

**IN THE MATTER OF AN OPPOSITION
by bebe stores, inc. to application no. 1082319
for the trade-mark B.B & Design
filed by H & M Hennes & Mauritz AB**

[1] On November 9, 2000, H & M Hennes & Mauritz AB filed an application to register the trade-mark B.B & Design, shown below:

The image shows the trade-mark 'B.B & Design'. It consists of two large, bold, black capital letters 'B' separated by a small black dot. The letters are in a serif font.

The application is based on (1) use and registration of the mark in Sweden and (2) proposed use of the mark in Canada in association with the following wares:

women's clothing, namely, shirts, pants, jackets, dresses,
skirts, blouses, pantyhose, shoes and socks.

[2] The Examination Section of the Trade-marks Office raised objections to the applied for mark on the basis that it was confusing with the word mark BIBI (regn. no. 476330) and with the mark BB Design (regn. no. 488128) shown below:

The image shows the trade-mark 'BB Design'. It consists of two large, bold, black capital letters 'B' that are interlocked. The left 'B' is on the left and the right 'B' is on the right, with their vertical stems overlapping in the center.

The Office also cited three earlier filed co-pending and confusing applications for the marks shown below:



[3] Each of the above cited marks was owned by different persons and was associated with clothing. The applicant responded to the Office objections by, among other things, pointing to the visual differences between the applied for mark B.B Design and the cited marks, and by relying on the principle that small differences can suffice to distinguish between weak marks.

[4] The applied for mark B.B Design was subsequently advertised for opposition purposes in the *Trade-marks Journal* issue dated April 14, 2004, and was opposed on September 14, 2004, by “bebe stores, inc.,” that is, the owner of the above cited mark BIBI registration no. 476330. The Registrar forwarded a copy of the statement of opposition to the applicant on October 5, 2004, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

[5] The opponent’s evidence consists of the affidavits of Yupu Liu; Thomasina Carroll, and Rabiah Shaikh. The applicant’s evidence consists of the affidavits of Scott Pratt and Haken Bjorkstedt. The opponent’s reply evidence consists of the affidavits of Larry Smith and Dianne Lemm. Only the applicant filed a written argument. Neither party requested an oral hearing.

STATEMENT OF OPPOSITION

[6] The first ground of opposition, pursuant to Section 30(d) of the *Trade-marks Act*, alleges that the applicant has not used the applied for mark in Sweden in association with the wares

specified in the application.

The second ground of opposition, pursuant to Section 30(e) of the *Act*, alleges that the applicant did not intend to use the applied for mark in Canada.

The third ground, pursuant to Section 30(i), alleges that the applicant could not have been satisfied that it was entitled to use the applied for mark in view of the opponent's use and ownership of its various trade-marks and trade-names.

[7] The fourth ground, pursuant to Sections 16(2) and 16(3), alleges that the applicant is not entitled to register the applied for mark B.B Design. In this regard, the opponent relies on various of its trade-marks and trade-names that had been previously used in Canada, including the marks "bebe," BEBE and BEBE STORES; the trade-names "bebe", "bebe stores", and BIBI; and previously filed trade-mark applications for various marks including the marks BEBE SPORT and "bebe." The opponent's marks cover, among other things, clothing and retail store services for clothing and accessories. The opponent's mark "bebe" is registered and used in the form shown below:

bebe

[8] The fifth ground, pursuant to Section 12(1)(d), alleges that the applied for mark is not registrable because it is confusing with three of the opponent's trade-mark registrations for the mark "bebe" and with the registered marks BIBI and "bbsp," covering, among other things,

women's clothing and accessories and retail store services for the same.

The sixth ground alleges that the applied for mark is not distinctive of the applicant's wares because the mark B.B Design is confusing with the opponent's trade-marks and trade-names previously used in Canada by the opponent.

OPPONENT'S EVIDENCE

Yupo Liu

[9] Mr. Liu identifies himself as the Senior Corporate Counsel for the opponent company.

Mr. Liu testifies that the opponent opened a women's clothing store in San Francisco, California in 1971 and expanded to four stores by 1976, at which time the name of the stores was changed to "bebe." By the end of 2005, there were 225 "bebe" stores operating in several countries including the United States and Canada.

