



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

**Citation: 2010 TMOB 161**  
**Date of Decision: 2010-09-30**

**IN THE MATTER OF AN OPPOSITION  
by Effigi Inc. to application No. 1,247,060  
for the trade-mark TAGLESS in the  
name of HBI Branded Apparel Limited,  
Inc.**

[1] On February 14, 2005 Sara Lee Corporation filed an application to register the trade-mark TAGLESS, application No. 1,247,060 (the Mark) based on proposed use for the wares “sleepwear” (the wares). The said application was assigned in March 2007 to HBI Branded Apparel Limited, Inc. (the Applicant).

[2] The application was advertised on December 21, 2005.

[3] On February 17, 2006, a statement of opposition was filed by Effigi Inc. (“the Opponent”); the Applicant filed and served its counter statement on April 13, 2006.

*Grounds of Opposition*

[4] The statement of opposition is summarized as follows:

- The application does not satisfy s. 30 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) because, at the filing date of the application, the Applicant was already using the Mark in question. Alternatively or cumulatively, that the Applicant never had an intention to use the Mark in question in Canada (contrary to s. 30(e) of the Act). The application is for a Mark that does not function as a trade-mark.

- Contrary to s. 30(i) of the Act the Applicant could not have been satisfied that it was entitled to use the Mark given the prior rights of the Opponent.
- The application is not in conformity with s. 30(a) of the Act because “sleepwear” is not sufficiently specific and thus not in ordinary commercial terms.
- The Mark is clearly descriptive or deceptively misdescriptive, contrary to s. 12(1)(b) of the Act of the character or quality of the wares, in that it clearly describes that the wares do not have tags.
- The Mark is confusing with a number of the Opponent’s registered trade-marks, and therefore contrary to s. 12(1)(d) of the Act. The Opponent’s TAG trade-marks are listed below:
  - SCUBA TAG, Registration No. TMA585321
  - TAG, Registration No. TMA599148
  - TAG 4MAN, Registration No. TMA620513
  - TAG: ATHLETICS, Registration No. TMA598517
  - TAG ATHLETIC, Registration No. TMA598518
  - TAG ATHLETIC, Registration No. TMA598575
  - TAG DOMO, Registration No. TMA590537
  - TAG DOMO, Registration No. TMA571362
  - TAG PRIMA, Registration No. TMA610705
  - TAG TREND AND GENERIC, Registration No. TMA505641
- Contrary to s. 16(3)(a) of the Act the Applicant is not the person entitled to registration because the Mark is confusing with the Opponent’s TAG trade-marks, previously used by the Opponent or the Opponent’s predecessor in title.
- Contrary to s. 16(3)(b) of the Act the Applicant is not the person entitled to the registration because at the date of filing of the application, the Mark was confusing with the Opponent’s previously filed Canadian applications, namely:
  - TAG ESCAPE, application No. 1150095;
  - TAG RIDER, application No. 1150097;

- TAG RIDER, application No. 1150098;
- Contrary to s. 16(3)(c) of the Act, the Mark was confusing at the date of filing of the application with the TAG denomination or those that include TAG, previously used in Canada by the Opponent or the Opponent's predecessor in title.
- The Mark is not distinctive as it does not distinguish the wares covered in the application from the wares of others, namely the Opponent. The term "TAGLESS" is used descriptively on many internet sites, newspapers, and in the Applicant's own promotions. The Applicant has allowed the Mark to be used by third parties, contrary to s. 50 of the Act, including Sara Lee Branded Apparel Americas, Sara Lee Global Finance, L.L.C., Make29tees.com, and Buyeshirts.com. These parties have exercised their rights concurrently and contrary to s. 48(2) of the Act.

[5] The Opponent filed the affidavit of Karina Hébert, two affidavits of Lorraine Laquerre, and the affidavit of Denis Allard. Mr. Allard was cross-examined by the Applicant on January 26, 2007. The Applicant's evidence consists of the affidavits of Marisa Hood and Lynda Palmer. The Opponent filed the affidavit of Claire Cébron as reply evidence.

