



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

**Citation: 2014 TMOB 88**  
**Date of Decision: 2014-04-25**

**IN THE MATTER OF AN OPPOSITION  
by Jacques Vert PLC. to application  
No. 1,457,444 for the trade-mark SHOE  
PLANET, in the name of YM Inc. (Sales)**

[1] Jacques Vert PLC (the Opponent), opposes registration of the trade-mark SHOE PLANET (the Mark), that is the subject of application No. 1,457,444 by YM Inc. (Sales) (the Applicant).

[2] Filed on October 30, 2009 by the Applicant, the application is based on proposed use in Canada in association with a variety of types of footwear, as well as “retail footwear store services”. The applied for wares and services are reproduced in their entirety in Schedule “A” to this decision.

[3] The Opponent alleges that: (i) the application does not comply with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under section 16 of the Act; and (iii) the Mark is not distinctive under section 2 of the Act. The last three grounds of opposition turn on the likelihood of confusion between the Mark and the Opponent’s registered trade-mark, PLANET (registration No. TMA387,969), and/or its PLANET trade-mark applications (application Nos. 641,981(1) and 1,475,332), particulars of which are attached under Schedule “B” to this decision.

## The Record

[4] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of April 28, 2010.

[5] The statement of opposition was filed by the Opponent on June 28, 2010. The grounds pleaded were denied by the Applicant by counter statement dated October 22, 2010.

[6] In support of its opposition, the Opponent filed certified copies of the following trade-marks: PLANET (TMA387,969), PLANET (application No. 641,981(1)), and PLANET (application No. 1,475,332).

[7] In support of its application, the Applicant filed the affidavit of Michael Godwin, sworn on October 19, 2011, the affidavit of Hugh Eric Grundy, also sworn on October 19, 2011, and a certified copy of its registration for URBAN PLANET (TMA653,892). No cross-examinations were conducted.

[8] Both parties filed written arguments and attended an oral hearing.

## The Parties' Respective Burden or Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, 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; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

## Grounds of Opposition Summarily Dismissed

### Section 30 grounds

[10] The grounds of opposition based on non-compliance with section 30 of the Act are threefold. In this regard, the Opponent alleges that the application does not comply with

section 30(a) of the Act in that the statement of services is vague and ambiguous and not in ordinary commercial terms. The Opponent also alleges that the application does not comply with section 30(e) of the Act in that the Applicant did not intend to use the trade-mark as alleged in the application or at all. Lastly, the Opponent alleges that the application does not comply with section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use or register the Mark in view of the Opponent's previously used and/or registered trade-marks.

[11] The Opponent's initial evidential burden under section 30(a) is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden [see *McDonald's Corporation and McDonald's Restaurant of Canada Ltd v MA Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[12] In the present case, the Opponent has neither provided any evidence nor argument to support a finding that the Applicant's services are defined in anything other than ordinary commercial terms. Consequently, the Opponent has failed to meet its burden and as a result, I dismiss the ground of opposition based on section 30(a) of the Act.

[13] With respect to the section 30(e) ground of opposition, the evidential burden upon an opponent with respect to this ground of opposition is relatively light and can be met by reference to the applicant's evidence [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC)].

[14] The application contains a statement that the Applicant by itself and/or through a licensee intends to use the applied-for trade-mark in Canada. Therefore, the application formally complies with section 30(e) of the Act. The issue therefore becomes whether or not the Applicant has substantially complied with section 30(e), i.e. – is the Applicant's statement that it intended to use the Mark true?

[15] In the instant case, the Opponent relies on the Applicant's own evidence to support its submission that there is non-compliance with section 30(e) of the Act. In particular, the Opponent refers to the Applicant's evidence concerning use of its URBAN

PLANET mark (Grundy affidavit). The Opponent submits that this evidence clearly demonstrates that the Applicant operates retail stores, while remaining silent on whether the Applicant uses trade-marks in association with any wares. The Opponent submits that the evidence does not show that the Applicant manufactures, or intends on manufacturing clothing or footwear. Furthermore, the Opponent submits that the affidavit does not even hint at an extension of the Applicant's business activities into wares rather than services. Consequently, the Opponent submits that the Grundy affidavit has the effect of suggesting that the Applicant intends to use the Mark in a use similar to that of the URBAN PLANET trade-mark.

