

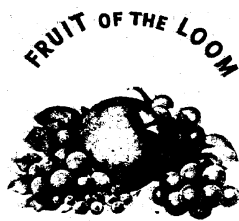
**IN THE MATTER OF AN OPPOSITION  
by Fruit of the Loom, Inc. to application No.  
785,371 for the trade-mark BÉBÉ FRUIT BABY  
filed by Importations Exportations Lam Inc.**

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On June 16, 1995, the applicant, Importations Exportations Lam Inc., filed an application to register the trade-mark BÉBÉ FRUIT BABY based on proposed use in Canada with “children’s toys namely dolls.” The applicant filed an amended application disclaiming the words BÉBÉ and BABY apart from the trade-mark. The application was subsequently advertised for opposition purposes on January 24, 1996.

The opponent, Fruit of the Loom, Inc., filed a statement of opposition on June 24, 1996, a copy of which was forwarded to the applicant on July 8, 1996. The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(e) of the Trade-marks Act because the applicant had no intention to use the applied for trade-mark. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-marks FRUIT OF THE LOOM and FRUIT OF THE LOOM & Design (shown below) registered under Nos. TMDA33513 and 120,178, respectively for a long list of clothing and related items including:

infants' playthings and training aids, namely: pacifiers, diaper pins, dressing combs and brushes, nail scissors, teethers, and teething toys; eating utensils, namely: feeding dishes and training cups; musical toothbrushes and hair brushes; hangers; toilet and training seats; mobiles and toys namely: blocks, pull toys, take-apart toys, snap beads, snap blocks, squeeze toys and terry toys; rattles; record books, switch plates; carriage and crib exercisers and baby carriers; and swim accessories namely: eardrum protectors and nose clips.



The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the two registered trade-marks noted above previously used and made known in Canada by the opponent. The fourth ground is that the

applicant is not the person entitled to registration pursuant to Section 16(3)(c) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-name Fruit of the Loom, Inc. previously used in Canada by the opponent. The fifth ground is that the applicant's mark is not distinctive because it is confusing with the opponent's trade-marks and trade-name previously used in Canada.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its Senior Vice-President and General Counsel, Joyce M. Russell. Ms. Russell was cross-examined on her affidavit and the transcript of that cross-examination and the replies to undertakings given during the cross-examination form part of the record of this proceeding. The applicant did not file evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the legal burden or onus is on the applicant to show its compliance with Section 30(e) of the Act. However, there is an evidential burden on the opponent to prove its supporting allegations of fact. Since the opponent has not filed any evidence on point, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's trade-mark BÉBÉ FRUIT BABY is inherently distinctive when used in relation to "children's toys namely dolls." However, the components BÉBÉ and BABY are descriptive when used with dolls and the applicant has

disclaimed those two words apart from its trade-mark. Thus, the applicant's mark is not inherently strong. There is no evidence of use or any reputation for the applicant's mark in Canada and I must therefore conclude that it has not become known at all.

The opponent's two registered marks are inherently distinctive in relation to the registered wares. However, the phrase FRUIT OF THE LOOM is suggestive when used with fabric items or clothing items. Thus, the opponent's two marks are not inherently strong in relation to most of the wares listed in the two registrations.

The Russell affidavit establishes that there have been extensive sales of FRUIT OF THE LOOM products in Canada. For the period 1992 to 1996, total Canadian sales were in excess of \$225 million. However, the Russell affidavit does not evidence any use of the opponent's design mark registered under No. 120,178. Thus, I must conclude that the trade-mark FRUIT OF THE LOOM & Design has not become known at all in Canada.

On cross-examination, Ms. Russell conceded that about 80% of FRUIT OF THE LOOM sales in Canada were of underwear and T-shirts (see page 28 of the Russell transcript). There have been Canadian sales of infant and toddler wear in association with the trade-mark totalling in excess of \$1.85 million for the period 1993 to 1996. However, the opponent has not sold any toys in Canada in association with the trade-mark FRUIT OF THE LOOM (see page 33 of the Russell transcript). Furthermore, Ms. Russell did not provide any admissible evidence of advertising activities in Canada in relation to the opponent's trade-mark. Thus, I am able to conclude that the opponent's mark FRUIT OF THE LOOM has become well known in Canada in association with underwear and T-shirts and has become known to a much lesser extent with infant and toddler wear. The opponent has evidenced no reputation in Canada for the remaining wares listed in its registration.

As for Section 6(5)(b) of the Act, the opponent's trade-mark FRUIT OF THE LOOM has been in use in Canada for a number of years. The applicant's mark, on the other hand, has apparently not yet been used.

