



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

**Citation: 2010 TMOB 119**  
**Date of Decision: 2010-08-05**

**IN THE MATTER OF AN OPPOSITION  
by 3681441 Canada Inc. to application  
No. 1,290,369 for the trade-mark  
AKADEMIKS JEANIUS in the name of  
Kemistre 8 LLC**

The Pleadings

[1] On February 17, 2006 Kemistre 8 LLC. (the Applicant) filed an application to register the trade-mark AKADEMIKS JEANIUS (the Mark), application number 1,290,369, based on use and registration abroad. The registration was made in the United States of America, the Applicant's country of origin, on March 11, 2003 under No. 2695968 in association with:

Clothing and apparel for men, women, young adults, children and infants, namely, bandannas, baseball caps, baseball t-shirts, bathrobes, beach cover-ups, belts, berets, Bermuda-shorts, casual and sport blazers, body suits, bow ties, coats, embroidered caps, embroidered shirts, football t-shirts, footwear, namely, boots, sandals, shoes, slippers and sneakers; golf shirts, gloves, hats, head bands, jackets, jeans, jerseys, jogging suits, jump suits, knit shirts, knitted hats, night shirts, overcoats, pants, parkas, polo shirts, pull-overs, pyjamas, rain coats, scarves, shirts, shorts, socks, sport coats, sport shirts, suits, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, tank tops, tee shirts, ties, top coats, track suits, trousers, tuques, undergarments, underpants, undershirts, underwear, vests, warm-up suits, woven-shirts; clothing for women and young adults, namely, blouses, boleros, brassieres, bustiers, camisoles, chemises, corselettes, corsets, dresses, dressing gowns, dusters, foundation garments, garter belts, girdles, halter tops, hosiery, housecoats, jumpers, lingerie, negligees, night

gowns, night shirts, panties, peignoirs, pyjamas, robes, sarongs, scarves, shawls, shrugs, skirts, stoles, teddies, tops, wraps (Clothing Wares)

[2] The application was also based on use in Canada since May 2000 in association with:

The Clothing Wares as well as all purpose sport bags, all-purpose athletic bags, attaché cases, backpacks, beach bags, billfold wallets, billfolds, book bags, brief bags, briefcases, business card cases, change purses, cosmetic bags, credit card cases, credit card holders, duffel bags, fanny packs, gym bags, handbags, key cases, knapsacks, luggage, multipurpose cloth bags, overnight bags, pocketbooks, portfolios, purses, rucksacks, school bags, shoulder bags, suitcases, tote bags, travel accessory bags, travelling bags, umbrellas, wallets, zipped wallets, straps for handbags and luggage and accessories used therewith, namely, bag closures, shoulder strap pads, holders and pouches; leather and leather imitation accessories, namely, attaché cases, billfolds, briefcases, business card cases, cases, change purses, cosmetic bags, credit card cases, credit card holders, fanny packs, garment bags for travel, handbags, key chains, key cases, pocketbooks, portfolios, shoe bags for travel, tote bags, trunks and travelling bags, wallets (collectively referred to as the Wares).

[3] The application was advertised on May 23, 2007 in the *Trade-marks Journal* for opposition purposes. 3691441 Canada Inc. (the Opponent) filed a statement of opposition on July 5, 2007. The Applicant filed a counter statement on August 29, 2007, denying all grounds of opposition listed below.

[4] The Opponent filed the affidavit of Gilbert Bitton as its evidence while the Applicant filed the affidavit of David Oved. None of the deponents were cross-examined.

[5] Both parties filed written arguments and there was no oral hearing.

### The Grounds of Opposition

[6] The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the “Act”) in that:

a) The Applicant did not use the Mark in association with the Wares since May 2000 in Canada;

- b) The Applicant did not use the Mark in the United States, as claimed, in association with the wares mentioned in the certificate of registration obtained in the United States of America;
- c) It is falsely that the Applicant declared that it was satisfied to be entitled to use the Mark in Canada in view of what it is alleged therein.

