



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

Citation: 2014 TMOB 42
Date of Decision: 2014-02-25

**IN THE MATTER OF AN OPPOSITION
by YM Inc. (Sales) to application
No. 641,981(1) to extend the statement of
wares and services of registration
No. TMA387,969 for the trade-mark
PLANET in the name of Jacques Vert
Group Limited**

[1] Jacques Vert PLC has applied to extend the wares and services for its registered trade-mark PLANET to include jewellery, watches, handbags, umbrellas and the retail sale of such items as well as high-fashion articles of clothing and ready-made garments. YM Inc. (Sales) has opposed this application to extend the wares and services on several grounds, including on the basis that there is a reasonable likelihood of confusion between this trade-mark and its registered trade-mark URBAN PLANET, previously used and made known in association with retail clothing store services.

[2] For the reasons that follow, I have found that this extension application should be refused.

Background

[3] Registration No. TMA387,969 for the trade-mark PLANET issued to Planet Fashion Limited on August 23, 1991. The registration covers the following wares:

Coats, raincoats, blazers, slacks, shirts, skirts, suits, jackets, knitted waistcoats, cardigans, sweaters, pullovers, scarves and belts (for wear), all for women and girls.

[4] On December 21, 2007, Planet Fashion Limited assigned registration No. TMA386,969 to Jacques Vert PLC.

[5] On April 24, 2008, Jacques Vert PLC filed an application to extend the statement of wares and services covered by registration No. TMA387,969, for the trade-mark PLANET to include the following:

Wares:

- (1) Jewellery and watches; handbags, clutch bags, evening bags, purses, wallets, umbrellas.
- (2) Jewellery and watches.
- (3) Handbags and umbrellas.

Services:

- (1) Retail sale of jewellery, watches, handbags, clutch bags, evening bags, purses, wallets, umbrellas, formalwear, business attire, high-fashion articles of clothing and ready-made garments, suits, waistcoats, coats, raincoats, blazers, jackets, trousers, skirts, shirts, blouses, vests, t-shirts, cardigans, sweaters, jumpers, pullovers, scarves, shawls, clothing belts, hats, formal footwear, evening footwear, beach footwear, casual footwear, slippers.

[6] The claims for these amendments are as follows:

- Used in CANADA since at least as early as 1997 on wares (1) and on services.
- Used in UNITED KINGDOM on wares (2), (3).
- Registered in or for OHIM (EU) on December 14, 2001 under No. 530790 on wares (2).
- Registered in or for UNITED KINGDOM on August 03, 1978 under No. 1099722 on wares (3).

[7] The proposed amendments were advertised in the *Trade-marks Journal* on September 29, 2010. On March 7, 2011, YM Inc. (Sales) (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The first two grounds of opposition are based on non-compliance with section 30 of the Act. The remaining four grounds, based on section 12(1)(d), section 16(1), section 16(2) and section 38(2)(d) of the Act,

each turn on the issue of confusion between the Mark and the Opponent's URBAN PLANET registration No. TMA653,892.

[8] In support of its opposition, the Opponent filed the affidavits of Jeff Vansteenkiste, employee of Digital Evidence International Inc. and Hugh Eric Grundy, Chief Executive Officer of the Opponent, and a certified copy of registration No. TMA653,892 for the trade-mark URBAN PLANET. Neither affiant was cross-examined.

[9] Jacques Vert Group PLC elected not to file any evidence.

[10] Both parties filed a written argument and a hearing was held at which both parties were represented.

Preliminary Issues

[11] On January 15, 2014, an amended application was filed reflecting Jacques Vert PLC's change of name from Jacques Vert PLC to Jacques Vert Group Limited and an amendment to its use claim to include use by its predecessor-in-title Planet Fashions Limited. Jacques Vert PLC also requested leave to file an amended counter statement to reflect its current name.

[12] By way of letter dated January 21, 2014, the amendments to the application were accepted on behalf of the Registrar. Jacques Vert Group Limited (the Applicant) was granted leave to file its amended counter statement on January 30, 2014.

[13] As another preliminary matter, I note that the Opponent withdrew the section 30(e) ground at the oral hearing.

Onus and Material Dates

[14] 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 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 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 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(1) – the Applicant’s date of first use [see section 16(1)];
- Section 38(2)(c)/Section 16(2) - the filing date of the application [see section 16(2)];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition

Section 30(b) – Non-Compliance

[16] Section 30(b) of the Act reads as follows:

An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessor-in-title, if any, have so used the trade-mark in association with each of the general classes of wares or services described in the application.

[17] As noted above, the Applicant in the present case amended its application on January, 15 2014, to include its predecessor-in-title in its use claim. Relying on the decision in *Empire Comfort Systems Inc v Onward Multi-Corp Inc* 2010 TMOB 38, the Applicant submits that an application can be amended at any time to claim use by a predecessor-in-title. The Applicant

further submits that the amendment to the application does not fall into any of the prohibitions specifically set out in sections 31 or 32 of the *Trade-mark Regulations*.

