



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

**Citation: 2016 TMOB 186  
Date of Decision: 2016-12-07**

**IN THE MATTER OF AN OPPOSITION**

<b>Nikita ehf.</b>	<b>Opponent</b>
<b>and</b>	
<b>Centennial Optical Limited</b>	<b>Applicant</b>
<b>1,604,164 for NIKITA</b>	<b>Application</b>

Introduction

[1] Nikita ehf. (the Opponent) opposes registration of the trade-mark NIKITA (the Mark) that is the subject of application No. 1,604,164 by Centennial Optical Limited (the Applicant).

[2] Filed on November 26, 2012, the application is based upon use of the Mark in Canada since at least as early as June 11, 2011 in association with the following goods:

Eyewear and accessories associated with eyewear namely optical frames, eyeglasses, sunglasses, eyeglass lenses, eyeglass ear and nose pieces, eyeglass chains, eyeglass necklaces, and eyeglass cases.

[3] The determinative issue in this proceeding is whether the Mark is confusing with the Opponent's trade-mark NIKITA of registration No. TMA689,118 for "bags, namely, shoulder bags, hand bags; clothing, namely, shirts, sweaters, sweat hooded parkas, swimwear, belts".

[4] For the reasons that follow, I find that the opposition ought to be rejected.

#### Record

[5] The statement of opposition filed on November 7, 2013 raises seven grounds of opposition under section 38(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition, in order of pleading, are summarized at Schedule “A” to my decision.

[6] The Applicant filed and served its counter statement on January 13, 2014.

[7] As evidence in support of its opposition, the Opponent filed certified copies of its trade-mark registration Nos. TMA689,118 and TMA689,948. These certified copies were issued on January 23, 2014. The Opponent also filed an affidavit of Frank Aeschbacher, sworn April 28, 2014. Mr. Aeschbacher, the Global Commercial Director of the Opponent, was cross-examined. The transcript of the cross-examination, exhibits thereto and the replies to undertakings are of record.

[8] As evidence in support of its application, the Applicant filed three separate affidavits of Elenita Anastacio, sworn respectively on May 26, 2015 (the first affidavit), February 8, 2016 (the second affidavit) and July 5, 2016 (the third affidavit). Ms. Anastacio, a trade-mark searcher employed by the Applicant’s trade-marks agent firm, was not cross-examined.

[9] Neither party filed a written argument.

[10] Both parties were represented at the hearing.

#### Material Dates

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

- sections 38(2)(a)/30 of the Act - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(b)/12(1)(d) of the Act – 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)];

- sections 38(2)(c)/16(1)(a) and 16(1)(c) of the Act – the date of first use claimed in the application [see section 16(1) of the Act]; and
- sections 38(2)(d)/2 of the Act– the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

### Legal Onus and Evidential Burden

[12] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

### Preliminary Remarks

[13] The Applicant’s evidence establishes that registration No. TMA689,948 for the trade-mark NIKITA & Design, shown below, was expunged on October 22, 2014 pursuant to section 45 of the Act [the second Anastacio affidavit].



[14] The Applicant’s evidence also establishes that registration No. TMA689,118 for the trade-mark NIKITA was amended on April 13, 2016 to restrict the statement of goods to “bags,

namely, shoulder bags, hand bags; clothing, namely, shirts, sweaters, sweat hooded parkas, swimwear, belts” pursuant to section 45 of the Act [the second and third Anastacio affidavits].

[15] With respect to the Opponent’s evidence, I note that in considering the affidavit of Mr. Aeschbacher, I disregard any assertions that I consider equivalent to an opinion on the questions of fact and law to be determined by the Registrar in the present proceeding. Furthermore, in discussing the evidence provided by Mr. Aeschbacher, I will refer to his cross-examination inasmuch as it pertains to relevant evidence and the parties’ representations in the present case.

#### Grounds of Opposition Summarily Dismissed

##### Non-conformity to the requirements of section 30 of the Act.

[16] At the hearing, the Opponent conceded that it did not file any evidence in support of the grounds of opposition alleging that the application does not conform to the requirements of sections 30(a), 30(b) and 30(i) of the Act.

[17] Accordingly, I dismiss the three grounds of opposition raised under sections 38(2)(a) and 30 of the Act for the Opponent’s failure to meet its evidential burden.

##### Non-entitlement pursuant to section 16(1)(c) of the Act.

[18] The ground of opposition alleging that the Applicant is not the person entitled to registration pursuant to section 16(1)(c) of the Act is premised on an allegation of confusion with the Opponent’s previously used trade-name NIKITA.

