

IN THE MATTER OF AN OPPOSITION by R. Griggs Group Limited, R. Griggs & Company Limited, “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, and GMF GmbH Trademarks to Application No. 721,466 for the trade-mark DOC’S in the name of Groupe Yellow Inc./Yellow Group Inc.

On January 26, 1993, Groupe Yellow Inc./Yellow Group Inc. (the “Applicant”) filed an application to register the trade-mark DOC’S (the “Mark”) in association with “men’s, women’s and children’s footwear, namely: shoes, athletic shoes, walking shoes and boots” on the basis of use in Canada since at least as early as August 1, 1992.

The application was advertised for opposition purposes in the *Trade-marks Journal* of December 5, 2001. A statement of opposition was filed on February 5, 2002 naming (1) R. Griggs Group Limited, (2) R. Griggs & Company Limited, (3) “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, and (4) GMF GmbH Trademarks, as joint opponents (the “Opponents”).

The first ground of opposition is that the application does not comply with the requirements of Section 30 of the *Trade-marks Act* (the “Act”) since (a) the applicant never used the Mark; (b) alternatively or cumulatively, the Applicant has abandoned the Mark in whole or in part; and (c) the statement that the Applicant is satisfied as to its entitlement to the use of the Mark is false in view of the content of the statement of opposition.

The second ground of opposition is that the trade-mark is not registrable pursuant to the provisions of Section 12(1)(d) since it is confusing (a) with the registered trade-marks DR. MARTENS (Registration Nos. TMA420,485; TMA491,426 and TMA489,555), DR. MARTENS AIR CUSHION SOLE & Design (Registration No. TMA475,799) and DR. MAERTENS LUFTPOLSTRECHUH (Registration No. TMA289,513), all owned by “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership; and (b) with the registered trade-mark DOX & Design (Registration No. TMA511,812) owned by GFM GmbH Trademarks.

The third ground of opposition is that the Applicant is not the person entitled to registration of the Mark since, contrary to Section 16(1)(a) introductive of the Act, at the date of first use (inasmuch as there were any use) and at any other relevant time, the Mark was confusing (a) with the trade-mark DR. MARTENS previously used or made known in Canada by “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership (or for its benefit by a licensee) in association with “clothing and clothing accessories, namely trousers, slacks, shorts, jumpers, sweaters, pullovers, shirts, t-shirts, sweatshirts, polo shirts, vests, parkas, jackets, raincoats, waistcoats, thermal shirts, hats, caps, scarves,

leggings, gloves, headgear, shoes and boots and other articles of footwear and components for shoes and boots including soles, heels and inner soles; luggage, bags, sacks, satchels and cases; leather and imitations of leather, namely handbags, and other cases not adapted to the product they are intended to contain and small leather articles, namely purses, pocket wallets and key cases; animals skins and hides; trunks and travelling bags” and (b) with the trade-mark DOC MARTENS for the above-identified wares. The Opponents further state that the Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of Section 16(1) introductive of the Act, (a) the application does not comply with the requirements of Section 30; (b) the Mark is not registrable; and (c) the Mark is not a used one but rather a proposed one.

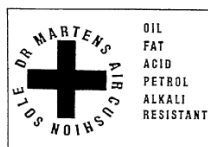
The fourth ground of opposition is that the Mark is not distinctive and is not adapted to distinguish the Applicant’s wares from the wares or services of others, including “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, and GFM GmbH Trademarks. The Opponents further allege that the Mark is not distinctive because (a) it is used outside the scope of the licensed use provided for by Section 50; and (b) as a result of its transfer, more than one person had rights into the Mark and exercised these rights contrary to the provisions of Section 48(2) of the Act.

The Applicant filed and served a counter statement on June 26, 2002. The Opponents filed evidence as well as a written argument. The Applicant elected not to file evidence and did not file a written argument. Only the Opponents were represented at the oral hearing.