[6] Only the Applicant submitted written arguments. Both parties were represented at the oral hearing.

#### *Material Dates*

The material dates relating to the grounds of opposition at issue are generally recognized as:

- non-compliance with s.30 of the Act - filing date of the application (February 14, 2005) [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B)]
- non-registrability of the Mark under s.12(1)(b) of the Act - filing date of the application [see *Zorti Investments Inc v. Party City Corp.* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th)

541 ( T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]

- non-registrability of the Mark under s.12(1)(d) of the Act - the date of this decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]
- non-entitlement to the Mark, pursuant to s. 16(3)(a)(b)(c) - the filing date of the application;
- non-distinctiveness of the Mark: the filing date of the statement of opposition (February 17, 2006) [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4 th) 317 (F.C.)]

#### Summary of the Opponent's Evidence

##### *Affidavit of Karina Hébert*

[7] In her affidavit, Ms. Hébert identifies herself as a paralegal with the Opponent's agents of record. Ms. Hébert has access (by virtue of the subscription of the Opponent's agents) to the "OnScope" database, which by permission of the Canadian Intellectual Property Office (CIPO), is updated weekly with information on Canadian trade-mark registrations and applications, as well as cancelled trade-marks. The affiant states that on April 21, 2006, she conducted a search on OnScope to determine the occurrence of registered or pending trade-marks containing the words "sleepwear" and "namely" in the statement of wares. She states that her search returned 3,047 trade-marks using these two terms.

[8] Ms. Hébert notes that these 3,047 results consist of marks where "sleepwear" and "namely" appear in the statement of wares, but not necessarily instances where "sleepwear" is specified by the term "namely". She states that, accordingly, she refined these results to instances of marks where "namely" followed "sleepwear". She includes a chart of the 500 results of this search as Exhibit KHE-1. She states that these registered marks were active at the time of her search, and, in the case of applications, were published or accepted to registration.

[9] The Applicant pointed out, however, that effectively this research also indicates that while there may be 500 entries on the database of Canadian trade-marks where “sleepwear” is followed by “namely”, there are also then, by deduction, 2,547 entries where sleepwear is *not* followed by “namely”. I would also observe that there is no indication in the refined search results as to whether the applicant in each case voluntarily specified sleepwear or was requested to by CIPO during the examination of the application. Accordingly, I find that this evidence is of limited value in supporting the Opponent’s submissions that CIPO practice suggests that “sleepwear” is not an ordinary commercial term.

*First Affidavit of Lorraine Laquerre*

[10] Ms. Laquerre identifies herself as an articling student with the Opponent’s agents. She states that she carried out a search in the OnScope database for registered or pending trade-marks containing “sleepwear, namely” in their statement of wares on September 14, 2006; which search returned 359 marks.

[11] The Affiant includes the results of each of this search as Exhibit LLA-1 of her affidavit. She further provides a chart summarizing the results listing the statements of wares for each trade-mark found (Exhibit LLA-2). I note that there is no indication in the evidence as to whether the applicant in each case voluntarily specified sleepwear or was requested to by the Trade-marks Office during the examination of the application. Accordingly, I find that this evidence is of limited value in supporting the Opponent’s submissions that Trade-Marks Office practice suggests that “sleepwear” is not sufficiently specific.

[12] Ms. Laquerre further states that she searched the Internet for products sold as “sleepwear” on September 27 and 28, 2006. She provides printouts from a number of websites selling “sleepwear” products as Exhibit LLA-6; the printouts provided show various styles and products under the heading “sleepwear”. I note that the web pages reflect the situation after the material date for assessing compliance with s. 30(a); there is no evidence that these websites reflected the same information or were even in existence at the date of filing of the application.

*Second Affidavit of Lorraine Laquerre*

[13] Ms. Laquerre's second affidavit is directed to the descriptiveness of the Mark as well as to the allegation of use of the Mark by entities other than the Applicant. The affiant provides printouts of Internet sites visited December 2005 and November 2006 (Exhibit LLA-10), which include interactive order websites for "Hanes Tagless" shirts, information on a Hanes' "Go Tagless" nationwide launch in the United States, and press regarding Hanes "Tagless T". It is apparent on reviewing this material, that at that time, Sara Lee Corporation (Applicant's predecessor in title) was the owner of Hanes.

