



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

**Citation: 2013 TMOB 169**  
**Date of Decision: 2013-10-07**

**IN THE MATTER OF OPPOSITIONS by  
Zainab Ansell and Roger Ansell, a  
partnership to application Nos. 1,544,442;  
1,544,447; 1,544,448; 1,544,449; and  
1,544,450 for the trade-marks ZARA BOYS,  
ZARA GIRLS, ZARA ACCESSORIES,  
ZARA UNDERWEAR, and ZARA  
KNITWEAR respectively in the name of  
Industria De Diseno Textil, S.A.**

[1] Zainab Ansell and Roger Ansell, a partnership (the Opponent) opposes registration of the trade-marks ZARA BOYS, ZARA GIRLS, ZARA ACCESSORIES, ZARA UNDERWEAR, and ZARA KNITWEAR (collectively referred to as the Marks) that are respectively the subject of application Nos. 1,544,442; 1,544,447; 1,544,448; 1,544,449; and 1,544,450 by Industria De Diseno Textil, S.A. (the Applicant).

[2] The particulars of the applications for the Marks are detailed in Schedule “A” to my decision.

[3] The Opponent alleges that the Applicant is not the person entitled to registration of the Marks and that the Marks are not distinctive under section 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because they are all confusing with the Opponent’s word and/or design marks ZARA TANZANIA ADVENTURES LOGO and ZARA TOURS, which have allegedly been previously used or made known in Canada by the Opponent in association with travel agency services and the operation of a wildlife campsite. The Opponent further alleges that the applications for the Marks do not comply with the requirements of section 30 of the Act in that

the Applicant has not used the Marks in association with all of the wares and/or services set forth in its applications since the claimed dates of first, and that some of the wares covered by the applications are not defined in ordinary commercial terms.

[4] For the reasons that follow, each of the Opponent's oppositions ought to be rejected.

#### The Record

[5] The statements of opposition were filed by the Opponent on January 23, 2012. By way of letter dated February 16, 2012, the Applicant filed and served its counter statement in each case and also requested an interlocutory ruling with respect to some paragraphs of the statements of opposition. The Opponent thereafter requested leave to file an amended statement of opposition in each case. By way of Office letter dated April 5, 2012, the Registrar granted leave to the Opponent to file its amended statements of opposition and refused the Applicant's request to strike certain paragraphs of the statements of opposition. By way of letter dated April 18, 2012, the Applicant requested a further interlocutory ruling on the sufficiency of paragraph 1(d) of the amended statement of opposition in each case. By way of Office letter dated April 26, 2012, the Registrar struck paragraph 1(d) of each amended statement of opposition. The remaining grounds of opposition are those contained in paragraphs 1(a); 1(b); 1(c); and 2, namely the non-entitlement, non-distinctiveness, and non-conformity grounds of opposition outlined above.

[6] As its evidence in each case, the Opponent filed a single affidavit (executed in five copies) of Shantelle Garrick, a secretary employed by the Opponent's agent, sworn June 15, 2012. By way of letter dated August 31, 2012, the Applicant advised the Registrar that it did not wish to submit evidence and that it objected to the admissibility of the Garrick affidavit. I will address that objection in more detail below in my analysis of the non-conformity grounds of opposition.

[7] Both parties filed written arguments in each case and a single hearing was held at which only the Applicant was represented.

#### The parties' respective burden or onus

[8] The legal onus is on the Applicant to show that each of its applications does not

contravene the provisions of the Act as alleged in the statements of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

[9] Applying these principles, the non-entitlement and non-distinctiveness grounds of opposition can be summarily dismissed for the reasons that follow.

#### Grounds of opposition summarily dismissed

##### The non-entitlement ground of opposition based on section 16(1) of the Act

[10] The non-entitlement ground of opposition based on section 16(1)(a) of the Act can be summarily dismissed in each case because the Opponent has failed to show that as of the dates of first use claimed in the Applicant's applications, the Opponent's word and/or design marks ZARA TANZANIA ADVENTURES LOGO, and ZARA TOURS had been previously used or made known in Canada and had not been abandoned as of the dates of advertisement of the applications [section 16(5) of the Act]. In fact, the Opponent did not file any supporting evidence or make any submissions with respect to this ground of opposition.

