

**IN THE MATTER OF AN OPPOSITION  
by Standard Knitting Ltd. to  
application no. 882,505 for the  
mark TUNDRA filed by Toyota  
Jidosha Kabushiki Kaisha (also trading  
as Toyota Motor Corporation)**

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On June 25, 1998, the applicant Jidosha Kabushiki Kaisha (also trading as Toyota Motor Corporation) filed an application to register the trade-mark TUNDRA for use in association with “trucks and parts thereof” based on proposed use of the mark in Canada. In order to overcome an objection by the Examination Section of the Trade-marks Office, the applicant amended the wares to

trucks and structural parts thereof.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 7, 1999 and was opposed by Standard Knitting Ltd. on September 3, 1999. A copy of the statement of opposition was forwarded to the applicant on November 17, 1999 (as the Registrar is required to do by section 38(5) of the *Trade-marks Act*) although the applicant had already responded by filing and serving its counter statement on September 20, 1999.

The first ground of opposition alleges that the applied for mark TUNDRA is not registrable, pursuant to Section 12(1)(d) of the *Trade-marks Act*, because it is confusing with the

opponent's registered marks namely T2 BY TUNDRA LOGO DESIGN; THE PRO BY TUNDRA & DESIGN; TUNDRA; TUNDRA & MOUNTAINS DESIGN; TUNDRA & PARKA DESIGN; TUNDRA ALLWEATHER; TUNDRA CANADA; and TUNDRA SPORT. Each of the aforementioned registrations cover items of clothing.

The second ground of opposition alleges that the applicant is not entitled to register the applied for mark TUNDRA, pursuant to Section 16(3)(a) of the *Act*, because the applied for mark TUNDRA is confusing with the opponent's above-mentioned marks previously used and made known in Canada.

The third ground of opposition alleges that the applicant is not entitled to register the applied for mark TUNDRA, pursuant to Section 16(3)(b) of the *Act*, because the applied for mark TUNDRA is confusing with the applicant's previously filed trade-mark application no. 845,068 for TUNDRA & ESKIMO DESIGN covering items of clothing and personal care products.

The fourth ground of opposition is reproduced below:

The opponent's evidence consists of the affidavit of George Groumoutis, Chief Operating Officer of the opponent company; and Sheri Segal. The applicant's evidence consists of the affidavit of Kerry Biggs, an employee of the firm representing the applicant. The opponent's evidence in reply consists of a second affidavit of George Groumoutis; and an affidavit of Gladys Tibbo-Witt, trade-mark agent. Both parties filed written arguments and both parties were represented at an oral hearing.

Mr. Groumoutis' evidence in chief, as it is pertinent to the issues in the Canadian jurisdiction, may be summarized as follows. The opponent is a Canadian-based privately held designer and manufacturer of knitwear and sportswear. It is one of the largest manufacturers of men's high-fashion knitwear with designers located in Canada, New York and Italy. Garments bearing the trade-mark TUNDRA are distributed throughout North America and Europe as well as Japan, Mexico, Taiwan and Australia. The opponent has been manufacturing and selling in Canada clothing bearing the mark TUNDRA. The mark appears on sewn-in labels on the clothing and on packaging or on specially designed wrapping paper. Tundra brand clothing is distributed through independent sales representatives through trade shows and through direct selling to retailers. In excess of 800 retail stores across Canada sell TUNDRA clothing to about 70,000 individual customers. The opponent has also been successful in export sales, winning the Canada Export Award in 1995. The opponent has promoted its wares continuously and extensively across Canada since the 1960's. About 3% of its total sales is expended in advertising and promotion.

Paragraphs 17 - 19 of Mr. Groumoutis' affidavit are reproduced below:

Ms. Segal's evidence corroborates Mr. Groumoutis' assertion that major automobile manufacturers sell clothing, and other consumer products, bearing their trade-marks.

The Biggs affidavit, and the Tibbo-Witt evidence filed in reply, establish that several

third parties have adopted the term “tundra” by itself for, or as a component of, trade-marks and trade-names for a variety of wares and services.

The determinative issue in this proceeding is whether the applied for mark TUNDRA for use in association with trucks and structural truck parts is confusing with the opponent’s mark TUNDRA used in association with various items of clothing. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the first ground of opposition alleging non-registrability, (ii) the date of filing the subject application namely, June 25, 1998, with respect to the grounds of opposition alleging non-entitlement, and (iii) the date of filing the statement of opposition namely, September 3, 1999 with respect to the last ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In the circumstances of this case, nothing turns on whether the issue of confusion is assessed at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the Trade-marks Act, between the applied for mark TUNDRA and the opponent's mark TUNDAR. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two

marks are confusing, are set out in Section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark TUNDRA possesses a fair degree of inherent distinctiveness as a trade-mark for clothing as there is no connection between tundra and clothing. However, the distinctiveness of the mark is lessened to the extent that it is an English word in current usage. Although the opponent has not provided quantitative evidence of sales or advertising under its mark TUNDRA, I am prepared to find, in the absence of cross-examination of Mr. Mr. Groumoutis, that the opponent's mark TUNDRA acquired a significant reputation in Canada at all material times. The applied for mark possesses a fair degree of inherent distinctiveness as a trade-mark for trucks as there is no direct connection between tundra and trucks. However, the distinctiveness of the mark is lessened to the extent that the mark is suggestive of a well built truck suitable for intemperate climates and rough terrain. The applied for mark had not acquired any reputation in Canada as of any of the material dates. The length of time that the marks have been in use favours the opponent as the applied for mark is based on proposed use while the opponent's mark has a long history of use in Canada. The parties' marks are, of course, the same namely, TUNDRA.

The nature of the parties wares are quite distinct. The opponent argues that since automobile manufacturers often sell clothing items under automotive trade-marks, the applicant may be expected to sell a line of clothing under the mark TUNDRA. That may be true, however, I am not certain that whether the applicant sells a line of clothing under the applied for mark TUNDRA is a relevant circumstance in considering whether the applicant may obtain a trade-mark registration which is restricted to automotive wares. The trade-mark registration sought by the applicant does create for the applicant any trade-mark rights with respect to clothing wares and does not prejudice any rights which the opponent has established with respect to the use of the mark TUNDRA for clothing. This is so because the registration sought by the applicant does not cover clothing. If the applicant does begin to sell clothing under the mark TUNDRA, then the opponent has recourse in a court of superior jurisdiction to raise the issues of infringement and passing off without being prejudiced by applicant's trade-mark registration which may be obtained pursuant to this proceeding.

In view of the above, and having regard in particular to the disparity in the parties' wares, I find that the applicant has met the legal onus on it to show, on a balance of probabilities, that

the marks in issue are not confusing.

Accordingly, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 26th DAY OF NOVEMBER, 2003.

Myer Herzig,  
Member,  
Trade-marks Opposition Board