

**IN THE MATTER OF AN OPPOSITION  
by Calvin Klein Trademark Trust to application  
No. 1,004,733 for the trade-mark DONNA  
KLEIN filed by Wertex Hosiery Inc.**

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**On February 9, 1999, the applicant, Wertex Hosiery Inc., filed an application to register the trade-mark DONNA KLEIN based on proposed use in Canada for the following wares:**

Clothing namely, sweaters, shirts, halter tops, tank tops, skirts, pants, dresses, hosiery, socks, slipper socks, underwear, lingerie; sweat shirts, sweat pants, sweat shorts, leggings, swimwear; bodywear, namely tights, shorts, capris and bodysuits; bedding, namely bed blankets, pillow cases, bed sheets and duvets.

**The application was amended to include a disclaimer to the word KLEIN and was subsequently advertised for opposition purposes on November 1, 2000.**

**The opponent, Calvin Klein Trademark Trust (“CKTT”), filed a statement of opposition on January 2, 2001, a copy of which was forwarded to the applicant on January 16, 2001. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with nine registered trade-marks of the opponent, the most relevant of which is the mark CALVIN KLEIN registered under No. 307,161 for the following wares:**

- (1) Women's wearing apparel, namely, skirts, shirts, blouses, jackets, pants, coats, fur-trimmed coats, vests, dresses, sweaters, bathing suits, robes, beach and swim coverups, T-shirts, tennis and golf dresses, shorts, warm-up suits, raincoats and rain jackets, capes, ponchos, hats, shawls, robes, walking shorts, tank tops and jump suits.
- (2) Men's wearing apparel, namely, suits, sports jackets, pants, sports shirts, dress shirts, sweaters, top coats, raincoats, trench coats, jackets, insulated jackets, leather pants, lined and unlined leather jackets, leather top coats, leather sport coats, ties, belts.
- (3) Women's denim jeans.
- (4) Sheets, towels, pillow cases.

- (5) Women's handbags and belts.
- (6) Women's scarves.
- (7) Women's wearing apparel, namely skirts, shirts, blouses, jackets, pants, coats, fur-trimmed coats, furs, vests, dresses, sweaters, bathing suits, robes, beach and swimming cover-ups, T-shirts, tennis and golf dresses, shorts, warm-up suits, raincoats and rain jackets, capes, ponchos, hats, scarves, shawls, belts, walking shorts, tank tops and jump suits.
- (8) Sheets, towels, pillow cases, comforters and bedspreads, men's wearing apparel, namely suits, sport jackets, blazers, dinner jackets, pants, jeans, outer coats, namely top coats, trench coats, jackets, insulated jackets, lined and unlined leather jackets, leather top coats, leather sport coats; raincoats, shirts, vests, sweaters, ties, belts, women's wearing apparel, namely jeans and gloves.

**The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(a) of the Act because the trade-mark DONNA KLEIN is primarily merely the name of a living individual. The third ground is that the applied for trade-mark is not registrable pursuant to the provisions of Sections 9(1)(k) and 12(1)(e) of the Act because the trade-mark DONNA KLEIN consists of matter that falsely suggests a connection with a living individual, namely Calvin Klein.**

**The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks CALVIN KLEIN and CALVIN KLEIN & Design previously used and/or made known in Canada by the opponent and/or its licensees in association with the goods covered by the opponent's trade-mark registrations. The fifth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Deirdre Miles-Graeter and Robert W. White. The applicant elected not to submit evidence. Only the opponent filed a written argument and no oral hearing was conducted.**

### **The Evidence**

**In her affidavit, Ms. Miles-Graeter identifies herself as Assistant Secretary and Vice President Corporate Affairs of of Calvin Klein, Inc. (“CKI”), which company is authorized to use and sub-license the trade-marks owned by CKTT. The opponent’s CALVIN KLEIN trade-marks have been used for many years by the opponent’s predecessors and by the opponent’s authorized licensees in association with swimwear, linen articles and various clothing items.**

**According to Ms. Miles-Graeter, CALVIN KLEIN wares are sold through department stores, clothing stores and specialized bedding stores. Canadian sales of CALVIN KLEIN wares for the period 1995 to 2000 were in excess of \$400 million with only a minor portion of those sales covering bedding items. Worldwide advertising expenditures for that same period were approximately \$1.4 billion. Ms. Miles-Graeter did not provide specific advertising figures for Canada. However, she did detail print advertising by the opponent in numerous magazines over a number of years.**

**In his affidavit, Mr. White identifies himself as the Senior Vice President, Canada of the Audit Bureau of Circulations. He provides Canadian circulation figures for a number of**

the magazines in which Ms. Miles-Graeter states that CALVIN KLEIN advertisements have appeared. Mr. White's evidence allows me to conclude that the opponent's trade-mark CALVIN KLEIN has been fairly widely advertised throughout Canada simply through the Canadian circulation of foreign publications.

### The Grounds of Opposition

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. Finally, the opponent's strongest case is with respect to its trade-mark CALVIN KLEIN registered under No. 307,161. Thus, a consideration of the issue of confusion with that mark will effectively decide the outcome of the first ground.