[16] The fact that the Applicant uses its URBAN PLANET trade-mark in respect of services is not a basis for saying that the Applicant did not intend to use the Mark in association with wares as of October 30, 2009. In any event, the Applicant was not required to provide evidence of trade-mark use in association with wares as opposed to services. The application for the Mark is based upon proposed use, and certainly it is open to an applicant to pursue a business model that may differ from that of the past; including one that involves retail store services featuring its own trade-marked goods.

[17] Having regard to the foregoing, I dismiss the ground of opposition based on section 30(e) of the Act, for the Opponent's failure to meet its evidential burden.

[18] Lastly, with respect to the final ground of opposition based on non-compliance with section 30 of the Act, section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, this 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).

[19] The Applicant has provided the necessary statement and there is no evidence to suggest that this is an exceptional case. The Opponent has therefore failed to meet its evidential burden, and I dismiss the section 30(i) ground accordingly.

### Section 12(1)(d) ground of opposition

[20] The material date with respect to a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[21] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent's registration relied upon in support of this ground of opposition remains in good standing as of the date of my decision. The Opponent has therefore satisfied its evidential burden.

[22] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered trade-mark PLANET (TMA387,969).

#### *The test for confusion*

[23] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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.

[24] In applying the test for confusion, the Registrar must have regard to all 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.

[25] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. As such, I will begin with the analysis of this factor.

*Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested*

[26] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. Furthermore, while the first portion of the mark is usually the most important for the purpose of distinguishing (see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d), 183 (FCTD) at 188), the Supreme Court of Canada in *Masterpiece* has advised 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. For the reasons that follow, I find that there is a significant degree of resemblance between the two marks in appearance, sound and in the ideas suggested.

[27] The Applicant submits that when comparing the parties' marks as a whole, they do not appear or sound similar. Citing *Conde Nast, supra*, the Applicant places relatively more emphasis on the first portion of its Mark. In particular, the Applicant submits that the first part of each mark is visually and phonetically distinct and the addition of the word SHOE in the Mark conveys the idea of a "planet of shoes", something that is conceptually different from a simple "planet".

[28] However, I do not find anything particularly striking or unique about the word SHOE. The word SHOE is descriptive of the Applicant's wares and services, and thus does not serve to diminish the resemblance between the parties' marks [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58]. Rather, as per the preferred approach set out in *Masterpiece*, I find the word "PLANET" to be the most striking portion of both parties' marks. The word "PLANET" bears no clear meaning in association with the parties' wares

or services. Phonetically and visually, this element of the parties' marks is identical; indeed, the Applicant has adopted the entirety of the Opponent's registered mark PLANET as a component of the Mark.

[29] Accordingly, I find this factor favours the Opponent

*Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known*

[30] The Opponent's mark consists of the word PLANET. While this word is a common dictionary word, it is not descriptive or suggestive of the Opponent's wares and services.

[31] Likewise, the Applicant's Mark includes the word PLANET. On account of the common inclusion of the word PLANET, both parties' marks possess some degree of inherent distinctiveness. However, the Applicant's Mark is not as inherently strong as the Opponent's mark due to the inclusion of the descriptive word SHOE.

[32] Although the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, neither party has filed evidence of use or promotion of their respective marks.

*Section 6(5)(b) – the length of time of use*

[33] As stated above, neither party has provided evidence of use of their respective marks.

[34] Although the Opponent has provided a certified copy of its PLANET trade-mark registration, the Registrar will assume only *de minimus* use of the trade-mark based on such evidence alone [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. As the mere existence of the registration can establish no more than *de minimus* use, it cannot give rise to an inference of significant and continuous use.

[35] Based on the foregoing, section 6(5)(b) favours the Opponent, but not significantly.

*Section 6(5)(c) and (d) – the nature of the wares and services and business or trade*

[36] 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 *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[37] The Opponent's registered wares include a variety of clothing and accessory items. The Applicant's wares include footwear, with the Applicant's applied-for services relating to the retail sale of such wares. As previously indicated, Schedules A and B to this decision include a complete listing of the parties' wares and services associated with their respective marks.

