



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

**Citation: 2014 TMOB 3**  
**Date of Decision: 2014-01-09**

**IN THE MATTER OF AN OPPOSITION  
by Twin Heart Clothing Inc. to  
application No. 1,418,244 for the trade-  
mark KOI, in the name of The Authentic  
T-Shirt Company ULC**

[1] Twin Heart Clothing Inc. (the Opponent), opposes registration of the trade-mark KOI (the Mark), that is the subject of application No. 1,418,244 by The Authentic T-Shirt Company ULC (the Applicant).

[2] Filed on November 13, 2008 by The Authentic T-Shirt Company ULC, the application is based on proposed use in Canada in association with wares which cover a variety of items of clothing and headwear, as well as umbrellas, key chains, water bottles and flasks, towels, mats, mugs, notebooks and journals. The statement of wares is reproduced in its entirety in Schedule “A” to this decision.

[3] The Opponent alleges that: (i) the Mark is not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act; and (iii) the Mark is not distinctive under section 2 of the Act. All three grounds revolve around the likelihood of confusion between the Mark and the Opponent’s trade-mark, BLACK KOI (registration No. TMA713,262), particulars of which are attached under Schedule “B” to this decision.

[4] Thus, the issues to be decided in this case are:

- (i) Is the application registrable in view of the Opponent's mark?
- (ii) Was the Applicant the person entitled to registration of the Mark at the date of filing of the Applicant's application?
- (iii) Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

#### The Record

[5] The statement of opposition was filed by the Opponent on January 13, 2011. The grounds were denied by the Applicant by counter statement dated March 25, 2011.

[6] In support of its Opposition, the Opponent filed the affidavit of Clifford Isenberg, the President of the Opponent, sworn July 25, 2011.

[7] In support of its application, the Applicant filed the affidavit of Amanda Jamieson, a legal assistant employed by the Applicant's agent, sworn December 12, 2011, and the affidavit of Harp Chahal, the Director of Marketing for the Applicant, sworn December 10, 2011. No cross-examinations were conducted.

[8] Both parties filed written arguments; an oral hearing was not conducted.

#### 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)].

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

[10] 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)].

[11] 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 BLACK KOI trade-mark (registration No. TMA713,262) remains in good standing as of the date of my decision. The Opponent has therefore satisfied its evidential burden.

[12] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's trade-mark. The Opponent's trade-mark is registered in association with a variety of ladies', men's and children's clothing.

#### *The test for confusion*

[13] 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.

[14] 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. The above-noted criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

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

[15] The Opponent’s mark consists of the words BLACK KOI.

[16] In his affidavit, Mr. Isenberg states the word KOI comes from the Japanese language and simply means fish known as carp. He states that in English, KOI are known as ornamental varieties of common carp that are kept for decorative purposes in outdoor ponds, etc; black among other colours, is a major colour of this type of fish variety. Further to this, he states that “in Japanese “koi” sounds very similar to another word that means affection or love and as such “koi” are symbols of love and friendship in Japan.” In support, he attaches as Exhibit 1 to his affidavit, an extract from Wikipedia on the subject of “koi”. Mr. Isenberg states that the trade-mark BLACK KOI was chosen by the Opponent because of the specific meaning of the word “KOI” in the Japanese language.

[17] The Applicant’s Mark consists solely of the word KOI. In its written argument, the Applicant attempted to adduce state of the register evidence to demonstrate that use of the word KOI is commonplace and therefore not distinctive. I will not be considering this evidence however, as it was not adduced through the proper channels. In any event, this evidence would not have aided the Applicant’s case. Not only were particulars of the registrations not provided, but the seven registrations incorporating the word “koi” located by the Applicant would have been insufficient to reach any conclusion about the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[18] In addition to the state of the register submissions, the Applicant submits that the word “KOI” is a common dictionary word. The Applicant does not provide a dictionary

definition; however, the Opponent's affiant Mr. Isenberg provides an explanation of the meaning of "koi" in English. In any event, I may refer myself to a dictionary to determine the meaning of a word [see *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)]. In so doing, I note that the following definition, as taken from the *Canadian Oxford Dictionary*, 2nd edition, is consistent with Mr. Isenberg's statements:

koi:     *noun* (also **koi carp**) (*pl.*, same) a carp of a large ornamental variety bred in Japan.