[18] The Opponent submitted at the oral hearing that the present application was not in compliance with section 30(b) at the material date for this ground (i.e. the filing date of the application) because the predecessor-in-title was not named at such time. In view that the use claimed was not use by the Applicant, the Opponent submits that the application was not in compliance with section 30(b) when it was filed.

[19] The Opponent has raised the question of whether the Applicant's amendment retroactively rectifies a problem or deficiency that existed in the original application. In my view, this situation is similar to the situation in which an initial statement of wares is not properly set out in ordinary commercial terms under section 30(a) of the Act. In this regard, even though the material date regarding section 30 is the date of filing, in the present case I find that it is appropriate to consider the Mark as it currently stands, and it is clear that the application as amended complies with section 30(b) of the Act [see *Ipex Inc v Royal Group Technologies Ltd* (2009), 77 CPR (4th) 297 (TMOB)].

[20] The Opponent's second argument under this ground is that the Applicant has not used the Mark in association with each of the wares and services set out in the application as of the claimed date of first use of 1997. The Opponent relies on the Vansteenskiste affidavit in support of this ground.

[21] Mr. Vansteenskiste conducted broad online keyword searches using multiple online search engines for the specific purpose of locating material that would corroborate the claims at issue in the application. The wares referenced at The Bay website identified in his affidavit suggest a reference to the goods covered by the Applicant's trade-mark registration TMA641,981 but do not name any of the applied for wares. There was also no evidence located that the Mark has been used by the Applicant in association with the applied for services.

[22] The Opponent submits that the failure of Mr. Vansteenskiste's searches to locate any corroborating evidence of use of the Applicant is noteworthy because the Applicant has claimed that the Mark has been used in Canada in association with the applied for wares and services for

16 years. If there was in fact 16 years of use of the Mark, the Opponent submits that it would be reasonable to expect some related information online, given that the application relates to consumer products and services.

[23] The Applicant made the following comments about the reliability of Mr. Vansteenskiste's evidence:

- He provided incorrect statements regarding the date of the Applicant's assignment;
- He attached the wrong document as an exhibit to his affidavit [para. 7 and Exhibit B];
- His Internet search was sloppy in its parameter, scope and execution; and
- He was not qualified to provide his opinions regarding trade-mark use.

[24] I agree with the Applicant that limited weight should be given to Mr. Vansteenkiste's evidence because of the issues the Applicant has raised regarding its reliability. Even if I would have given full weight to his evidence, I would not have been satisfied that the lack of evidence of use of the Mark on the Internet would have been sufficient, by itself, to meet the Opponent's burden. In this regard, I considered the following comments by Member De Paulsen in *Blistex Inc v Smith Medical ASD Inc* (2012), 106 CPR (4th) 125 (TMOB) at para. 19:

I agree with the Applicant that the apparent absence of the Applicant on the *www.smiths-medical.com* website is insufficient to meet the Opponent's evidentiary burden. I note that the Opponent's evidence does not lead to the inference that the Applicant has not used the Mark in Canada since the date claimed in the application. The Opponent's allegation implies an unsubstantiated assumption that use of a trade-mark by an applicant necessarily will include reference to that applicant on the Internet. I do not consider this to be the case. Failure to locate the Applicant, the Wares or goods branded with the Mark on a very limited search of a website which includes reference to numerous related corporate entities, the brand at issue and Canadian distributors does not meet the Opponent's burden.

[25] While I appreciate that the existence of online stores has been prevalent for some time, I am prepared to take judicial notice of the fact that the Internet was in its infancy at the Applicant's claimed date of first use (i.e. 1997). Further, the application does not claim that the Mark has been used on the Internet. It therefore cannot be assumed from a lack of evidence of

use of the Mark on the Internet alone that the Applicant has not been using its Mark in association with the applied for wares or services. This ground therefore fails.

Section 12(1)(d) – Non-registrability

[26] The Opponent further pleads that the Mark is not registrable because it is confusing with its URBAN PLANET trade-mark set out above. I have exercised my discretion and checked the register to confirm that the Opponent's registration No. TMA653,892 is extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[27] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

test for confusion

[28] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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. In applying the test for confusion, the Registrar must have regard to all the 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.

[29] This list of enumerated factors is 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); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC), the

Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

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

[30] Both parties' marks possess some degree of inherent distinctiveness because the word PLANET is not descriptive or suggestive of either party's wares or services. The Opponent's mark is not as inherently strong as the Applicant's Mark because it includes the word URBAN which does suggest that its style of clothing is urban or city fashion.

[31] With respect to the acquired distinctiveness of the Opponent's mark, the evidence of the Opponent's affiant, Mr. Grundy, provides the following information:

- The first URBAN PLANET store opened in Toronto's Eaton Centre on July 7, 1998;
- URBAN PLANET is a chain of retail stores offering an assortment of fashion merchandise and accessories;
- The URBAN PLANET stores have grown from one store in 1998 to over 86 stores in Canada today;
- Canadian sales in association with the URBAN PLANET trade-mark have grown from greater than \$1.2 million in October 1998 to over \$184 million in 2009 and over \$186 million as of the date of his affidavit (i.e. January 20, 2012);
- Since January 2010 consumers have had the option of purchasing goods online from the website urban-planet.com;
- The total marketing expense for the URBAN PLANET banner stores in Canada has been over \$1.8 million in 2009 and \$2.4 million in 2011; and
- The URBAN PLANET trade-mark is promoted by radio, newspaper and by print in the stores.

