

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

Citation: 2014 TMOB 91
Date of Decision: 2014-04-30

**IN THE MATTER OF AN OPPOSITION
by Target Brands, Inc. to application
No. 1,476,736 for the trade-mark
NEILPRYDE & Design in the name of
Neil Pryde Limited**

[1] Target Brands, Inc. (the Opponent) opposes registration of the trade-mark NEILPRYDE & Design (shown below) (the Mark) that is the subject of application No. 1,476,736 by Neil Pryde Limited (the Applicant):



[2] Filed on April 13, 2010, the application is based on proposed use of the Mark in Canada with the following wares, as amended on December 30, 2013:

Bicycles and parts thereof; land, air and water vehicles, namely, cars motorcycles, airplanes, ships, sailboats, yachts, boats and parts of the aforesaid goods; sailboats; booms for sailboats, ship's masts and boat masts, as well as parts for these goods, mast feet and mast foot protectors, safety shackles and pointers for water vehicles, namely, ships, sailboats, yachts, boats; tires; apparatus for locomotion by water, namely, yachts, sailboats and parts for the aforesaid goods; windsurfing boards; sailboard hulls; sails, masts, booms, harnesses, namely, safety harnesses, climbers' harnesses, bags namely, sport bags, gear bags, board bags, mast bags, equipment bags, sail bags, quiver bags, tote bags, duffle bags, travel bags, accessories clothing namely, car seat cover, roof rack pad and boards, namely, surf board, skate boards, snow boards.

[3] The Opponent alleges that: (i) the application does not conform to sections 30(a), 30(b), 30(e), and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(b) of the Act; and (iv) the Mark is not distinctive under section 2 of the Act. Aside from the section 30 grounds of opposition, the remaining grounds turn on the issue of confusion with the Opponent's trade-marks, but only with respect to the wares listed below (the Opposed Wares):

Bicycles and parts thereof; bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags, accessories clothing namely, car seat cover, roof rack pad.

[4] For the reasons that follow, the application ought to be refused, but only with respect to the Opposed Wares described as "bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags".

The Record

[5] The Opponent filed its statement of opposition on November 8, 2011. The Applicant filed and served its counter statement denying all of the grounds of opposition alleged in the statement of opposition on January 20, 2012. The Opponent was granted leave to file an amended statement of opposition on February 28, 2013.

[6] In support of its opposition, the Opponent filed certified copies of its alleged applications and registrations set out in Schedule "A" to this decision. The Applicant did not file any evidence.

[7] Only the Opponent filed written argument; an oral hearing was held where both parties were represented.

The Parties' Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

[9] The grounds of opposition raised under sections 30(b), 30(e) and 30(i) of the Act are summarily dismissed for the reasons that follow.

[10] In its statement of opposition, the Opponent alleges the application does not conform to section 30(b) of the Act because it cannot be based upon proposed use of the Mark given that the Applicant had already used the Mark in Canada as of the filing date. In the alternative, the Opponent alleges that the application does not conform to section 30(e) of the Act because the statement that the Applicant by itself or through a licensee intends to use the Mark in Canada is false. Since the Opponent has not provided or referred to any evidence, nor has it made any submissions in support of its sections 30(b) and 30(e) grounds of opposition, they are dismissed for the Opponent's failure to meet its evidential burden.

[11] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[12] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is 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)]. For the reasons that follow, I reject this ground of opposition and decide this issue in favour of the Applicant.

[13] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that registration Nos. TMA815,386, TMA817,876, TMA817,877, TMA817,878, TMA817,880 and TMA818,808 remain valid and therefore the Opponent has satisfied its evidential burden.

[14] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trade-marks.

The test for confusion

[15] 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.

[16] 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 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[17] In my opinion, comparing the Mark with the marks Bullseye Design I (TMA817,876), Bullseye Design II (TMA817,877), and TARGET & Design (TMA817,878), shown below, will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and Bullseye Design I, Bullseye Design II, or TARGET & Design, then it would not be likely between the Mark and any of the other registered marks alleged by the Opponent (registration Nos. TMA815,386, TMA817,880, and TMA818,808).



(Bullseye Design I)

TMA817,876



(Bullseye Design II)

TMA817,877



(TARGET & Design)

TMA817,878

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[18] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[19] Both parties' marks possess some inherent distinctiveness as they are neither descriptive nor suggestive of their respective wares and services although I do not consider either party's design to be particularly original, unique or inventive. In this regard, both concentric circles designs appear to be rather ordinary. In the case of TARGET & Design, the term TARGET, a common dictionary word of the English language that neither describes or suggests the Opponent's wares or services, increases slightly the inherent distinctiveness of the Opponent's composite mark. In comparison, by virtue of the inclusion of the term NEILPRYDE, a coined word with no apparent meaning, it renders the Mark more distinctive than the Opponent's marks [see *General Motors Corp v Bellows* (1949) 10 CPR 101 (SCC) p. 691].

[20] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. However, neither party provided any evidence of promotion or use of their marks in Canada.

[21] Accordingly, the section 6(5)(a) factor favours the Applicant.