[19] I note that Mr. Aeschbacher throughout his affidavit references the use of trade-mark and trade-name NIKITA altogether. The absence of distinction between use of NIKITA as a trade-mark or trade-name necessarily creates ambiguity in the evidence. It is trite law that any ambiguity in an affidavit should be resolved against the party who files the evidence [see *Conde Nast Publications Inc v Union Des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[20] At the hearing, I specifically asked the Opponent to point out the documentary evidence purportedly establishing trade-name use of NIKITA. In reply, the Opponent noted references to NIKITA on pages of the Opponent's website and catalogue respectively provided as Exhibits FA-1 and FA-2 to the affidavit of Mr. Aeschbacher (I discuss these later on). However, the Opponent said that it will not insist that its evidence shows use of the trade-name NIKITA. In other words, the Opponent seemingly acknowledged that its evidence does not support the section 16(1)(c) ground of opposition.

[21] Absent substantive representations of the Opponent to convince me otherwise, I am not satisfied that the evidence allows me to conclude to use of the Opponent's alleged trade-name NIKITA prior to the date of first use claimed in the application.

[22] Accordingly, I dismiss the ground of opposition raised under sections 38(2)(c) and 16(1)(c) of the Act for the Opponent's failure to meet its evidential burden.

#### Analysis of the Remaining Grounds of Opposition

[23] The issues arising from the remaining grounds of opposition are:

1. Is the Mark registrable as of today?
2. Was the Applicant the person entitled to registration of the Mark in Canada as of June 11, 2011?
3. Was the Mark distinctive of the Applicant's goods as of November 7, 2013?

[24] I will analyze these issues in turn.

#### Is the Mark registrable as of today?

[25] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-mark registration Nos. TMA689,118 for NIKITA and TMA689,948 for NIKITA & Design.

[26] Since registration No. TMA689,948 for the trade-mark NIKITA & Design is expunged as of today, the section 12(1)(d) ground of opposition based upon this registration is dismissed for the Opponent's failure to satisfy its evidential burden.

[27] Having exercised the Registrar's discretion, I confirm that registration No. TMA689,118 for the trade-mark NIKITA is extant for "bags, namely, shoulder bags, hand bags; clothing, namely, shirts, sweaters, sweat hooded parkas, swimwear, belts". Thus, the Opponent has satisfied its evidential burden.

[28] The question becomes whether the Applicant has met its legal onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trade-mark NIKITA of registration No. TMA689,118.

[29] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[30] 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 the trade-marks have been in use; c) the nature of the goods, 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 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

[31] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis

by considering that factor. Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the marks.

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

[32] Since the trade-marks at issue are identical, this factor favours the Opponent.

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

[33] It emerges from the hearing that the parties agree that the trade-marks at issue possess the same degree of inherent distinctiveness in the context of their respective goods. However, the parties disagree as to the actual degree of inherent distinctiveness.

[34] The Opponent submits that the term NIKITA is inherently distinctive. The Applicant submits that NIKITA is a first name and as such the trade-marks have little inherent distinctiveness (citing *Mattel, Inc, supra*, at para 3; *Maurices Inc v Dollarama LP*, 2014 TMOB 129, at para 21). The Opponent responds by noting that the Applicant did not provide evidence establishing that NIKITA is a first name. Absent such evidence, the Opponent submits that an average Canadian consumer would react to NIKITA as nothing but a coined word.

[35] Applying common sense to the assessment of the facts of the present case, I find it is reasonable to conclude that an average Canadian consumer would likely perceive NIKITA as a first name. Accordingly, I agree with the Applicant that the parties' trade-marks possess little inherent distinctiveness.

[36] A trade-mark may acquire distinctiveness by means of it becoming known through promotion or use in Canada. Yet, there is no evidence of use or promotion of the Mark in Canada. Thus, I shall now review the Opponent's evidence concerning the use and promotion of its trade-mark.

[37] According to Mr. Aeschbacher’s testimony, the Opponent is a corporation of Iceland. It carries on business, under the name Nikita Clothing, as a manufacturer and distributor of women’s clothing and accessories [paras 1 and 5 of the affidavit, reply to undertaking Q57].

[38] As mentioned before, Mr. Aeschbacher throughout his affidavit provides evidence by referencing the use of the trade-mark and trade-name NIKITA altogether, which is reflected in my review of the evidence below.

*Use of the Opponent’s trade-mark*

[39] In terms of use, Mr. Aeschbacher states at paragraph 6 of his affidavit:

Since at least as early as 2002, THE OPPONENT has sold in Canada its clothing (mainly dresses, tops [jackets, shirts, tees, hoodies, tops and tanks], bottoms [pants, shorts, denim and skirts], accessories and swimsuits) (all the aforesaid wares being collectively designed as “THE CLOTHING”) under the trade-mark and trade name NIKITA.

