on proposed use in Canada in association with “retail clothing store services” (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 1, 2008.

[3] On November 7, 2008, River Island Clothing Co. Limited (the Opponent) filed a statement of opposition against the application for the Mark. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant could not have stated that it was satisfied of its entitlement to use the Mark in association with the Services as it filed the application “in bad faith, with its eyes wide open and knowing of the existence of the Opponent’s reputation in Canada with respect to its trade name River Island Clothing Co. Limited and its trade-mark RIVER ISLAND, in the field of clothing, fashion accessories and retail stores services of clothing and fashion accessories and more particularly ‘men’s, women’s, boy’s and girls’ clothing and sports clothing namely suits, coats, jackets, capes, dresses, skirts, trousers, slacks, jeans, jumpsuits, shorts, jumpers, cardigans, jerseys, sweaters, sweatshirts, blouses, waiscoats [*sic*], shirts, t-shirts, raincoats, parkas, swimwear, belts (for wear), hats, scarves, collars, ties, gloves, underwear, lingerie, brassieres, foundation garments,

hosiery, stockings, tights, socks, housecoats, dressing gowns, sleepwear, boots, shoes, slippers, sandals; hairbands [*sic*], hair ornaments' and the following services: 'retail store services and retail fashion accessories store services'(the Opponent's Wares and Services)";

- pursuant to sections 38(2)(a) and 30(i) and 7(b) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services as the adoption and use of the Mark for such services "would direct public attention to its services in such a way as to cause or be likely to cause confusion in Canada" as between the Services and the wares and services and business of the Opponent contrary to sections 30(i) and 7(b) of the Act in light of the Opponent's reputation in Canada for its trade-name and trade-mark in the field of clothing and retail store services for clothing and fashion accessories;
- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive. The Mark does not and cannot act to distinguish the Services from the wares and services and business of the Opponent nor is it adapted so to distinguish them in view of the acquired reputation of the above trade-name and trade-mark in Canada by the Opponent in the field of clothing, fashion accessories and retail store services of clothing and fashion accessories.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed two affidavits of Zeina Waked, a paralegal employed by the Opponent's agent (one sworn August 14, 2009 and one sworn September 3, 2009) as well as an affidavit of John Moore, the Opponent's company Secretary. Both Ms. Waked and Mr. Moore were cross-examined on their affidavits and the transcripts and responses to undertakings form part of the record.

[6] The Applicant filed an affidavit of Keith Chung, a barrister and solicitor employed by the Applicant's agent, and an affidavit of Paul Brener, a Chartered Accountant and the VP of Finance and Administration for the Applicant. Both Mr. Chung and Mr. Brener were cross-examined on their affidavits and the transcripts form part of the record.

[7] I note that with respect to the cross-examination of Mr. Brener, the Opponent raised a preliminary objection regarding the fact that the responses to undertakings were not made of record. Specifically, the Opponent asks that I draw an adverse inference from the Applicant's failure to file responses to undertakings. I note that the failure was not a substantive one but rather the result of technical and administrative oversight. Specifically, I note that the Applicant

filed the responses to undertakings directly with the Registrar one day after the Opponent's deadline for doing so. Given that the responses were filed by the wrong party, and after the deadline, the parties were advised that these responses would not be made of record and the Opponent was given the opportunity to request an extension of time to make the responses of record [see section 44(4) of the Regulations]. The Opponent chose not to do so. I do not consider it appropriate in the circumstances to draw an adverse inference from the fact that the responses to undertakings were not made of record in the present proceeding. Rather, I am of the view that from a substantive legal perspective the affiant did respond to the undertakings given on cross-examination and the deficiency is merely of a technical nature. Finally, while I am not willing to draw an adverse inference, I will not be placing any weight on the responses which were not made of record.

[8] Both parties filed written arguments and an oral hearing was held at which both parties were ably represented. Both parties made substantial submissions, in their written arguments and at the oral hearing, based upon the evidence and supporting case law. I have considered all of the submissions and the evidence of record. Reference will only be made in my decision to those parts of the submissions and evidence which I consider directly relevant to my findings.

#### Onus and Material Dates

[9] 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].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## Section 30(i) Grounds of Opposition

### *Allegation of Passing Off (Section 7(b) of the Act)*

[11] I will deal with the second ground of opposition based on non-compliance with section 30(i) first. In this ground of opposition, the Opponent alleges that the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Services because the adoption and use of the Mark “would direct public attention to its services in such a way as to cause or be likely to cause confusion in Canada” contrary to section 7(b) of the Act. Section 7(b) of the Act is a statutory codification of the common law action for passing off.

[12] I would note that the Registrar has previously considered section 7(b) as a valid ground of opposition under the general principle that the Registrar cannot condone the registration of a mark if the applicant’s use of the mark would violate Federal legislation [see *Institute National des Appellations d’Origine v Pepperidge Farm* (1997), 84 CPR (3d) 540 at 556-557 (TMOB)].