**Opponents’ evidence**

The Opponents filed Certificates of Authenticity for the following trade-mark registrations:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
DR. MARTENS	TMA420,485	Clothing and clothing accessories, namely trousers, slacks, shorts, jumpers, sweaters, pullovers, shirts, t-shirts, sweatshirts, polo shirts, vests, parkas, jackets, raincoats, waistcoats, thermal shirts, hats, caps, scarves, leggings, gloves, headgear shoes and boots and components for shoes and boots including soles, heels and inner soles; luggage, bags, sacks, satchels and cases; leather and imitations of leather, namely handbags, and other cases not adapted to the product they are intended to contain and small leather articles, namely purses, pocket wallets and key cases; animals skins and hides; trunks and travelling bags.



TMA475,799	Footwear and parts thereof, namely shoes, boots, sandals, laces, buckles, welts, soles, heels, heel inserts, inner soles, shanks, cushion pads and fillers.
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The Certificates of Authenticity confirm that “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, owns the registrations. From the footnotes of both registrations, I note that “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, became their owner by assignment. The footnotes indicate January 30, 1998 as the date of registration of the assignment and February 24, 1997 as the date of change.

A Certificate of Authenticity of notice of recordal and licence agreement thereto have also been filed as evidence. The licence agreement confirms that R. Griggs Group Limited and R. Griggs & Co. Ltd. have the exclusive right in the whole of Canada to use, amongst others, the trade-marks covered by Registration Nos. TMA420,485, TMA489,555, TMA475,799 and by Application No. 763,824 (now Registration No. TMA491,426) with respect to all the wares identified in the registrations and application.

Affidavits of Peter Sauer, Claude Sincennes, Marie-Josée Lapointe and Catherine Lemay complete the evidence. None of the Opponents’ deponents has been cross-examined.

#### Affidavit of Peter Sauer

Mr. Sauer is President of Stage 4 International Footwear Inc. (“Stage 4”), the distributor in Canada of various articles of footwear under the trade-mark DR. MARTENS since August 31, 2000. He states that from that date up to the date of his affidavit [January 24, 2003], Stage 4 has distributed footwear under the trade-mark DR. MARTENS to various retail chains across Canada, which amount to at least 268 retail stores. A list of such stores is attached as Exhibit PS-1. At paragraph 7 of his affidavit, Mr. Sauer states that since August 31, 2000, Stage 4 has sold 90,608 pairs of footwear to its retail customers who in turn sell the products to Canadian consumers. At the oral hearing, I pointed out to the Opponents’ agent that the number 90,608 has been hand written in the affidavit without the entry being initialized. Since the Applicant elected to forgo cross-examination, which could have clarified this issue, I accept the Opponents’ submission that I have no reasons to question the validity of the hand written entry.

Mr. Sauer, who has access to and visits from time to time the establishments of Stage 4’s various retail customers, confirms that footwear articles are sold under the trade-mark DR. MARTENS in these retail establishments. He states that the trade-mark can be seen on the boxes in which the footwear articles are sold and in store displays. He attaches as Exhibit PS-2 various colour photographs illustrating the display of the trade-mark DR. MARTENS in stores, either on boxes or signage. These photographs were taken in October 2001 in three different retail establishments operating in Canada, namely: Shoes 22 in Waterloo (Ontario), Soley Shoes in New Glasgow (Nova Scotia) and Shoetopia in Fergus (Ontario). Some

photographs show the logo reproduced hereafter (the “Logo”) on the wall above a display of footwear boxes as well as on the boxes. Other photographs illustrate the Logo on store window and inside signage.



I find that the Logo depicted on the wall in close proximity to the footwear on display for sale amounts to use of the trade-mark DR. MARTENS within the meaning of Section 4(1) of the Act, in that it creates sufficient notice of association between the wares and the trade-mark at the time of transfer [see *Loblaws Ltd. v. Richmond Breweries Ltd.* (1982), 73 C.P.R. (2d) 258 (T.M.O.B); *Loblaws Ltd. v. Richmond Breweries Ltd.* (1983), 78 C.P.R. (2d) 258 (T.M.O.B)]. However, the Logo depicted on store window and inside signage not shown in close proximity to footwear on display for sale does not amount to use of the trade-mark within the meaning of Section 4(1).