Section 6(5)(b) – the length of time the trade-marks have been in use

[22] As noted above, the Opponent did not file any evidence of use of its marks in Canada. Since the registrations relied upon by the Opponent in the present proceeding are based solely on use and registration of the marks in the United States, I am not prepared to infer any use of the marks in association with the registered wares and services in Canada.

[23] The application for the Mark is based upon proposed use in Canada and there is no evidence that the Mark has been used to date in association with the Opposed Wares.

[24] Accordingly, the section 6(5)(b) factor does not favour either party.

Sections 6(5)(c) and (d) – the nature of the wares, services, trade and business

[25] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of wares and services in the Opponent’s registration Nos. TMA817,876, TMA817,877 and TMA817,878, as well as the statement of wares as defined in the application for the Mark, that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[26] Bullseye Design I is registered with a large variety of items for the home, kitchen, and bathroom, including “fitted fabric furniture cover”, “unfitted fabric chair covers”, “chair pads”, “fitted toilet lid covers” and “fitted toilet seat covers”. In comparison, the Opposed Wares consist of “bicycles and parts thereof”, “bags namely, sport bags, gear bags, [...], equipment bags, [...], tote bags, duffle bags, travel bags” and “accessories clothing namely, car seat cover, roof rack pad”. I find little similarity or connection between the two parties’ wares.

[27] No evidence was filed as to the nature of the trade engaged in by either the Opponent or the Applicant. However, neither the Opponent's registration nor the subject application contains any restriction on the channels of trade. For the purposes of assessing confusion and in the absence of any evidence to the contrary, given the differences in the nature of the parties' wares, I find it reasonable to presume that the parties' channels of trade would also be different.

[28] Accordingly, in the case of Bullseye Design I, both factors favour the Applicant.

[29] Bullseye Design II is registered with several retail services including "retail department store [...] services". I find little similarity between the Opposed Wares and retail department store services which, by definition, carry a wide variety of merchandise from various sources. No evidence was filed as to the nature of the trade engaged in by either the Opponent or the Applicant. Nevertheless, bearing in mind that retail department store services are broad enough to cover the sale of different categories of wares, including all of the Applicant's Opposed Wares, I conclude that there is potential for overlap between the parties' channels of trade in this regard.

[30] Accordingly, in the case of Bullseye Design II, the section 6(5)(c) factor favours the Applicant whereas the section 6(5)(d) factor favours the Opponent. However, I do not consider the potential for overlap in the parties' channels of trade to be a determining factor in these circumstances as it is in the nature of a retail department store to sell products from a wide variety of sources that are not related to the entity which operates the establishment.

[31] TARGET & Design is registered with a variety of services including "retail department store [...] services", "toys and athletic sporting goods sales services", "tire, battery, oil, antifreeze and automotive accessory sales services", and "bicycle and bicycle accessories sales services". There are clear connections between the parties' wares and services. In this regard, there is a close relationship between Applicant's "bicycles and parts thereof" and the Opponent's "bicycle and bicycle accessories sales services", between the Applicant's "car seat cover" and "roof rack pad" and the Opponent's "[...] automotive accessory sales services", as well as between the Applicant's "sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags" and the Opponent's "[...] athletic sporting goods sales services".

[32] No evidence was filed as to the nature of the trade engaged in by either the Opponent or the Applicant. However, given the close relationship between the Opposed Wares and some of the Opponent's services registered in association with TARGET & Design, and bearing in mind that retail department store services are broad enough to cover the sale of different categories of wares, including all of the Applicant's Opposed Wares, I conclude that there is potential for overlap between the parties' channels of trade.

[33] Accordingly, in the case of TARGET & Design, both factors favour the Opponent. Again, I do not consider the potential for overlap in the parties' channels of trade with respect to retail department stores services to be a determining factor in these circumstances given the nature of the establishment. Nevertheless, there is clear overlap between the channels of trade for the Opposed Wares and some of the Opponent's other registered services.

[34] As I understand the Applicant's submissions, during the oral hearing, the Applicant relied on paragraph 35 of the decision *Volvo Trade-mark Holding AB v Hebei Aulion Heavy Industries Co* 2012 TMOB 46 to support its position that the expensive nature of its wares and the specialised nature of its trade would minimize the risk of confusion. Having reviewed the cited case, I note that the paragraph merely provides a summary of the applicant's argument and that ultimately, the Registrar came to the conclusion that the sections 6(5)(c) and 6(5)(d) factors favoured the opponent, thus finding similarities and potential for overlap between the parties' wares, services, and the nature of their trades, despite the applicant's submissions. In any event, there is no evidence in the present case that the Opposed Wares are expensive in nature or that the Applicant is engaged in a specialised trade.

[35] Moreover, the Applicant relied on *American Pacific Industries Inc v Chrysler LLC* (2013) 114 CPR (4th) 212 (TMOB) to support its position that there is no potential for overlap between the parties' channels of trade in the present case. Apart from the fact that each case must be decided based upon its own merit, the *American Pacific* decision is clearly distinguishable from the present proceeding. In particular, the cited case dealt with expert evidence regarding the nature of the parties' trades in the fields of motor vehicles and tires whereas the current case has no evidence of either party's actual or proposed channels of trade. Consequently, I am unable to draw any parallel

between the nature of the parties' wares, services, and trades, of the present case and those of the cited case.