##### The non-distinctiveness ground of opposition

[11] The non-distinctiveness ground of opposition can be summarily dismissed in each case because the Opponent has failed to show that as of the filing date of the statements of opposition, its word and/or design marks ZARA TANZANIA ADVENTURES LOGO, and ZARA TOURS had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the Marks [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. In fact, the Opponent did not file any evidence or make any submissions in support of this

ground of opposition.

[12] This leaves us with the non-conformity grounds of opposition in each case.

#### Remaining grounds of opposition

[13] The Opponent has pleaded two grounds of opposition under section 30 of the Act, namely one based on section 30(a) of the Act, and one based on section 30(b) of the Act.

#### The section 30(a) ground of opposition

[14] As indicated above, the Opponent has pleaded that some of the wares covered by the Applicant's applications are not defined in ordinary commercial terms.

[15] More particularly, the Opponent contends that the wares "walking stick seats", "leather board" and "beach dresses" are not defined in ordinary commercial terms contrary to section 30(a) of the Act.

[16] Generally, the material date for considering a ground of opposition based on section 30(a) of the Act is the date the application was filed. However, when an application has been amended to conform to ordinary commercial terms in response to a preliminary report by the Examiner, the amended application date will be considered as the material date for considering grounds of opposition that are based on section 30(a) of the Act [see *Eaton Williams (Millbank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB)]. Applying similar reasoning to the present cases, the material date is March 29, 2012, that is the date the applications were last amended.

[17] Except for the wares "beach dresses" discussed below, there is no evidence to support the Opponent's pleading. Furthermore, the Opponent did not make any submissions with respect to the wares "walking stick seats" and "leather board" in its written arguments.

[18] As for the wares "beach dresses", the Opponent relies on the Garrick affidavit that purports to introduce into evidence, among other search results, the results of a search conducted on the Online Wares and Services Manual (the Manual) of the Canadian Trade-marks Office database at [www.ic.gc.ca](http://www.ic.gc.ca).

[19] More particularly, Ms. Garrick states that on June 15, 2012, she “received instructions to access the Canadian Trade Marks Office database at *www.ic.gc.ca* and conduct a search in the Online Wares and Services Manual for ‘beach dresses’”. She attaches to her affidavit as Exhibit “C” the printout of her search results [paras 8 and 9 of her affidavit].

[20] As indicated above, the Applicant objects to the admissibility of the Garrick affidavit. That said, I do not find it necessary to rule on the admissibility of that portion of the Garrick affidavit because, even if I were to find it admissible, I would still find that it is of no assistance to the Opponent.

[21] The mere fact that the term “beach dresses” per se is not found in the Manual does not necessarily lead to a finding that these wares are not defined in ordinary commercial terms.

[22] First, the Manual contains a representative list of acceptable wares and services under section 30(a) of the Act. This list is not exhaustive. Second, 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. Third, the search results attached as Exhibit “C” to the Garrick affidavit expressly provide that the term “dresses” by itself is acceptable. They also provide that the terms “beach robes”, “beach coats”, “beach cover-ups”, and “beach footwear” are acceptable.

[23] To sum up, I find that the Opponent has failed to satisfy its evidential burden in respect of this ground of opposition. Accordingly, the section 30(a) ground of opposition is dismissed in each case.

#### The section 30(b) ground of opposition

[24] As indicated above, the Opponent has pleaded that the Applicant has not used the Marks in Canada in association with each of the wares and services set forth in its applications since the claimed dates of first use contrary to section 30(b) of the Act.

[25] The material date to consider this ground of opposition is the filing date of the Applicant’s applications [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the evidential

burden on the Opponent with respect to such a ground of opposition is less onerous [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)].

[26] To support its factual allegations, the Opponent relies on the Garrick affidavit that purports to introduce into evidence, in addition to the search results discussed above, the results of various searches conducted on the website *www.zara.com*.

[27] As indicated above, the Applicant objects to the admissibility of the Garrick affidavit.

[28] More particularly, relying primarily on the decision in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA), the Applicant submits that the Garrick affidavit is inadmissible (as least as far as Ms. Garrick's searches conducted on the website *www.zara.com* are concerned) as it comes from an employee of the Opponent's agent, and relates to a point of substance and controversy in these proceedings. In the alternative, the Applicant submits that little weight, if any, should be given to the affidavit since there is so little in it which is admissible or reliable.

