



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

**Citation: 2015 TMOB 109**  
**Date of Decision: 2015-06-17**

**IN THE MATTER OF AN OPPOSITION  
by List Trade-mark S.r.l. to application  
No. 1,531,262 for the trade-mark  
A-LISTA Design in the name of 2282356  
Ontario Ltd.**

[1] On June 10, 2011, 2282356 Ontario Ltd. (the Applicant) filed an application to register the trade-mark A-LISTA Design (the Mark) set out below.

A-LISTA

[2] The application was filed on the basis of the Applicant's proposed use of the Mark with the following Goods and Services (as amended):

(1) Clothing, namely, dresses, evening gowns, t-shirts, tank tops, crop tops, jeans, harem pants, skirts, shorts, jackets, coats, swimwear and beachwear, workout wear, denim wear, namely, denim jackets, denim jeans, denim pants, denim shirts, denim skirts, denim shorts, denim athletic shorts, denim casual clothing, denim gym shorts, denim running shorts, denim blouses, denim dress shirts, denim vests, denim dresses, denim travel bags, denim purses and accessories, namely, belts, handbags, purses, clutch bags, clutch purses, change purses, wallets, travel wallets, luggage, travel bags, watches, rings, earrings, bracelets, necklaces, gloves, leg warmers, socks, lingerie, hosiery, hats, scarves, headbands, headgear, namely, head bands, caps, hair clips, hair bands, hair accessories, knitted hats, sun hats, winter toques, beanie hats, bandanas, fedora hats, hair care preparations, blow dryers, hair straighteners, curling irons, fragrances, namely

perfume and eau du toilette, makeup, namely, lipstick, lipgloss, foundation, bronzer, eyeshadow, eyeliner, eyelashes; footwear, namely, sandals, stilettos, pumps, wedges, boots, athletic shoes, sneakers, lingerie.

Recording studio services; nightclub services.

[3] The application was advertised for opposition purposes in the Trade-marks Journal of March 22, 2013.

[4] On July 4, 2013, List Trade-mark S.r.l. (the Opponent) filed a statement of opposition. The grounds are summarized below:

- (a) contrary to section 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant used the Mark in Canada in association with the Goods and Services prior to the filing date;
- (b) contrary to section 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark as it must have been aware of the prior use and registration of the Opponent's trade-mark LIST Design under registration No. TMA670,980;
- (c) contrary to section 12(1)(d) of the Act, the application is confusing with the Opponent's trade-mark LIST Design under registration No. TMA670,980;
- (d) contrary to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date of the application it was confusing with the Opponent's use of the LIST Design trade-mark;
- (e) contrary to section 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date of the application it was confusing with the Opponent's use of the following trade-name: List Trade-mark S.r.l.; and
- (f) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant, nor has it been adapted to distinguish the Applicant's Goods and Services from (i)

those of the Opponent and (ii) those of others who have used its trade-mark in Canada as unauthorized licensees.

[5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. In support of its opposition, the Opponent filed an affidavit of Ruben Dell'Ariccia. The Applicant did not file evidence. The Opponent alone filed a written argument and attended a hearing on March 3, 2015.

#### Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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].

[7] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- sections 38(2)(b)/12(1)(d) of the Act - 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)];

- sections 38(2)(c)/16(3) of the Act – the filing date of the application; and

- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

#### Section 30 Grounds of Opposition

[8] The Opponent has pleaded that the application is contrary to sections 30(e) and 30(i) of the Act.

[9] There is no evidence that supports the ground of opposition based on section 30(e) of the Act. Consequently, this ground is rejected on the basis that the Opponent has not satisfied its initial burden.

[10] The section 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the Mark in Canada in association with the Goods and Services because the Applicant must have been aware of the use and registration of the Opponent's trade-mark. 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 [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Section 12(1)(d) Ground of Opposition

[11] I have exercised my discretion and checked the Register to confirm that the registration relied on by the Opponent for its LIST Design trade-mark, set out below, is extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

Registration No.	Trade-mark	Wares
TMA670,980	<b>LIST</b>	Perfumes; jewellery and jewellery accessories namely, sunglasses, bracelets, necklaces, watches, handbags; clothing and clothing accessories namely, dresses, blouses, leotards, boleros, hats, belts, suits, scarves, jackets, waistcoats, blousons, skirts, gloves, jeans, underwear, sweaters, trousers, bras, shoes, coats, petticoats, tops, T-shirts.

[12] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[13] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*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.

*degree of resemblance*

[14] In the present case, the Mark incorporates the word LIST and both parties trade-marks appear in a similar block letter stylization so there is a clear resemblance between the trade-marks as sounded and in appearance.

[15] With respect to idea suggested, as I may take judicial notice of dictionary definitions [*Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29], I reproduce from the Canadian Oxford Dictionary (2<sup>nd</sup> ed) the definitions of “list” and “a-list” in part:

List            a number of connected items, names, etc., written or printed together consecutively to form a record or aid to memory: *shopping list*.

A-list         a list of people or items of the highest importance.

