

TRADUCTION/TRANSLATION

**IN THE MATTER OF AN OPPOSITION by
R.M.P. Athletic Locker Ltd. to application
No. 893719 for the registration of the trade-
mark R and design filed by Skis Rossignol
Canada Ltd.**

I The Pleadings

On October 16, 1998, Skis Rossignol Canada Ltd. (the “Applicant”) filed application number 893719 for the registration of the R trade-mark and design as illustrated below:



(the “Mark”)

This application was based on expected use in Canada in association with the following wares:

[Translation] Alpine and cross-country skis and parts thereof; alpine ski poles and cross-country ski poles; bindings for downhill and cross-country skis; snowboards and parts thereof; snowboard bindings; luges; in-line skates; ice skates; tennis racquets; squash racquets; tennis balls; squash balls; tennis nets; alpine ski boots; cross-country ski boots; snowboarding boots; après-ski boots; gaiters; tennis shoes; boots, shoes, slippers; protective bags and covers for carrying alpine and cross-country skis; boot bags for alpine and cross-country ski boots; bags for tennis racquets and squash racquets; bags for in-line skates; bags for ice skates; tennis bags, sports bags and carry-all bags; backpacks; fanny packs, clothing and accessories for skiing, snowboarding, skating, tennis, namely: coats, jackets, anoraks, parkas, windbreakers, waist-length jackets, pants, shorts, sweaters, T-shirts, tops, long underwear, sweatshirts, pullovers, one-piece ski suits, snowboard suits; nightgowns, tunics, skirts, dresses, hose, socks, ankle socks, gloves, mittens, toques, hoods, headbands, hats, scarves, neck warmers (the “Wares”).

The application was advertised for opposition purposes in the August 4, 1999 edition of the *Trade-marks Journal*.

R.M.P. Athletic Locker Ltd. (the “Opponent”) filed a statement of opposition on January 4, 2000, which the Registrar forwarded to the Applicant on January 18, 2000. On February 10, 2000, the Applicant filed a counter statement denying all grounds of opposition.

The Opponent filed in evidence the affidavits of Mary P. Noonan and Scott Hopkins, while the Applicant filed those of François Goulet and Yves Simard. All the affiants, except for Mary P. Noonan, were cross-examined.

On November 7, 2005, the Opponent requested leave to file an amended statement of opposition. On February 15, 2006, the Registrar refused this application.

Both parties submitted written arguments, and only the Opponent was represented at the hearing.

II Statement of Opposition

The grounds for opposition may be summarized as follows:

1. The Applicant could not state that it was satisfied that it was entitled to use the Mark in association with the Wares because the Applicant and the Opponent are both in the same field of activity, such that each of them is aware of the activities of its competitors. Accordingly, the Applicant could not be unaware of the rights of the Opponent and therefore could not state that it was entitled to the registration of the Mark as required (paragraphs 38(2)(a) and 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the “Act”));
2. The Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application for registration, the Mark was confusing with the Opponent’s R trade-mark and design it previously used in Canada and for which an application for registration number 810664 had been previously filed (paragraph 38(2)(c) and subsection 16(3) of the Act);
3. The Mark is not distinctive because it neither distinguishes nor is adapted to distinguish the Wares from the wares associated with the R trade-mark and design of the Opponent (paragraph 38(2)(d) and section 2 of the Act).

III Analysis of the Grounds of Opposition

The Applicant has the onus of showing that the application for registration is in compliance with the Act, but the Opponent has the initial onus of proving the facts that support each ground of the opposition. If the Opponent discharges this onus, it is then up to the Applicant to prove on a balance of probabilities that the grounds of the opposition invoked cannot prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. and others v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, pages 329-330, *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