At the oral hearing, the Opponents’ agent directed my attention to the photographs taken at Shoes 22 that show DOCS displayed on signage on top of footwear boxes and in close proximity to them, as well as DOC MARTENS displayed on signage on top of footwear boxes. I may reasonably infer from the photographs that DOCS and DOC MARTENS are displayed in proximity to boxes for footwear associated with the trade-mark DR. MARTENS. I note that the trade-mark DOC MARTENS has been alleged in support of the non-entitlement ground of opposition based upon Section 16(1)(a), but not the trade-mark DOCS. I should add that there is no reference to the trade-mark DOCS in the statement of opposition. Even if I were to find that the display of DOC MARTENS on signage in close proximity to the wares could amount to use within the meaning of Section 4(1), the photographs would be evidence of use in October 2001 only.

Mr. Sauer attaches as Exhibit PS-3 copies of randomly selected and representative invoices relating to DR. MARTENS footwear and that have been issued by Stage 4 to retail chains or establishments. I note that the exhibit comprises two invoices dated September 22, 2000 and November 12, 2001.

Mr. Sauer concludes by stating that the trade-mark DR. MARTENS has not been abandoned and its use continues without interruption.

### Affidavit of Claude Sincennes

Mr. Sincennes is Vice President Finance of The Aldo Group Inc./Le Groupe Aldo Inc. (“Aldo”). He states that Aldo is the distributor in Canada of different types of footwear under the trade-mark DR. MARTENS since at least as early as 1989. I should remark that the year 1989 has been hand written at paragraphs 3 and 6 of the affidavit without these entries being initialized. Since the Applicant elected to forgo cross-examination, it could again be argued that I have no reasons to question the validity of the hand written entries. Nonetheless, I would remark that the application having resulted in Registration No. TMA420,485 was filed on December 17, 1990 based on proposed use of the trade-mark in Canada. In addition, there is no documentary evidence or further information supporting Mr. Sincennes’ statements with respect to the year 1989.

Mr. Sincennes states that the footwear, supplied to Aldo for distribution in Canada, is sold in various retail establishments specialized in the field of footwear and operated by Aldo. A list of such stores is attached as Exhibit CS-1. He further states that Aldo’s sale figures of various types of DR. MARTENS footwear, be it boots, shoes or sandals, that amounted to a minimum of \$20,000,000 per year for 1998, 1999 and 2000 are illustrative of Aldo’s sale figures of various types of DR. MARTENS footwear, these sales continuing during the years 2001 and 2002.

Finally, Mr. Sincennes attaches as Exhibit CS-2 the reproduction of a box that is representative of those in which DR. MARTENS products are sold in Canada. The Logo and the words DR. MARTENS are displayed on the footwear box. Some marking appears on one side of the box cover, including “© R. Griggs Group Ltd.” and the sentences “*Dr. Martens is a registered trademark used under license. The Dr. Martens AirWair logo is a trade mark used under license*”.

### Affidavit of Marie-Josée Lapointe

Ms. Lapointe introduces as evidence the results of an Internet search concerning the terms “doc’s” that she conducted on January 17, 2003 through the Yahoo! search engine (Exhibit MJL-1). Excerpts on the content and workings of the Yahoo! search engine are attached as Exhibit MJL-3. Included in the search results are copies of the first page of the websites corresponding to each “sponsor matches” located by her search as well as copies of the first page of the websites corresponding to each of the first 20 of 255,000 “web matches” located by her search. According to information available on the websites of Yahoo! and Overture Services Inc. (Exhibit MJL-2), “sponsor matches” are paid listing provided by Overture Services, Inc. and are based upon the specific terms used in the query. On the basis of my examination of the search results, it would seem that three “sponsor matches” that turned up relate to websites where one

can purchase DR. MARTENS footwear on line. Even if I do not question the reliability of the search engine, there is no evidence as to the number of Canadians that have accessed these three websites at anytime whatsoever. As for the 20 “web matches”, it appears that none relate to the Applicant or to the Opponents. I would add that the “web matches” seem to concern businesses or individuals involved in various fields of activities, but not in the footwear industry.

