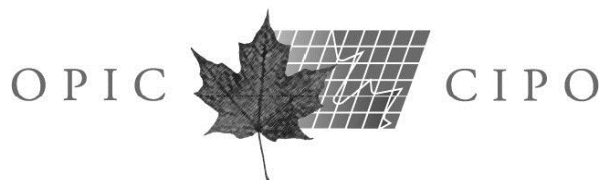


TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 244
Date of Decision: 2011-12-07

**IN THE MATTER OF AN OPPOSITION
by The Forzani Group Ltd. to application
No. 1,336,280 for the trade-mark ONYX
BLACK ELEMENTS in the name of
Effigi Inc.**

[1] On February 21, 2007, Effigi Inc. (the Applicant) filed an application for registration of the trade-mark ONYX BLACK ELEMENTS (the Mark), on the basis of proposed use of the Mark in Canada in association with the following wares:

[TRANSLATION]

Clothing, namely urban wear, business wear, casual wear, loungewear, clothing for gymnastics, exercise clothing, sports clothing, formal wear, sleepwear, swimwear, beachwear, rain wear, outerwear, ski wear, protective clothing, clothing for children, babies and newborns, underwear; headwear, namely hats, skull caps, berets, headbands, kerchiefs, ear muffs, toques, caps; fashion accessories, namely belts, suspenders, ties, scarves, bandanas; shoes, namely street shoes, leisure shoes, sports shoes, beach shoes, children's footwear, evening footwear, exercise footwear, fishing footwear, golf shoes, winter footwear, safety footwear, rain shoes, ski boots. Bags, namely sports bags, gym bags, beach bags, diaper bags, backpacks, handbags, travel bags, school bags, shoe bags, fanny packs, hiking bags, shoulder bags, tote bags, baby carriers. Eyeglasses, sunglasses, sport glasses. Perfume; watches; jewellery. Synthetic fabric and textiles for use in the manufacture of clothing, waterproofing and breathable coatings for fabric items, insulating fibres for clothing. Baby items, namely baby bottles, nipples, pacifiers, rattles, teething rings, plush toys, bath toys, mobiles. (the Wares)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 14, 2007.

[3] The Forzani Group Ltd. (the Opponent) filed a statement of opposition to this application on April 14, 2008. The grounds of opposition can be summarized as follows:

1. The application for registration does not meet the requirements of s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the Act), in that some of the Wares listed in the application are not defined in ordinary commercial terms.
2. The application does not meet the requirements of s. 30(i) of the Act in that, at the filing date of the application, the Applicant and the Opponent were both involved in a dispute over various “ONYX” trade-marks and that, for that reason and the rest of the reasons set out in the statement of opposition, the Applicant could not have been satisfied that it was entitled to use the Mark as alleged in its application.
3. The Applicant is not the person entitled to the registration of the Mark under s. 16 of the Act in that, at the filing date of the application, the Mark was confusing with the Opponent’s trade-marks ONYX and ONYX & Design (reproduced below), previously used in Canada in association with clothing; the mark ONYX & Design being, moreover, the subject of an application for registration in Canada under No. 1,356,998:



4. The Mark is not distinctive of the Applicant’s Wares within the meaning of s. 2 of the Act in that it is not adapted to distinguish and does not actually distinguish these Wares from the wares of other persons on account of previous use by (i) the Opponent of the trade-mark ONYX & Design described above; (ii) Groupe BBH Inc. of the trade-marks ONYX and ONYX & Design registered and used in Canada in association with “safety

equipment and protective clothing”; and (iii) Consoltex Inc. of the trade-mark ONYX registered and used in Canada in association with “textile goods of all kinds”.

[4] The Applicant filed a counter statement denying all of the grounds of opposition.

[5] In support of its opposition, the Opponent filed an affidavit by Tom Sampson, sworn on December 17, 2008. However, this affidavit was returned to the Opponent in accordance with Rule 44(5) of the *Trade-marks Regulations* (SOR/96-195). Consequently, there is no evidence in the record that was filed on the Opponent’s behalf. In support of its application for registration, the Applicant filed the certificates of authenticity for registrations No. TMA595,233 (ONYX & Design) and No. TMA599,265 (ONYX), formerly in the name of Lorne Nadler Sales Inc., and TMA419,649 (ONYX), showing that these registrations have all been expunged.