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

[36] When considering the degree of resemblance, 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 trade-marks. While the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA) at 263]. Even though the first word of a trade-mark may be the most important for purposes of distinctiveness in some cases, the preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[37] During the oral hearing, the Opponent submitted that the term "NEILPRYDE" of the Applicant's Mark would be perceived as a "submark" to the Opponent's Bullseye design marks. In the case of Bullseye Design I and Bullseye Design II, I agree that there is a fair degree of resemblance in appearance considering that the whole of the Opponent's design marks have been adopted as the first portion of the Applicant's Mark. Even though neither of the Opponent's concentric circles designs is particularly striking or unique, it is the sole feature of each of the design marks that serves to distinguish the Opponent from other sources of wares and services. Nevertheless, I am mindful that the Mark also includes a word component NEILPRYDE that is rather unique and distinctive. In terms of sound, the parties' marks clearly differ by virtue of the fact that the Opponent's design marks cannot be sounded whereas the Mark would be sounded as "NEILPRYDE". As for ideas suggested, I am of the view that the Opponent's concentric circles designs would simply be seen as geometric figures. Likewise, when the Mark is viewed as a whole, neither the geometric figure nor the term "NEILPRYDE" would evoke a particular idea.

[38] In the case of TARGET & Design, even though the first portions of the parties' marks are nearly identical, the geometric designs in question are not particularly striking or unique as mentioned earlier. Moreover, there are clear differences between the word components as "NEILPRYDE" is rather unique and distinctive. In terms of sound, the parties' marks clearly

differ considering that TARGET & Design would be sounded as “TARGET” and the Mark would be sounded as “NEILPRYDE”. As for ideas suggested, TARGET & Design evokes the idea of a target by virtue of its written component “TARGET”, which according to *The Canadian Oxford Dictionary*, could be defined as “a mark or point fired or aimed at, esp. a round or rectangular object marked with concentric circles”. In that case, the idea of a target is reinforced by the concentric circles design, which could be seen as a simplified version of a target in these circumstances. In comparison, neither the design component nor the written component of the Mark evokes a particular idea.

[39] When the parties’ composite marks are viewed in their entirety, the word portion has a determinative influence on the overall impression of each composite mark despite being the second component. Given the size of the word element in relation to the design element in each case, and bearing in mind that the sound and the idea suggested by each mark are heavily influenced by its written component, I am of the view that the word portion is at least as important as the design portion in each composite mark, if not more. Consequently, I do not find TARGET & Design and the Mark to have a high degree of resemblance as there are sufficient differences visually, phonetically and in ideas suggested to outweigh any similarities in appearance.

Conclusion in the likelihood of confusion

[40] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances of this case, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between Bullseye Design I, Bullseye Design II, TARGET & Design and the Mark in association with the Opposed Wares.

[41] With respect to the Opponent’s mark Bullseye Design I registered in association with a variety of items for home, kitchen and bathroom, despite some similarities in the appearance of the parties’ marks, in view of the higher inherent distinctiveness of the Mark, the differences in the nature of the parties’ wares as well as their channels of trade, I am satisfied that the Applicant has discharged its legal onus of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between Bullseye Design I of registration No. TMA817,876 and the Mark with respect to the Opposed Wares.

[42] With respect to the Opponent's mark Bullseye Design II registered in association with various services including retail department store services, I find that the higher inherent distinctiveness of the Mark combined with the differences in the nature of the parties' wares and services are sufficient to outweigh any similarities in the appearance of the marks and any potential for overlap between the parties' channels of trade. As mentioned above, given the nature of a retail department store, I find it reasonable to conclude, in the absence of evidence to the contrary, that the average consumer would not think that the wares sold in a retail department store emanate from or are sponsored by or approved by the same entity that operates the establishment. Consequently, I am satisfied that the Applicant has discharged its legal onus of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between Bullseye Design II of registration No. TMA817,877 and the Mark with respect to the Opposed Wares.

[43] With respect to the Opponent's mark TARGET & Design, even though there is a close relationship between the parties' wares and services and a potential for overlap between the parties' channels of trade, I am of the view that the differences in the appearance, sound and ideas suggested of the parties' marks and the higher inherent distinctiveness of the Mark are significant enough to shift the balance of probabilities in favour of the Applicant. In this regard, confusion will be unlikely in situations where marks share common features but also dominant differences [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)]. I therefore conclude that the Applicant has discharged its legal onus of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between TARGET & Design of registration No. TMA817,878 and the Mark with respect to the Opposed Wares.

