



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

Citation: 2012 TMOB 81
Date of Decision: 2012-04-30

**IN THE MATTER OF AN
OPPOSITION by Sears Canada
Inc. to application No. 1,305,434
for the trade-mark JS BY
JESSICA in the name of With
You, Inc.**

FILE RECORD

[1] On June 14, 2006, With You, Inc. filed an application to register the trade-mark JS BY JESSICA, based on proposed use in Canada, for use in association with a large and varied number of consumer wares including, for example:

audio and video disks featuring music and movies; opera glasses; sculpture; ornaments of precious metals; activity books for children; prepaid telephone calling cards; photograph albums; backpacks; and various items of clothing.

[2] The trade-mark application Examination Section of the Canada Intellectual Property Office objected that the applied for mark was confusing with four registered marks namely, the word mark JESSICA and three combination word and design marks comprised in part of the word JESSICA. The cited marks are in the name of Sears Canada Inc. and cover the wares shoes, dresses, shirts, watches, fashion jewellery, eyeglasses and the like. The applicant responded to the objection by filing an amended application advising the trade-mark Examiner that it had “removed from its application all eyewear, clothing, footwear, jewelry[sic] and watches which overlap those in the cited

registrations.” However, the amended application still covered wares which overlapped with those specified in the cited registrations.

[3] The subject application was subsequently advertised for opposition purposes in the *Trade-marks Journal* issue dated September 5, 2007 and was opposed by Sears Canada Inc., the owner of the above mentioned cited marks, on January 31, 2008. The Registrar forwarded a copy of the statement of opposition to the applicant on February 28, 2008, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent’s evidence consists of the affidavits of Doug Piett, Shawn Belle and Terry Brewer. The applicant’s evidence consists of the affidavits of Kathryn Stewart and Emilie Nicholas. Mss. Stewart and Nicholas were cross-examined on their affidavits, the transcripts thereof and exhibits thereto forming part of the evidence of record. Both parties filed a written argument, however, only the opponent was represented at an oral hearing held on April 11, 2012.

STATEMENT OF OPPOSITION

[5] The opponent pleads that it is the owner of eleven registrations and two applications for trade-marks comprised, in whole or in part, of the component JESSICA (the “JESSICA trade-marks),” covering an assortment of items of clothing and related wares including fashion jewellery. The trade-mark registrations relied on by the opponent include JESSICA and JESSICA SPORT.

[6] Various grounds of opposition are pleaded, including non-registrability pursuant to s.12 of the *Trade-marks Act*, non-entitlement pursuant to s.16(3)(a) of the *Act*, and non-distinctiveness pursuant to s.2, all of which turn on the issue of confusion between the applied for mark JS BY JESSICA and the opponent’s mark JESSICA.

OPPONENT’S EVIDENCE

Doug Piett

[7] Mr. Piett identifies himself as a senior executive with the opponent company. The opponent is one of Canada’s largest full-line retailers of general merchandise and home-

related services. The opponent operates over 100 department stores, over 1,500 catalogue merchandise pick-up locations and since 1999 has offered online shopping. Among other duties, Mr. Piett is responsible for retail advertising of the JESSICA brand.

[8] The trade-marks comprising the JESSICA brand were sold to a wholly owned subsidiary of the opponent on February 3, 2008. The opponent has the exclusive right to use the JESSICA trade-marks pursuant to a license agreement with the subsidiary. The subsidiary controls the character, quality, workmanship and style of the wares sold in association with the JESSICA trade-marks. The JESSICA brand was first used by the opponent in association with clothing and footwear in 1988 and has been in continuous use since then. The brand expanded to include watches, fashion jewellery and eyewear in 2003. Total gross retail sales in Canada under the JESSICA brand averaged about \$150 million annually for the six year period 2001 – 2006. The opponent has extensively advertised the JESSICA brand in Canada by means of retail flyers, catalogues, the Internet, in-store signage and television and radio commercials, examples of which are attached as exhibits to Mr. Piett's affidavit. The cost of such advertising has exceeded \$10 million during the period 2003 to 2008.

Shawn Bell

[9] Ms. Bell identifies herself as a Buyer for the opponent. She determines which products will be purchased by the opponent to be stocked in its stores. Her affidavit serves to introduce into evidence, by way of exhibit material, various examples of the mark JESSICA appearing on labels, hangtags and packaging and as displayed in association with wares on the opponent's website.

Terry Brewer

[10] Ms. Brewer identifies herself as the Women's Wear Category Marketing Manager for the opponent. Wares bearing the JESSICA brand are sold at Sears department stores throughout Canada, through Sears catalogues and through the Internet. The opponent's advertising activities include offering JESSICA branded products for sale through Sears' catalogues. Total gross catalogue sales in Canada under the JESSICA brand averaged about \$56 million annually for the five-year period 2001 – 2005. The cost to create,

publish and distribute such catalogues was in excess of \$5 million per year in the period 2005 to 2008.