The relevant dates for the analysis of the grounds of opposition vary depending on the ground. Accordingly, where there is a failure to comply with the provisions of section 30 of the Act, the relevant date will be the date of filing of the application for registration (October 16, 1998) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263 and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]. In the case of entitlement to register the Mark where the application is based on a proposed use, it is also the date of filing of the application (subsection 16(3) of the Act). Finally, it is generally acknowledged that the distinctiveness of the Mark must be determined on the date of filing of the statement of opposition (January 4, 2000) [see *E. & J. Gallo Winery v. Andres Wines Ltd.* (1975), 25 C.P.R. (2d) 126, page 130; [1976] 2 F.C. 3 (F.C.A.), and *Metro-Goldwyn-Mayer Inc v. Stargate Connections Inc.*, [2004] F.C. 1185 (F.C.T.D.)].

i) Opposition based on section 30 of the Act

The first ground of opposition is incomplete. Under paragraph 30(i) of the Act, the Applicant must submit a statement to the effect that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares or services in question. The Applicant included such a statement in its Application. The fact that the parties operate in the same field of activity is not sufficient to conclude that the Applicant could not state in good faith that it was entitled to registration of the Mark. Therefore, the first ground of opposition as drafted is dismissed.

ii) The right to registration

Mr. Hopkins is the Opponent's vice-president of marketing. He has been employed by the Opponent for more than 20 years. The Opponent's commercial activities include the sale of clothing, sporting goods, footwear and hosiery. The Opponent uses the R trade-mark as illustrated below:



It also uses the RIPZONE trade-mark in association with the wares described above. Some of these wares bear these two trade-marks. Wares bearing the Opponent's R trade-mark and design are sold in several countries throughout the world, including Canada and the United States.

He submitted two distinct catalogues, one for clothing and the other for footwear. He also submitted photographs of articles of clothing bearing the Opponent's R trade-mark and design, as well as samples of packaging and tags. Since the spring of 1997, the Opponent has been selling the following wares in Canada in association with its trade-mark:

Clothing, namely, jackets, pants, t-shirts, shorts, socks, vests, sweaters, warm-up suits, gloves, mitts; sporting goods namely, bags, knapsacks and sunglasses; footwear namely, boots, shoes and sandals; headgear namely, hats.

He submitted the Canadian sales figures from 1997 to 2000 for products bearing the R trade-mark and design, which totalled more than \$43 million for nearly 2 million items of clothing and footwear. He enclosed with his affidavit a long list of stores where Canadian consumers can purchase merchandise bearing the R trade-mark and design.

Promotion of these products began in the spring of 1996. The Opponent spent more than \$3 million in Canada from 1996 to 2000 to promote the sale of products bearing the R trade-mark and design. Samples of excerpts from magazines showing advertising to promote the sale of products bearing the R trade-mark and design were annexed to his affidavit. He also submitted other advertising materials and gave the sales figures in the United States and Japan for the years 1997, 1998 and 1999 for the products bearing the R trade-mark and design.

During his cross-examination, he stated that the Opponent's target market was young people aged 12 to 19 years, with an emphasis on skateboarding, snowboarding and surfboarding. He admitted that the Opponent did not sell either skis or snowboards.

Ms. Noonan is a researcher for the Opponent's agents. She submitted a certified copy of the registration LMC532382 for the Opponent's R trade-mark and design reproduced above, but it should be noted that the registrability of the Mark under paragraph 12(1)(d) is not one of the grounds of opposition at issue in this case. She also submitted the following excerpts from the register in connection with the Applicant's trade-marks, whether filed or not, including the one which is the subject of this opposition:

LMC211892



in association with clothing, namely: coats, jackets, anoraks, pants, nightgowns, tunics, skirts, dresses, shorts, tops, pull-overs, hose, socks, ankle socks, hoods; boots, shoes, slippers;

LMC221682 for the same trade-mark as illustrated above but for tennis racquets;

LMC191221



in association with skis.

On the basis of all this evidence, I conclude that the Opponent has discharged its onus of showing previous use of its R trade-mark and design and that it had not abandoned its use at the date of advertisement of the Applicant's application for registration (subsection 16(5) of the Act). Therefore, I must analyze the evidence submitted by the Applicant to determine if it has discharged its onus of proving on a balance of probabilities that the Mark is not confusing with the Opponent's trade-mark.