[19] Further to this, the Applicant submits that marks comprised solely of letters, as in the Opponent's mark, have been determined to be inherently weaker than marks which incorporate both letters and other distinctive indicia. When marks are weak marks, comparatively small differences will suffice to distinguish [see *Anamet Inc v Acklands Ltd* (1996), 67 CPR (3d) 478 (FCTD); and *Commercial Union Assurance Co plc v Canadian Co-Operative Credit Society Ltd* (1992), 42 CPR (3d) 239 (FC)]. However, I find these cases to be clearly distinguishable. The marks at issue in these cases either involved the use of a single letter, or the use of two letters that would likely be perceived as an acronym relating to the services associated with the mark (i.e. – CU for services pertaining to the operation of a credit union).

[20] The Opponent submits that while the word KOI is a dictionary word, its meaning would not be known by the average Canadian consumer.

[21] However, even if the average Canadian consumer is aware of the meaning of the word KOI, the word KOI does not bear any relationship whatsoever to the wares of the parties. In the alternative, the word KOI would be construed as a coined term. As a result, regardless of the perception of the word KOI by the average Canadian consumer, I find the marks of the parties are inherently distinctive. As I do not find the inclusion of the word BLACK has any effect upon the inherent distinctiveness of the Opponent's mark, I assess the inherent distinctiveness of the Applicant's Mark and the Opponent's trade-mark as being the same.

[22] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use.

[23] The Applicant's application is based upon proposed use in Canada, and the Applicant has not provided any subsequent evidence of promotion or use of the Mark.

[24] The Opponent has submitted evidence of use of its BLACK KOI trade-mark (Isenberg affidavit). In particular, Mr. Isenberg states that continuously since 2008, the Opponent has sold to retail customers in Canada "ladies' and girls' pants, shirts, t-shirts, jackets, blazers, dresses, blouses and skirts to which were attached labels or hangtags bearing the trade-mark "BLACK KOI"." This date is consistent with the particulars of the registration, which show that the Opponent filed a declaration of use with the Registrar on April 15, 2008. Mr. Isenberg further indicates in his affidavit that major customers of the Opponent in Canada include Wal-Mart Canada Corp. and Winners retail outlets. He attaches as Exhibit 4 to his affidavit, specimens of hangtags and labels bearing the BLACK KOI mark, that were attached to its ladies' and girls' wearing apparel at the time of delivery to Winners.

[25] While the evidence does not speak to the extent of sales of BLACK KOI branded apparel to these major retailers, given Mr. Isenberg's sworn statement concerning continuous sales, and that sales were made to such major retailers in Canada, I accept that the Opponent's BLACK KOI trade-mark would have become known in Canada to some extent. As such, this factor favours the Opponent.

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

[26] As discussed above, I am satisfied that the Opponent has evidenced use of its BLACK KOI trade-mark. In the absence of evidence of use of the Mark, I find the Opponent's BLACK KOI trade-mark has been in use for longer than the Mark; this factor therefore favours the Opponent.

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

[27] 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)]. These statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. While evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)], the rights conferred by registration will be restricted by the statement of wares as it reads in the application or registration.

[28] There is a direct overlap between the parties' wares as both are associated with a variety of clothing, including several identical items of apparel. These wares include: Clothing, namely, athletic wear, outerwear, swimwear, shirts, t-shirts, tank tops, sweaters, sweatshirts, hoodies, pullovers, shorts, pants, skirts, jackets, coats, scarves; headwear, namely, caps, beanies, headbands, hats. Furthermore, I find that the following wares of the Applicant are related to clothing: "bags, namely, duffle bags, tote bags, yoga bags; purses, and backpacks". While some of these wares are accessory items, others are closely linked to athletic apparel. For the purposes of further discussion, I will refer to all of the above-mentioned wares as the Overlapping Wares. However, I consider the remaining wares in the Applicant's application to be distinct from the Opponent's wares.