[44] During the oral hearing, the Opponent submitted that the present case is similar to that of *MicroAge Computer Stores, Inc v North American Microtech Inc* (1988), 19 CPR (3d) 289 (TMOB) where the mark THE SOLUTION P.C. for computers and computer peripheral hardware was found to be confusing with the mark THE SOLUTION STORE for services such as retail store in the field of small computers and accessories. I disagree. The present case is distinguishable from the cited case in that the present case deals with marks which are comprised of distinctive elements that differ from one another, with no resemblance in sound or ideas suggested, whereas *MicroAge* dealt with marks bearing the same distinctive features, with strong similarities in sound and ideas suggested. Moreover, the Opponent in the present proceeding did not provide any evidence of

promotion or use of its marks whereas the opponent in the cited case established that its mark has been used in Canada and had become known for its computer retail store services. None of the surrounding circumstances in the *MicroAge* case exists in the present case.

[45] I would add that if the circumstances of the case were different, that is, if the Opponent had established a significant degree of acquired distinctiveness and use of its marks in Canada, then the confusion analysis might well have resulted in a broader ambit of protection for Bullseye Design I, Bullseye Design II, and TARGET & Design trade-marks.

[46] Accordingly, the non-registrability ground of opposition is rejected.

Was the Applicant the Person Entitled to Registration of the Mark?

[47] The material date for considering this ground of opposition is the filing date of the application for the Mark, namely April 13, 2010. For the reasons that follow, I accept the ground of opposition and decide this issue in favour of the Opponent, but only with respect to the Opposed Wares described as “bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags”.

[48] In order to meet its initial evidential burden under section 16(3)(b) of the Act, the Opponent must show that its applications were filed prior to the filing date of the Applicant’s application, and that its applications were still pending at the advertisement date of the Mark, namely, June 8, 2011 [see section 16(4) of the Act]. Having verified the certified copies submitted by the Opponent, I confirm that application Nos. 1,433,996 and 1,450,026 contain, respectively, a priority filing date and a filing date, prior to the Applicant’s application, and that both were pending as of the date of advertisement of the Mark. The Opponent has therefore met its initial burden with respect to its section 16(3)(b) ground.

[49] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent’s applied for trade-marks.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[50] Since the Opponent's Bullseye Design of application Nos. 1,433,996 and 1,450,026 is identical to that of registration No. TMA817,876, I refer to my previous analysis on the inherent distinctiveness of the parties' marks under the non-registrability ground of opposition.

[51] Once again, there is no evidence of acquired distinctiveness as neither party provided any evidence of promotion or use of their marks in Canada, as of April 10, 2013.

[52] In view of the above, the section 6(5)(a) factor favours the Applicant.

Section 6(5)(b) – the length of time the trade-marks have been in use



[53] The Opponent's application No. 1,433,996 is based upon proposed use of the mark in Canada whereas application No. 1,450,026 is based upon use and registration in the United States as well as proposed use of the mark in Canada. The Opponent did not file any evidence of use of its marks in Canada as of April 10, 2013.

[54] The application for the Mark is based upon proposed use in Canada and there is no evidence that the Mark has been used in association with the Opposed Wares.

[55] Accordingly, the section 6(5)(b) factor does not favour either party.

Sections 6(5)(c) and (d) – the nature of the wares, services, trade and business

[56] The Opponent's Bullseye Design of application Nos. 1,433,996 and 1,450,026 are applied for use in association with a wide variety of wares and services, including:

Trade-mark	Application No.	Applied for Wares and Services
	1,433,996	<ul style="list-style-type: none"> • Carry-all bags; tote bags • All purpose sport bags; all-purpose athletic bags; all-purpose carrying bags; back packs; beach bags; duffel bags; gym bags; luggage; overnight bags; overnight cases; shoulder bags; travel bags; travel cases; traveling bags • [...]
	1,450,026	<ul style="list-style-type: none"> • Men’s, women’s and children’s apparel; swimsuits; headwear; footwear • Costumes for use in dress up; toys; party favors • Telephone calling cards; clocks • Balls for games; collectible toy figures; stuffed and plush toys; toy vehicles • Extended warranties services • Stored value prepaid card services • Photography services • Facilities for festivals and entertainment events; stadium facilities for the presentation of events • [...]

[57] As mentioned earlier, the Applicant’s Opposed Wares include bicycles, a variety of bags, and car accessories.

[58] There is clear overlap between the Applicant’s “sport bags, gear bags, equipment bags, tote bags, duffel bags, travel bags” and the Opponent’s “tote bags; all purpose sport bags; all-purpose athletic bags; all-purpose carrying bags; back packs; beach bags; duffel bags; gym bags; travel bags” of application No. 1,433,996. However, I find little similarity or connection between the remaining Opposed Wares and the wares and services associated with either Bullseye Design.

[59] No evidence was filed as to the nature of the trade engaged in by either the Applicant or the Opponent. For the purposes of assessing confusion, given the clear overlap between some of the parties’ wares, I conclude that there is potential for overlap in the channels of trade between the

Opponent's Bullseye Design of application No. 1,433,996 and the Mark, with respect to "sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags". In terms of the remaining Opposed Wares, in the absence of any evidence to the contrary, given the differences in the nature of the parties' wares, I find it reasonable to conclude that the parties' channels of trade would also be different. Likewise, I see no potential for overlap between the Opposed Wares and the Opponent's applied for services.