[32] Based on the foregoing information, I conclude that the Opponent's mark has become quite well known across Canada.

[33] As there is no evidence of any use of the Mark, the overall consideration of this factor favours the Opponent.

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

[34] In view of the above, the length of time that each mark has been in use favours the Opponent.

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

[35] It is the Applicant's statement of wares and services as defined in its application versus the Opponent's registered services that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[36] The Opponent's registered services are "retail clothing store services". The applied for wares include jewellery, watches, handbags and umbrellas, and the applied for services include the retail sale of such wares and other wares including: formalwear, business attire, high fashion articles of clothing, ready-made garments and various types of footwear. The parties' wares and services are different to the extent that the applied for services include the retail sale of various types of footwear. With respect to the other applied for wares and services, although they may not be identical to the Opponent's registered services, I find that they are related.

[37] The Applicant submits that the parties' channels of trade are different because the Applicant sells its own brand of clothing whereas the Opponent sells third party wares. However, the Applicant did not introduce evidence with respect to either its wares or services or the channels of trade associated with the Mark. Further, neither the Opponent's registration nor the Applicant's application contains any restrictions regarding channels of trade. Therefore, in the absence of evidence to the contrary, it is presumable that the parties' channels of trade would also overlap.

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

[38] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. Further, while the Supreme Court of Canada in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[39] The Applicant submits that the component “URBAN” is the dominant and most important word in the Opponent’s mark. In this regard, the Applicant submits that this word gives a certain flavour to the mark as a whole, that is, it suggests city life or a city feeling. Since consumers see and hear this element of the Opponent’s mark first, the primary idea evoked is that of an urban or city environment or style. The Applicant further submits that this is different from the primary idea evoked by the Mark which is space, earth or the environment.

[40] While I agree with the Applicant that the first portion of a mark may be the most important for the purpose of distinguishing between marks, it has also been held that where when the first or dominant portion of a mark is a common descriptive word, its importance diminishes: see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD). In view that the word “URBAN” is a word suggestive of a style of clothing, I do not consider it to be the most striking or unique feature of the Opponent’s mark. In my view, the most striking or unique feature of the Opponent’s marks is the word PLANET. In view that the word PLANET is the only element of the Mark, I find that there is a considerable degree of resemblance between the marks in appearance, sound and idea suggested.

further surrounding circumstances

[41] The Applicant submits that the following three surrounding circumstances favour a finding that there is no likelihood of confusion between the Mark and the Opponent’s mark: the

fact that the trade-mark examiner did not cite the PLANET trade-mark during prosecution of the URBAN PLANET mark nor send a section 37(3) notice to Planet Fashion Limited; the absence of any evidence of confusion despite the co-existence of the marks; and the fact that this is an extension application of a trade-mark that has been registered for over 21 years. I will deal with each circumstance sequentially.

[42] First, a decision by the examination section of the Canadian Intellectual Property Office is not binding on this Board and does not have precedential value for this Board. As stated in *Interdoc Corp v Xerox Corp*, 1998 CanLii 18615 TMOB at p.5:

This Board is not in a position to explain findings by the examination section of the Trade-marks Office. Further, the examination section does not have before it evidence that is filed by parties in an opposition proceeding: see the Board decisions in *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 at 277 and *Proctor & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386.

[43] Second, while it is not necessary for an Opponent to evidence confusion in order for me to find that there is a likelihood of confusion, the absence of confusion despite the overlap of the wares and channels of trade could result in a negative inference being drawn about the Opponent's case [see *Mattel*, above; *Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA)]. In the present case, however, the lack of admissible evidence that the Mark has been used in Canada to any great extent prevents me from drawing any negative inference.

[44] Finally, the Applicant submits that since this is an extension application of a trade-mark that has been registered for over 21 years, the applied for wares and services would be viewed by the consumer as a natural extension of the Applicant's PLANET line of clothing and accessories. While I agree with the Applicant that this factor may reduce the likelihood of confusion between the parties' marks in the present case, I note that 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 CPR (3d) 533 (TMOB) at p. 538].

Conclusion

[45] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the trade-mark PLANET on the Applicant's wares or services at a time when he or she has no more than an imperfect recollection of the Opponent's URBAN PLANET trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[46] In view of my findings above, and in particular the Opponent's extensive reputation of its URBAN PLANET mark in association with overlapping services and the high degree of resemblance between the marks, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares and services associated with URBAN PLANET and PLANET were manufactured, sold or performed by the same person.

[47] The section 12(1)(d) ground of opposition therefore succeeds.

Remaining Grounds of Opposition

[48] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's marks. I am satisfied from the Opponent's evidence that it has met its initial burden under each of these grounds.

[49] The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's date of first use, the Applicant's filing date and the date of the statement of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to these grounds of opposition which also succeed.

Disposition

[50] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application to extend the statement of wares and services of registration No. TMA387,969 pursuant to section 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office