[13] The three necessary components of a passing off action (pursuant to section 7(b) of the Act) are: (a) the existence of goodwill; (b) deception of the public due to a misrepresentation; and (c) actual or potential damage to the plaintiff [see *Ciba-Geigy Canada Ltd v Apotex Inc* [1992] 3 SCR 120 at paragraph 33].

[14] Thus, in order to meet its evidential burden the Opponent must provide sufficient evidence to support the alleged facts, including, and most importantly, the allegation that the Opponent has established a reputation in the trade-mark RIVER ISLAND in Canada as of the date of filing the application for the Mark. The Opponent submits that it has succeeded in doing so; however, for the reasons set out in the following paragraphs I do not agree.

[15] Mr. Moore provides statistics on hits to the Opponent’s website by Canadians (paragraph 15 and Exhibit E). Specifically, Mr. Moore states that from 2007 – 2009 between 5,000 and 40,000 Canadians viewed the Opponent’s website. The statistics are derived from a report generated by Google Analytics (Exhibit E). I note that the earliest figures date from late 2007 such that this evidence post-dates the material date for this ground of opposition. Furthermore, the report, having been prepared by a third party, constitutes hearsay. Hearsay deficiencies aside,

even if I was able to consider the Google Analytics data in support of this ground of opposition, I note that on cross-examination, Mr. Moore admitted that it could not be known whether these Canadians intended to view the Opponent's website or just happened upon it, or whether any of these individuals were ever actually customers of the Opponent's stores (Q119-130). The Applicant submits, and I agree, that evidence merely showing Canadian hits to a website in the absence of any other evidence relating to reputation in Canada (e.g. sales or advertising directly related to the Canadian marketplace) would likely be insufficient to support a finding that the mark had become known in Canada to any significant extent.

[16] Ms. Waked attaches to her September 3, 2009 affidavit printouts from the Vaughan Mills website which advertises the opening of the Applicant's first store but makes reference to the Opponent and the Opponent's website (Exhibits ZW-1, ZW-2, ZW-3 and ZW-4). As pointed out by the Applicant at the oral hearing, the printouts are dated August 31, 2009 and as a result this evidence postdates the material date for this ground of opposition and thus cannot be relied upon in support thereof.

[17] Mr. Moore attaches to his affidavit printouts from the *ebay.ca* website which displays a skirt for sale (Exhibit J). The skirt is listed as being from the Opponent's store. Firstly, I note that the printouts are dated after the material date and thus cannot be relied upon in support of this ground of opposition. Even if I was able to consider the printouts, I note that on cross-examination Mr. Moore admitted that it is not known where this skirt originated or who purchased it or whether it was even purchased from the *ebay.ca* website such that it is not clear that this is evidence of a sale of the Opponent's products in Canada (Q262-285).

[18] During his cross-examination, Mr. Brener was shown a printout from the website *www.dealcetera.ca* which appears to feature a coupon for the Applicant's store at the Vaughan Mills mall but it makes reference to the Opponent (Exhibit PB7 to the cross-examination of Mr. Brener). Firstly, I note that this printout postdates the material date and thus cannot be relied upon in support of this ground of opposition. Secondly, I note that even if I was able to consider this piece of evidence, it constitutes inadmissible hearsay.

[19] In its written argument, the Applicant submits that while Mr. Moore claims that RIVER ISLAND is "one of Britain's best known high street brands" and that sales of its RIVER

ISLAND products and services are substantial, he admitted on cross-examination that the Opponent has no stores in Canada and has had no sales in Canada (see Moore affidavit paragraphs 8-12 and Q44-48 and 68 on cross-examination). The Applicant submits that no evidence has been provided that a single Canadian has ever purchased any goods at any of the Opponent's stores or that a single Canadian has any knowledge of the Opponent's stores. I agree with the Applicant's submissions.

[20] The Applicant also points to the following evidence in support of its submission that the Opponent has not established a reputation in Canada in association with its RIVER ISLAND mark:

- a. Exhibits A and B to the Chung affidavit show that the Opponent had two applications in Canada, both of which were abandoned due to failure to file declarations of use and a registration that was expunged pursuant to section 45 of the Act (see Chung affidavit paragraphs 5-8, Exhibits C-F);
- b. Exhibit C to the Moore affidavit is a copy of a mail order catalogue for the Opponent's UK store. The Applicant submits that not only is there no evidence that the catalogue was ever mailed to Canada but also the currency displayed in the catalogue is pound sterling which is consistent with it being a UK document;
- c. Exhibit D to the Moore affidavit are copies of printouts from the Opponent's website; the prices thereon are listed in pound sterling and there is no indication that the Opponent has any stores in Canada (Moore cross-examination Q62, 108, 110);
- d. Exhibit F to the Moore affidavit are copies of the Opponent's corporate brochures. On cross-examination Mr. Moore admitted that none of the shops depicted in the brochure are in Canada nor is there any evidence that a single Canadian has ever seen the Opponent's shops or this brochure (Q169-Q170);
- e. Exhibit I to the Moore affidavit contains printouts of webpages in a language which the Opponent says is Korean. This is entirely irrelevant to the Opponent having an alleged reputation in Canada (cross-examination of Mr. Moore Q247-248; 258-259).

