



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

Citation: 2010 TMOB 84
Date of Decision: 2010-06-11

**IN THE MATTER OF AN OPPOSITION by
Guess?, Inc. to application No. 1,235,809 for
the trade-mark YES MISS filed by 167081
Canada Inc. operating under the trading style
Dizaro**

[1] On October 26, 2004, 167081 Canada Inc. operating under the trading style Dizaro (the Applicant) filed an application to register the trade-mark YES MISS (the Mark) based upon proposed use of the Mark in Canada in association with women's wearing apparel, namely skirts, pants, shorts, shirts, blouses, t-shirts, tank tops, sweatshirts, sweatpants, sweat suits, suits, sweaters, jumpers, overalls, rompers, dresses, slacks, jackets, jeans, vests and coats.

[2] In an amended application, the Applicant has disclaimed the right to the exclusive use of the word MISS apart from the trade-mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 25, 2005.

[4] On December 20, 2005, Guess?, Inc. (the Opponent) filed a statement of opposition against the application setting out grounds based on s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[5] The Applicant filed and served a counter statement, in which it generally denied the

Opponent's allegations.

[6] The Opponent's evidence consists of the affidavit of Deborah Siegel together with exhibits A to G.

[7] The Applicant's evidence consists of two affidavits of Irina Dinu. Appended to the first affidavit is exhibit IDI-1, and appended to the second is exhibit IDI-2.

[8] Only the Opponent filed a written argument and was represented at a hearing.

Grounds of Opposition

[9] The grounds of opposition may be summarized as follows: the Applicant's application does not conform to the requirements of s. 30(i) of the Act, the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and s. 16(3)(b), and the Mark is not distinctive.

Onus and Material Dates

[10] 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 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[11] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[12] I will now assess the grounds of opposition, but not necessarily in the order they were pleaded.

Ground of opposition based on s. 12(1)(d)

[13] The Opponent alleges that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, as it is confusing with the Opponent's registered trade-mark YES CLOTHING CO., No. TMA378,251, covering women's sportswear, namely pants, trousers and blouses.

[14] I note that the Opponent's initial burden with respect to this ground has been satisfied because registration No. TMA378,251 is in good standing as of today's date.

the test for confusion

[15] The test for confusion is one of first impression and imperfect recollection. In assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question within the scope of s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. These enumerated factors need not be attributed equal weight.

s. 6(5)(a) -the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[16] Section 6(5)(a) of the Act concerns the inherent distinctiveness of the marks at issue and the extent to which they have become known. Both marks are inherently distinctive particularly in view of the word YES which I consider to be the dominant and most distinctive portion of the marks.

[17] With respect to the extent to which the marks have become known, as the Applicant's application is based on proposed use and no evidence of use has been filed since the filing date, I come to the conclusion that the Mark is not known in Canada.

[18] The Opponent filed as its evidence the affidavit of Deborah Siegel. Ms. Siegel has held the position of Secretary for the Opponent for the past six years. She provides details regarding the Opponent's inception since 1981 and describes its line of business which specialises in casual apparel, accessories and related consumer products. Additionally, she provides general information regarding the Opponent's worldwide sales and advertising since 2000, as well as sales and advertising of its products in Canada since 2003. I note however that Ms. Siegel does not specifically indicate which trade-marks are the subjects of these figures.

[19] Ms. Siegel explains that the Opponent's trade-mark portfolio includes the trade-mark YES CLOTHING CO. which is a relatively recent addition to its line of apparel and accessories. Ms. Siegel indicates that the Opponent commenced selling products in Canada in association with the trade-mark YES CLOTHING CO. in 2005. She appends as exhibit D to her affidavit photographs of sample clothing. I note that the trade-mark YES CLOTHING CO. appears on hang tags attached to some of the garments. Ms. Siegel does not provide sample invoices, or sales figures in Canada with respect to this mark. Faced with only Ms. Siegel's bald statement of use and a few sample hang tags illustrating the mark, I am only prepared to conclude that the mark has become known to a very minimal extent in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[20] The length of time that each mark has been in use favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[21] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[22] All of the Applicant's wares are either identical or closely related to the Opponent's wares.

[23] The evidence establishes that the Opponent's wares are sold through retail department stores, small specialty clothing stores and boutiques. On the other hand the Applicant has not yet commenced use of its Mark. The onus is on the Applicant to differentiate the trades of the parties and in my view the Applicant has not demonstrated in any manner that the channels of trade would be different.