[40] As per the above, Mr. Aeschbacher throughout his affidavit introduces the evidence by collective reference to the goods associated with the trade-mark.

[41] I reproduce the table found at paragraph 7 of the affidavit and providing the Opponent’s Canadian annual sales figures for the clothing sold under the trade-mark and trade-name NIKITA for the years 2009 through 2013. Mr. Aeschbacher indicates: “On 2014-03-10, the interbank exchange rate was 1.54 Canadian dollars for one euro.”

<b>YEAR</b>	<b>AMOUNT (IN EUROS)</b>
2009	147,960
2010	856,660
2011	555,590
2012	470,290
2013	277,920

[42] In reply to the undertaking to indicate for each of the above-mentioned years the portion of sales that is actually clothing and the portion that is actually accessories, the Opponent



answered “10%” [Q153-Q155]. At the hearing, the Opponent specified that “10%” applies to accessories.

[43] Mr. Aeschbacher files as Exhibit FA-1 to his affidavit extracts from the Opponent’s website to show “the kind of products” sold under its trade-mark NIKITA since at least 2009 [para 8]. I note that these extracts were apparently printed on March 10, 2014. There is no information as to how long the Opponent’s website has been in operation, nor information on the number of Canadians that would have accessed the website at any time. This was not disputed by the Opponent at the hearing where the Opponent reiterated that the website extracts were filed to show the products sold under its trade-mark NIKITA in Canada since at least 2009.

[44] Mr. Aeschbacher states in his affidavit that the trade-mark NIKITA is always identified on the clothing, either by way of a hang tag or a sew-in label [para 10]. Notably, Mr. Aeschbacher’s statement is worded in the present tense, i.e. as of April 28, 2014 when he swore the affidavit. Furthermore, while Mr. Aeschbacher states at paragraph 11 of his affidavit that he files, as Exhibit FA-3, “a representative sampling of said labels and other identifying material”, on cross-examination he acknowledged that Exhibit FA-3 strictly consists of one hang tag [Q177-Q181].

[45] On cross-examination, Mr. Aeschbacher was asked to confirm that the goods that were crossed out in the document marked as Exhibit 3 to the transcript are those for which the trade-mark NIKITA was not being used in Canada. Exhibit 3 to the cross-examination transcript is reproduced at Schedule “B” to my decision. It consists of an excerpt of the affidavit of Mr. Aeschbacher filed in the section 45 proceeding concerning registration No. TMA689,118. Mr. Aeschbacher confirmed that the trade-mark NIKITA was not used in association with the crossed out goods from December 11, 2010 to December 11, 2013, i.e. the relevant period for the section 45 proceeding [Q83-Q86]. Furthermore, Mr. Aeschbacher confirmed that the Opponent went through all the records and the invoices, and crossed out all of the products for which it had no invoices [Q87-Q88].

[46] On cross-examination, Mr. Aeschbacher was also asked to provide, for each year from 2009 to 2013, a representative invoice for each of the goods for which in his view the trade-mark NIKITA remained in use in Canada [Q134]. The Opponent’s reply to the undertaking was:

“Such document is not available, as it does not exist”. In addition, the Opponent referred to paragraphs 9 and 10 of the affidavit subscribed by Mr. Aeschbacher in the section 45 proceeding, an unsigned copy of which was provided as part of the reply. However, I stress that the affidavit filed in the section 45 proceeding is not part of the Opponent’s evidence in the present case. Further, the Opponent at the hearing seemingly acknowledged that statements contained in the unsigned affidavit are of no significance in the present case. Indeed, while the Opponent made a few remarks in an attempt to explain why it had no invoices, the Opponent acknowledged that such explanation was not provided by Mr. Aeschbacher in the affidavit filed in the present proceeding.

[47] The Applicant submits that the reply that invoices do not exist undermines the testimony of Mr. Aeschbacher with respect to the use of the trade-mark NIKITA in the present case. In that regard, the Applicant submits that since Mr. Aeschbacher testified that invoices were reviewed for the purposes of the section 45 proceeding, the Opponent should have been able to provide invoices to support Mr. Aeschbacher’s assertions of use of the trade-mark NIKITA in the present case. In addition, the Applicant points out that most of the goods not crossed out in Exhibit 3 to the transcript were deleted from registration No. TMA689,118 further to the section 45 proceeding. Hence, the Applicant contends that the outcome of the section 45 proceeding also undermines the testimony of Mr. Aeschbacher with respect to the use of the trade-mark NIKITA in the present case.