Mr. Goulet has been the president of the Applicant since August 1997. He explained the French origins of the Applicant's parent company, which at the outset had focused its activities on the manufacture of skis.

The Applicant was incorporated on August 18, 1977. During the 1980s, the Applicant expanded its activities to include tennis racquets and sports accessories. In the early 1990s, the Applicant's activities included the sale of clothing. In September 1991, the French company Rossignol S.A. assigned to the Applicant its rights in its registered trade-marks used in Canada.

The affiant submitted the number of pairs of skis and boots sold in Canada by the Applicant from 1993 to today but without stating which of the above-mentioned trade-mark or trade-marks they were associated with. He gave the world sales figures of the parent company and its subsidiaries. He explained that over time the R trade-mark had evolved and showed this evolution from 1965 to 2000. The graphic designs used were covered by the registrations reproduced above.

In 1998, the parent company decided to retain French marketing agency GBGM to conduct an analysis of the visual identity of its trade-marks. He submitted a copy of this report. The company also retained the services of French communications agency G&M Compagnie to design its new R trade-mark and design. Exhibit FG-7 is a brochure designed by G&M which traces the history and evolution of the Applicant's R trade-mark and design. Exhibit FG-8 is a

letter from G&M confirming that the Mark is the evolution of the R trade-mark and design. I attach little probative value to this letter, as it is hearsay evidence.

The Mark has been used since the 1999–2000 season on corporate communications, catalogues and other administrative documents. Since the 2000–2001 season, it has been placed on products sold to Canadian consumers. Several brochures or catalogues from the years 2000–2001 and 2002–2003 were submitted to show that the Mark appeared on them. Some invoices showing the Mark were also submitted.

On cross-examination, Mr. Goulet did not know if research on the availability of the Mark had been conducted before this application was filed. In answer to an undertaking made during his cross-examination, he confirmed that no such research had been conducted.

He stated that the shapes of the R used before 2000 were more rectangular, while the Mark has a rounded shape. The Applicant did not conduct a study of the Canadian market before introducing the Mark. On cross-examination, he stated that he was not familiar with the RIPZONE brand before the present opposition was filed.

Mr. Simard is the president of Symio Branding Inc. and acts as a senior consultant in trade-mark strategy and management, as well as in branding. His fields of practice include strategy, positioning, development and management of trade-mark portfolios.

He has more than 18 years of experience in branding and communications. He was trained in graphic design and has designed several logos. At this stage, I will refrain from concluding whether or not he is qualified to give an opinion on the likelihood of confusion between the two trade-marks at issue. In fact, for reasons which will be obvious from the content of Mr. Simard's affidavit and his admissions on cross-examination, the Opponent strenuously objected to Mr. Simard's standing as an expert able to give such an opinion.

Mr. Simard stated that, over time, companies modify or change their logo. He illustrated this by citing examples of the designs of trade-marks such as IBM, AVIS and BUDGET, to name just

those few. He then analyzed the evolution of the Applicant's R trade-mark and design to show that the Mark is based on the R trade-mark and design used by the Applicant since 1975. He noted the similarities and differences between the trade-marks of the parties and concluded that there was no significant risk that the general public would confuse the two trade-marks in question.

One of the constant visual elements he noted in the old logos used by the Applicant is the horizontal bar which is part of the letter R. Where the lines cross, they form well-defined angles. According to him, the evolution of the shape of the R in the first three trade-marks used by the Applicant is barely visible. The Mark has a line which is no longer continuous. This change was made to do away with the angles and create a more rounded look. According to him, a consumer would note the changes. He submitted that the elimination of sharp angles and the use of rounded lines suggested a more dynamic look.