[14] The attached pages include a description (from what appears to be a marketing case study) of the success of the nationwide launch of Hanes "revolutionary Tagless T-Shirt". The articles states, "[t]he annoying T-shirt tag was officially "retired" as it was raised to the rafters, ushering in the next generation of comfortable T-shirts".

[15] On the Hanes interactive order websites, I note that the words "Tagless-no tag" are included in the bulleted list of features of the T-shirt (along with features such as: 100% cotton, available in XXL, etc.). Other pages from websites where one can order T-shirts on-line include the description "these shirts do not have a label sewn into the collar". Another news article (Boston Globe) bears the title "*Clothing retailers scratch a big itch; Tags disappear, replaced by art, and sales rise*". This article states that "Sara Lee's success has prompted other retailers including Aeropostale, Banana Republic, Holister, and Nike to venture into tagless territory..."

[16] To the extent that the affidavits of Ms. Laquerre contain conclusions and opinions on the contentions issues of the opposition, they will be disregarded [see *Cross Canada Auto Body Supply (Windsor) Limited et al. v. Hyundai Auto Canada* [2005] F.C.J. No. 1543, 43 C.P.R. (4th) 21 (F.C.T.D.); affirmed [2006] FCA 133 [*Cross Canada*]].

[17] With respect to the internet searches conducted by Ms. Laquerre, I note that the affiant conducted the searches herself, and that multiple websites for ordering Hanes Tagless T-shirts provided similar information. Further, I would observe that it would be difficult to file reliable evidence of interactive websites related to the other party's business, in any other manner; as well the Applicant did have the opportunity to file evidence to respond to this material.

Therefore, although these searches post date the material date for descriptiveness, and I cannot have regard to them as categorical indication of the descriptiveness of the Mark at the date of

filing the application, I am willing to give some weight to evidence for the purposes of reasoning whether or not the Mark is (and was) clearly descriptive pursuant to the governing principles of law in this regard. [See *Canadian Council for Professional Engineers v. Alberta Institute of Power Engineers* (2008), 71 C.P.R. (4th) 37 (T.M.O.B.) at paragraph 35 [CCPE]; *Build-A-Vest Structures Inc. v. Red Deer (City)*, 2006, 29 M.L.P.R. (4<sup>th</sup>) 210 (Alta. Q.B.) [Build-A-Vest]; *ITV Technologies Inc. v. WIC Television Ltd.*, (2003), 29 C.P.R. (4th) 182 (F.C) [ITV]].

*Affidavit of Denis Allard*

[18] In his affidavit, Mr. Allard states that he is Vice-President of Operations of the Opponent, and has been employed by the Opponent since 1995. As part of his position, he is responsible for the business, especially the marketing of the trade-mark TAG by the Opponent in Canada. He acts as a liaison with the Opponent's trade-mark agents; accordingly, he states he has knowledge of several of the Opponent's trade-marks that are registered or pending.

[19] He states that the Opponent is involved in the design, manufacturing, sale, and distribution of clothing, clothing accessories, and personal and household articles. Mr. Allard states that the Opponent obtained the trade-mark TAG in November 1998 (Registration No. 599,148).

[20] Mr. Allard provides a sampling of magazine advertisements for the Opponent's clothing associated with the TAG trade-marks as Exhibit DA-1. He states these publications are circulated widely in Canada and are representative of the types of ads the Opponent has used for its TAG trade-marks. I note that the earliest of these publications is for the month of December 2003, and that most of the ads show a trade-mark composed of the word "TAG" with another word, such as "RIDER" "LOGICAL" and "SPORT". A few advertisements (June 2004, March 2005, and November 2005) are for wares with the trade-mark "TAG" only.

[21] Mr. Allard also attaches labels illustrating the way the trade-mark TAG is associated with the Opponent's wares as Exhibit DA-2. I note that some of these labels depict the word "TAG" in combination with other words, but there are also several instances where "TAG" appears on its own.