[48] Ultimately, the Applicant submits that in the circumstances of this case, absent any invoices, the Opponent’s evidence is insufficient to establish that transfers of goods in association with the trade-mark NIKITA have occurred in Canada, as required by section 4(1) of the Act, from 2009 to 2013.

[49] Not surprisingly, the Opponent submits that its evidence is more than sufficient to show continuous use of its trade-mark NIKITA, within the meaning of section 4(1) of the Act, since at least 2009. I do not consider it necessary at this juncture to discuss at length the Opponent’s submissions in this regard.

[50] Indeed, even if I were to find that the Opponent’s evidence in this case, when considered as a whole, is sufficient to establish use of the trade-mark NIKITA in Canada within the meaning

of section 4(1) of the Act, it remains that Mr. Aeschbacher provides evidence pertaining to Canadian sales of clothing sold under the trade-mark *and* trade-name altogether. Consequently, I have no information with respect to which portion of these sales is directly attributable to the Opponent's sales of clothing in association with the trade-mark. In other words, I cannot draw any meaningful conclusion on the extent of use of the trade-mark NIKITA in Canada based on the Opponent's sale figures, as introduced into evidence by Mr. Aeschbacher.

*Promotion of the Opponent's trade-mark*

[51] In terms of promotion, Mr. Aeschbacher states in his affidavit that the clothing bearing the trade-mark and trade-name NIKITA is sold in Canada "through a distributor", who "invests around 10% of its business sales in publicity and marketing" [para 9]. On cross-examination, Mr. Aeschbacher confirms that the Opponent has only one Canadian distributor, whose name is Endorphin [Q65, Q77]. However, Mr. Aeschbacher indicates that, aside from NIKITA, Endorphin sells at least three other brands [Q167]. Therefore, barring the absence of data specifically related to the amount spent by Endorphin to promote the clothing associated with the Opponent's trade-mark NIKITA, in my view no meaningful inference can be drawn from Mr. Aeschbacher's broad statement concerning Endorphin's publicity and marketing investments.

[52] Mr. Aeschbacher files as Exhibit FA-2 to his affidavit "a representative sampling of the kind of publicity and marketing done in Canada" for the NIKITA clothing [para 9]. Since Mr. Aeschbacher does not describe the content of Exhibit FA-2, I note that it appears to consist of photographs of an exhibition booth, a sticker, and the NIKITA Spring/Summer 2014 catalogue. Absent further information, the mere filing of the exhibition booth photographs and sticker do not assist the Opponent's case. Also, no details have been provided concerning the volume of the distribution of the NIKITA Spring/Summer 2014 catalogue.

[53] Similarly, no details have been provided concerning the distribution of the NIKITA Fall/Winter 2013-2014 catalogue and the NIKITA Fall/Winter 2012-2013 workbook, copies of which were provided in reply to an undertaking to provide the product overview (if they exist) of the NIKITA catalogue for the period 2009 to 2013 [Q165].

[54] In view of the above, I agree with the Applicant that the evidence is insufficient for me to draw any conclusion as to the extent to which the Opponent's trade-mark NIKITA has become known as a result of its promotion in Canada.

*Conclusion on the section 6(5)(a) factor*

[55] In the end, I disagree with the Opponent's contention that it is favoured by the overall assessment of the section 6(5)(a) factor, which involves a consideration of inherent and acquired distinctiveness of the trade-marks at issue.

[56] Indeed, as discussed above, I find that the trade-marks at issue possess little inherent distinctiveness. I acknowledge that the Applicant did not provide evidence of use or promotion of the Mark in Canada whereas the Opponent did. Still, given the ambiguities and deficiencies of the Opponent's evidence, as discussed above, I am unable to draw any meaningful conclusion with respect to the extent to which the Opponent's trade-mark has become known in Canada as a result of its use or promotion.

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

[57] The application claims use of the Mark in Canada since at least as early as June 11, 2011 whereas the Opponent's registration No. TMA689,118 claims use of the trade-mark NIKITA in Canada since at least as early as March 14, 2002.

[58] I note from the outset that at no time during the hearing did the Opponent argue that its evidence establishes use of the trade-mark NIKITA in Canada, within the meaning of section 4(1) of the Act, since the date claimed in its registration or since at least as early as 2002, as asserted by Mr. Aeschbacher in his affidavit. As discussed above, the Opponent contends that its evidence establishes continuous use of its trade-mark NIKITA since at least 2009. Besides disputing the Opponent's contention, the Applicant submits that it cannot be concluded from the evidence that the Opponent has used the trade-mark NIKITA prior to June 11, 2011 and so I would be justified to find that the section 6(5)(b) factor favours the Applicant.