His cross-examination revealed that he had not studied law. He did not consider himself to be an expert in trade-mark law. He has a bachelor's degree in graphic arts. He has taken only one course in psychology. None of the trade-marks he cited as examples in his report concern clothing. He has never studied trade-marks associated with snow sports equipment before. He did not conduct a market study. He did only one trade-mark search, and this was only to locate the Opponent's trade-mark. He did not read the affidavits submitted by the Opponent but did read the one submitted by Mr. Goulet. He did not go onto the market to find the Opponent's products, although he did visit a Sport Expert store to look at the Applicant's products. His mandate mainly concerned the evolution of the R trade-mark and design. For the purposes of his mandate, he was not required to determine if there was a trade-mark similar to the Mark in the trade-mark register.

In paragraph 33 of his affidavit, he tried to identify the differences between the trade-marks in question on the basis of a detailed visual analysis which took more than 30 minutes, according to his testimony on cross-examination. According to him, the similarities of the trade-marks in question are the following:

- A stylized R

- Inside a curved geometric figure (circle vs. an oval)
- The lines used to draw the letter R are curved
- The R is white on a black background.

When he saw the Mark for the first time, he did not associate it with snow sports. Finally, he did not analyze how the parties' trade-marks were used on their respective products.

On the basis of the cross-examination, I cannot conclude that Mr. Simard can be characterized as an expert in a position to give his opinion in this case as to whether or not there is a likelihood of confusion between the trade-marks in question. In fact, Mr. Simard has no expertise in clothing on the Canadian market. He did not conduct any such market analysis. His mandate did not consist in determining whether there was a likelihood of confusion between the trade-marks, but rather in studying the evolution of the Applicant's R trade-mark and design over the years. He conducted a detailed analysis of the trade-marks in question to detect any differences, but this is far from the test acknowledged by case law for a long time, namely, that of an average Canadian consumer with an imperfect memory who vaguely remembers the Opponent's trade-mark. Would that consumer identify the Opponent as the source of the wares bearing the Applicant's trade-mark? At no time did Mr. Simard deal with this issue in his affidavit or cross-examination, either directly or indirectly. In addition, the fact that the Mark is the result of the evolution of the R trade-mark and design used by the Applicant over the years does not entitle it to obtain registration of a trade-mark which could be confusing with a trade-mark previously used in Canada.

Therefore, I do not attach any probative value whatsoever to Mr. Simard's affidavit with respect to the issue to be determined: Is the Mark likely to be confusing with the Applicant's R trade-mark and design?

The likelihood of confusion between two trade-marks must be analyzed on the basis of the criteria mentioned in subsection 6(5) of the Act. The Supreme Court of Canada, in a judgment written by Binnie J., recently ruled on the scope of this section in *Mattel Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321, stating:

Within the “all the surrounding circumstances” test, s. 6(5) of the Act lists five factors to be considered when making a determination as to whether or not a trade-mark is confusing. These are: “(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them”. The list of circumstances is not exhaustive and different circumstances will be given different weight in a context-specific assessment. See *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.). In opposition proceedings, as stated, the onus is on the applicant (here the respondent) to show on a balance of probabilities that there is no likelihood of confusion.

Each of the trade-marks has the same inherent distinctiveness. Both trade-marks in question consist of the letter R and a circular or oval design. However, the Opponent has continuously and extensively used its trade-mark in Canada since May 1997. This use increases the distinctiveness of the trade-mark. On the relevant date, that is, the date of filing of the application for registration, the Applicant was not using the Mark. This fact clearly favours the Opponent.

As regards the duration of use of the trade-marks as at the relevant date, as mentioned previously, this factor is clearly to the advantage of the Opponent.

There is a similarity in the nature of certain wares bearing the trade-marks of each of the parties.

I am referring to the following wares mentioned in the application for registration:

boots, shoes, slippers; sports bags and carry-all bags; backpacks, fanny packs; clothing and accessories for skiing, snowboarding, skating and tennis, namely: coats, jackets, anoraks, parkas, windbreakers, waist-length jackets, pants, shorts, sweaters, T-shirts, tops, long underwear, sweatshirts, pullovers, one-piece ski suits, snowboard suits; nightgowns, tunics, skirts, dresses, hose, socks, ankle socks, gloves, mittens, toques, hoods, headbands, hats, headscarves, scarves, neck warmers (the “Similar Wares”).