APPLICANT'S EVIDENCE

Kathryn Stewart

[11] Ms. Stewart identifies herself as a technical consultant with the firm representing the applicant. On August 25, 2009, she conducted searches of the trade-marks register to locate “the term ‘jessica’ within trade-marks that are registered in association with the wares ‘clothing’ or ‘apparel.’” The results of her search are summarized in Exhibit A of her affidavit. I note that of ten registered marks listed in Exhibit A, eight stand in the name of the opponent’s subsidiary company referred to by Mr. Piett.

Emillie Nicholas

[12] Ms. Nicholas identifies herself as an articling student employed by the firm representing the applicant. In August 2009 she visited various websites and retail stores in Toronto. The results of her investigations are summarized below:

- (i) Jessica McClintock is a clothing designer selling clothing under the brand JESSICA MCCLINTOCK through various retail outlets across Canada.
- (ii) TOWN SHOES and STERLING SHOES are chain shoe stores with locations in various cities across Canada. Both chains carry shoes sold in association with the name JESSICA SIMPSON. JESSICA SIMPSON shoes are also available through ARNOLD CHURGIN stores as well as through the opponent’s stores.
- (iii) The website Clothes and Things offers women’s clothing bearing the brand name “Jessica” for sale and for shipment into Canada.
- (iv) Jessica Scott Ltd. sells maternity clothing, via its website and through a retail outlet in Vernon, British Columbia, in association with the name JESSICA SCOTT.
- (v) The 144 Collection website offers a line of “Jessica” handbags for sale and for shipment into Canada.
- (vi) JESSICA JENSON handbags are available for purchase in retail stores in Alberta, British Columbia, Ontario and Quebec.

(vii) The QVC website offers “Jessica Holbrook” women’s clothing for sale and for shipment into Canada.

(viii) The YELLOW PAGES online telephone directory, which lists retail stores in the Greater Toronto area, includes JESSICA SEASON WEAR. The store is in actual operation in Kensington Market offering clothing, including women’s clothing, for sale.

[13] I have not had regard to paragraphs 19 and 20 of Ms. Nicholas’ affidavit which I consider to be inadmissible hearsay.

MAIN ISSUE & MATERIAL DATES

[14] As mentioned earlier, the main issue in this proceeding is whether the applied for mark JS BY JESSICA is confusing with the opponent’s mark JESSICA. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Trade-marks Act*, shown below, between the applied for mark and the opponent’s mark:

The 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[15] Thus, s.6(2) does not concern confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant’s wares sold under the mark JS BY JESSICA as products emanating from or sponsored by or approved by the opponent.

[16] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability; (ii) the date of filing of the application with respect to the ground of opposition alleging non-entitlement, in this case June 14, 2006; and (iii) the date of filing the statement of opposition, in this case January 31, 2008, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American*

Retired Persons v. Canadian Retired Persons (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

[17] With respect to the ground of opposition alleging non-entitlement, pursuant to s.16(3)(a), it should be noted that s.17(1) of the *Trade-marks Act*, shown below, requires an opponent who is relying on the previous use of a confusing trade-mark to be the owner of the confusing mark and not to have abandoned it at the date of advertisement (in the *Trade-marks Journal*) of the applicant's application:

No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

[18] In the instant case, the opponent effectively abandoned its JESSICA marks by assigning them to a subsidiary on February 3, 2008, that is, after the date of advertisement on September 5, 2007. The opponent may therefore rely on its use of the mark JESSICA to support the ground of opposition pursuant to s.16(3)(a). The grounds of opposition alleging non-registrability and non-distinctiveness do not prohibit an opponent from relying on marks which it does not own or has not used.

TEST FOR CONFUSION

[19] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not

necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trademarks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Section 6(5) Factors

[20] The opponent's mark JESSICA is an inherently weak mark as it has first name significance. Similarly, the applied for mark JS BY JESSICA does not possess a high degree of inherent distinctiveness as the main components of the mark are the letters JS and the name JESSICA. It is a relatively weak mark. From a fair reading of the opponent's evidence, and a review of the exhibit material, I am able to conclude that the opponent's mark JESSICA had acquired a significant reputation, at all material times, in association with women's clothing and to a lesser degree a reputation in association with fashion accessory items such as shoes, handbags and eyewear. The applied for mark JS BY JESSICA is based on proposed use in Canada and there is no evidence to indicate that the mark had acquired any reputation in Canada at any material time. The first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, therefore favours the opponent, at least in regard to clothing and fashion accessory items.