[59] First, the fact is that the Applicant elected not to provide evidence to establish use, much less continuous use, of the Mark since at least as early as June 11, 2011, as claimed in the application. Second, I do not consider the absence of invoices to be detrimental to the Opponent's case, if only because the Opponent has provided Canadian sales figures starting in 2009, albeit by reference to the trade-mark and trade-name NIKITA altogether.

[60] That being said, while there may be merit to the Opponent's contention that the section 6(5)(b) factor lends support to its case, I find this factor should not be afforded as much significance than argued by the Opponent.

[61] Indeed, as noted above, Mr. Aeschbacher's statement that the trade-mark NIKITA is always identified on the clothing, either by way of a hang tag or a sew-in label, is worded in the present tense, i.e. as of April 28, 2014. In other words, there is no clear statement that the trade-mark has always been identified on the clothing for the period 2009 to 2013.

Sections 6(5)(c) and (d) - The nature of the goods or business, and the nature of the trade

[62] It is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration No. TMA689,118 that must be taken into consideration when assessing these factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[63] Thus, it is worth reminding that the statement of goods in the application for the Mark reads "eyewear and accessories associated with eyewear namely optical frames, eyeglasses, sunglasses, eyeglass lenses, eyeglass ear and nose pieces, eyeglass chains, eyeglass necklaces, and eyeglass cases". The statement of goods in registration No. TMA689,118 reads "bags, namely, shoulder bags, hand bags; clothing, namely, shirts, sweaters, sweat hooded parkas, swimwear, belts".

[64] At the outset, I note that based on a plain reading of the statement of goods in the application, it appears that the Applicant is in the eyewear business. As for the Opponent,

Mr. Aeschbacher testifies that its business is the manufacture and distribution of women's clothing and accessories; this is in line with the statement of goods in the registration. Finally, except for Mr. Aeschbacher referencing the Opponent's Canadian distributor, neither party has provided evidence with respect to its channels of trade.

[65] Bearing the above in mind, I will summarize the representations of the Opponent and the Applicant, and thereafter conclude with my findings with respect to both factors.

[66] First, the Opponent stresses that under section 6(2) of the Act, there may be confusion between two trade-marks whether or not the goods or services *are of the same general class*.

[67] Second, the Opponent submits that although the Applicant's goods differ from its registered goods, the Applicant's goods are fashion accessories and therefore they relate and overlap with the Opponent's registered goods. In this regard, the Opponent cites decisions where goods that did not consist of clothing were nonetheless considered to be fashion accessories (citing *Camiceria Pancaclidi & B SRL v Cravatte Di Pancardi Srl*, 74 CPR (3d) 551 (TMOB); *Bally Schuhfabriken AG v 603753 Ontario Inc*, 1999 CanLII 19594 (TMOB); *Garbo Group v Harriet Brown & Co*, 1999 CanLII 19594, 3 CPR (4th) 224 (FCTD); *Emilio Pucci International BV v El Corte Ingles, SA*, 2011 TMOB 32; *Ben Sherman Group Limited v Knautz*, 2013 TMOB 122).

[68] At the hearing, the Opponent particularly noted the decision *Bally Schuhfabriken AG, supra (Bally)*, where the Registrar commented that the opponent's registered goods belts, ties, scarves, gloves, wallets, watches, hats and caps were somewhat related to the applicant's sunglasses, in that these goods might be characterized as fashion accessories. While the Opponent did not argue that "sunglasses" are fashion accessories associated with its trade-mark, the Opponent pointed out that its NIKITA Spring/Summer 2014 catalogue contains photographs of models wearing sunglasses [Exhibit FA-2 to the Aeschbacher affidavit].

[69] Finally, the Opponent submits that the statement of goods of the application and the statement of goods of the registration do not restrict the parties' channels of trade. Hence, the Opponent submits that given the overlap between the parties' goods, it must be concluded to an overlap between the parties' nature of the trade.

[70] For its part, the Applicant submits that its goods are intrinsically different from the Opponent's registered goods. Furthermore, the Applicant submits that there is no potential for overlap between the nature of the parties' respective goods and trade. More particularly, the Applicant submits that it is clear from the application that its goods are optical eyewear, and, as such, the probable type of trade for the eyewear and eyewear accessories would be the optician business.

[71] As for the cases cited by the Opponent, the Applicant submits that they do not assist the Opponent. Suffice it to say that the Applicant submits that the evidence in those cited cases differ from the evidence provided by the Opponent in the present case. Moreover, the Applicant submits that it is clear from the documentary evidence provided by the Opponent that its registered goods are not high fashion clothing and accessories goods.