[10] The opponent develops and produces contemporary women's apparel and accessories targeted to the 21 to 35 age range. The opponent describes its wares as "high quality modern, sexy and sophisticated." The opponent's wares are sold in high-end department stores in the USA, or through "bebe" stores or the opponent's on-line store at www.bebe.com. In Canada the opponent's wares are only available in "bebe" stores. The opponent operates three types of stores namely, "bebe" retail; "bebe" Sport, which carry a line of active wear and accessories; and "bebe" outlets, which function as a clearance vehicle for merchandise from the opponent's other stores.

[11] In Canada, the opponent operates (i) four “bebe” retail stores in Toronto, Burnaby, and Vancouver (2 stores), (ii) two “bebe” Sports stores in Burnaby and Toronto, (iii) one outlet store in Vaughn, Ontario. Two stores have been operating since 1999 while four more were added in 2005. Net sales for the four year period 2000 - 2003 averaged \$4.7 million annually, while net sales for the two year period 2004 - 2005 averaged \$8.4 million annually. The opponent displays its marks (predominately the mark “bebe”) (i) on hang tags attached to merchandise and on shopping bags and merchandise boxes used as packaging in “bebe” stores, (ii) on labels attached to the opponent’s wares, (iii) at its retail stores, and (iv) at its on-line store. Since the year 2000, the opponent has spent about US \$300,000 in Canada on advertising through magazines, on billboards and posters. From my review of the exhibit material attached to Mr. Liu’s affidavit, it appears that the opponent’s advertising predominantly features the mark “bebe.” The opponent’s products are worn and used by various American celebrities who would be known to Canadians. The opponent’s products can also be seen worn by actresses on popular television shows that are broadcast in Canada.

Thomasina Carroll

[12] Ms. Carroll’s affidavit serves to introduce into evidence copies of BEBE trade-mark registrations owned by the opponent.

Rabiah Shaikh

Mr. Shaikh is the Store Manager of a retail “bebe” store in Vancouver. His evidence corroborates Mr. Liu’s testimony concerning how the opponent’s marks are used in the

opponent's stores, and that the store staff pronounce the opponent's mark as "bee-bee." The exhibit material attached to Mr. Shaikh's affidavit corroborates Mr. Liu's evidence that the opponent's mark "bebe" is displayed in the opponent's stores on shopping bags, bags, boxes, hang tags and clothes hangers.

APPLICANT'S EVIDENCE

Hakan Bjorkstedt

[13] Mr. Bjorkstedt identifies himself as a senior lawyer with the applicant company. His evidence is that the applicant company began doing business in Sweden in 1947 and subsequently expanded throughout Europe. As of 2006, the applicant operated about 1200 stores in 22 countries. The applicant's stores sell clothing collections for men and women of all ages, as well as fashion accessories and cosmetics. Some of the clothing collections have been designed by famous designers.

[14] The applicant opened its first store in the United States in the year 2000. As of 2006, a further 90 stores were opened. Since 2000, total sales in the United States have amounted to US \$550 million. The first store in Canada opened in early 2004 in Toronto. As of 2006, a further 11 stores opened, mostly in Ontario. Since 2000, total sales in Canada have amounted to CAD \$102 million.

The applicant introduced its B.B Design mark in Europe in the early 1990's to be used in association with a line of plus size clothing for larger women. It appears from Mr. Bjorkstedt's

evidence that the applicant commenced use of the mark in Canada in the year 2004, and that by year end 2005 sales under the mark totalled about CAD \$1.8 million. In both Canada and the United States, the B.B Design branded line of clothing is sold exclusively through the applicant's own retail stores.

Scott Pratt

[15] Mr. Pratt's affidavit serves to introduce evidence concerning the state of the trade-marks register. In this regard, Mr. Pratt evidences fourteen registrations and four applications covering clothing and accessories (including marks belonging to the opponent) comprised in whole or in part of the letters BB including, for example, BB CURVES, BB ZANIMO, and BB GOLD. His evidence also includes dictionary entries for the French word "bébé." In this regard, the French word bébé is pronounced as "bay-bay" and is translated to English as "baby."