[60] In light of the similarity between some of the parties' wares, the sections 6(5)(c) and 6(5)(d) factors clearly favour the Opponent, but only with respect to the "sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags". As the remaining Opposed Wares share no similarity with the Opponent's wares and services, the sections 6(5)(c) and 6(5)(d) factors favour the Applicant.

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

[61] Since the Opponent's Bullseye Design of applications Nos. 1,433,996 and 1,450,026 is identical to that of registration No. TMA817,876, I refer to my previous analysis on the degree of resemblance between the parties' marks under the non-registrability ground of opposition.

[62] In the end, when the trade-marks are viewed in their totality, I find that there is a fair degree of resemblance in appearance between the Bullseye Design marks and the Mark considering that the Mark appropriates the Opponent's design marks in their entirety as its first portion. Nevertheless, I am mindful that the Mark also includes a word component NEILPRYDE that is rather unique and distinctive.

Conclusion in the likelihood of confusion

[63] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the relevant factors, in particular, similarities in the appearance of the parties' marks combined with clear overlap between some of the parties' wares and potential for overlap between their channels of trade, I am not satisfied that, despite the higher inherent distinctiveness of the Mark, the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Bullseye

Design of application No. 1,433,996, and the Mark, with respect to “bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags” as of the filing date of the application.

[64] However, similarities in the appearance of the parties’ marks remain insufficient to outweigh the higher inherent distinctiveness of the Mark, the differences in the nature of the parties’ remaining wares and their channels of trade. I am therefore satisfied that the Applicant has discharged its legal onus of establishing, on a balance of probabilities, that there was no reasonable likelihood of confusion between Bullseye Design of application Nos. 1,433,996 and 1,450,026, and the Mark, in association with the Opposed Wares described as “bicycles and parts thereof” and “accessories clothing namely, car seat cover, and roof rack pad” as of the filing date of the application.

[65] As noted above, if the circumstances of the case were different, that is, if the Opponent had established a significant degree of acquired distinctiveness of its marks in Canada as of the material date, then the confusion analysis might well have resulted in a broader ambit of protection for Bullseye Design trade-marks.

[66] Accordingly, the section 16(3)(b) ground of opposition is successful to the extent that it is based on application No. 1,433,996, but only with respect to “bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags”.

Was the Mark Distinctive of the Applicant’s Opposed Wares?

[67] The Opponent has pleaded that the Mark is not distinctive under section 2 of the Act as it does not actually distinguish, nor is it adapted to distinguish, the Opposed Wares of the Applicant from the wares and/or services of others, (i) in view of the likelihood of confusion between the Mark and the Opponent alleged trade-marks, and (ii) in that the Applicant does not control sufficiently the character or quality of the Opposed Wares.

[68] In order to meet its initial burden with respect to the first prong of the non-distinctiveness ground of opposition, the Opponent was required to show that its alleged trade-marks had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Applicant’s Mark [see *Metro-Goldwyn-Mayer* (2004), 34 CPR

(4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. As the Opponent failed to file any evidence in this regard, it has failed to discharge its evidentiary burden.

[69] With respect to the second prong of the non-distinctiveness ground of opposition, given that the Opponent has not furnished any evidence or made any submissions in this regard, it has also failed to meet its initial evidential burden. Accordingly, the non-distinctiveness ground of opposition is dismissed.

Does the Application Contain a Statement in Ordinary Commercial Terms of Specific Wares?

[70] In its written argument, the Opponent submits that the Opposed Wares described as “accessories clothing namely, car seat cover, roof rack pad” are improper since the description “accessories clothing” is not coherent, ordinary or specific. It further states that “car seat cover” and “roof rack pad” do not fall under any general class of clothing wares.

[71] Conversely, the Applicant submitted during the oral hearing that the Opponent has not met its initial burden and that in any case, there is no ambiguity in the wares described “accessories clothing namely, car seat cover, roof rack pad” which are specific and in ordinary commercial terms. In this regard, the Applicant states that the description “accessories clothing” is the English equivalent of the term “revêtement pour accessoires” in French.

[72] Neither party filed any evidence with respect to this ground of opposition.

[73] The Opponent’s initial burden under section 30(a) is a light one. In fact, the Opponent may only need to present sufficient argument in order to meet its initial burden [see *McDonald’s Corporation and McDonald’s Restaurants of Canada Ltd v MA Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)]. In the present case, since the Opponent has satisfied its initial burden, the issue becomes whether the Applicant has satisfied its onus of proving that the application is in compliance with section 30(a) of the Act.

[74] There are two issues to be determined under a section 30(a) ground of opposition, whether the statement of wares is in ordinary commercial terms and whether it adequately identifies the specific wares and services [*Whirlpool SA v Eurotherm Holdings Ltd* 2010 CarswellNat 4282 (TMOB) at para 39].

[75] As I understand the Opponent's submissions, its objection focuses on the description "accessories clothing" rather than the identification of the wares that follow, namely "car seat cover" and "roof rack pad".