[24] Therefore, in the absence of evidence to the contrary, I presume that both parties' overlapping wares could share similar trade channels.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[25] With respect to the degree of resemblance between the marks at issue, there is some obvious similarity in appearance and sound, as they both commence with the word YES, which in my view is the distinctive portion of the respective marks. The ideas suggested by the marks are somewhat different, on the one hand the Opponent's trade-mark could suggest a company manufacturing YES branded clothing, whereas the Mark is an affirmative combined with a courtesy title.

[26] Nonetheless, I am mindful that it is usually the first word or syllable of a trade-mark that is the most important for purposes of distinction, as it is this portion which is more often remembered by consumers, and in this case they are identical [see *Conde Nast Publications Inc. v. Union des editions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

further surrounding circumstances

State of the Register

[27] As a surrounding circumstance, the Applicant filed state of the register evidence introduced through the first affidavit of Irina Dinu, an articling student with the agents for the Applicant. This affidavit serves to introduce into evidence particulars of trade-mark registrations and one trade-mark application not owned by the Opponent, all of which include YES as a component of the marks.

[28] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welsh Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[29] Of the ten trade-marks containing the word YES covering, *inter alia*, clothing items, one is an application which has since been abandoned. The other nine are registrations, one of which has been expunged. This leaves only eight relevant registrations owned by five different entities, and as the Applicant has not provided any evidence to establish that any of these marks were used in Canada at the relevant time, I am of the view that the limited number of relevant registrations is not significant enough to allow me to draw any conclusions from them in respect of the state of the marketplace.

conclusion re likelihood of confusion

[30] The legal burden is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks. In addition, the issue must be considered as a matter of first impression and imperfect recollection. I find that the Applicant's Mark is very close in appearance and sound to the Opponent's mark, particularly since the first portion of the respective marks is also the most distinctive element. This combined with the fact that the wares are identical or closely related, leads me to conclude that an average purchaser, as a matter of

first impression and imperfect recollection, would think that the Applicant's and the Opponent's wares emanate from the same source.

[31] For all of the reasons detailed above, I am of the view that the Applicant has not discharged its onus to show that its Mark is not confusing with the Opponent's mark.

[32] Accordingly, the s. 12(1)(d) ground is successful.

Ground of opposition based s. 16(3)(b)

[33] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(b) of the Act, on the basis that at the date the Applicant filed its application it was confusing with the Opponent's previously filed trade-mark applications Nos. 1,149,739 and 1,170,909 for the trade-mark YES.

[34] Application No. 1,149,739 for the trade-mark YES covers mens', women's and children's apparel, namely, underwear, swimwear, robes, pyjamas, hosiery, gloves, belts, neckties, undershirts, socks, sweatpants, sweatshirts, knit tops, skirts, pants, trousers, shorts, sweaters, jeans, vests, coats, jackets, blazers, dresses, scarves, blouses, cardigans, golf shirts, jogging suits, turtlenecks, suits, and polo shirts; women's panties, bras, tank tops, crop tops, bustiers, camisoles, tap pants, teddies; men's briefs and boxer shorts; footwear, namely, shoes, boots, sneakers, sandals, athletic footwear, thongs, hiking boots; headwear, namely, hats, visors, headbands, hair clips.

[35] The Opponent has met its initial burden with respect to this ground as its application was filed prior to the filing date of the Applicant's application [s. 16(3)(b) of the Act] and was pending when the Applicant's application was advertised, as required by s. 16(4).

[36] As the Opponent has met its initial evidentiary burden, the Applicant has the legal onus to show that there is no reasonable likelihood of confusion, within the meaning of s. 6(2) of the Act between the marks at issue.

[37] I am of the view that the Opponent's evidence with respect to its YES mark is highly similar to the evidence supporting its YES CLOTHING CO. mark, thus my conclusions regarding the s. 12(1)(d) ground are for the most part equally applicable to this ground. I would add that the Opponent's case is even stronger with respect to its YES trade-mark as the Applicant has appropriated the entirety of the Opponent's mark, making confusion even more likely.

[38] This ground of opposition is therefore successful.

[39] Having already found the Opponent successful on two grounds of opposition there is no need to assess this ground with respect to application No.1,170,909 or to consider any of the remaining grounds of opposition.

Disposition

[40] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office