[29] The Applicant submits that its channels of trade are vastly different from that of the Opponent. In this regard, the Applicant submits that the Chahal affidavit shows that the Applicant proposes to use its Mark in association with the marketing and bulk sale of blank, unprinted clothing to imprint apparel businesses, embroiderers and printing companies (promotional products customers). In particular, Mr. Chahal describes the nature of the Applicant's business, stating in his affidavit that the Applicant sells its products to promotional products customers. These customers then embroider or imprint the purchased products with corporate logos and advertising for sale to corporations, non-profit organizations and others for use as give-away items for advertising, corporate communication and identity purposes.

[30] Mr. Chahal further explains that the Applicant is a member of Promotional Product Professional of Canada (“PPPC”), and that the Applicant’s customers similarly belong to PPPC or comparable promotional product industry associations. He states that mass retailers of products to consumers are neither members of such associations nor customers of the Applicant. He provides as exhibits C and D, printouts from the PPPC website which explain the structure of the promotional products industry and PPPC membership qualifications.

[31] Lastly, as evidence of sales of products to promotional products customers, Mr. Chahal provides as exhibits E and F respectively, a copy of a product brochure for apparel products for the year 2012 and a selection of invoices showing bulk sales of apparel to a number of promotional products companies.

[32] Unlike the business of the Applicant, the Applicant submits, the Opponent has targeted a niche market, wherein there is no overlap in the ultimate consumer of the products of the parties. In particular, the Applicant submits that the Opponent’s evidence shows that its BLACK KOI mark is used to “identify a collection of clothing designed specifically to fit petite customers, 5’3” or under with particular emphasis on Asian consumers” (Isenberg affidavit, paragraph 3). Furthermore, the Opponent sells to mass retailers such as Wal-Mart and Winners, and does not operate in the promotional products industry.

[33] The Opponent submits that despite targeting a particular niche market, there is no evidence to suggest that its apparel would not be purchased by a broader spectrum of customers. Further to this, the Opponent submits that although the nature of the trade of the parties is different, the Overlapping Wares are ultimately destined to be purchased and used by the same segment of the Canadian public. Accordingly, the Opponent contends that the difference in the nature of the trade of the parties will not negate the likelihood of confusion between the parties’ marks.

[34] I agree that given the evidence, there is no direct overlap between the channels of trade through which the parties’ wares are currently being sold. However, there is no restriction in the specification for the Wares limiting the Applicant to selling its Wares only to promotional products companies. Similarly, there is no restriction in the Opponent’s registration for the BLACK KOI mark that limits the Opponent to selling its wares only



through mass retail channels. In the absence of any restrictions, and given the overlap in the nature of the wares of the parties, it is conceivable that the Overlapping Wares could travel through the same channels of trade. Consequently, insofar as the Overlapping Wares are concerned, this factor also favours the Opponent.

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

[35] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2) 145, conf. 60 CPR (2d) 70 (FCTD)]. This principle was recently upheld by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles* (2011), 92 CPR (4th) 361.

[36] In *Masterpiece*, the Supreme Court of Canada 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 [see *Masterpiece* at para 64].

[37] In the present case, I find the word “KOI” to be the most striking portion of the Opponent’s mark. The word “KOI” is unique, as it bears no meaning in association with the parties’ wares. Phonetically and visually, this element of the parties’ marks is identical. Furthermore, I find the addition of the word “black” in the Opponent’s Mark does not alter the idea suggested between the parties’ marks in any substantial way. As an adjective and a common ordinary word, the word “black” places relatively more emphasis on the word “KOI”. Indeed, the more distinctive portion of the Opponent’s mark comprises the entirety of the Mark.