[38] While the parties' wares are not identical, I agree with the Opponent that they are related. The Applicant submits that neither party has furnished evidence on this point; however, similar wares have been held to be related in the past, with or without the benefit of evidence [see for example *I. Hignell & Associates Ltd v HH Brown Shoe Co (Canada) Ltd – Chaussures HH Brown (Canada) Ltée* (1991), 34 CPR (3d) 569 (TMOB); *Salamandar Aktiengesellschaft v Pacific Clothing Exchange Ltd* (1988), 19 CPR (3d) 349 at 351 (TMOB); *Eber San Francisco v Iramaos Pedro Ltda* (1986), 9 CPR (3d) 141 at 144 (TMOB)]. In any event, the Applicant's own evidence filed under the Grundy affidavit supports this conclusion, as advertisements for the Applicant's URBAN PLANET stores show that both clothing and footwear are available for sale through its retail stores (Exhibit C).

[39] Having regard to the above, it is presumable that the parties' channels of trade would also overlap. Consequently, I conclude that these factors favour the Opponent.

*Surrounding Circumstances*

*State of the Register*

[40] Evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods*



*Inc* (1992), 44 CPR (3d) 205 (FCTD)]. Furthermore, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[41] The Applicant submitted state of the register evidence with respect to use of the word PLANET under the Godwin affidavit. In this regard, Mr. Godwin conducted a search of the Canadian Trade-marks Register using the *CDNameSearch* system for registered trade-marks incorporating the word PLANET in connection with clothing, footwear and related wares, in addition to services relating to the retail sale of clothing, footwear, and related wares. He attaches the results of his search under Exhibits B and C to his affidavit. Mr. Godwin's search produced 55 such trade-marks.

[42] The Opponent questions the reliability of the *CDNameSearch* system employed by Mr. Godwin, and submits that at best this evidence is inadmissible hearsay evidence. However, I accept this evidence as admissible and reliable. Mr. Godwin is an experienced trade-mark searcher and has fully explained the parameters of his search. In addition, I note from Mr. Godwin's affidavit that the Trade-marks Office itself is the source of information for the third party search mechanism that Mr. Godwin used to conduct the state of the register search [see *Sleep Products International Inc v Park Avenue Furniture Corp* (2002), 25 CPR (4th) 263 at 270 (TMOB); *Canadian Council of Professional Engineers v John Brooks Co* (2001), 21 CPR (4th) 397 (TMOB)].

[43] As indicated above, Mr. Godwin's search produced 55 trade-marks. The Opponent refutes much of the state of the register evidence as being irrelevant. In particular, the Opponent submits that aside from the Opponent's mark, all but five trade-marks identified in the search include at least one other non-descriptive word in addition to the word PLANET, including marks that use the word PLANET as part of a sentence or title. Further to this, the Opponent submits many of the marks identified list clothing and/or footwear as incidental or ancillary to other primary wares or services.

[44] The Applicant submits that Mr. Godwin's search shows that there are a sufficient number of relevant "PLANET" trade-marks such that inferences about the marketplace may

be drawn from the state of the register [citing *Polo Ralph Lauren Corp v United States Polo Assn*, 9 CPR (4<sup>th</sup>) 51; and *International Clothiers Inc v Dorna Sports SL* 2012 TMOB 43]. The Applicant draws attention to 13 trade-marks from Mr. Godwin's search that it describes as particularly "noteworthy".

[45] Upon review of the state of the register evidence, I agree with the Opponent that there are too few marks that incorporate the word PLANET as a dominant element of the trade-mark in association with clothing, footwear and accessories related wares and/or services. Even among those marks that the Applicant submits are "noteworthy", many of those trade-marks include additional words that alter the overall idea suggested behind those marks to such an extent that co-existence is understandable.

[46] In summary, there are simply too few relevant marks to draw any inferences concerning the state of the marketplace from the state of the register evidence filed.

*Co-existence with the Applicant's Urban Planet trade-mark*

[47] In addition to the state of the register evidence, the Applicant points to co-existence between the Applicant's URBAN PLANET trade-mark and the Opponent's PLANET trade-mark as a further surrounding circumstance.

[48] While the evidence does support that the Applicant's URBAN PLANET trade-mark has been used extensively in Canada (Grundy affidavit), I am mindful that the Opponent has not filed any evidence of use of its PLANET trade-mark. Indeed, the Opponent has only filed a certified copy of its PLANET registration. As previously stated, in the absence of evidence of use, the Registrar will assume only *de minimus* use of the trade-mark based on such evidence alone [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Given that the Registrar can only assume *de minimus* use, no meaningful conclusion can be drawn regarding co-existence in the marketplace.