[21] The second factor in s.6(5), which is the length of time that the marks in issue have been in use, also favours the opponent. In this regard, the opponent began to use its mark JESSICA in 1988, that is, about 28 years before the date of filing of the subject applicant for JS BY JESSICA.

[22] The nature of the parties' wares overlap with respect to items of clothing and fashion accessory items. With respect to the parties' channels of trade, the opponent's evidence indicates that it sells its JESSICA brand of wares solely through its own retail outlets. The applicant, in its written argument, submits that if the opponent were concerned about the issue of confusion, then the opponent could choose not to carry any products sold in association with the applied for mark JS BY JESSICA. However, the opponent is not obliged to restrict its channels of trade solely to its own stores. Therefore,

in the absence of evidence from the applicant pertaining to how the applicant intends to market its wares, I assume that there is potential for overlap in the parties' channels of trade. Accordingly, the third and fourth factors favour the opponent, at least in regard to clothing and fashion accessory items.

[23] There is necessarily a fairly high degree of resemblance visually, in sounding and in ideas suggested between the opponent's mark JESSICA and the applicant's mark JS BY JESSICA as the applicant has incorporated the whole of the opponent's mark. The first component of the applied for mark, that is, the letters JS, do to some extent act to lessen the resemblance between the parties' marks as the first component of a mark is often considered more important for the purpose of distinction: see, for example, *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD). However, as the component JS is the less dominant component of the applied for mark and is fairly non-distinctive, its effect in distinguishing between the parties' marks is diminished. Accordingly, I find that the last factor in s.6(5) favours the opponent.

[24] The applicant at paragraph 25 of its written argument submits that the range of protection to be given to the opponent's mark JESSICA should be limited because the opponent has "reached inside the common trade vocabulary" for its mark. However, in my view, the applicant's evidence of examples of third party use of marks incorporating the component JESSICA is insufficient to establish that the component JESSICA is commonly used in the clothing and clothing accessories industries. Nevertheless, I agree that the applicant's evidence of third party use does to some extent limit the range of protection to be accorded to the opponent's mark JESSICA. I am also aware of the principle in trade-marks law that small differences in "weak marks" may suffice to avoid confusion: see *GSW Ltd. v. Great West Steel Industries* (1975), 22 CPR(2d) 154 at 163-164 and at 169 (FCTD). This principle also acts to limit the range of protection to be accorded to the opponent's mark JESSICA.

DISPOSITION

[25] Considering all of the above, and considering in particular the fairly close resemblance between the marks in issue and the acquired distinctiveness of the opponent's mark, I find that the applicant has not, at any material time, met the onus on it

to show that on a balance of probabilities there is no reasonable likelihood of confusion between the applied for mark JS BY JESSICA and the opponent's mark JESSICA, at least for use in association with clothing and fashion accessories. Accordingly,

(1) the application is refused in respect of the wares shown struck out below:
blank audio and video cassettes; audio and video discs featuring music and movies; audio and video tapes featuring music and movies; alkaline batteries; magnetically encoded cash cards; CD players; CD ROM computer game discs; cellular telephone covers; cellular telephone face covers; computer carrying cases; computer keyboard wrist rests; cordless telephones; credit cards; debit cards; decorative magnets; digital audio tape recorders and players; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; electronic diaries; fitted cases for storage and transportation, namely, cases for compact discs, audio cassettes, video cassettes, CD-ROMs, home video games, home video game accessories, computers, computer accessories, cameras, camcorders and portable phones; game equipment sold as a unit for playing a parlor-type computer game; hand-held calculators; hand-held karaoke players; magnetically encoded key cards; motion picture films about comedy, drama, action, adventure and/or animation; mouse pads; novelty magnets; opera glasses; pre-paid telephone calling cards, magnetically encoded; prerecorded vinyl records featuring music; radios; refrigerator magnets; stereo headphones; radio pagers; interactive video and computer game programs; video cassette recorders; video game cartridges and cassettes; wrist rests and supports for computer mouse users; wrist rests for computers; alarm clocks; ashtrays of precious metal; ~~badges of precious metal; belt buckles of precious metal;~~ bolo ties with precious metal tips; book markers of precious metal; bottle caps of precious metal; ~~brooches;~~ busts, figures, figurines, sculpture, statues, statuettes and stirring rods of precious metal; candlesticks, candle holders, candle rings and candle holders of precious metal; charms; cigarette holders and lighters of precious metal; clocks; clocks incorporating radios; coffee services, tea services and toothpick holders of precious metal; cruet stands for oil or vinegar of precious metal; cruets of precious metal; cuff-links; ~~ear clips;~~ flower bowls of precious metal; ~~hat ornaments and hat pins of precious metal;~~ ~~ornaments of precious metal;~~ ~~jewelry boxes and cases of precious metal;~~ lapel pins; letter openers of precious metal; match boxes and holders of precious metal; non-