[16] Based on these definitions, I find that the trade-marks at issue suggest slightly different ideas. The Mark suggests an important person who would purchase or wear the Applicant’s Goods or access its Services or, in the alternative, that the Goods and Services are important. On

the other hand, the Opponent's trade-mark is a non-specific suggestion of a connected group of clothes, jewellery and perfume.

[17] On balance, I find that this section 6(5) factor favours the Opponent slightly and it is significant that the Mark essentially incorporates the whole of the Opponent's trade-mark LIST. Therefore, given the similarity of the trade-marks at issue, the other factors take on added significance [*Masterpiece supra*].

*inherent distinctiveness*

[18] The Opponent's LIST Design trade-mark and the Mark have a similar degree of inherent distinctiveness as both are essentially a dictionary word or derivative which is not overly suggestive of the associated goods or services appearing in a stylized format.

*extent known and length of time in use*

[19] This factor favours the Opponent as only it has adduced evidence of use. Mr. Dell'Ariccias, the administrator of the Opponent, evidence is that :

- the LIST Design trade-mark is licensed to List Fashion Group of S.p.A. and that the "character or quality of the wares is under the control of the owner" (para 3); and
- the registered goods have been sold in association with the LIST Design trade-mark on hang tags and labels since 2002 in Canada and that sales to its retailers between 2009-2013 were over \$500,000 CDN (Dell'Ariccias's affidavit, paras 5, 11, Exhibit B).

[20] While the examples of how such control is exercised do not speak to controlling the character and quality of the registered goods, in the absence of cross-examination or submissions from the Applicant, there is no reason to doubt the veracity of Mr. Dell'Ariccias's statement quoted above.

[21] In contrast, the application for the Mark is based upon proposed use and the Applicant has not adduced any evidence of use.

*nature of the goods, services or business; the nature of the trade*

[22] This factor favours the Opponent with respect to the Goods as there is significant overlap in the nature of the goods and trade of the parties. It is the Applicant's statement of goods and services as defined in its application versus the Opponent's registered goods that govern my determination of this factor [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. In this case, the Opponent's registration for LIST Design covers items of clothing and clothing accessories, perfumes, and jewellery all of which appear in the Goods.

[23] With respect to the Services, this factor favours the Applicant as there is no apparent overlap between recording studio services or nightclub services and the Opponent's registered goods. While it is true that the Opponent's registered goods may be worn to night clubs this in itself is not enough to create an overlap in the nature of goods, services or trade.

#### *Conclusion*

[24] I conclude that, on a balance of probabilities, that there is a reasonable likelihood of confusion between the LIST Design trade-mark and the Mark for use in association with the Goods. I conclude this based on the degree of resemblance between the trade-marks and the significant overlap in the nature of these Goods with the Opponent's registered goods. Accordingly, this ground of opposition is successful for the Goods. This ground of opposition is rejected with respect to the Services since the differences in the nature of the Services and the Opponent's registered goods shifts the balance of probabilities in the Applicant's favour.

#### Section 16(3)(a) Ground of Opposition

[25] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the LIST Design trade-mark. The Opponent's evidence detailed above is sufficient to meet its burden that its trade-mark was used in Canada prior to the filing date of the application and had not been abandoned at the date of advertisement of the application (section 16(5) of the Act). For the reasons set out with respect to the section 12(1)(d) ground of opposition, the Applicant has failed to meet its legal onus of proving that

there is no reasonable likelihood of confusion between the Mark and the LIST Design trade-mark with respect to the Goods. This ground of opposition succeeds with respect to the Goods and is rejected with respect to the Services.

#### Section 16(3)(c) Ground of Opposition

[26] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the name List Trade-mark S.r.l. As there is no evidence that the Opponent has used this trade-name in Canada at the filing date of the application, the Opponent fails to meet its evidential burden with respect to this ground of opposition. Accordingly, the section 16(3)(c) ground of opposition is rejected.

#### Distinctiveness Ground of Opposition – Opponent’s Use

[27] The Opponent has pleaded that the Mark is not distinctive of the Goods and Services of the Applicant based on its use of its trade-mark and trade-name. The Opponent must prove that its trade-mark LIST Design and its trade-name List Trade-mark S.r.l. had become sufficiently known as of July 4, 2013 to negate the distinctiveness of the Mark [*Bojangles’ International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 at para 34]. The conclusion reached on the issue of likelihood of confusion discussed with respect to the section 12(1)(d) and 16 grounds of opposition are equally applicable to this ground of opposition. Consequently, the same result follows and the ground of opposition is successful with respect to the Goods and is rejected with respect to the Services.

#### Distinctiveness Ground of Opposition-Unauthorized Licensees

[28] The Opponent has alleged that the Mark is not distinctive “from those of others who have used its trade-mark in Canada as unauthorized licensee(s)”. As there is no evidence of use of the Mark at all, let alone use by an unauthorized licensee, the Opponent fails to meet its evidential burden and this ground of opposition is rejected.



Disposition

[29] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the Goods and I reject the opposition with respect to the Services, pursuant to section 38(8) of the Act [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office