[21] Having reviewed the evidence of record, and the parties' submissions, I find that the Opponent has failed to establish any use or reputation for the trade-mark RIVER ISLAND in Canada. While I accept that the Opponent has an extensive presence in the European marketplace this evidence is not sufficient to infer a finding of reputation in Canada.

[22] Based on the foregoing, the ground of opposition based on sections 30(i) and 7(b) necessarily fails on account of the Opponent's failure to establish evidence of a reputation for its RIVER ISLAND mark in Canada.

*Bad Faith Allegation*

[23] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement. The Opponent alleges that the Applicant filed the application for the Mark "in bad faith, with its eyes wide open and knowing of the existence of the Opponent's reputation in Canada with respect to its trade name River Island Clothing Co. Limited and its trade-mark RIVER ISLAND" in the field of clothing, fashion accessories and the retail sale of these items.

[24] The Opponent bases its bad faith allegation on: Mr. Brener's conduct on cross-examination; evidence which the Opponent alleges supports a finding that the Applicant had engaged in a pattern of applying for trade-marks similar to established brands; and the fact that the Applicant, or entities related to the Applicant, has previously been engaged in other trade-mark disputes (i.e. Tommy Hilfiger, French Connection, Target Apparel).

[25] I will deal with the three submissions made in support of this ground of opposition in turn.

[26] The Opponent first submits that Mr. Brener's conduct on cross-examination and more generally the selection of Mr. Brener as the Applicant's affiant supports a finding of bad faith on the part of the Applicant. The Applicant's agent objected to a number of questions posed on cross-examination on the basis of relevance, including those detailed below. For the purposes of assessing whether these refusals were appropriate in the circumstances, I note that while the ambit of questioning in a cross-examination can go beyond the four corners of the affidavit itself, the questions must relate to relevant issues to the opposition proceeding [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB) at 332; *Coca-Cola Ltd v*

*Cie Française de Commerce International Cofci SA* (1991), 35 CPR (3d) 406 (TMOB) at 412;  
*Distrimed Inc v Richards Packaging Inc* (2012), 108 C.P.R. (4th) 33 (TMOB) at para 19-20].

- a. The Applicant's agent objected to questions posed regarding the Applicant's labels and a photograph of the Applicant's storefront (Q109-125 and Exhibit PB2 and PB4; Q221-224 and PB8). Mr. Brener also appeared not to recognize the Applicant's labels which were put to him during cross-examination.
  - i. At the oral hearing the Applicant submitted that these questions were not relevant as they dealt firstly with facts that post-dated the material dates for the grounds of opposition and secondly that they related to documents which had not been identified by Mr. Brener and thus could not properly be made exhibits to his cross-examination. I agree with the Applicant's submissions and thus I find that these refusals were appropriate in the circumstances.
- b. Mr. Brener was not overly familiar with the types of products sold at the Applicant's RIVER ISLAND store at the Vaughan Mills Mall (Q170-176).
  - i. The Applicant submitted that these questions were not relevant as they dealt with circumstances that post-dated the material dates since the Applicant's store did not open until August 2009. I agree with the Applicant's submissions and thus I find that these refusals were proper in the circumstances.
- c. The Applicant's agent objected to questions regarding the Vaughan Mills website incident (Q181-195).
  - i. At the oral hearing the Applicant submitted that these questions were not relevant as they dealt with circumstances that post-date the material dates. I agree and thus I find that these refusals were proper in the circumstances.
- d. The Opponent submitted that Mr. Brener did not seem to know the basics about the Applicant's operations; he was unsure of the nature of the products sold at the Applicant's store, was not familiar with the labels or with the storefront, etc.
  - i. The Applicant submitted that Mr. Brener is an accountant and is not in charge of operations for the Applicant. Furthermore, the Applicant submitted that it is a large corporation with many brands such that someone in Mr. Brener's position would not be expected to be intimately familiar with the details of the operations carried out under the Mark. I am satisfied, based on a review of Mr. Brener's evidence as a whole, that he was properly qualified to provide affidavit evidence in support of the application for the Mark.