[22] Mr. Allard also provides the annual sales figures for the Opponent in Canada for clothing and clothing accessories sold under the TAG trade-marks. Sales figures were \$3.1 million for 1998, but increased to be well over \$15 million (even as high as \$39.5 million in 2005) each year until September 28, 2006.

[23] During cross-examination Mr. Allard clarified that the trade-mark in use in 1998 was not the word TAG alone, but rather the trade-mark TAG TREND AND GENERIC (Q.33-38). Mr. Allard also confirmed that the sales figures cited in his affidavit relate to sales of wares in association with all of the Opponent's TAG trade-marks and not simply sales in association with the word TAG alone (Q.117-119). The Applicant pointed out that during cross-examination Mr. Allard stated that TAG appears most often with one or more additional words or elements.

[24] Finally, Mr. Allard provides printouts of the register obtained from <http://strategis.ic.gc.ca> for the following trade-marks owned by the Opponent:

- Exhibit DA-3: SCUBA TAG, Registration No. TMA585321
- Exhibit DA-4: TAG DOMO, Registration No. TMA590537
- Exhibit DA-5: TAG TREND AND GENERIC, Registration No. TMA505641
- Exhibit DA-6: TAG DOMO, Registration No. TMA571362
- Exhibit DA-7: TAG, Registration No. TMA599148
- Exhibit DA-8: TAG: ATHLETICS, Registration No. TMA598517
- Exhibit DA-9: TAG ATHLETIC, Registration No. TMA598575
- Exhibit DA-10: TAG ATHLETIC (& Design), Registration No. TMA598518
- Exhibit DA-11: TAG 4MAN, Registration No. TMA620513
- Exhibit DA-12: TAG PRIMA, Registration No. TMA610705
- Exhibit DA-13: TAG DOMO, Application No. 1087279(1)
- Exhibit DA-15: TAG ESCAPE, Application No. 1150096
- Exhibit DA-16: TAG ESCAPE, Application No. 1150095
- Exhibit DA-17: TAG RIDER, Application No. 1150098
- Exhibit DA-18: TAG RIDER, Application No. 1150097

#### Summary of the Applicant's Evidence



*Affidavit of Marisa Hood*

[25] Ms. Hood identifies herself as a legal assistant employed by the Applicant's agents of record. Ms. Hood provides that she accessed the United States Patent and Trademark Office (USPTO) website on July 24, 2007, and downloaded four registered trade-marks that included the word "TAGLESS". The Applicant is the registered owner of these marks; the registrations are for the trade-marks TAGLESS, GO TAGLESS!, and GO TAGLESS, copies are attached as Exhibits A-D.

[26] Ms. Hood also searched the USPTO website for any trade-marks owned by the Opponent that included the word "TAG". A printout of the search results is attached as Exhibit E. A few of the Opponent's trade-marks located incorporate the element "TAG", such as TAG RIDER, TAG PRIMA, and TAG TREND AND GENERIC; none of the results include "TAG" on its own. Copies of the registration pages are attached as Exhibits G to I.

[27] The Applicant submits that this evidence demonstrates co-existence in the United States between the respective trade-marks of the parties for a number of years; in addition the Applicant points out that the three of the Opponent's trade-marks were applied for and registered in face of prior use and registration of TAGLESS by the Applicant in the United States. I note that while it appears that the trade-marks have co-existed on the register in the United States, and that the Applicant's registrations preceded those of the Opponent, there is no evidence to support the allegation that they co-existed in the marketplace. In any event, the state of the register in the U.S. is of little, if any, relevance in assessing the issue of likelihood of confusion in Canada.

*Affidavit of Lynda Palmer*

[28] Ms. Palmer identifies herself as an independent trade-mark searcher. On July 12, 2007 she performed a search of the CIPO Trade-mark Database for all trade-marks that include the element "TAG" for use in association with clothing or clothing accessories, not owned by either of the parties to this proceeding. She attaches a copy of the search as Exhibit 1. Twenty-one trade-marks are listed, and the particulars of each trade-mark are attached as Exhibits 2 to 22. I note from the summary results chart in the affidavit that three of the trade-marks are expunged; the most relevant trade-marks with respect to the issue of confusion are: TAG HEUER &

DESIGN, JON TAGIA, TAG RAG, TAGFLAG, RED TAG, TAGGIES & DESIGN, and TAG+ JEANS.