2. The Mark is not registrable under s. 12(1)(d) of the Act because it is confusing with the Opponent's registered trade-mark no. TMA278,717 for the trade-mark JEANIUS JEANS used in association with men's, women's and children's jeans, shorts, skirts, shirts, pants and overalls;

3. The Applicant is not the person entitled to registration in that, contrary to s. 16(1)(a) and (b) of the Act, at the claimed date of first use of the Mark, namely May 2000, it was confusing with the Opponent's trade-mark JEANIUS JEANS previously used and made known in Canada by the Opponent (since at least as early as November 1976) or by the Opponent under license or, by its predecessors in title, in association with wares including articles of clothing and accessories, adding that the Opponent through its predecessor in title Jeanius Jeans Ltée had previously filed an application for its trade-mark JEANIUS JEANS on August 10, 1977;

4. The Mark is not distinctive in that it does not distinguish, and is not adapted to distinguish, the Wares from the wares of the Opponent in view of the prior use, making known and registration of the trade-mark JEANIUS JEANS owned by the Opponent.

#### Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

#### Preliminary remarks

[8] Both parties' evidence contains legal opinion, argument or conclusions in law. I shall disregard those. I refer in particular to paragraph 17 of Mr. Bitton's affidavit and to paragraphs

13, 16, 18, 22 and 26 of Mr. Oved's affidavit. I also give little weight to the assertions made by Mr. Oved in paragraphs 20 and 21 of his affidavit as there is no evidence to support them.

#### Ground of Opposition Summarily Dismissed

[9] The Opponent has an initial evidential burden when alleging non-compliance with the provisions of s. 30(b) of the Act but it has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant itself [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156]. However such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in its application [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84, *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 and *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999), 4 C.P.R. (4th) 107].

[10] I will analyze in detail the evidence filed by both parties under the registrability ground of opposition. Suffice to say at this stage that the Opponent has not adduced any evidence to support its assertions contained in the first-two portions of its first ground of opposition. The Applicant's evidence may have lacunas with respect to the use of the Mark in Canada. However, when such evidence was filed, the Applicant was not facing the challenge to prove that the Mark had been used in Canada since the claimed date of first use alleged in the application, as none of the evidence filed by the Opponent was addressing such issue. For these reasons, I dismiss the first-two portions of the first ground of opposition.

[11] With respect to the third portion of the first ground of opposition, where an applicant has provided the statement required by s. 30(i) of the Act, as the Applicant did, that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares described in the application, this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no evidence in the file of that nature. The third portion of the first ground of opposition is also dismissed.

Registrability of the Mark under s. 12(1)(d)

[12] The relevant date for the analysis of a ground of opposition based on s. 12(1)(d) of the Act is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424].

[13] The Opponent has met its initial burden by filing, through the affidavit of Mr. Bitton, a photocopy of an extract of CIPO Canadian Trade-marks database for certificate of registration TMA278,717 (exhibit GB-1 to his affidavit) for the trade-mark JEANIUS JEANS. 3681441 Canada Inc. is listed as the current owner. I used my discretion and checked the register. I confirm that the registration is in good standing. It covers men's, women's, children's jeans, shorts, skirts, shirts, pants and overalls.

[14] Therefore I must determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the Opponent's registered trade-mark JEANIUS JEANS. If the answer is affirmative then the Mark cannot be registered.

[15] The test to decide if there is a likelihood of confusion is set out in s. 6(2) of the Act wherein 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 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. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5) of the Act: 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 wares, services, or businesses; 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. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[16] The Mark consists of two words that are spelling variations of the English words "genius" and "academic" while the Opponent's trade-mark is composed of one English word and a spelling variation of another. The corruption or misspelling of a descriptive word cannot

change its character [see *C. Fairall Fisher v. British Columbia Packers Ltd.*, [1945] Ex. C.R. 128]. As there is no connection between the Mark and the Wares, I conclude that the Mark is inherently distinctive. The Opponent's trade-mark does refer to "jeans" and is therefore less inherently distinctive than the Mark.

[17] The distinctiveness of a trade-mark may be enhanced through use or extensive promotion in Canada.

[18] Mr. Bitton has been the Opponent's President and director and was a director of Jeanius Jeans Ltd, a predecessor in title of the Opponent. He alleges that since November 1976 the Opponent and its predecessors in title have been using the trade-mark JEANIUS JEANS in Canada in association with men's, women's jeans, shorts, skirts, shirts, pants and overalls.

