

**IN THE MATTER OF AN OPPOSITION  
by Venator Group Canada Inc. to application  
No. 772,603 for the trade-mark NORTHERN  
NATURALS filed by Upstein's Limited**

---

**On January 11, 1995, the applicant, Upstein's Limited, filed an application to register the trade-mark NORTHERN NATURALS based on use in Canada since July of 1994 with the following wares:**

shorts, tops, blouses, pants and other clothing, namely T-shirts, sweatshirts, sweat pants, shirts, denim jeans, pants, slacks, blouses, skirts, jackets, shorts and tops.

**The application was advertised for opposition purposes on September 13, 1995.**

**On January 31, 1996, Woolworth Canada Inc. (now Venator Group Canada Inc.), filed a statement of opposition, a copy of which was forwarded to the applicant on February 20, 1996. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(b) of the Trade-marks Act because the applicant did not use the applied for trade-mark with the applied for wares since the date claimed.**

**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 following trade-marks of the opponent registered for various clothing items and/or the operation of a clothing store:**

<u>Registration No.</u>	<u>Trade-mark</u>
424,058	NORTHERN TRADITIONS
410,327	NORTHERN TRADITIONS
428,058	NORTHERN TRADITIONS & Design
427,812	NORTHERN AUTHENTICS & Design
427,811	NORTHERN REFLECTIONS AUTHENTICS
372,905	NORTHERN REFLECTIONS
372,896	NORTHERN REFLECTIONS & Design
406,620	NORTHERN GETAWAY
406,621	NORTHERN GETAWAY
430,146	NORTHERN GETAWAY & Design

425,563

NORTHERN GETAWAY & Design

449,944

NORTHERN REFLECTIONS & Design

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the registered trade-marks noted above previously used in Canada by the opponent and with the trade-mark NORTHERN REFLECTIONS previously used in Canada by the opponent with footwear. The fourth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's various trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Richard D. Fulwood, Vice-President of Sales for the Northern Group of Woolworth Canada Inc. As its evidence, the applicant submitted the affidavits of Lisa Corbeil and R.L. (Bob) Moore. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show that its application conforms with the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the

applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

Although the opponent's evidence does not support its first ground of opposition, the Moore affidavit does. Mr. Moore identifies himself as the President and owner of the applicant, Upstein's Limited. He concedes that his company only commenced using the trade-mark NORTHERN NATURALS for jeans, pants and slacks in November of 1995. Furthermore, he concedes that the trade-mark has not yet been used in association with shorts and blouses. Thus, the first ground of opposition is successful in respect of those wares.

Mr. Moore states that the trade-mark NORTHERN NATURALS was in use as of the claimed date (i.e. - July 31, 1994) for sweatshirts and t-shirts. Mr. Moore indicates that his company orders plain sweatshirts and t-shirts from suppliers who affix a garment label to the goods bearing the applicant's trade-mark and the applicant's identification number (i.e. - CA 30446) pursuant to the Textile Labelling Act. According to Mr. Moore, once the applicant receives blank sweatshirts and t-shirts from its supplier, it affixes the trade-mark NORTHERN NATURALS and various designs on the front of the shirts by means of heat transfers.

Appended as exhibits to Mr. Moore's affidavit are a number of invoices for sweatshirts and t-shirts from one of his company's suppliers. However, only one of those invoices is dated prior to the applicant's claimed date of first use, namely Exhibit C which is dated May 26, 1994. Furthermore, it seems unlikely that those sweatshirts bore the garment label referred to by Mr. Moore since the applicant did not receive approval for its identification number until January 11, 1995 which was well after the claimed date of first use (see Exhibit C to the Moore affidavit).

Appended as Exhibits K through R to the Moore affidavit are invoices for heat transfers including NORTHERN NATURALS heat transfers. The earliest of those invoices is dated August 4, 1994 which is after the applicant's claimed date of first use.