[72] In concluding my summary of the parties' representations, I note that during its reply representations, the Opponent pointed out that it does not contend that the goods associated with its trade-mark are high fashion clothing and accessories. Rather, the Opponent contends that the case law in opposition proceedings supports a finding that the goods associated with the Mark correspond to fashion accessories and this is a fact sufficient for finding that the section 6(5)(c) and (d) factors favour the Opponent.

[73] I begin my discussion of the section 6(5)(c) and (d) factors by noting that the decisions cited by the Opponent are of interest to the extent that they involve opposition proceedings and address the principles that govern the test for confusion. However, it is trite law that each case has to be decided based upon its own merit.

[74] For instance, the cases *Emilio Pucci International BV, supra*, and *Ben Sherman Group Limited, supra*, cited by the Opponent are distinguishable from the present case not only in term of the evidence of record, but also because the trade-marks applied for registration in those cases were not associated with eyewear and eyewear accessories, as in the present case.

[75] I acknowledge that in *Camiceria Pancaaldi & B SRL v Cravatte Di Pancardi Srl, supra*, the applicant's trade-mark was associated with "glasses, namely sun-glasses and sight glasses;

fittings and accessories therefor”. However, as shown by the following comments of the Registrar, at page 55, that case is distinguishable in terms of evidence:

The parties’ wares are of course different. However, the unchallenged and uncontradicted evidence of Messrs. De Stefanis and Inghirami is that it is common for the same mark to be used in association with both clothing and with fashion accessories including eye-glasses and sun-glasses. Their evidence is further supported, to some extent, by Ms. McDonald’s state of the trade-marks register evidence.

[76] Indeed, I have no evidence in the present case that it is common for the same trade-mark to be used in association with clothing, including clothing accessories, and eyewear, including eyewear accessories.

[77] I consider that the goods of the parties differ. I acknowledge that the Registrar in *Bally* commented that sunglasses might be characterized as fashion accessories. Still, I find it somewhat telling that the Registrar nonetheless rejected the opposition. In reaching his conclusion, the Registrar summarized as follows his assessment of the section 6(5) factors in that particular case:

Since the evidence of record in this proceeding shows that the opponent’s trade-mark BALLY possesses a limited degree of inherent distinctiveness and therefore is not entitled to a broad ambit of protection, and bearing in mind the (apparently) unlicensed use of the mark BALLY by Bally Corporation in association with the operation of BALLY retail outlets and the fact that the mark BALLY has otherwise been shown to have become known to only a limited extent in Canada ‘as a trade-mark of the opponent’, and considering further that the wares of the parties differ although the applicant’s sunglasses and certain of the opponent’s wares as noted above might be generally categorized as fashion accessories, I have concluded that the applicant has met the legal burden upon it of showing that there would be no reasonable likelihood of confusion between its trade-mark BALI and the opponent’s BALLY trade-marks regardless of the material date being considered. (My underlining)

[78] The *Bally* case illustrates that the mere fact that similar trade-marks are used with clothing and with what can be considered as “fashion accessories” does not necessarily lead to a finding of a likelihood of confusion. One should not lose sight that whether there is a reasonable likelihood of confusion between trade-marks depends on a consideration of the facts in light of all of the factors listed at section 6(5) of the Act, not all of which are to be afforded the same weight. I note that the Court in *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD)



stated that one should be cautious about giving too much weight to the fact that the goods of the parties exist in the “same general class”, especially in the case of a weak mark.

[79] Insofar as the section 6(5)(d) factor is concerned, based on a plain reading of the statement of goods of the application, it may not be without merit for the Applicant to submit that the probable type of trade for its goods would be the optician business. However, the Applicant did not file any evidence to establish its channels of trade. Also, the statement of goods of the application does not restrict the Applicant’s channels of trade.

[80] In any event, if the Opponent rightly argues that this is a case where it may be concluded to an overlap between the nature of trade, then in my view comments made by the Court in *Garbo Group, supra*, should be given consideration in assessing the section 6(5)(d) factor.

[81] More particularly, when considering the nature of the trade, in *Garbo Group* the Court opined that the diversity of the goods included within the fashion accessory industry did not necessarily detract from a finding that some of the parties’ products in that case were within the same general category of goods. The Court went on to state:

[84] In light of the evidence that was not before the Registrar, I find that the goods sold by the appellant and those proposed to be sold by the respondent are not too diverse to prevent them from being in the same general category of goods. Further, while not identical, the channels of trade through which they normally pass overlap.

[85] Thus, contrary to the Registrar’s conclusion, the "nature of the trade" factor supports a conclusion that there might be a reasonable likelihood of confusion. However, since the marks relate to different goods within a broad category, I do not regard the support as being particularly strong. (My underlining)

[82] If I were to find that there is a potential for overlap in the nature of the trade because some of the Applicant’s goods might be characterized as fashion accessories, applying the above reasoning of the Court, the fact that the trade-marks are associated with different goods would remain relevant when considering the section 6(5)(d) factor, so that it would not significantly favour the Opponent.