Also provided by Ms. Lapointe are excerpts from the 1996 edition of *The Oxford English Reference Dictionary* relating to “Dr.”, “doc” and “doctor” (Exhibit MJL-4) and the results of her search of *Merriam-Webster’s Collegiate Dictionary* website concerning the meaning of “doc” and “Dr.” (Exhibit MJL-5). At the oral hearing, the Opponents’ agent noted that included in Exhibit MJL-4 is an excerpt of *The Oxford English Reference Dictionary* defining “Doctor Martens” as “...*n. propr. (also Doc Martens, Dr Martens) a type of heavy (esp. laced) boot or shoe with a cushioned sole...*”. It can be noted from Exhibit MJL-4 that Oxford University Press in the United Kingdom publishes *The Oxford English Reference Dictionary*. Therefore the dictionary definition provided for “Doctor Martens” originates from a source outside Canada. Although there may be instances where references from sources outside Canada could be considered relevant to an issue arising in opposition proceedings [see *Inovatech Inc. v. Burnbrae Farms Ltd.* (2003), 31 C.P.R. (4<sup>th</sup>) 151 (T.M.O.B.)], I do not consider that such is the case in this instance. In my view, the excerpt from *The Oxford English Reference Dictionary* cannot serve as evidence that the footwear associated with the trade-mark DR. MARTENS are known in Canada as DOC MARTENS or as evidence of use of trade-mark DOC MARTENS in Canada in association with footwear.

#### Affidavit of Catherine Lemay

Ms. Lemay introduces as evidence articles that appeared in the Toronto newspaper *The Globe and Mail*, namely, an article of June 25, 1993 entitled “Docs get leg up on sneakers” (Exhibit CL-1), and an article of December 15, 1993 entitled “Why Docs rise is no mean feat” (Exhibit CL-2). The Opponents submitted that both articles refer to DR. MARTENS footwear using the term DOCS. At the oral hearing, the Opponents’ agent particularly directed my attention on the first article in which it is written “...*the shoe line – regularly known as Doc Martens or Docs – ...*”. Ms. Lemay also introduces as evidence a photocopy of an editorial cartoon that appeared in the editorial page of the January 23, 1994 issue of the *The Sunday Star* (Exhibit CL-3), which is the Sunday edition of *The Toronto Star* newspaper. The editorial cartoon illustrates four delivery trucks, including one displaying DOC MARTENS.

Although I can take judicial notice that *The Globe and Mail* and *The Toronto Star* have a substantial circulation in Canada [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1988), 14 C.I.P.R. 104 (T.M.O.B.); *Milliken & Co. v. Keystones Industries (1970) Ltd.*, 12 C.P.R. (3d) 166 (T.M.O.B.)], I find

that the exhibits do not evidence that the footwear associated with the trade-mark DR. MARTENS are known in Canada as DOC MARTENS or DOCS nor that there has been use of the trade-mark DOC MARTENS in Canada in association with footwear.

I shall now deal with the grounds of opposition.

### **Section 30**

The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with Section 30 is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. While the legal burden is on the Applicant to show that its application complies with Section 30, there is an initial evidential burden on the Opponents to establish the facts relied upon in support of the Section 30 grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *Joseph E. Seagram & Sons Limited v. Seagram Real Estate Ltd.* (1984) 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)]. To the extent that the relevant facts are more readily available to the Applicant, the evidentiary burden on the Opponents with respect to the ground of opposition based upon non-compliance with Section 30(b) is lower [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (4<sup>th</sup>) 84 (T.M.O.B.)].

As light as the Opponents' burden of proof may be, the fact that internet searches did not turn up the Mark is surely not sufficient for discharging their initial evidential burden with respect to the ground of opposition based upon non-compliance with Section 30(b). As I find that the Opponents have failed to discharge their initial evidential burden, I dismiss the ground of opposition based upon non-compliance with Section 30(b).

With respect to Section 30(i), the Opponents have essentially alleged that the Applicant falsely made the statement that it was entitled to use the Mark in view of the content of the statement of opposition. The mere fact that the application is being opposed does not support a ground of non-conformity with Section 30(i). Deciding on the sufficiency of the pleading by considering both the evidence and the statement of opposition [see *Novopharm Ltd. v. Astrazeneca et al* (2002), 21 C.P.R. (4<sup>th</sup>) 289 (F.C.A.)], I find that it could at least be inferred that the Opponents were alleging that the Applicant falsely made the statement because the Mark was confusing with the alleged trade-mark DR. MARTENS. However, there is no evidence that the Applicant was aware of the alleged trade-mark. Furthermore, even if the Applicant had been aware of the alleged trade-mark DR. MARTENS as of the relevant date, such a fact is not

inconsistent with the statement that the Applicant was satisfied that it was entitled to use the Mark on the basis that it was not confusing with the alleged trade-mark. I therefore dismiss the ground of opposition based on non-compliance with Section 30(i).