**In view of the above, I find that the evidence of record meets the opponent's evidential burden in that it is inconsistent with the applicant's claimed date of first use. It was therefore incumbent on the applicant to clearly evidence use of its trade-mark NORTHERN NATURALS for t-shirts and sweatshirts on or before July 31, 1994. Thus, the first ground of opposition is also successful in relation to sweatshirts and t-shirts. Given Mr. Moore's concessions respecting the remaining wares in the application, the first ground of opposition is successful in relation to all of the wares in the application.**

**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 Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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 mark NORTHERN NATURALS is somewhat suggestive of clothing emanating from, or designed for use in, a northern climate and made from natural fibers. Thus, the applicant's mark is not an inherently strong mark. At best, the Moore affidavit evidences limited sales of NORTHERN NATURALS clothing items through several stores in three communities in Newfoundland. Thus, I am only able to conclude that the applicant's mark has become known to a limited extent in one area of that province.**

**The opponent's marks comprising or including the words NORTHERN TRADITIONS, NORTHERN REFLECTIONS, NORTHERN GETAWAY and NORTHERN AUTHENTICS are inherently distinctive in relation to clothing wares and services. At most, they have a suggestive connotation related to a possible northern source. Thus, the opponent's registered marks are inherently stronger than the applicant's mark.**

**The Fulwood affidavit evidences extensive sales by the opponent through its retail clothing outlets in Canada operating under the trade-mark NORTHERN REFLECTIONS. According to Mr. Fulwood, the opponent started using the mark in November of 1986 and, as of the date of his affidavit (March 14, 1997), the opponent was operating 190 NORTHERN REFLECTIONS stores in Canada and 352 outlets in the United States. Sales from 1987 to 1996 through the Canadian stores (including sales of wares bearing the NORTHERN REFLECTIONS mark) totalled in excess of one billion dollars. According to Mr. Fulwood, advertising expenditures for that period were in excess of \$2.4 million. Thus, I am able to conclude that the opponent's trade-mark NORTHERN REFLECTIONS has become very well known throughout Canada in association with clothing and retail clothing stores.**

**The Fulwood affidavit also evidences fairly extensive sales by the opponent through its retail outlets in Canada operating under the trade-mark NORTHERN TRADITIONS. The opponent started using the mark in July of 1991 and, as of March 14, 1997, the opponent was operating 44 stores in Canada under that mark. Sales from 1991 to 1996 through the opponent's Canadian stores (including sales of wares bearing the NORTHERN TRADITIONS mark) totalled in excess of \$100 million. From a review of the exhibits to the Fulwood affidavit, it is apparent that those sales covered women's clothing and accessories. Thus, I am able to conclude that the opponent's mark NORTHERN TRADITIONS has become well known in Canada in association with women's clothing and retail stores selling such clothing.**

**The Fulwood affidavit also evidences fairly extensive sales of children's clothing through the opponent's retail outlets operating under the trade-mark NORTHERN GETAWAY & Design. As of March 14, 1997, there were 98 such outlets in Canada and sales for the period 1992 to 1996 totalled in excess of \$200 million. Thus, I am able to conclude that the mark NORTHERN GETAWAY & Design has become well known in Canada in association with children's clothing and retail stores selling such wares.**

Finally, Mr. Fulwood evidences some minor use of the opponent's trade-marks comprising or including the words NORTHERN AUTHENTICS. However, that use has been minimal and I can only ascribe a limited reputation for those marks in Canada.

The length of time the marks have been in use favors the opponent. As for the wares, services and trades of the parties, it is the applicant's statement of wares and the opponent's statements of wares and services in its twelve registrations that govern: 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. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The applicant's wares are clothing items. The opponent's wares comprise clothing, accessories and footwear and its services consist of the operation of retail outlets selling such items.

As for Section 6(5)(e) of the Act, I consider that there is a fair degree of visual and phonetic resemblance between the marks at issue in view of the fact that they all commence with the word NORTHERN. To the extent that each mark suggests a northern connection, there is some resemblance between the ideas suggested by the marks.

The manner of use of the applicant's trade-mark on labels used for jeans heightens the degree of resemblance with respect to the opponent's trade-mark NORTHERN AUTHENTICS. As illustrated in Exhibits S, T and U to the Moore affidavit, the applicant's labels include the word AUTHENTIC either above or below the words NORTHERN NATURALS.