[76] I agree with the Opponent that the meaning of the description "accessories clothing" is not readily apparent. Moreover, in the absence of evidence, I am not prepared to accept the Applicant's submission that the term "accessories clothing" is the English equivalent of the term "revêtement pour accessoires" in French. However, when the statement of wares is read in its entirety, and bearing in mind that the description "accessories clothing" merely serves to provide a context to the wares that follow, I am of the view that any ambiguity resulting from the description of the context is resolved and rectified by the acceptable identification of the wares in the remaining statement. Thus, I am satisfied that the wares described "accessories clothing namely, car seat cover, roof rack pad" are specific and in ordinary commercial terms.

[77] Having regard to the foregoing, I dismiss the ground of opposition based upon section 30(a) of the Act.

Disposition

[78] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,476,736 with respect to the Opposed Wares described as "bags namely, sport bags, gear bags, equipment bags, tote bags, duffle bags, travel bags".

[79] However, I reject the opposition under section 38 of the Act for the Opposed Wares described as "bicycles and parts thereof" and "accessories clothing namely, car seat cover, roof rack pad" [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

[80] In other words, the application may proceed to allowance with respect to the following wares:

Bicycles and parts thereof; land, air and water vehicles, namely, cars motorcycles, airplanes, ships, sailboats, yachts, boats and parts of the aforesaid goods; sailboats; booms for sailboats, ship's masts and boat masts, as well as parts for these goods, mast feet and mast foot protectors, safety shackles and pointers for water vehicles, namely, ships, sailboats, yachts, boats; tires; apparatus for locomotion by water, namely, yachts, sailboats and parts for the aforesaid goods; windsurfing boards; sailboard hulls; sails, masts, booms, harnesses, namely, safety harnesses, climbers' harnesses, bags namely, board bags, mast bags, sail bags, quiver bags, accessories clothing namely, car seat cover, roof rack pad and boards, namely, surf board, skate boards, snow boards.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Opponent’s trade-mark:



Application No.:

1,144,789

Registration No.:

TMA815,386

Services:

(1) On-line retail store services featuring a wide variety of consumer goods, namely on-line retail department store services, on-line retail grocery store services, on-line retail bakery services, on-line retail photography services, on-line retail delicatessen services, on-line retail pharmacy services, on-line retail liquor store services.

Opponent's trade-mark:



Application No.:

1,278,717

Registration No.:

TMA817,876

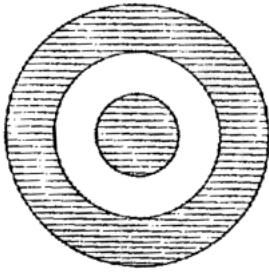
Wares:

1) Potpourri; Candles; Metal shower curtain hooks and rings, decorative metal wall hooks, general purpose metal storage units and bins, metal wall pegs, baskets of common metals; Flatware, kitchen knives and knife sets, non-motorized knife sharpener, hand-pump cooking oil sprayers, scissors, pizza cutters, sharpening stones, zester; Lamps, lamp shades, sconces light fixtures, electric night lights, electric string lights for decorating, electric overhead lighting fixtures, electric fans; Clocks; Framed art pictures and prints, photo albums, bookends, memo boards, picture boards, magnet boards, desk organizers in the nature of in/out boxes, paper shredders, pencil sharpeners, binders, notebooks, letter holders, file and memo sorters, staplers, tape dispensers, pencil cups, drawer organizers, push pins, hanging file folders, dry erase boards, desktop business card holders, pens, pencils, sheet protectors, portfolios, presentation folders, binder pockets, report covers, index dividers, file boxes, coupon holders, envelopes, stationery tape, corkboard tacks, staples, cardboard mailing tubes, stationery note cards, note pads containing adhesive on one side of the sheet for attachment to surfaces, photo album inserts, staple remover, drawing ruler, and letter opener; Non-metal shower curtain hooks and rings, plastic mailing tubes, fitted fabric furniture covers, interior window blinds, decorative non-metal wall hooks; furniture in the nature of headboards for beds, nightstands, dressers, benches, bookcases, television stands, wall shelving, room dividers, vanity tables, armoires, stools, mirrors, desks, hutches, file cabinets, coffee tables, end tables, coat trees, bar cabinets, magazine racks, storage cubes, buffets, wine cabinets, tables, room screens, decorative trunks, chests, entertainment centers, storage towers, chairs, plastic storage bins, closet organizers, clothes hangers, decorative pillows, bed pillows, toss pillows, floor cushions, hassocks, curtain rods, window drapery hardware, namely traverse rods, poles, curtain hooks, curtain rods and finials; bed wedge pillows, shelves, shadow boxes, hampers, plastic storage bins, wall cabinets, storage benches, stepstools, vanity table, cabinets in the nature of floor storage units with or without drawers, decorative door bead curtains, picture frames, backrest pillows, non-metal wall pegs, foot boards for beds, carpet coasters for protecting furniture legs, bed frames, shoe racks, decorative knobs of wood and plastic; napkin rings, shaped ironing board covers, wine racks, wine charms, plastic coasters, dinnerware, napkin holder, bread box, salt and pepper shakers, salt and pepper grinders, sugar bowl, creamer pitcher, garlic press, baking stone, spoon rest, trivets, butler trays, candle sticks not of precious metal, decorative chargers, trays made of wood, metal