As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of the parties differ. Most of the opponent's registered wares are in the nature of textile goods or clothing items. The applicant's wares are dolls. Although the opponent's statement of wares includes a few toy items, it does not specifically include dolls. Furthermore, as conceded by Ms. Russell, the opponent does not use its trade-mark FRUIT OF THE LOOM in Canada with toys.

The natures of the parties' trades also differ. In her affidavit, Ms. Russell states that the opponent's wares are sold to Canadian retail chains such as K-Mart, Wal-Mart and The Real Superstore. She further states that those chains also carry toys and dolls. On cross-examination, however, it became apparent that that statement was hearsay (see pages 63 ff. of the Russell transcript). Nevertheless, I am prepared to conclude that large Canadian retail chain stores would likely carry toys in general and dolls in particular but that such items would not be sold in the same department as underwear, T-shirts and infant and toddler wear.

As for Section 6(5)(e) of the Act, I find that there is little resemblance between the marks at issue in any respect. Although both marks include the word FRUIT, it appears as the first and dominant word of the opponent's two marks whereas it is the middle word of the applicant's mark. The marks would be sounded differently and the ideas suggested are quite distinct. The applicant's mark suggests small fruit whereas the opponent's mark is a clever metaphor to describe cloth or clothing - i.e. - that which is the fruit of the loom.

In its written argument, the applicant sought to rely on state of the register evidence to show common adoption of the word FRUIT by other traders in the trades at issue. However, the applicant failed to file evidence on point and I have therefore not considered the third party marks referred to by the applicant. Even if the marks referred to had been properly evidenced, there would only have been half a dozen or so relevant registrations. Such numbers are insufficient to allow me to conclude that any of the marks are in active use and that FRUIT is therefore in common use as a component of trade-marks for clothes or dolls.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the

differences in the wares, trades and marks of the parties, I find that the applicant's trade-mark **BÉBÉ FRUIT BABY** is not confusing with the registered mark **FRUIT OF THE LOOM** notwithstanding the acquired reputation for the opponent's mark in Canada for various clothing items. The same conclusion applies to the opponent's registered design mark particularly in view of the fact that the opponent failed to evidence use of that mark in Canada. Thus, the second ground of opposition is unsuccessful.

As for the third ground of opposition, as discussed, the opponent has failed to evidence any use of its registered trade-mark **FRUIT OF THE LOOM & Design** in Canada. Thus, it did not meet its burden to evidence use or making known of that mark prior to the applicant's filing date. As for the registered mark **FRUIT OF THE LOOM 'per se'**, the opponent has evidenced prior use of that mark although it has not shown that it was made known in Canada pursuant to Section 5 of the Act as of the applicant's filing date (i.e. - June 16, 1995). Thus, the third ground of opposition remains to be decided on the issue of confusion between the applicant's trade-mark **BÉBÉ FRUIT BABY** and the opponent's trade-mark **FRUIT OF THE LOOM** as of the applicant's filing date. My conclusions respecting the second ground of opposition are, for the most part, applicable to this ground as well. Thus, I find that the marks were not confusing as of this earlier date and the third ground is therefore also unsuccessful.

As for the fourth ground of opposition, the opponent has evidenced some use of its trade-name **Fruit of the Loom, Inc.** in Canada in relation to its business of selling clothing, some of that use having been before the applicant's filing date. However, most of the trade-name use evidenced by the opponent is of the trade-name **Fruit of the Loom Canada, Inc.**, the opponent's Canadian subsidiary. The opponent did not rely on the Canadian subsidiary's trade-name in support of its fourth ground of opposition.

The fourth ground remains to be decided on the issue of confusion between the applicant's trade-mark **BÉBÉ FRUIT BABY** and the opponent's trade-name as of the applicant's filing date. My conclusions respecting the second ground of opposition are also applicable to this ground. In fact, the applicant's case is even stronger respecting the fourth ground since (1) the degree of resemblance between the mark and name at issue is less than

in the case of the marks at issue, (2) there is no evidence of use of the trade-name with the business of selling toys and (3) the opponent failed to evidence a significant reputation for its trade-name in Canada. Thus, I find that the applicant's mark was not confusing with the opponent's name and the fourth ground is also unsuccessful.

As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from the wares and services of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - June 24, 1996): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fifth ground essentially turns on the issue of confusion between the applicant's mark and the opponent's trade-mark FRUIT OF THE LOOM and trade-name Fruit of the Loom, Inc. Given my conclusions above respecting the issue of confusion respecting the second and fourth grounds, it also follows that the applicant's mark is not confusing with the opponent's trade-mark and trade-name as of the filing of the present opposition. Thus, the fifth ground is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 21<sup>st</sup> DAY OF NOVEMBER, 2000.

David J. Martin,  
Member,  
Trade Marks Opposition Board.