### **Section 12(1)(d)**

The material date for considering the issue of confusion pursuant to Section 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. There is a legal onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the alleged registered trade-marks [see *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4<sup>th</sup>) 155 (F.C.A.)]. In *Wrangler Apparel Corp. v. The Timberland Company* (2005) FC 722 (F.C.), Mr. Justice Snider made the following comments with respect to the balance of probabilities:

*“However, before jumping to a conclusion that the Registrar applied an incorrect burden to the evidence, it is helpful to read further in the Dion decision. In para. 13, the court acknowledges the description of the burden of proof in a civil case as defined by Lord Denning in Miller v. Minister of Pension, [1947] 2 All E.R. 372, at 374 (K.B.):*

*It must carry a reasonable degree of probability but not so high as is required in a criminal case. If the evidence is such that the tribunal can say: 'we think it more probable than not', the burden is discharged, but if the probabilities are equal it is not. [emphasis added]*

*Later in the decision, at para. 15, the court states that:*

*At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent.*

*The words of Lord Denning and these final words of the court in Dion make logical sense. Applying a burden of balance of probabilities requires a weighing of evidence or a series of findings. Where one side bears the burden, the result of this measurement of the evidence must be that the scale upon which the weighing is done tips in favour of the party bearing the burden. In this case, with respect to the use of TIMBER CREEK BY WRANGLER for clothing, the balance favoured the Applicant and the Registrar concludes that the Respondent's marks were not confusing with the Respondent's trade-mark and trade-name.*

*However, if the scale is tipped toward the opposing party or is completely balanced, the burden will not be satisfied. If the Registrar, after carefully analyzing each relevant factor, concludes that the probabilities are equally balanced, the applicant will lose.”*

Dealing first with the registrations owned by “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership, I consider Registration No. TMA420,485 for the trade-mark DR. MARTENS (the “Registered Mark”) to be the most relevant of the registrations. Accordingly, the



determination of the issue of confusion between the Registered Mark and the Mark will effectively decide the ground of opposition based upon confusion with the registered trade-marks of this opponent.

It has been held repeatedly that in determining whether trade-marks are confusing, it is not a proper approach to place them side-by-side to compare their components. The test is one of first impression and imperfect recollection. Factors to be considered in assessing the risk of confusion are set out at Section 6(5) of the Act as: (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 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. Each of these factors does not necessarily have equal weight as the significance of one may far outweigh that of the others [see *Classic Door & Millwork Ltd. v. Oakwood Lumber & Millwork Co.* (1995), 63 C.P.R. (3d) 337 (F.C.T.D.)]. In addition, these factors are not exhaustive since all the surrounding circumstances have to be considered.

The Registered Mark is composed of “Dr.”, which is an abbreviation used in the common vocabulary in reference to “doctor”. Furthermore, the right to the exclusive use of MARTENS has been disclaimed apart from the Registered Mark. I would add that while there is no clear descriptive connotation attaching to the Registered Mark when considering the wares associated therewith, the Registered Mark suggests that a medical doctor or a podiatrist is behind the footwear. Accordingly, I find that the Registered Mark does not possess a high degree of inherent distinctiveness. The Mark includes the term “doc”, which is a noun used in the common vocabulary in reference to “doctor”. Therefore, while it is not without distinctive character, the Mark does not possess a high degree of inherent distinctiveness. There is no evidence of use of the Mark whereas there is evidence of significant sales throughout Canada of footwear associated with the Registered Mark. Accordingly, the extent to which the trade-marks have become known favours the Opponents.

As I have previously noted, Mr. Sincennes’ statements with respect to the year 1989 are not supported by documentary evidence or additional information. Nonetheless, there is evidence of continuous use of the Registered Mark in association with footwear since at least 1998. The Applicant did not file any evidence supporting the date of first use claimed in the application. Therefore, the length of time the trade-marks have been in use in association with footwear favours the Opponents.