Conclusion on the likelihood of confusion

[83] Section 6(2) of the Act is not concerned with confusion between the trade-marks themselves, but rather confusion as to the sources of the goods or services. Hence, in this case, an assessment of confusion asks whether there would be confusion of the goods provided in association with the Mark, as emanating from or sponsored by or approved by the Opponent.

[84] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors enumerated at section 6(5) of the Act and their relative importance, I have concluded that the Applicant has met the legal burden upon it of showing that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark NIKITA of registration No. TMA689,118.

[85] Indeed, while the trade-marks are identical, the Opponent's trade-mark NIKITA possesses a limited degree of inherent distinctiveness and therefore it is not entitled to a broad ambit of protection. Further, given the evidence as introduced by the Opponent, I cannot draw any meaningful conclusion with respect to the acquired distinctiveness of the Opponent's trade-mark. Likewise, I am not satisfied that the Opponent's evidence may lead to a finding that the length of time its trade-mark has been in use is of significance. Finally, I do consider that there are differences between the goods associated with the Mark and those associated with the Opponent's trade-mark.

[86] Accordingly, the section 12(1)(d) ground of opposition fails.

Was the Applicant the person entitled to registration of the Mark in Canada as of June 11, 2011?

[87] This issue arises from the ground of opposition raised under section 16(1)(a) of the Act and premised on allegations of confusion between the Mark and the Opponent's trade-marks NIKITA, either word or design, previously used or made known in Canada in association with the goods indicated in the registrations listed in the statement of opposition or similar goods.

[88] I find from the outset that there is no evidence establishing that the Opponent's alleged trade-marks NIKITA, either word or design, have been made known in Canada pursuant to the

definition of “made known” set out in section 5 of the Act. Furthermore, there is no evidence establishing use of the trade-mark NIKITA & Design of registration No. TMA689,948.

[89] Thus, the question that remains to be considered is whether the Opponent has met its evidential burden of establishing that its word trade-mark NIKITA was used in Canada prior to June 11, 2011 pursuant to the relevant definition of “use” set out in section 4(1) of the Act, and had not been abandoned at the date of advertisement of the application, namely September 11, 2013 [section 16(5) of the Act].

[90] However, at this juncture I find it not necessary to discuss the parties’ representations with respect to this question since the outcome of the ground of opposition would be the same whatever the answer. Indeed, the ground of opposition would fail either because the Opponent has not discharged its evidential burden or because, for reasons similar to those discussed under the section 12(1)(d) ground, I would find on a balance of probabilities that there was no likelihood of confusion between the Mark and the Opponent’s trade-mark NIKITA as of June 11, 2011.

[91] Accordingly, the section 16(1)(a) ground of opposition fails.

Was the Mark distinctive of the Applicant’s Goods as of November 7, 2013?

[92] This issue arises from the three-pronged ground of opposition alleging that the Mark is not distinctive of the Applicant’s goods within the meaning of section 2 of the Act.

[93] At the hearing, the Opponent conceded that it did not furnish evidence to support the second prong of the ground of opposition premised on the allegation that the Mark has been used contrary to the provisions of section 50 of the Act. The Opponent also conceded that it did not furnish evidence to support the third prong of the ground of opposition premised on the allegation that more than one person had rights into the Mark.

[94] Accordingly, the second and third prongs of the non-distinctiveness ground of opposition fail. Thus, what remains to be considered is the first prong of the ground of opposition which revolves around the likelihood of confusion between the Mark and the Opponent’s alleged trade-marks and trade-name NIKITA.

[95] There is an evidential burden on the Opponent to establish that either of its alleged trade-marks or its alleged trade-name had a substantial, significant or sufficient reputation in Canada in association with the Opponent's goods as of November 7, 2013 to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[96] To the extent that the ground of opposition revolves around the likelihood of confusion between the Mark and the Opponent's trade-name NIKITA, it is dismissed for the Opponent's failure to meet its evidential burden. Suffice it to say that besides the absence of substantive representations from the Opponent at the hearing, I find its evidence insufficient for concluding that its alleged trade-name had a substantial, significant or sufficient reputation in Canada as of November 7, 2013, so as to negate the distinctiveness of the Mark.

[97] To the extent that the ground of opposition revolves around the likelihood of confusion between the Mark and the trade-mark NIKITA & Design (TMA689,948), it is dismissed for the Opponent's failure to meet its evidential burden. Suffice it to say that there is no evidence pertaining to the use or promotion of the trade-mark in Canada.