[27] I would add that even if Mr. Brener had answered the questions regarding the Vaughn Mills website incident and the Applicant's storefront and labels, this evidence would have post-dated the material dates and thus would not have been relevant to the issues in the present opposition in any event.

[28] The second submission the Opponent makes in support of its allegation of bad faith is that the Applicant's actions were similar to those of Mr. Marcon in *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB). Specifically, the Opponent pointed to printouts from the Canadian Intellectual Property Office (CIPO) Trade-marks Database which it states demonstrate a series of applications applied for by the Applicant or its related companies for trade-marks similar to arguably established marks which were ultimately abandoned (Exhibit PB9 to the cross-examination of Mr. Brener). The Opponent submits that this supports a finding that the Applicant was engaged in a pattern of applying for trade-marks already registered by other entities.

[29] The results presented to Mr. Brener on cross-examination emanated from a search of the CIPO Trade-marks Database for trade-mark applications with a status of "inactive" owned by International Clothiers Inc. The document, dated October 5, 2010, includes only a list of the trade-marks and associated status (abandoned/expunged).

[30] The Applicant objected to the search results being made an exhibit as Mr. Brener was not able to identify the document. The Applicant further objected to questions relating to the search results on the basis of relevance (Q225-229).

[31] I agree with the Applicant's submissions and I refuse to place any weight on the search results. As a result, I am not satisfied that the Opponent has provided sufficient evidence to support the second submission in support of the bad faith allegation and I reject it.

[32] The third submission the Opponent makes in support of its allegation of bad faith is that the Applicant is familiar with intellectual property law by virtue of being involved in various intellectual property disputes over the years and thus was sophisticated enough to intentionally adopt a mark identical to the Opponent's mark in association with identical services in an attempt to usurp the Opponent's goodwill. In support of this submission, the Opponent points to

the decisions from three trade-mark disputes in which the Applicant or one of its related companies was involved.

[33] Firstly, the Opponent points to *Tommy Hilfiger Licensing Inc v International Clothiers Inc* [2004] Carswell Nat 2103 (FCA) in which the Applicant was involved in a copyright and trade-mark infringement dispute with Tommy Hilfiger. The Opponent submits that the fact that the Applicant was involved in this dispute supports a finding that the Applicant is aware of trade-mark law and made its decision to adopt the Opponent's mark knowingly. I do not accept the Opponent's submissions on this point. I find the Applicant's involvement in this unrelated dispute to have no bearing on the present opposition proceeding.

[34] Secondly, the Opponent points to *French Connection Ltd v International Clothiers Inc* [2007] CarswellNat 2281 (TMOB) an opposition decision in which the Applicant's application for the trade-mark FHUK was refused due to confusion with the trade-mark FCUK owned by French Connection Ltd. The Opponent submits that the fact that the Applicant has previously filed at least one trade-mark which was similar to a registered trade-mark and was unsuccessful in an opposition proceeding supports a finding that the Applicant intentionally adopted the Opponent's mark in bad faith. Again, I refuse to accept the Opponent's submissions on this point. The fact that the Applicant was involved in an opposition proceeding with respect to an unrelated trade-mark is not relevant to the Applicant's intentions at the date of filing the application for the Mark.

[35] Lastly, the Opponent points to *Bereskin & Parr v Fairweather Ltd* (2005), 40 CPR (4th) 92 (TMOB); rev'd 58 CPR (4th) 50 (FC). This was a section 45 decision regarding the trade-mark TARGET APPAREL which was owned by a company related to the Applicant. The Applicant submits, and I agree, that the facts of this case are completely irrelevant and not applicable to the present case.

[36] Having reviewed the evidence and the parties' submissions, I am not satisfied that the Opponent has provided sufficient evidence to meet its evidential burden under section 30(i) of the Act and the first ground of opposition based on section 30(i) is accordingly dismissed.

## Non-distinctiveness Ground of Opposition – Section 38(2)(d) of the Act

[37] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[38] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, one or more of the RIVER ISLAND mark and the Opponent's trade-name River Island Clothing Co. Limited had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[39] I adopt the findings made above in the ground of opposition based on sections 30(i) and 7(b) on the issue of the Opponent's failure to establish a reputation for its RIVER ISLAND mark in Canada with the following modification. I note that Google Analytics report pre-dates the material date for the non-distinctiveness ground of opposition and thus it could be relevant to show some visits to the Opponent's website by Canadians (Moore affidavit, Exhibit E). Hearsay deficiencies aside, I note that while the Google Analytics report evidences some visits to the Opponent's website by Canadians, I am not satisfied that this evidence by itself is sufficient to establish that the Opponent's RIVER ISLAND mark had become known sufficiently in Canada to negate the distinctiveness of the Mark. As a result, the Opponent has failed to meet its evidential burden and the non-distinctiveness ground of opposition is dismissed accordingly.

## Disposition

[40] 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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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office