[29] By contrast, the Opponent submits that the Garrick affidavit is admissible as it does not comprise any contentious opinion evidence whatsoever. In support, the Opponent relies on the decisions of the Registrar in *Mr Lube Canada Inc v Denny's Lube Centre Inc* (2008), 73 CPR (4th) 308; *Canadian Council of Professional Engineers v Alberta Institute of Power Engineers* (2008), 71 CPR (4th) 37; and *Canadian Jewellers Assn v American Gem Society* (2010), 86 CPR (4th) 131.

[30] The Federal Court of Appeal makes it clear that "it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give opinion evidence on the most crucial issues in the case" [*Cross-Canada, supra*, at para 4]. While the Court is less clear on how solely non-opinion evidence furnished by a firm's employee should be treated, it does state that "it is improper for a solicitor to compromise his independence by acting in a proceeding in which a member of his firm has given affidavit evidence on a point of substance" [*Cross-Canada, supra*, at para 7].

[31] This brings me to review the Garrick affidavit.

[32] Ms. Garrick states that she has been employed as a secretary by the agent of record for the Opponent since April, 2008 and that as part of her secretarial duties, she has occasions to access various online databases and to conduct online searches through various search engines [paras 1 and 3 of her affidavit].

[33] More particularly, Ms. Garrick states that:

- she “received instructions to access the Applicant’s website at *www.zara.com*” and to conduct searches for a number of wares in the search box provided. Ms. Garrick lists a total of 31 items searched, including “walking sticks”, “whips”, “saddlery”, “harnesses”, etc. She attaches to her affidavit as Exhibit “A” the printouts of the results of these searches dated May 28, 2012 [paras 4 and 5 of her affidavit]; and
- she “received instructions to access the Applicant’s corporate website at *www.inditex.com* and print the webpage at *www.inditex.com/en/who\_we\_are/stores?zone=CA*.” She attaches to her affidavit as Exhibit “B” the printout of this webpage dated June 15, 2012 [paras 6 and 7 of her affidavit].

[34] In the present cases, I agree with the Applicant that the Garrick affidavit relates to a contested issue, that is whether or not the Applicant has used the Marks as alleged in its applications. On the other hand, I agree with the Opponent that a parallel can be made between the present cases and the decisions of the Registrar relied upon by it, wherein the decision to consider affidavit evidence given by an employee turned on whether or not contentious *opinion* evidence of the type adduced in *Cross-Canada* was given.

[35] That said, I do not find it necessary to discuss those decisions further. Nor do I consider it necessary to rule on the admissibility of the above-cited portions of the Garrick affidavit because, even if I were to find them admissible, I would still find that no weight ought to be given to them since they provide little, if any, relevant or reliable evidence.

[36] As stressed by the Applicant, there is no evidence that the website *www.zara.com* belongs to the Applicant. The mere fact that Ms. Garrick baldly states that she was instructed “to access the Applicant’s website at *www.zara.com*” does not establish that this website belongs to the

Applicant. Neither of the Exhibits “A” and “B” attached to the Garrick affidavit provides any indication as to the ownership of the domain name *zara.com* or the entity operating the website *www.zara.com*. As a result, I agree with the Applicant that the Opponent has failed to establish a connection between the website *www.zara.com* and the Applicant [see *Quiksilver International Pty Ltd v Equinox Entertainment Limited* 2010 TMOB 59 CanLII].

[37] In addition, all of the webpages and printouts attached to the Garrick affidavit postdate the material date to assess each of the non-conformity grounds of opposition based on section 30(b) of the Act raised in these proceedings. Further, it is unclear how searches conducted in 2012 could locate evidence of use from the years 1999, 2003 or 2006 as alleged in the Applicant’s applications.

[38] Other deficiencies with the Garrick affidavit include the following facts:

- Ms. Garrick’s searches apparently purported to locate wares as opposed to the Marks themselves; and
- the Applicant’s applications do not claim that the Marks have been used on the Internet.

[39] To sum up, the Garrick affidavit is of no assistance to the Opponent.

Conclusion regarding the non-conformity ground of opposition based on section 30(b) of the Act

[40] In view of my findings made above as to the weight to be given to the Garrick affidavit, I find that the Opponent has failed to satisfy its evidential burden in respect of this ground of opposition. Accordingly, the section 30(b) ground of opposition is dismissed in each case.

Disposition

[41] In view of the foregoing and pursuant to the authority delegated to me under



section 63(3) of the Act, I reject each of the oppositions pursuant to section 38(8) of the Act.