[98] Finally, to the extent that the ground of opposition revolves around the likelihood of confusion between the Mark and the Opponent's word trade-mark NIKITA, my previous comments concerning the ambiguities and deficiencies of the Opponent's evidence remain applicable. In any event, regardless of the answer to the question of whether the Opponent has discharged its evidential burden, the outcome of the ground of opposition would be the same. Indeed, the ground of opposition would fail either because the Opponent has not discharged its evidential burden or, for reasons similar to those discussed under the section 12(1)(d) ground, I would find on a balance of probabilities that there was no likelihood of confusion between the Mark and the Opponent's word trade-mark NIKITA as of November 7, 2013.

Disposition

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

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule "A"

### Summary of the Grounds of Opposition

- (a) The application does not conform to the requirements of section 30(b) of the Act. The Applicant has not used the Mark in Canada as claimed in the application. Alternatively or cumulatively, the alleged use of the Mark has been discontinued in whole or in part.
- (b) The application does not conform to the requirements of section 30(i) of the Act. The Applicant falsely made the statement that it was satisfied of its entitlement to use the Mark in Canada since: (i) the use of the Mark infringes the Opponent's rights; (ii) the use of the Mark contravenes section 22 of the Act; (iii) the adoption and use of the Mark contravenes section 7(b) of the Act.
- (c) The application does not conform to the requirements of section 30(a) of the Act. The terms used to identify the applied-for goods do not meet the required level of specificity.
- (d) The Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's trade-marks NIKITA of registration Nos. TMA689,118 and TMA689,948.
- (e) The Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act. The Mark, at the relevant time, was confusing with the Opponent's trade-marks NIKITA, either word or design, previously used or made known in Canada for the goods indicated in the alleged registrations or similar goods.
- (f) The Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act. The Mark, at the relevant time, was confusing with the Opponent's previously used trade-name NIKITA.
- (g) The Mark is not distinctive under section 2 of the Act since: (i) the Mark does not distinguish the Applicant's goods from the goods associated with the Opponent's trade-marks and trade-name NIKITA; (ii) third parties, including 1455552 Ontario Limited, have used the Mark in Canada outside the scope of the licensed use provided by section 50 of the Act; (iii) as a result of its transfer more than one person, including 1455552 Ontario Limited, had rights into the Mark and exercised them contrary to section 48(2) of the Act.

## Schedule "B"

### Exhibit 3 - Transcript of the Cross-examination of Mr. Aeschbacher

Ex. 3

8. I have reviewed the list of goods set out in the registration for NIKITA (TMA689,118). I can confirm from my personal knowledge and from information taken from business records that most of the goods listed in the registration were sold in Canada in the normal course of trade during the Relevant Period. Below, I have identified the NIKITA brand goods in the registration that were, or were not, sold in Canada during the Relevant Period. The goods that were sold are in bold, and those that were not sold are struck out.

(1) ~~Leather and imitations of leather and goods made of these materials, namely, shopping bags of leather, leather bags for merchandise packaging, pouches; wallets; purses, key cases; key chains, key fobs and key tags all being of leather, animal hides and imitations thereof; bags, namely, beach bags, all purpose sports bags, all purpose athletic bags, barrel bags, tote bags, carry-all bags, textile or mesh, shoulder bags, handbags, clutch bags, waistpacks, rucksacks, knapsacks, backpacks, school bags, book bags, satchels, cosmetic bags sold empty, shaving bags sold empty; travel bags, trunks, luggage, duffle bags, garment bags for travel and other travel goods; cases, namely travel cases, overnight cases, briefcases, document cases, credit card cases, business card cases, cosmetic and toiletry cases sold empty, vanity cases; jewellery bags for travel; umbrellas, bags and covers for sporting goods, surfing traction systems, grips, legropes and tethers for sporting goods, waxes for surfboards, skateboards, skis, parasols, walking sticks; clothing, footwear and headgear, namely, shirts, t-shirts, singlets, blouses and tops, sweaters, sweat tops, sweat hooded parkas, jumpers, beach pants, sporting and gymnastic wear, jackets, winter jackets, protective outdoor wear, namely, snowboarding outfits, snowboarding pants, jackets, vests, turtleneck sweaters, pullovers, coats, dresses, skirts, sarongs, trousers, pants, jeans, shorts, board shorts, leisure wear, surfwear, swimwear, sportswear, underwear, sleepwear, belts, scarves, gloves, hosiery, socks, boots, shoes, sandals, slides, thongs, slippers, headwear, namely, hats, caps, beanies, peaks and visors; sportswear for water; wetsuits, wetsuit vests, wetsuit shorts and wetsuit tops.~~

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2016-09-20

**APPEARANCES**

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