[6] Only the Applicant filed a written argument and participated in an oral hearing.

Analysis

[7] The onus is on the Applicant to show that its application meets the requirements of the Act. However, it is up to the Opponent to ensure that each of its grounds of opposition is duly argued and to meet its initial evidentiary onus by establishing the facts supporting its grounds of opposition. Once this initial burden is met, it is up to the Applicant to prove, on a balance of probabilities, that none of these grounds of opposition impedes the registration of the Mark [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] Applying those principles to this case, each of the grounds of opposition is summarily dismissed for the following reasons:

- Section 30(a) ground

[9] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. It merely asserts the following in its statement of opposition:

It is submitted that the following references which appear in the applied for wares do not appear in ordinary commercial terms, nor indicated as acceptable in the online *The Wares and Services Manual*. Further, they are vague and unclear :

- Protective clothing
- Street shoes
- Winter footwear
- Urban wear
- Baby carriers
- Breathable coatings for fabric items

The wares as stated are arbitrary [*sic*] and do not permit a clear understanding as to the real nature of the products.

[10] As the Applicant quite rightly pointed out at the hearing, the application for registration is drafted in French. Therefore, this ground of opposition must be considered in respect of the official version of the statement of Wares, that is, the French version. However, there is no evidence in the record supporting the conclusion that the corresponding wares, that is, those described in French as “vêtements de protection”, “chaussures de ville”, “chaussures d’hiver”, “vêtements de ville”, “sacs porte-bébés” and “enduits imperméabilisants et respirants pour articles de tissu” are not, in the context of the statement of Wares, acceptably described in ordinary commercial terms. From the Opponent’s mere allegation that the Wares listed in its ground of opposition are not found in the English version of the Canadian Intellectual Property Office’s *Wares and Services Manual*, it does not necessarily follow that the wares, as set out in French in the statement of wares, are unacceptably described. The Manual contains a representative list of acceptable wares and services under s. 30(a) of the Act. This list is not exhaustive. Furthermore, the Manual indicates that the entries it contains may be used as analogies for wares and services that are not listed, as such, in the Manual.

[11] Given that the Opponent has failed to meet its initial burden of proof with respect to this ground of opposition, I am of the opinion that there is no need to rule on the Applicant’s submission that this ground of opposition is, furthermore, improperly argued since it refers to the English version of the Wares rather than to the official version, in French.

- Non-distinctiveness ground

[12] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. The Opponent had to show that one or more of the “ONYX” trade-marks alleged in support of this ground of opposition had become sufficiently known in Canada at the filing date of the statement of opposition to negate the distinctiveness of the Mark [see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.); and *Bojangles’ International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[13] However, as previously stated, no evidence in the record to this effect was filed on the Opponent’s behalf. What is more, and although this is not truly relevant, the Applicant’s evidence shows that the registration for Consoltex Inc.’s trade-mark ONYX has been expunged.

- Section 16 ground

[14] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. To the extent that the Opponent intended to use this ground to contend that the Applicant is not the person entitled to the registration of the Mark under s. 16(3)(a) of the Act (whereas the Opponent incorrectly refers to s. 16(1) of the Act in its statement of opposition), the Opponent had the onus of showing that either one of its ONYX trade-marks had been in use before the filing date of the application and had not been abandoned at the date of advertisement of the application [see s. 16(5) of the Act]. However, as mentioned above, there is no evidence in the record to this effect that was filed on the Opponent’s behalf.

[15] I would further add that the ground of opposition argued by the Opponent cannot be deemed to be raised under s. 16(3)(b) of the Act, given that the Opponent’s application for registration No. 1,356,998 was filed after the Applicant’s application for registration.

- Section 30(i) ground

[16] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. Although it may be argued that this ground of opposition refers implicitly to bad faith on the part of the Applicant at the time of filing of the application, none of the evidence in the

record supports that allegation. All that is required of an applicant under s. 30(i) of the Act is to provide a statement that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares or services described in its application. The Applicant has formally complied with this provision. It is well established in the case law that a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where it has been established that there is bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co. (1974)*, 15 C.P.R. (2d) 152 (T.M.O.B.) at page 155]. That has not been established in this case.

Decision

[17] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition under s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Sarah Burns, Translator