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

Schedule "A"

Trade-mark	Appl'n No. / Appl'n Date	Wares and/or Services (as last amended by the Applicant) Claims
ZARA BOYS	1,544,442 2011-09-21	<p>(1) Precious metals and their alloys; goods in precious metals or coated therewith, namely: jewellery, imitation jewellery, watches, clocks, chronometers; precious stones. Leather and imitations of leather; goods made of these materials, namely: animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, bags for climbers, bags for campers, beach bags, handbag frames, umbrella or parasol frames, mountaineering sticks, handbags, key cases, attaché cases, purses not of precious metal, school bags, garment bags for travel, hat boxes of leather, sling bags for carrying infants, wheeled shopping bags, flower pots and decorative pots of leather or of leather board, decorative boxes of leather, jewellery boxes of leather, music boxes of leather and pencil boxes of leather, decorative boxes of vulcanised fibre, school satchels, pocket wallets, briefcases, vanity cases sold empty, collars for animals, leather leashes, leather leads, umbrella covers, saddle cloths for horses, backpacks, horse blankets, haversacks, halters, envelopes and pouches of leather for packaging, riding saddles, pads for horse saddles, umbrella rings, blinders [harness], harness fittings, harness for animals, walking stick seats, bandoliers, tool bags of leather sold empty, chain mesh purses, muzzles, bridles [harness], leather board, travelling trunks, shopping bags, straps for soldiers' equipment, harness straps, straps of leather [saddlery], straps for skates, trimmings of leather for furniture, leather straps, butts [parts of hides], curried skins, cat o' nine tails, coverings of skins [furs], stirrup leathers, part of rubber for stirrups; reins, suitcases, moleskin [imitation of leather], fur-skins, chamois leather, nose bags [feed bags], net bags for shopping, knee-pads for horses, fastenings for saddles, card cases, note cases, traces [harness], valves of leather, stirrups. Ready-made clothing for women, men and children, namely: athletic clothing, baby clothing, casual clothing, children's clothing, dress clothing, fire protective clothing, fire retardant clothing, fishing clothing, infant clothing, motorcyclist protective clothing, radiation protective clothing, sports clothing, sun protective clothing, outdoor winter clothing, belts, jackets, bibs, not of paper; bathrobes; swimming costumes, boas (to wear around the neck), underwear, babies' pants, scarves, hoods, money belts (clothing), wet suits for waterskiing, ties,</p>

		<p>corsets, sashes, fur stoles, girdles, shawls, gloves, waterproof clothing, mantillas, stockings, socks, neck scarves, textile nappies, pyjamas, veils, braces, layettes, collars, singlets, mittens, bow ties, pareos, cuffs, dress shields, masquerade costumes, beach dresses. Footwear (except orthopaedic footwear), namely: athletic footwear, beach footwear, casual footwear, children's footwear, evening footwear, exercise footwear, fire protective footwear, golf footwear, infant footwear, rain footwear, outdoor winter footwear, ski footwear, sports footwear, bathing sandals, soles, heels, insoles. Headgear, namely: headbands, beret, bonnets, caps, bathing caps, hoods, hats, ear muffs, bandanas, cap peaks.</p> <p>(1) Retail sale of perfumery, make-up products, soaps, clothing, clothing accessories, hats, footwear, watches and clocks, eyeglasses, sunglasses, sports glasses, CDs, DVDs, protection helmets, leather and artificial leather goods, luggage and bags, jewellery, imitation jewellery, stationery, umbrellas, beach towels, textiles and textile goods, hair ornaments, games and toys, sport articles.</p> <p>Used in CANADA since at least as early as 2006.</p>
ZARA GIRLS	1,544,447 2011-09-21	<p>Wares and Services: Same as those for ZARA BOYS.</p> <p>Used in CANADA since at least as early as 2003.</p>
ZARA ACCESSORIES	1,544,448 2011-09-21	<p>Wares and Services: Same as those for ZARA BOYS.</p> <p>Used in CANADA since at least as early as 1999.</p>
ZARA UNDERWEAR	1,544,449 2011-09-21	<p>Wares and Services: Same as those for ZARA BOYS.</p> <p>Used in CANADA since at least as early 1999.</p>
ZARA KNITWEAR	1,544,450 2011-09-21	<p>Wares and Services: Same as those for ZARA BOYS.</p> <p>Used in CANADA since at least as early 2003.</p>