OPPONENT'S REPLY EVIDENCE

Larry Smith, Dianne Lemm

[16] Mr. Smith has been acting as general counsel for retail clothing businesses, in the United States, since 1995. Ms. Lemm has been involved, in Canada, in advising clients in the retail industry, including the retail clothing industry, on real estate matters for about 21 years. Their evidence is that in the United States and Canada the opponent's mark "bebe" is pronounced as "bee-bee."

MAIN ISSUE & LEGAL ONUS

[17] There is no evidence to support any of the first three grounds of opposition which are therefore rejected. The determinative issue with respect to the remaining grounds is whether the applied for mark B.B Design is confusing with the opponent's mark "bebe." The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability, (ii) the date of filing of the application, in this case November 9, 2000, with respect to the second ground of opposition alleging non-entitlement, and (iii) the date of opposition, in this case September 14, 2004, in respect of the issue of non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

[18] The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Act*, shown below, between the applied for mark B.B Design and the opponent's mark "bebe":

6(2) The use of a trademark causes confusion with another trademark 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.

The presence of an onus on the applicant means that if a determinate conclusion cannot

be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

CONSIDERATION OF SECTION 6(5) FACTORS

[19] The applied for mark B.B Design is a weak mark as it is comprised mainly of a letter of the alphabet: see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 at 167 (F.C.T.D.). The opponent's mark "bebe" is also a relatively weak mark because it is sounded as a letter of the alphabet (repeated twice) and because it would be recognised as the French word "bébé" by French speaking and bilingual Canadians. The applied for mark would not have acquired any reputation in Canada at the earliest material date. However, the mark B.B Design would have acquired at least a minimal reputation in Canada beginning in 2004 and continued to acquire distinctiveness through sales and promotion through to the latest material date. The opponent's mark "bebe" had acquired some reputation in Canada as of the earliest material date

and continued to acquire distinctiveness through sales under the mark and promotion of the mark through to the latest material date. The length of time that the marks in issue have been in use in Canada favours the opponent as the opponent's use of its mark "bebe" predates the applicant's use of its mark B.B Design by about five years.

[20] In regard to the wares and trades of the parties, it is the applicant's statement of wares in the application and the opponent's statement of wares in its registrations that govern, at least in respect of the ground of opposition based on Section 12(1)(d) of the *Act*: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Dale Bohna* (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. For this purpose, evidence of the actual trades of the parties is useful: see *McDonald's Corporation v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.). I find that there is significant overlap between the parties' wares in respect of women's clothing keeping in mind that I am not permitted to recognize a distinction between goods of the same general class in which price is the main distinguishing feature: see *Bagagerie SA v. Bagagerie Willy Ltée* (1992), 45 C.P.R. (3d) 503 at 509-510 (F.C.A.). However, it is unlikely that the parties' wares would be sold through the same channels of trade given that (i) the applicant's wares are sold exclusively through its own retail stores and (ii) the parties' clothing wares appear to be intended for different consumer groups.

[21] While the marks in issue are different visually, most consumers would likely sound the marks identically as “bee-bee.” The opponent’s mark “bebe” is a coined term in the English language and would not suggest anything in particular to English speaking Canadians, or it might possibly suggest a person’s nickname. However, the mark would likely suggest the idea of a baby or infant to French Canadian and bilingual consumers who would likely sound the mark as “bay-bay.” The applied for mark does not suggest anything other than the letter B.

DISPOSITION

[22] Having regard to the above, and keeping in mind in particular that the opponent’s mark “bebe” is a relatively weak mark, and that the parties’ marks have different visual impacts, I am satisfied that the applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark B.B Design and the opponent’s mark “bebe” at any material time.

In view of the foregoing, the opposition is rejected. This decision has been made pursuant to a delegation of authority under Section 63(3) of the *Trade-marks Act*.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 16th DAY OF JULY, 2009.

Myer Herzig,
Member,
Trade-marks Opposition Board