As for Section 6(5)(a) of the Act, the applicant's mark DONNA KLEIN would be perceived as the name of an individual. Thus, it is an inherently weak mark. There being no evidence from the applicant, I must conclude that it has not become known at all in Canada.

As evidenced by Ms. Miles-Graeter in her affidavit, the opponent's registered mark CALVIN KLEIN is the name of the original founder of the opponent's business. Thus, that

**mark is also inherently weak. However, the opponent's evidence allows me to conclude that the trade-mark CALVIN KLEIN has become very well known throughout Canada, primarily in association with clothing.**

**The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of the parties are almost identical and presumably the trades of the parties would, or could, overlap.**

**As for Section 6(5)(e) of the Act, the marks at issue bear a fair degree of resemblance in all respects. Both marks would be perceived as the name of an individual and both use the component KLEIN as the second portion of the name.**

**The opponent submitted that an additional surrounding circumstance in this case was the opponent's use of a family of trade-marks. However, the evidence does not support such a contention.**

**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 of the similarities between the wares, trades and marks of the parties and the reputation associated with the opponent's registered mark, I find that the applicant has failed to satisfy the onus on it to show no reasonable likelihood of confusion between the marks at issue. Thus, the first ground of opposition based on registration No. 307,161 is successful. It is therefore unnecessary to consider the other aspects of the first ground.**

As for the second ground of opposition, this Board has previously taken the material time for considering the issue arising pursuant to Section 12(1)(a) of the Act to be the date of decision. This position was based on the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.) which appeared to support the contention that the material time for considering the issue under Section 12(1)(b) of the Act was the date of decision. Given that the provisions of Section 12(2) of the Act apply to both Sections 12(1)(b) and 12(1)(a), it followed that the same material time should apply to both subsections. Recently, however, the Federal Court held that the material time for Section 12(1)(b) is the filing date of the applicant's application: see Fiesta Barbeques Ltd. v. General Housewares Corp. (2003), 28 C.P.R.(4th) 60 at 69 (F.C.T.D.) and that position has been subsequently followed by this Board: see, for example, the unreported opposition decisions in Havana Club Holdings S.A. v. Bacardi & Company Limited (S.N. 795,803; January 12, 2004) and Zorti Investments Inc. v. Party City Corporation (S.N. 766,534; January 12, 2004). Thus, in view of the wording of Section 12(2) of the Act, I consider the material time to consider the circumstances respecting a ground of opposition based on Section 12(1)(a) is also the filing date of the applicant's application.

The onus or legal burden respecting the second ground is on the applicant to show that its applied for trade-mark is registrable. Furthermore, in considering this issue, I am guided by the decision of Mr. Justice Cattnach in Gerhard Horn Investments Ltd. v. Registrar of Trade Marks (1983), 73 C.P.R.(2d) 23 (F.C.T.D.). At page 30 of the reported reasons, Mr.

**Justice Cattanach states as follows:**

The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

**In the present case, the opponent failed to evidence its contention that Donna Klein was the name of a living individual as of the material time. It therefore follows that the second ground of opposition is unsuccessful. Had the opponent been able to meet its evidential burden, the second ground would likely have been successful.**

**As for the fourth ground of opposition, insofar as it is based on prior use of the trade-mark CALVIN KLEIN, the opponent has met its initial burden to show use of that mark prior to the applicant's filing date and non-abandonment of that mark as of the applicant's advertisement date. The fourth ground therefore turns on the issue of confusion between the trade-marks CALVIN KLEIN and DONNA KLEIN as of the filing date of the applicant's application. Again, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion as of that date. For the most part, my conclusions respecting the issue of confusion for the first ground are also applicable to the fourth ground. Thus, I find that the applicant failed to show that its mark DONNA KLEIN was not confusing with the opponent's previously used mark CALVIN KLEIN as of February 9, 1999. Insofar as it is based on prior use of the trade-mark CALVIN KLEIN, the fourth ground of opposition is successful and the remaining aspects of that ground need not be considered.**

As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from the wares and services 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.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - January 2, 2001): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Insofar as the fifth ground is based on an allegation of confusion with the trade-mark CALVIN KLEIN used for the wares identified in registration No. 307,161, it essentially turns on the issue of confusion between that mark and the applicant's mark DONNA KLEIN. My conclusions respecting the first ground of opposition are, for the most part, also applicable to this ground. Thus, I find that the marks at issue were confusing as of the filing of the opposition. The fifth ground is therefore also successful insofar as it is based on the use of the opponent's trade-mark CALVIN KLEIN as registered under No. 307,161 and the remaining aspects of that ground need not be considered.

In view of my conclusions above, it is unnecessary to consider the third ground of opposition based on Sections 9(1)(k) and 12(1)(e) of the Act. However, in light of the fact that Calvin Klein is a living individual and given the extent to which his name has become known



**in Canada as a trade-mark for clothing and related products, it seems likely that the third ground would also have been successful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT GATINEAU, QUEBEC, THIS 15<sup>th</sup> DAY OF JULY, 2004.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**