or plastic, vases, non-metal baskets for home use, serving platters, beverage ware, canisters for kitchen use, paper towel holders, mixing bowls, cutting boards, turners, grill brushes, tongs of wood or metal, basting brushes, cooking skewers, ironing boards, dispenser for lotion, bath accessories, namely tooth brush and cup holders, decorative knobs of ceramic and glass, shower caddies, towel bars, wastebaskets, soap dishes, towel rings, candle holders not of precious metal, candle plates not of precious metal, incense holders, hanging candle holders not of precious metal, candle stands not of precious metal, non-electric votive chandeliers, non-electric candle wall sconces, multi-candle holders not of precious metal; Bed sheet sets, pillow cases, pillow shams, duvets, quilts, coverlets, bed blankets, bed skirts, mattress pads, feather beds, comforters, fabric tablecloths, fabric table runners, fabric placemats, fabric napkins, kitchen towels, oven mitts, pot holders, unfitted fabric chair covers, chair pads, throw blankets, window curtains, bath sheets, bath towels, washcloths, hand towels, fingertip towels, fitted toilet lid covers, fitted toilet seat covers, shower curtains made of plastic or fabric, shower curtain liners made of plastic, dish towels, cloth coasters; Rugs, bath mats, non-slip tub mats, wallpaper appliqués, door mats.

(2) Metal shower curtain hooks and rings, decorative metal wall hooks, general purpose metal storage units and bins, metal wall pegs, baskets of common metals; kitchen knives and knife sets; lamps, lamp shades, sconces light fixtures, electric night lights, electric string lights for decorating, electric overhead lighting fixtures; framed art pictures and prints; desk organizers in the nature of in/out boxes, file and memo sorters; hanging file folders, desktop business card holders, stationery tape, corkboard tacks, cardboard mailing tubes, stationery note cards, drawing ruler; Non-metal shower curtain hooks and rings, plastic mailing tubes, fitted fabric furniture covers, interior window blinds, decorative non-metal wall hooks; furniture in the nature of headboards for beds, nightstands, dressers, benches, bookcases, television stands, wall shelving, room dividers; plastic storage bins; clothes hangers, curtain rods, window drapery hardware, namely traverse rods, poles, curtain hooks, curtain rods and finials; plastic storage bins; clothes hangers; curtain rods, window drapery hardware, namely traverse rods, poles, curtain hooks, curtain rods and finials; cabinets in the nature of floor storage units with or without drawers, decorative door bead curtains, picture frames, non-metal wall pegs, foot boards for beds, carpet coasters for protecting furniture legs, decorative knobs of wood and plastic; napkin rings, shaped ironing board covers; plastic coasters; sugar bowl, creamer pitcher; candle sticks not of precious metal; non-metal baskets for home use, serving platters, beverage ware, canisters for kitchen use, paper towel holders; cooking skewers; dispenser for lotion, bath accessories, namely tooth brush and cup holders; decorative knobs of ceramic and glass; candle holders not of precious metal, candle plates not of precious metal; , hanging candle holders not of precious metal, candle stands not of precious metal, non-electric votive chandeliers, non-electric candle wall sconces, multi-candle holders not of precious metal; bed sheet sets; bed blankets; unfitted fabric chair covers, window curtains, fitted toilet lid covers, fitted toilet seat covers, shower curtain liners made of plastic, cloth coasters, non-slip tub mats.

Opponent's trade-mark:



Application No.:

1,061,498

Registration No.:

TMA817,877

Services:

(1) Retail department store, retail grocery store, retail bakery, retail pharmacy store and restaurant and snack bar services

Opponent's trade-mark:



Application No.:

1,061,499

Registration No.:

TMA817,878

Services:

(1) Retail department store, retail grocery store, retail bakery, medicine prescription compounding and medicine dispensing, and restaurant and snack bar services.

(2) Photofinishing services.

(3) Retail department store sales services, namely men's, women's, children's and infants' clothing and accessories sales services; jewellery, clocks and watches sales services; health and beauty aids sales services; pharmacy and prescription sales services; optical supplies sales services; cigarettes and tobacco sales services; records and tapes sales services; books and magazines sales services; men's, women's, children's and infants' shoes sales services; furniture and rugs sales services; food and candy sales services; trees, plants and flowers sales services; toys and athletic sporting goods sales services; hobby and crafts supplies and equipment sales services; tire, battery, oil, antifreeze and automotive accessory sales services; guns and ammunition sales services; bedding, linens, curtains and draperies sales services; cameras, calculators and telephone sales services; computer hardware, software and accessories sales services; bicycle and bicycle accessories sales services; automotive maintenance and repair supplies and equipment sales services; pet equipment and supplies sales services; giftshop, housewares and tableware sales services; radio, television and sound equipment sales services; video recorders, videotape and video games sales services; tool and hardware sales services; fishing, boating, camping and hunting equipment sales services; garden, lawn and patio equipment and supplies sales services; stationery, office and school supplies sales services; small electrical appliances sales services; electrical and plumbing maintenance and repair supplies and equipment sales services; bakery goods sales services; pictures, picture frames and mirror sales services; and Christmas trees, ornaments, decorations, lights and accessories sales services.