[29] The balance of Ms. Palmer's affidavit is directed to establishing that there is use of these trade-marks in the marketplace in Canada. In this regard she states that she accessed websites referring to TAG JEANS on July 16-17, 2007. She provides information on the brand TAG+ JEANS from a Brandbible listing as Exhibit 23A. The material also boasts the brand's popularity, mentioning celebrity patrons like Eva Longoria, Hillary Swank, Lindsay Lohan, etc. Ms. Palmer provides that she researched online stores where TAG Jeans can be purchased from Canada and provides printouts of the TAG Jeans listings from the online stores "Angela's Runway", "Couture Candy", "Revolve Clothing.com", and "Design by Stephene" as Exhibits 23B to 23E, respectively. I note that these websites refer to this jean brand either as "TAG+" or "TAG".

[30] Ms. Palmer also explains that on July 18, 2007, she accessed a website referring to the mark TAGGIES ([www.taggies.com/home](http://www.taggies.com/home)), downloaded pages from the website, and provides printouts from these pages as Exhibit 24. These printouts display the mark TAGGIES, provide information on the products offered (security blankets, clothing, stuffed animals and toys, sleepwear, etc. for babies) and that they may be purchased online from Canada.

[31] Ms. Palmer provides printouts from pages she accessed on July 18, 2007 at [www.mytagalongs.com](http://www.mytagalongs.com), referring to TAGALONGS undergarments as Exhibit 25. She also attaches webpage printouts referring to TAG SAFARI that she obtained from [www.tagsafari.com](http://www.tagsafari.com) as Exhibit 26.

[32] Ms. Palmer also accessed the TAG HEUER website on July 22, 2007; she states that TAG HEUER products are available for purchase in Canada; printouts are provided from [www.tagheuer.com](http://www.tagheuer.com) showing authorised retailers in the Ottawa area, and showing Uma Thurman as the "ambassador" for TAG HEUER (Exhibit 27). She also provides an article from [www.femail.com](http://www.femail.com) discussing Uma Thurman as the TAG HEUER fashion ambassador (Exhibit 28).

[33] Exhibit 29 is a copy of the first ten search results from a Google search that Ms. Palmer carried out on July 22, 2007 under the search string “Tag Heuer & fashion”. I note that this search returned a total of 967,000 results, and that the first ten results refer exclusively to the TAG HEUER brand and TAG HEUER watches. Ms. Palmer explains she accessed the websites of these search results, and provides printouts from these websites as Exhibit 30.

[34] Ms. Palmer states that after searching “Sof’Tag” on July 22, 2007, she found a website identifying the corporate owner of the Sof’Tag brand at *www.findownersearch.com*. Exhibit 31 is the printout of the listing, which lists the brand owner as “Gildan Activewear Inc./Les Vetements de Sport Gildan Inc.” in Quebec, Canada.

[35] I am willing to give some weight to this affidavit on the same basis as stated previously. There is similar information from multiple websites; the information appears to be from relevant official corporate websites and the Opponent had the opportunity to file evidence in reply. [See *CCPE; Build-A-Vest* and *ITV*]. I am therefore prepared to reach the general conclusion that there are some third party trade-marks in the Canadian marketplace that include the word TAG. As will become apparent however, this evidence is not determinative in this case.

#### Summary of the Opponent’s Reply Evidence

##### *Affidavit of Claire Cébron*

[36] Ms. Cébron identifies herself as an articling student with the Opponent’s agents of record. Her affidavit appears to be directed towards replying to the Applicant’s state of the register evidence. She states she has consulted CIPO’s Strategis database and downloaded a series of register pages for marks that include the word TAG on December 24, 2007. She provides the printouts for each of these marks from the Strategis database as Exhibit CC-1. She summarizes her findings in a chart that indicates that the trade-marks she looked up incorporate the element “TAG” and provides the respective application numbers, registration numbers, and status.