In considering the nature of the wares and the nature of the trade, it is the statement of wares in the application and the statement of wares in the registration that govern the assessment of the likelihood of confusion under Section 12(1)(d) [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc, supra*]. As the wares associated with each trade-mark

correspond to footwear, there are no differences between the nature of the wares. Furthermore, because there is no limitation in the application as to the channels of trade associated with the Mark, I could reasonably conclude that the Applicant's wares would be sold in retail establishments where one expects to buy footwear. Therefore the channels of trade are not distinguishable.

The remaining criterion is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested. In *Berverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.), Mr. Justice Cattanaach stated at page 149:

*“Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”*

The Opponents argued that there is a high degree of resemblance between the trade-marks at issue especially between the ideas suggested. While I acknowledge that “doc” and “Dr.” are both understood as a reference to “doctor”, this is not sufficient to conclude to similarities between the trade-marks as they should be considered in their entirety. Although the apostrophe serves to set the letter “s” apart from “doc” when the Mark is viewed, it does not when the Mark is sounded. The Mark would be pronounced “docs” whereas it may reasonably be concluded that “Dr.” in the Registered Mark would be pronounced “doctor”. The presence of MARTENS in the Registered Mark also results in differences between the trade-marks when viewed and sounded. In support of their submission with respect to the resemblance between the ideas suggested, the Opponents relied on the affidavits of Catherine Lemay and of Marie Josée Lapointe (internet search for the term “doc’s” and pages 6 to 9 of Exhibit MJL-1) to argue that their evidence reveals that the footwear associated with the Registered Mark have been referred to as either DOC MARTENS or DOCS. Regardless of whether or not the evidence supports the Opponents’ contention, because the Registered Mark is neither DOC MARTENS nor DOCS, I do not consider that the Opponents’ argument lends support to a finding of similarities between the ideas suggested by the trade-marks. The Registered Mark suggests that an individual, be it medical doctor or a podiatrist, is behind the footwear associated therewith. The Mark does not suggest the idea of an individual being behind the footwear.

The Opponents also argued that their evidence with respect to DOC MARTENS or DOCS should be considered as an additional favourable circumstance in assessing the risk of confusion. In my view, the Opponents’ evidence falls short from establishing that the wares associated with the Registered Mark are known in Canada as DOC MARTENS footwear or DOCS footwear Accordingly, whether this could constitute a relevant additional circumstance becomes a moot point.

In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Despite the similarities between the nature of the wares and channels of trade, I find that the balance of probabilities tips in favour of the Applicant in view of the differences between the trade-marks in appearance, sound and in the ideas suggested. I therefore find that there is no reasonable likelihood of confusion between the Mark and the trade-mark DR. MARTENS of Registration No. TMA420,485.

Turning now to Registration No. TMA511,812 for the trade-mark DOX & Design owned by GFM GmbH Trademarks, I note that the Opponents did not file a copy of said registration. Having regard to the potential public interest in having such a ground of opposition raised, I do consider it appropriate to exercise my discretion to check the Registrar's record [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have checked the register and can confirm that Registration No. TMA511,812 covering the trade-mark illustrated hereafter in association with "shoes" is in good standing in the name of the GFM GmbH Trademarks.



I have previously found that the Mark does not possess a high degree of inherent distinctiveness. Despite the terms PRESCRIPTION FOR COMFORT suggesting that the wares are comfortable, I find that the trade-mark DOX & Design possesses some degree of inherent distinctiveness as it includes the coined word DOX. The most that I can presume from the mere existence of the registration is that there has been *de minimis* use of the trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. However, since there is no evidence to show the manner of use of the trade-mark DOX & Design, I am unable to determine the extent to which it has become known in Canada. In the absence of evidence of use of each party's trade-mark, the extent to which they have become known in Canada is not a material circumstance in this case nor is the length of time the trade-marks have been in use in Canada.

Both trade-marks are associated with shoes. In the absence of any evidence, and because the wares are of the same nature, it can be presumed that there are no differences between the channels of trade.