electric candelabras made of precious metal; ~~ornamental lapel pins; ornamental pins;~~
~~pendants~~; piggy banks made of precious metal; potpourri dishes made in whole or in part
of precious metal; precious metal money clips; ~~shoe ornaments made of precious metal;~~
snuff boxes and serviette rings of precious metal; tie pins and clips; vases of precious
metal; wall clocks; ~~watch cases; watch chains and fobs; watch straps and bands;~~ activity
books for children; address books; adhesive backed note paper; adhesives for stationery
or household use; appliqués in the form of decals; appointment books; art paper; arts and
craft paint kits; autograph books; baby books; ball point pens; loose-leaf binders; book
covers; book markers; bookends; bookmarks; books in the field of music and
entertainment; paper bows for gift paper; bumper stickers; calendars; pre-paid telephone
calling cards, not magnetically encoded; cartoon prints; cartoon strips; chalk; colored
pencils; coloring books; comic books; comic strip books; comic strips; construction
paper; copybooks; crayons; decals; decorative paper centerpieces; decorative paper
holders; diaries; drawing rulers; drawing sets comprised of finger paints; envelopes;
rubber erasers; fan magazines in the field of music and entertainment; film cels in the
nature of music and entertainment; folders; framed and unframed photographs; gift cards;
gift wrap paper; gift wrapping paper; greeting cards; iron-on transfer; lithographs; printed
song lyric sheets; magazines featuring music and entertainment; memo pads; modeling
clay; mounted and unmounted photographs; music sheets; newspaper cartoons;
newspapers featuring stories, games and activities; non-calibrated drawing rulers; non-
gauged rulers; notebooks; notepads; paint books; paper bags for parties; paper cake
decorations; paper coasters; paper decorations for cakes; paper gift wrap bows; paper
mats; paper napkins; paper party bags; paper party decorations; paper party hats; paper
place mats; paper table cloths; paper weights; pastes for stationery or household
purposes; pen and pencil boxes; pen and pencil cases; pencil sharpeners; pencils; pens;
periodicals in the field of music and entertainment; photographs; photograph albums;
picture books; postcards; poster paints; posters; rubber stamps; drawing boards; staplers;
stencils; stickers; temporary tattoos; trading cards; and writing paper; ~~all-purpose athletic~~
~~bags; all-purpose sports bags; athletic bags; attaché cases; baby backpacks; backpacks;~~
~~beach bags; beach umbrellas; belt pouches; billfolds; book bags; briefcases; briefcase-~~
~~type portfolios; business cases; business card cases; calling and credit card cases;~~

camping bags; canes; change purses; coin purses; cosmetic cases sold empty; diaper bags; duffel bags; fanny packs; garment bags for travels; gym bags; handbags; key cases; knapsacks; leather key chains; luggage; luggage tags; men's clutches; multi-use sports bags; parasols; purses; saddle bags; satchels; school bags; textile shopping bags; sports bags; suitcases; toiletry bags sold empty; tool bags sold empty; tote bags; travel bags; trunks; umbrellas; waist packs; and wallets; anoraks; aprons; ascots; baby bibs not of paper; bandanas; bathing suits; beachwear; beanies; waist belts; berets; boxer shorts; capes; caps with visors; cardigans; chemises; chemisettes; cloth bibs for babies; cloth diapers; cloth ski bibs; corsets; coveralls; crop tops; culottes; denim jeans; ear muffs; fleece tops; flip-flops; galoshes; garters and garter belts; girdles; gloves, namely dress gloves and winter gloves; gowns; Halloween costumes; halter tops; headbands; infant wear; jeans; jerseys; jogging suits; jumpers; knee highs; leg warmers; leggings; leotards; loungewear; mittens; neckerchiefs; neckties; negligees; night gowns; night shirts; overalls; pajamas; panties; pants; pantyhose; parkas; polo shirts; ponchos; robes; sandals; sarongs; shorts; singlets; ski wear; sleepers; sleepwear; sneakers; snow suits; socks; sports bras; stockings; surf wear; suspenders; sweat bands; sweat pants; sweat shirts; sweat shorts; swim and bathing trunks; swim caps; swimwear; tank tops; tennis wear; tights; clothing, namely tops; track suits; T-shirts; turtlenecks; under-shirts; underclothes; underwear; school uniforms; unitards; visors; warm-up suits; shawls; wrist bands.

(2) Otherwise, the opposition is rejected.

[26] Authority for a divided decision is found in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD). This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