I am of the opinion that there is similarity with the following wares:

in-line skates; tennis balls, squash balls, tennis nets; tennis shoes; bags for tennis racquets and for squash racquets; bags for in-line skates; tennis bags. (the “Different Wares”)

The Opponent argued that for the following wares there was a high degree of association, because they are sold in the same type of stores which also sell wares bearing the Opponent’s trade-mark:

Alpine and cross-country skis and parts thereof; alpine ski poles and cross-country ski poles; bindings for downhill and cross-country skis; snowboards and parts thereof; snowboard bindings; luges; in-line skates; ice skates; alpine ski boots; cross-country ski boots; snowboarding boots; après-ski boots; gaiters; protective bags and covers for carrying alpine and cross-country skis; boot bags for alpine and cross-country ski boots; bags for ice skates;

I am not prepared to go so far. There are sufficient differences between these wares and the wares bearing the Opponent's trade-mark. Therefore, I will add these wares to the Different Wares.

Finally, the trade-marks in question are similar phonetically and visually. I am referring to the similarities described above and admitted by Mr. Simard.

In these circumstances, I conclude that there is a likelihood of confusion between the Mark and the Opponent's trade-mark as regards the Similar Wares. The nature of these wares when compared with the wares bearing the Opponent's trade-mark and the degree of similarity between the trade-marks of the parties lead me to this conclusion. Accordingly, the second ground of opposition is allowed for the Similar Wares only.

As regards the third ground of opposition (distinctiveness of the Mark), the main issue remains the likelihood of confusion between the parties' trade-marks, because the Opponent has discharged its initial onus to show that its R trade-mark and design was distinctive in Canada on the relevant date, namely, January 4, 2000. Although this later date might be to the advantage of the Applicant because it may benefit from a certain period of use of the Mark in Canada in association with the Wares, there is no evidence of a specific date of first use of the Mark in Canada in association with the Wares, except for the fact that the Applicant had begun this use during the 2000–2001 season. Considering that the critical date is January 4, 2000, at most, the Applicant would have used the Mark for a period of three (3) days, assuming that this use started on January 2, 2000.

My conclusions on each of the criteria set out in subsection 6(5) of the Act also apply to this ground of opposition. Therefore, I allow the last ground of opposition for the Similar Wares only.

V Conclusion

The Applicant did not discharge its onus of proving on a balance of probabilities that the Mark is not confusing with the Opponent's R trade-mark and design when used in association with the Similar Wares.

On the basis of the authority which has been delegated to me by the Registrar of Trade-marks under subsection 63(3) of the Act, and considering the principles stated in *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH* 10 C.P.R. (3d) 482 , I allow the application for registration, but only for the following wares:

In-line skates; tennis balls; squash balls, tennis nets; tennis shoes; bags for tennis racquets and squash racquets; bags for in-line skates; tennis bags; alpine and cross-country skis and parts thereof; ski poles for alpine and cross-country skis; bindings for alpine and cross-country skis; snowboards and parts thereof; snowboard bindings, sleds; in-line skates; ice skates, downhill ski boots; cross-country ski boots; snowboarding boots; après-ski boots; gaiters; protective bags and covers for carrying downhill and cross-country skis; boot bags for downhill and cross-country ski boots; bags for ice skates;

and I dismiss the application for registration of the Mark in association with the following wares:

boots, shoes, slippers; sports bags and carry-all bags; backpacks; fanny packs, clothing and accessories for skiing, snowboarding, skating and tennis, namely: coats, jackets, anoraks, parkas, windbreakers, waist-length jackets, pants, shorts, sweaters, T-shirts, tops, long underwear, sweatshirts, pullovers, one-piece ski suits, snowboard suits; nightgowns, tunics, skirts, dresses, hose, socks, ankle socks, gloves, mittens, toques, hoods, headbands, hats, scarves, neck warmers.

Pursuant to subsection 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 28TH DAY OF MARCH 2008

Jean Carrière
Member
Trade-marks Opposition Board