Opponent's trade-mark:



Application No.:

1,144,791

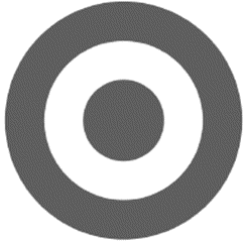
Registration No.:

TMA817,880

Services:

(1) On-line retail store services featuring a wide variety of consumer goods.

Opponent's trade-mark:



Application No.:
1,450,028

Registration No.:
TMA818,808

Services:
(1) Retail department store services.

Opponent's trade-mark:



Application No.:
1,433,996

Registration No.:
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Wares:

- (1) Calculators; Decorative magnets; Laptop carrying cases.
- (2) Ear phones; Headphones.
- (3) Jewelry; Rubber or silicon wristbands in the nature of a bracelet; Watches.
- (4) Carry-all bags; Cosmetic bags sold empty; Credit card cases; Tote bags; Umbrellas
- (5) All purpose sport bags; All-purpose athletic bags; All-purpose carrying bags; Back packs; Beach bags; Briefcases and attaché cases; Business card cases; Card wallets; Clutch bags; Coin purses; Collars for pets; Cosmetic cases sold empty; Duffel bags; Fanny packs; Garment bags for travel; Gym bags; Handbags; Leashes for animals; Luggage; Luggage tags; Overnight bags; Overnight cases; Pet clothing; Purses; Shoulder bags; Toiletry bags sold empty; Toiletry cases sold empty; Travel bags; Travel cases; Traveling bags; Wallets; Wine carrying cases; Wristlet bags

Opponent's trade-mark:



Application No.:

1,450,026

Registration No.:

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Wares:

(1) Non-magnetically encoded prepaid reloadable telephone calling cards.

(2) Men's, women's and children's apparel, namely, pants; shirts, short sleeved shirts, sleeveless shirts, 3/4 length sleeved shirts, long sleeved shirts, sweatshirts; coats; headwear, namely, hats, caps, visors, bandanas, scarves, sweatbands, ear bands, ear muffs, berets; swimsuits; jackets; shoes; athletic shoes, walking shoes, court shoes, evening shoes; shoes, namely, joggers, runners; underwear; and socks;

(3) CD storage towers, CD storage racks, electric irons, electric outlet covers, decorative magnets, switch plate covers; men's, women's, and children's apparel, namely, shorts, overalls, swimwear, leggings, pajamas, robes, sleepwear, bodysuits, loungewear, snow pants, snowsuits, gloves, mittens, skiwear, ties, undergarments, cloth diapers, bras, nightgowns, slippers, camisoles, dresses, skirts, school uniforms; costumes for use in dress up play, dresses, Halloween costumes and masks sold in connection therewith; footwear, namely, casual footwear, boots, sandals, slippers; toys, namely, action figures accessories, baby rattles, baby swings, balloons, bath toys, battery operated action toys, bean bags, bendable toys, bobsleds, canteens, children's multiple activity tables, children's play cosmetics, children's play mat, children's wire construction and art activity toys, construction toys, crib toys, disc toss toys, dolls and accessories therefore, drawing toys, egg decorating kits, electronic action toys, flashlights, flying saucers, infant exercise seats, namely, jumpers and infant saucers, infant toys, inflatable toys, insect collection bags, kaleidoscopes, lanterns, magnetic toys, mechanical action toys, mobiles for children, multiple activity toys, musical toy instruments, musical toys, non-riding transportation toys, party favors in the nature of small toys, piñatas, plastic toy hoops, play houses and accessories, play swimming pools, play tents, pop up toys, pull toys, puppets, push toys, puzzles, sand toys, shadow projectors, soap bubbles, soft sculpture toys, spinning tops, squeeze toys, stacking toys, streamers, talking toys, tossing disc toys, toy armor, toy bake ware, cookware, dishes and cooking and eating utensils, toy automatic teller machines, banks and cash registers, toy bow and arrow, bowling, croquet and golf sets, toy boxes, toy building blocks, toy buildings and accessories therefore, toy detachable numbers and letters, toy doctor sets and cases therefore, toy food and grocery pieces, toy furniture, toy guns, toy microwave, toy modeling dough and putty, toy money, toy robots, toy shopping carts, toy strollers, toy steering wheels, toy telescope and

attachments and accessories therefore, toy tools and tool sets, toy vacuum cleaners, twirling batons, water toys, wind-up toys;

(4) Clocks.

(5) Balls for games, namely, beach balls, playground balls; collectible toy figures, namely, action figures, toy animal figures; stuffed and plush toys; toy vehicles, namely, electronically operated toy motor vehicles, radio controlled toy vehicles, toy model vehicles and train sets, toy scooters and ride on toys, toy vehicles and vessels, toy wagons.

Services:

(1) Providing extended warranties on electronics.

(2) Stored value prepaid card services namely, processing electronic payments made through prepaid cards.

(3) Studio and portrait photography services.

(4) Providing plaza facilities for festivals and entertainment events.

(5) Providing stadium facilities for the presentation of sports, entertainment, cultural and civic events.