An additional surrounding circumstance in the present case is the existence of a family or series of trade-marks owned and used by the opponent. As noted, the opponent operates three chains of clothing stores under different trade-marks commencing with the word NORTHERN and sells some clothing wares bearing those marks. Sales through all three chains have been significant. The opponent has also shown some minor use of another family member - i.e. - the trade-mark NORTHERN AUTHENTICS.

In view of the above, I find that the opponent has established the existence of a family of NORTHERN trade-marks in the retail clothing industry. Thus, in accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.), consumers viewing a mark commencing with the component NORTHERN for clothing wares or services would be more likely to associate such a mark with the opponent.

As another surrounding circumstance, the applicant has relied on the state of the register evidence in the Corbeil affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Ms. Corbeil searched the records of the Canadian Trade-marks Office with a view to locating trade-marks for clothing incorporating the word NORTHERN. Ms. Corbeil located 28 registrations for such marks standing in the names of 22 different owners. Given those results, I am able to conclude that there are a number of NORTHERN trade-marks in active use in the clothing industry. Thus, I am able to conclude that consumers have become familiar with trade-marks incorporating the word NORTHERN in the clothing trade and are therefore more likely to distinguish such marks based on their other components.

**In her affidavit, Ms. Corbeil also indicates that she conducted a search of a database containing domain names used on the Internet. Her search revealed a fairly large number of such names containing the word NORTHERN although less than 40 had Canadian addresses. More importantly, her search gives no indication of what those domain names are used for. In particular, there is no indication that any of them have been actively used in association with any type of business, much less a clothing business. Thus, this evidence is of no assistance in the present case.**

**Ms. Corbeil also states that she instructed others to perform a “Common Law” search in various registers, directories and printed sources. Exhibit LC-3 to her affidavit comprises the results of that search. Little weight can be given to those results, however, since they constitute inadmissible hearsay having been compiled by someone other than Ms. Corbeil. Apart from the hearsay deficiency, the results would appear to be of little help in this case since there is no clear indication of what sources were searched, what the results mean and whether or not any references located refer to business entities engaged in the retail clothing trade. A cursory review of some of the results suggests that many of the references located may, in fact, be individual retail outlets operated by the opponent under its various trade-marks throughout Canada. This highlights the potential danger in making inferences about the state of the marketplace from unreliable evidence.**

**In his affidavit, Mr. Moore states that he is unaware of any confusion between his company’s trade-mark and the opponent’s trade-marks. However, the evidence shows that the applicant’s sales to date have been very limited and made exclusively through its own stores in three communities in Newfoundland. Given that the actual trades of the parties have up until now been separated and given the limited sales of the applicant’s wares, the absence of evidence of actual confusion is not surprising.**

**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 overlap in the wares and trades of the parties, the extent to which the opponent’s**



marks have become known, the resemblance between the marks at issue and the existence of the opponent's family of NORTHERN trade-marks and notwithstanding the common use by others of NORTHERN marks in the clothing trade, I find that I am left in a state of doubt respecting the issue of confusion between the applicant's trade-mark NORTHERN NATURALS and the opponent's registered trade-marks. I must resolve that doubt against the applicant and the second ground of opposition is therefore successful.

As for the third ground of opposition, in view of the success of the first ground of opposition, there was an initial onus on the opponent to evidence use of each of its marks prior to the applicant's filing date (rather than the applicant's claimed date of first use) and non-abandonment of those marks as of the applicant's advertisement date. The opponent has satisfied these burdens by means of the Fulwood affidavit.

The third ground of opposition therefore remains to be decided on the issue of confusion between the applicant's mark and each of the opponent's marks as of the material time which is January 11, 1995. My conclusions respecting the second ground are, for the most part, applicable to this ground as well although the reputation associated with each of the opponent's marks may be somewhat less in view of the earlier material time. Thus, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's previously used marks and the third ground is also successful.

As for the fourth 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 those 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. - January 31, 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.).

**Given my conclusions respecting the second and third grounds of opposition, it also follows that the applicant has failed to show that its applied for mark is not confusing with the opponent's trade-marks as of the filing of the opposition. It therefore follows that the applicant's trade-mark was not capable of distinguishing its wares from those of the opponent as of that date. The fourth ground is therefore also successful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT HULL, QUEBEC, THIS 24<sup>th</sup> DAY OF MAY, 2000.**

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