[19] He states that on February 10, 2000 the Opponent granted a license to Buffalo Inc. and filed a copy of such license. It contains provisions concerning the control over the quality and character of the wares bearing the licensed mark of the licensor. Therefore any use of the trade-mark JEANIUS JEANS by the licensee is deemed use of that trade-mark by the Opponent [see s. 50(1) of the Act].

[20] To support the allegation of use of the trade-mark JEANIUS JEANS, Mr. Bitton filed pictures of a sample pair of jeans sold by Buffalo Inc. in Canada. There are at least 3 labels or hang tags bearing the trade-mark JEANIUS JEANS. He filed samples of invoices illustrating the sale of similar pairs of jeans to those shown on the pictures filed. The invoices were issued in 2002 and 2003. The deponent alleges that it was impossible to file invoices prior to 2002. The archives of Jeanius Jeans Ltd., the Opponent's predecessor in title and dissolved in 1999, as well as those of Buffalo Inc. were moved on at least two occasions and in the midst of those moves, many boxes were lost. Moreover Mr. Bitton alleges that the computer system of Buffalo Inc. has encountered many problems such that some information, without providing any particulars, would no longer be available.

[21] He also filed pictures of another sample of a pair of jeans sold by Buffalo Inc. in Canada in 2006. That pair of jeans bears 4 labels or hang tags on which appears the trade-mark

JEANIUS JEANS. He filed samples of invoices issued in 2006 to illustrate the sale by Buffalo Inc. of such pair of jeans.

[22] Unfortunately we do not have the quantities of the pairs of jeans sold by the Opponent, its licensees or its predecessors in title since 1976. Therefore it is difficult to assess to what extent the Opponent's trade-mark was known in Canada. There is evidence of use since 2002 of the trade-mark JEANIUS JEANS but in association with jeans only.

[23] Mr. Oved has been the Applicant's president since its incorporation on April 1, 1999. It is an American corporation located in New York, New York. It is a family corporation which is in the business of production and commercialisation of men's, women's and children's clothing, and bags and luggage.

[24] He filed photographs of t-shirts and woven shirts sold in Canada in association with the Mark. However we have no information as to the extent of those sales.

[25] He alleges that products bearing the Mark are available in Canada since at least May 2000, through its Canadian distributors, but there is no documentary evidence to show use of the Mark in Canada since that date within the meaning of s. 4(1) of the Act, namely documents evidencing the transfer of property of the Wares bearing the Mark.

[26] Without such information, I am unable to determine to what extent the Applicant's Mark is known in Canada.

[27] From this evidence, I conclude that the first factor listed under s. 6(5) favours the Opponent.

[28] I already concluded that there is no evidence of use of the Mark in Canada. As for the use of the Opponent's trade-mark JEANIUS JEANS, the evidence filed shows use in Canada since at least June 2002 in association with jeans. The second factor described in s. 6(5)(b) of the Act also favours the Opponent.

[29] As for the nature of the wares of the respective parties, there is clearly an overlap between the Clothing Wares listed as part of the wares covered by the application and the articles of clothing listed in registration number TMA278,717. As for the other wares enumerated in the

application, there could be some connexity between them and the Opponent's wares. This factor favours the Opponent.

[30] In the absence of evidence on the Applicant's channels of trade I have to presume that, for the Clothing Wares, they could be the same as those used by the Opponent for similar wares. With respect to the remainder of the wares described in the application, they cover a variety of bags, luggage, purses, wallets and cases. In the absence of evidence on the parties' respective channels of trade, I cannot infer that those wares (luggage, bags, wallets and the like) would be sold through the same channels of trade as those for clothing items. This factor favours the Opponent only with respect to the Clothing Wares.

[31] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. One must look at the marks in their totalities and should not dissect each one of them into its components.

[32] It has been held that the first portion of a trade-mark is the most relevant for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183]. In this case the first component of the parties' respective trade-marks is different. The only resemblance between the marks is the fact that the second portion of the Mark is identical to the first portion of the Opponent's registered trade-mark JEANIUS JEANS. The idea suggested by the parties' trade-marks is also different. The Mark refers to an individual who has success in school while the Opponent's trade-mark suggests a type of clothing that is ingenuous. Overall this factor does favour the Applicant.