[37] The evidence indicates (as of December 24, 2007) that the following trade-marks had been opposed by the Opponent:

- RED TAG – Application No. 1, 159,455
- TAGGIES – Application No. 1, 164, 479
- TAGGIES & Design – Application No. 1, 237, 253
- TAGALONGS – Application No. 1, 265,900, and
- MY TAGALONGS – Application no. 1, 322, 882

[38] The trade-marks remaining on the register were:

- TAG HEUER & Design – Registration No. TMA362, 318
- TAG HEUER & Design – Registration No. TMA443, 848
- TAG HEUER & Design – Registration No. TMA589, 413
- JON TAGIA – Registration No. TMA409, 074
- TAG RAG – Registration No. TMA455, 636
- TAGFLAG – Registration No. TMA451, 244
- TAGUS PARK – Registration No. TMA582,249
- TRIMTAG – Registration No. TMA614,812; and
- FREITAG & Design – Registration No. 649, 336

*Onus*

[39] 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

*Grounds of Opposition under s. 30*

[40] With respect to the ground of opposition based on s. 30(a), the Opponent argues that “sleepwear” is not defined in ordinary commercial terms. In support of this allegation the Opponent filed evidence of a search of the Canadian Trade-marks database revealing 500 registrations and/or approved applications wherein “sleepwear” was followed by “namely”. The Opponent also filed evidence that its initial search of the database revealed in excess of 2,500 entries where “sleepwear” was preceded by “namely”. The Opponent argues that the evidence supports its contention that “sleepwear” is not normally accepted without further specification, however I agree with the Applicant that the evidence filed does not necessarily support this conclusion. First of all, clearly, there are more entries where sleepwear is not preceded by namely, thus one might infer, by the Opponent’s logic, that it is acceptable in general as sufficiently specific. In any event, as I have previously observed, there is no indication in evidence if the respective owners of the registrations and applications where sleepwear is preceded by namely, voluntarily specified sleepwear, or if they were asked to do so during the trade-mark examination process.

[41] Further, I find that the first affidavit of Lorraine Laquerre does in fact indicate that “sleepwear” is sufficiently specific and therefore acceptable as an ordinary commercial term. Ms. Laquerre’s search disclosed many entries under that terminology supporting the fact that it is an ordinary commercial term; the fact that “sleepwear” encompasses a number of individual products does not mean that “sleepwear” itself is not sufficiently specific and unacceptable for the purposes of s. 30(a). In addition, I am guided by the Canadian Oxford Dictionary Online definition of *sleepwear* as; “*pyjamas or other suitable clothing worn to bed; clothing worn to bed.*”

[42] I would also observe in passing that the *CIPO Wares and Services Manual* does list “sleepwear” as acceptable without further specification.

[43] Furthermore, while it might be logical to infer that much of this evidence was on the register at the material date, given that the search was conducted within 14 months of the date of

filing of the application, since I am unable to ascertain on the face of the evidence whether or not such statements of wares might be subject to amendments or additions since the date of the filing of the application, I am unwilling to make any inferences concerning the state of affairs at the material date for consideration of s.30(a) of the Act.

[44] Accordingly, I find that “sleepwear” is sufficiently specific and an ordinary commercial term, given that it clearly refers to clothing items that may be worn for sleeping. This ground of opposition is therefore dismissed.

[45] With respect to the ground of opposition based on s. 30(e) of the Act, the Opponent may rely on the Applicant’s evidence to meet its initial burden in relation to this ground but the Opponent must show that the evidence is clearly inconsistent with the Applicant’s claim [see *Molson Canada v. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.T.D.) and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 T.M.O.B.]. In the present case, there is nothing in the Applicant’s evidence which is clearly inconsistent with the claim that it intended to use the Mark in association with wares. Accordingly, the s. 30(e) ground is also dismissed.