The term DOC'S is phonetically equivalent to the term DOX. Despite the visual similarities between DOC'S and DOX, there are arguably differences between the trade-marks when viewed and between the

ideas they suggest. That said, while the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [see *Nature Path Foods Inc. v. Quaker Oats Co. of Canada* (2001), 12 C.P.R. (4<sup>th</sup>) 190 (F.C.T.D.)]. In this instance, not only is the term DOX the first portion of the registered trade-mark, it is also the dominant feature.

In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. I find that the balance of probabilities is evenly balanced between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the registered trade-mark DOX & Design, I must decide against the Applicant.

In view of the above, I dismiss the ground of opposition based upon confusion with the registered trade-marks owned by "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH, a partnership, but I maintain the ground of opposition based upon confusion with Registration No. TMA511,812 for the trade-mark DOX & Design.

### **Non-entitlement**

The relevant date in assessing the risk of confusion between the Mark and the trade-marks relied upon by the Opponents in support of the ground of opposition based upon Section 16(1)(a) is the date of first use claimed in the application, namely August 1, 1992. Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no risk of confusion, the Opponents have the initial onus of proving that the alleged trade-marks were being used at the relevant date and had not been abandoned at the date of advertisement of the application [Section 16(5)].

As the Applicant elected to forgo the cross-examination of Mr. Sincennes, there is no evidence contradicting his statements regarding the distribution of DR. MARTENS footwear in Canada since 1989. However, the Applicant may have decided not to challenge these statements on the basis that they did not by themselves constitute proper evidence of prior use of the trade-mark DR. MARTENS. In any event, I find that Mr. Sincennes' bald statements do not evidence use of the trade-mark DR. MARTENS in Canada since 1989. Therefore, the Opponents have failed to discharge their initial onus to evidence use of the trade-mark DR. MARTENS in Canada prior to the date of first use claimed in the application. The Opponents have also failed to discharge their initial onus to evidence use of the trade-mark DOC MARTENS in Canada prior to the date of first use claimed in the application. I therefore dismiss the ground of opposition based upon Section 16(1)(a) of the Act.

In my view, the introductory wording of Section 16(1) is not the basis of a ground of opposition as defined in Section 38(2) of the Act since Section 16(1) as a whole relates to the entitlement ground of opposition. Accordingly, I dismiss the ground of opposition based upon the introductory wording of Section 16(1). For all intents and purposes, I note that the allegations in support of that ground of opposition are identical to those supporting grounds of opposition pleaded under Section 38(2)(a) and Section 38(2)(b). Consequently, if I have erred in dismissing the ground of opposition based upon the introductory wording of Section 16(1), I have decided its outcome in reaching my decision on prior grounds of opposition.

### **Distinctiveness**

While there is a legal onus is on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponents to establish the facts relied upon in support of the ground of non-distinctiveness. The material date for considering the issue of distinctiveness of the Mark is generally accepted to be the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) (F.C.T.D.)].

The ground of opposition based upon non-distinctiveness appears to be pleaded as a three-prong ground of opposition. I should note that the Opponents have not alleged any facts supporting the second and third pleadings of the ground of opposition. After having considered the evidence and the statement of opposition, I find that the second and third parts of the ground of opposition have both been improperly pleaded. I therefore reject the second and third pleadings of the ground of opposition.

With respect to the first pleading, it should be noted that the Opponents did not refer to any trade-marks or trade-names nor did they specify wares or services. In view of *Novopharm Ltd., supra*, I must take into consideration all of the evidence filed to assess such a ground of opposition. Deciding on the sufficiency of the pleading by considering both the evidence and the statement of opposition, I find that it could only be inferred that the Opponents were referring to the registered trade-mark DR. MARTENS owned by “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH, a partnership. The difference in the relevant date does not affect my analysis that there is no reasonable likelihood of confusion between the Mark and the registered trade-mark DR. MARTENS under the second ground of opposition. I therefore dismiss the first pleading of the ground of opposition based upon non-distinctiveness.

## **Conclusion**

Accordingly, and with the authority delegated to me under Section 63(3) of the Act, I maintain the opposition on the basis of confusion with Registration No.TMA511,812 for the trade-mark DOX & Design and reject the application to register the Mark pursuant to Section 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 6<sup>th</sup> DAY OF JUNE 2005.

Céline Tremblay  
Member  
Trade-marks Opposition Board