[33] As an additional surrounding circumstance the Applicant, through Mr. Oved's affidavit, has filed evidence of the state of the register. In paragraph 11 of his affidavit he refers to a search conducted on the Canadian Intellectual Property Office database. Mr. Oved does not provide any information on how, when and by whom such search was conducted. In any event the search reveals 5 citations, all containing the word "genius" or its phonetic equivalent "jeanius". Only 2 of those citations are registered trade-marks and 2 applications are only at the formalization stage.



[34] Even if I were to consider such evidence, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. 5 citations are not sufficient to draw any inference about the state of the marketplace.

[35] In paragraph 12 of his affidavit Mr. Oved argues that the Applicant was able to obtain, without any opposition, a registration for the trade-mark AKADEMIKS JEANIUS LEVEL PRODUCTS, certificate of registration TMA593,930 covering similar wares. It is one of the citations listed in the results of the search of the register. Section 19 of the Act does not give the owner of a registration the automatic right to obtain further registrations for the same or similar marks [see *Groupe Lavo Inc. v. Procter & Gamble Inc.* (1990), 32 C.P.R. (3d) 533].

[36] From this analysis I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark JEANIUS JEANS. I reach this conclusion on the basis that overall the marks do not resemble one another, phonetically, visually and in the ideas suggested by them. Moreover there is no connexity between the wares covered by the Opponent's registration, TMA278717 and the wares listed in the application, except for the Clothing Wares. However, even for the Clothing Wares, the differences in the trade-marks of the parties outweigh the factor of the similarity of those wares. Therefore the second ground of opposition must fail.

### Entitlement

[37] The relevant date associated with this ground of opposition, when the application is based on use, is the date of first use alleged in the application (May 2000) [see s. 16(1) of the Act]. The Opponent must show that it had previously used its trade-mark and had not abandoned such use at the advertisement date of the application (May 23, 2007) [see s.16(5) of the Act].

[38] The evidence filed by Mr. Bitton establishes use of the trade-mark JEANIUS JEANS since only June 2002 which is after the filing date of the application. Mr. Bitton did provide

explanations as to why he was unable to file invoices dating prior to 2002. It remains that his assertion that the Opponent and its predecessor in title have used the aforesaid trade-mark since November 1976 is a bald statement without any documentary evidence to substantiate such allegation. Therefore the Opponent has not met its initial onus and consequently this ground of opposition is dismissed.

[39] Even if I were to accept Mr. Bitton's statement of prior use of the trade-mark JEANIUS JEANS by the Opponent's predecessor in title, and thus the Opponent would have met its initial onus, my conclusion on the likelihood of confusion between such trade-mark and the Mark would have been the same as the one drawn under the registrability ground of opposition.

[40] As drafted, the third ground of opposition makes reference to a previously filed application; but it does not refer to the application number. The extract of the register filed by Mr. Bitton with respect to certificate of registration TMA 278,717 does mention that the corresponding application was filed on August 10, 1977. However that application was no longer pending at the advertisement date as it matured to registration on April 8, 1983. Therefore that application could not form the basis of a ground of opposition under s. 16(1)(b) [see s. 16(4) of the Act].

#### Distinctiveness

[41] The relevant date with respect to this ground of opposition is the filing date of the statement of opposition (July 13, 2007) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 and *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317].

[42] To meet its initial onus the Opponent had to prove that its trade-mark JEANIUS JEANS had become sufficiently known at that relevant date to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's trade-mark JEANIUS JEANS such that it was adapted to distinguish or actually distinguishes throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[43] Even if I were to conclude that the Opponent's trade-mark was sufficiently known in Canada prior to the filing date of its statement of opposition, the issue to be decided would remain the likelihood of confusion between the Mark and the Opponent's trade-mark. The difference in the relevant dates between this ground of opposition and registrability would not influence my analysis of the various relevant factors to be considered. My conclusion is that the Mark was distinguishing and was apt to distinguish, at the relevant date, the Applicant's Wares from the Opponent's jeans bearing the trade-mark JEANIUS JEANS. Consequently this ground of opposition is also dismissed.

Disposition

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

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office