[49] In any event, the Applicant's ownership of a registration for URBAN PLANET does not give it the automatic right to obtain any further registrations no matter how closely they may

be related to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB)].

### *Conclusion*

[50] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In *Masterpiece Inc v Alavida Lifestyles* (2011), 92 CPR (4th) 361, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have concluded that the parties' marks share a high degree of resemblance, given that the Applicant has taken the Opponent's mark in its entirety and merely added a word that is clearly descriptive of the wares and services to which it is associated. Furthermore, the parties' wares and services are related and absent evidence to the contrary, could be sold through the same channels of trade. Lastly, the state of the register evidence was simply insufficient to draw any meaningful inferences regarding the state of the marketplace.

[51] Having regard to the foregoing, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark. Accordingly, the ground of opposition based on 12(1)(d) of the Act is successful.

### Non-entitlement under section 16(3)(b) of the Act

[52] In order to meet its initial burden under section 16(3)(b) of the Act, the Opponent must establish that at least one of its PLANET applications was filed prior to the filing date of the Applicant's application (October 30, 2009), and was not abandoned at the date of advertisement of the application for the Mark (April 28, 2010) [section 16(4)].

[53] As previously detailed, the Opponent filed as part of its rule 41 evidence, certified copies of its PLANET trade-mark applications (application Nos. 641,981(1) and 1,475,332). The Opponent has only satisfied its initial burden under this ground with respect to application no. 641,981(1), as application no. 1,475,332 was filed after the filing date of the Applicant's application.

[54] The difference in material date does not affect my findings under this ground, and consequently my conclusions regarding confusion between the Mark and the Opponent's PLANET trade-mark are substantially the same. However, I would note that a stronger overlap between the wares and services of the parties further confounds confusion under this ground.

Non-entitlement under section 16(3)(a) and Non-distinctiveness

[55] The Opponent has not filed any evidence of use of its PLANET registration or of its PLANET trade-mark applications. Furthermore, I note that any reference to use in the Opponent's registration is not sufficient to satisfy the Opponent's evidential burden under section 16(3)(a) of the Act [see *Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. The same is true with respect to the non-distinctiveness ground. Accordingly, I find that the Opponent has failed to meet its evidential burden with respect to both the section 16(3)(a) non-entitlement and non-distinctiveness grounds of opposition.

[56] Based on the foregoing, I dismiss these grounds of opposition.

Disposition

[57] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Kathryn Barnett  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule "A"

<u>Application No.</u>	<u>Trade-mark</u>	<u>Wares/Services</u>
1,457,444	SHOE PLANET	Wares: (1) Footwear, namely, shoes, boots, slippers, sandals, insoles, athletic footwear, beach footwear, children's footwear, rain footwear, evening footwear. Services: (1) Retail footwear store services.

## Schedule “B”

<u>Registration or Application No.</u>	<u>Trade-mark</u>	<u>Wares/Services</u>
TMA387,969	PLANET	(1) Coats, raincoats, blazers, slacks, shirts, skirts, suits, jackets, knitted waistcoats, cardigans, sweaters, pullovers, scarves and belts (for wear), all for women and girls.
641,981 (01)	PLANET	<p>Wares:</p> <p>(1) Jewellery and watches; handbags, clutch bags, evening bags, purses, wallets, umbrellas.</p> <p>(2) Jewellery and watches.</p> <p>(3) Handbags and umbrellas.</p> <p>Services:</p> <p>(1) Retail sale of jewellery, watches, handbags, clutch bags, evening bags, purses, wallets, umbrellas, formalwear, business attire, high-fashion articles of clothing and ready-made garments, suits, waistcoats, coats, raincoats, blazers, jackets, trousers, skirts, shirts, blouses, vests, t-shirts, cardigans, sweaters, jumpers, pullovers, scarves, shawls, clothing belts, hats, formal footwear, evening footwear, beach footwear, casual footwear, slippers.</p>
1,475,332	PLANET	(1) Coats, raincoats, blazers, pants, shirts, skirts, suits, jackets, cardigans, sweaters, tops, namely short-sleeved or long-sleeved T-shirts, tank tops, knitted jerseys, vests; blouses, dresses, scarves and belts; casual women's clothing; lingerie and undergarments; pyjamas; footwear namely, sandals, boots, slippers, shoes; knickers, socks, tights, leggings, hats.