[46] With respect to the ground of opposition based on s. 30(i) of the Act, no evidence was filed demonstrating that the Applicant was aware of any prior rights of the Opponent when it filed its application. Even if the Applicant was aware of the Opponent’s use in Canada of the Opponent’s trade-marks, that alone would not prevent the Applicant from making in good faith the statement required. Where an applicant has provided the statement required by s. 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is dismissed.

#### *Ground of Opposition under s. 12(1)(b)*

[47] The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) since the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used.

[48] The Opponent has the initial burden of proof to provide some admissible evidence from which it might reasonably be concluded that the facts alleged in support of the ground of opposition exist [see *Joseph E. Seagram & Sons, Limited v. Seagram Real Estate* (1984) 3 C.P.R. (3d) 325 at 329 (F.C.T.D.); *John Labatt Ltd v. Molson Cos Ltd.* (1980) 30 C.P.R. (3d) 293 affirmed (1992) 42 C.P.R. (3d) 495 (F.C.A.)].

[49] The issue as to whether the Mark is clearly descriptive must be considered from the point of view of the average purchaser of the associated wares. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [*Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, (1978) 40 C.P.R. (2d) 25 at 27-8 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade Marks*, (1984) 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.)]. To be objectionable as clearly descriptive under s.12(1)(b) a mark must be a word so apt for normal description of the article, that a monopoly on the use of it should not be acquired [*Clarkson Gordon v. Registrar of Trade-marks* (1985) 5 C.P.R. (3d) 252 at 256 (F.C.T.D.)].

[50] The Opponent’s initial onus has been met in view of the ordinary meaning of the words TAG and LESS.

[51] Having regard to the principles reviewed above, I find that TAGLESS when viewed in association with sleepwear is clearly descriptive; as a matter of first impression on the average purchaser, the “self-evident” meaning of the Mark is that the wares are without a tag.

[52] I do not agree with the Applicant’s submissions that TAGLESS might just as easily be a suggestion of a “no name” brand, thereby appealing to anti-brand name consumers. Rather, I am of the view that on seeing TAGLESS a consumer of sleepwear would immediately think that the wares bore no labels. With respect to the argument that the Mark is not a clear description of an intrinsic characteristic of the sleepwear, I am of the view that being “tagless” is a special feature of the wares that is desirable to some consumers, and thus being tagless is intrinsic to those particular products, as are other features such as the fabric content, for example.

[53] In coming to this decision I have had some regard to the second affidavit of Ms. Laquerre that included web pages with references to tagless T-shirts as having no label, and to the indication that this is a desirable feature of the clothing. I do not give the affidavit definitive weight in this matter; however, as noted previously, I am willing to consider that it supports the conclusion arrived at from application of the legal principles as set out above.

[54] I am not satisfied that the Applicant has discharged its burden of establishing that on a balance of probabilities that the Mark not clearly descriptive within the meaning of s. 12(1)(b) of the Act. Therefore the Opponent is successful on this ground of opposition.

*Ground of Opposition under s.2 Distinctiveness*

[55] The Opponent has pleaded that the trade-mark is not distinctive, within the meaning of s. 2 of the Act, by reason of the fact that the Mark does not actually distinguish and is not adapted to distinguish the wares in association with which it is proposed to be used by the Applicant from the wares of others, including those of the Opponent. The Opponent has also pleaded that the Mark does not function as a trade-mark.

[56] In *Canadian Council of Professional Engineers v. APA- The Engineered Wood Assn.* (2002), 7 C.P.R. (4th) 239 (F.C.T.D.) Mr. Justice O’Keefe stated, “a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive”. Therefore based on my earlier finding that the Mark is clearly descriptive, I conclude that the Mark is also not inherently adapted to distinguish the wares of the Applicant from similar wares of others.

[57] In addition, the application is based on proposed use, and the Applicant has not filed any evidence of use since the filing of its application, with the result that there is no basis on which to conclude that as of February 17, 2006 the Mark had acquired sufficient distinctiveness in Canada to result in it actually distinguishing the Applicant’s wares.

[58] Accordingly, this ground of opposition succeeds.

[59] Having already determined that the Opponent is successful on two grounds, it is not necessary to discuss the remaining grounds of opposition.



[60] In view of all of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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P. Heidi Sprung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office