[38] The Applicant submits that the mere fact that there is overlap in a portion of the words used does not necessarily result in the conclusion that there is a likelihood of confusion (citing as support *Genfoot Inc v Consolidated Footwear Co* (1987), 17 CPR (3d) 557 – “Apple Pie” vs. “The Big Apple” for footwear). While I agree that it is not an absolute, the *Genfoot* case is distinguishable in that the ideas conveyed by the respective marks as a whole were clearly distinct.

[39] Accordingly, I find this factor favours the Opponent.

### *Conclusion*

[40] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[41] In the present case, the degree of resemblance between the parties' marks is significant, as the Applicant has subsumed the most striking portion of the Opponent's mark in its entirety. The word KOI possesses a high degree of inherent distinctiveness, and the Applicant has not led any evidence to support that its use is common in the marketplace.

[42] Lastly, it is conceivable that the Overlapping Wares could travel through the same channels of trade, as the Applicant would not be precluded from doing so given that there is no such restriction in the statement of wares in the application.

[43] 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 for the Overlapping Wares. However, confusion does not seem likely with respect to the remaining wares because there is no evidence that the Opponent sells such wares or that such wares would be a natural extension of the Opponent's business. Accordingly, the ground of opposition based on 12(1)(d) of the Act is successful with respect to the Overlapping Wares.

### Non-entitlement ground of opposition – section 16(3)(a)

[44] In order to meet its initial burden under section 16(3)(a) of the Act, the Opponent must show that the trade-mark alleged in support of its ground of opposition based on section 16(3)(a) of the Act was used in Canada prior to the date of filing of the application for the Mark (November 13, 2008) and had not been abandoned at the date of advertisement of the application for the Mark (November 17, 2010) [section 16(5) of the Act].

[45] As previously mentioned, I am satisfied that the Opponent has evidenced use of its BLACK KOI trade-mark in Canada prior to the date of filing of the application for the Mark, and had not abandoned the mark at the date of advertisement of the application for the Mark.

[46] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of filing of the Applicant's application, namely, November 13, 2008, there was not a reasonable likelihood of confusion between its Mark and the Opponent's trade-mark.

[47] The difference in material date is not significant and as a result, my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable with respect to the Overlapping Wares. Consequently, the ground of opposition based on non-entitlement under section 16(3)(a) of the Act is successful with respect to the Overlapping Wares.

#### Non-distinctiveness ground of Opposition

[48] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, January 13, 2011, the Opponent's BLACK KOI trade-mark had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc, supra; Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[49] As previously indicated, I am satisfied that the evidence shows sufficient use of the Opponent's BLACK KOI trade-mark. Thus, the Opponent has met its evidential burden.

[50] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's BLACK KOI trade-mark.

[51] In this regard, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here as well. Accordingly, the ground of opposition based on non-distinctiveness is successful with respect to the Overlapping Wares.

## Disposition

[52] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark with respect to “Clothing, namely, athletic wear, outerwear, swimwear, shirts, t-shirts, tank tops, sweaters, sweatshirts, hoodies, pullovers, shorts, pants, skirts, jackets, coats, scarves; headwear, namely, caps, beanies, headbands, hats” and I reject the opposition with respect to the remainder of the wares pursuant to section 38(8) of the Act [see *Produits Menagers Coronet v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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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</u>
1,418,244	KOI	(1) Clothing, namely, athletic wear, outerwear, swimwear, shirts, t-shirts, tank tops, sweaters, sweatshirts, hoodies, pullovers, shorts, pants, skirts, jackets, coats, scarves; headwear, namely, caps, beanies, headbands, hats; umbrellas; keychains; water bottles and flasks; towels; bags, namely, duffle bags, tote bags, yoga bags; purses, backpacks; floor mats; yoga mats; glassware, namely drinking glasses; mugs; notebooks, journals.

### Schedule “B”

Registered mark:

<u>Registration No.</u>	<u>Trade-mark</u>	<u>Wares</u>
TMA713,262	BLACK KOI	(1) Ladies', men's and children's pants, slacks, jeans, shorts, shirts, T-shirts, sweaters, jackets, blazers and ladies and girls' dresses, blouses and skirts.