

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION
BY Mexx International B.V. to the application
for registration No. 851106
for the trade-mark
LES MECS, owned by Maryo Poulin**

Maryo Poulin (the Applicant) filed an application on July 17, 1997, for registration of the trade-mark LES MECS (the Mark), in association with men's and women's clothing, namely: undergarments and specifically boxer shorts, socks, sleepers, women's pyjamas, bathrobes, waist-cloth, sports shorts, and casual coordinates, used in Canada since July 1, 1997, and in association with beach outfits consisting of jackets and swim suits, men's and women's accessories, namely: slippers and belts, based on a proposed use. This application for registration was published in the *Trade-marks Journal* on January 12, 2000.

Mexx International B.V. (the Opponent) filed a statement of opposition on February 24, 2000, on the grounds that:

- (a) the Applicant has not used the Mark in Canada since July 1, 1997, in association with men's and women's clothing, namely: undergarments and specifically boxer shorts, socks, sleepers, women's pyjamas, bathrobes, waist-cloth, sports shorts, and casual coordinates, as alleged in its application for registration;
- (b) the Applicant did not intend to use the Mark on July 17, 1997, in association with beach outfits consisting of jackets and swim suits, men's and women's accessories, namely: slippers and belts, as alleged in its application for registration;
- (c) the Mark is not registrable under the provisions of paragraph 12(1)(d) of the *Trade-marks Act* (the Act) in that it causes confusion with the Opponent's family of registered trade-marks, namely:

MEXX certificate of registration 334906

MEXX certificate of registration 472051

MEXX certificate of registration 433299

MEXX and Design certificate of registration 337047

MEXX

MEXX and Design certificate of registration 374394

MEXX

MEXX and Design certificate of registration 475638

MEXX

MEXX and Design certificate of registration 466266

MEXX

MINI MEXX certificate of registration 442683

Hereinafter collectively referred to as the “Opponent’s marks”

- (d) The Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(1)(a) of the Act, in that as of July 1, 1997, the date of first use of the Mark in association with men’s and women’s clothing, namely: undergarments and specifically boxer shorts, socks, sleepers, women’s pyjamas, bathrobes, waist-cloth, sports shorts, and casual coordinates, the Mark caused confusion with the Opponent’s Marks and the trade-mark XX BY MEXX and design described in the application for registration number 883850, as all of these Marks belonging to the Opponent have been previously used by the Opponent or by its licensees in Canada in association with the wares specified in said certificates of registration or application for registration;
- (e) The Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(3)(a) of the Act, in that as of July 17, 1997, the date of filing of the application for registration of the Mark in association with the beach outfits consisting of jackets and swim suits, men’s and women’s

accessories, namely: slippers and belts, the Mark caused confusion with the Opponent's Marks and the trade-mark XX BY MEXX Design, described in the application for registration number 883850, as all of these Marks belonging to the Opponent have been previously used by the Opponent or by its licensees in Canada in association with the wares specified in said certificates of registration or application for registration;

- (f) The Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(1)(c) of the Act, in that as of July 1, 1997, the date of first use of the Mark in association with men's and women's clothing, namely: undergarments and specifically boxer shorts, socks, sleepers, women's pyjamas, bathrobes, waist-cloth, sports shorts, and casual coordinates, the Mark caused confusion with the Opponent's trade name MEXX used previously in Canada by the Opponent in association with the wares covered under the certificates of registration of the Opponent's Marks and the wares covered in its application for registration mentioned above;
- (g) The Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(3)(c) of the Act, in that as of July 17, 1997, the date of filing of the application for registration of the Mark in association with beach outfits consisting of jackets and swim suits, men's and women's accessories, namely: slipper and belts, the Mark caused confusion with the Opponent's trade name, MEXX, previously used in Canada by the Opponent in association with the wares covered under the certificates of registration of the Opponent's Marks and the wares covered in its application for registration, mentioned above;
- (h) The Mark is not distinctive and has not been adapted to distinguish the Applicant's wares in Canada from the Opponent's wares previously sold by the Opponent in Canada in association with the Opponent's Marks which incorporate the word MEXX in that it causes confusion with each and every one of the Opponent's Marks and the Mark described in the application for registration, mentioned above.

The Applicant filed a counter-statement of opposition in which it essentially denies the allegations contained in the statement of opposition, adding that there had not been any cases of confusion between the Mark and the Opponent's Marks even though they were both used in the same territory. The Applicant also alleges that each and every allegation in the Opponent's statement of opposition is inadequate, vague and unclear, preventing the Applicant from defending itself fully against the opposition.

The Opponent filed the affidavits of Joseph Nezri and Arun Mehta. The Applicant filed the affidavit of Maryo Poulin. None of these affiants was cross-examined. The parties filed a written argument and only the Opponent was represented at the hearing. At the hearing, the Opponent's agent aptly pointed out that, on October 30, 2000, it had filed an application for extension of time for the filing of Mr. Mehta's affidavit. This application had not been contested by the Applicant and was not ruled on by the Registrar. The affidavit has already been served and filed in the record. For the record, I am giving the Opponent permission to produce said affidavit because this will not cause any prejudice to the Applicant.

At this point, it would be appropriate to dispose of the Applicant's argument concerning the inadequacy and lack of clarity of the paragraphs in the statement of opposition. This argument was not included in the written argument of the Applicant. In any case, if the allegations in the statement of opposition were inadequate or unclear, the evidence filed by the Opponent and summarized below made up for this alleged shortcoming. The Registrar must consider the evidence in the record when he addresses this issue after it has been filed in the record. [See *Novopharm Limited v. AstraZeneca AB et al.*, (2002) 21 C.P.R. (4th) 289].

Mr. Joseph Nezri is the founding president of MEXX Canada Inc. (Mexx Canada), initially incorporated under the name 111736 Canada Inc. on November 25, 1981. This corporation then amended its corporate name several times after its incorporation before finally adopting the trade name MEXX Canada Inc. on September 2, 1986. On January 31, 1985, the Opponent named MEXX Canada as its sole distributor, in Canada, of wares bearing the Opponent's Marks or any Mark bearing the letters XX in addition to the word MEXX. MEXX Canada obtained a licence to use the Opponent's Marks in order to promote wares bearing the Opponent's marks. The Opponent and

MEXX Canada are bound by a contract for services in which the Opponent undertook to provide support and control services to MEXX Canada. MEXX Canada also received permission to use the word MEXX as a component of its trade name.

Since 1985, MEXX Canada's sales of wares bearing a trade-mark containing the word MEXX or the letters XX in addition to MEXX, including men's and women's clothing namely: pants, shorts, Bermuda shorts, swimwear, sweaters, cardigans, t-shirts, coats, suits, jackets, raincoats, scarves, belts, socks, and gloves; men's undergarments, shirts and ties, men's and women's sportswear; women's skirts, dresses and shirts; men's and women's shoes, children's clothing, namely, pants, dresses, vests, singlets, t-shirts, sweatshirts, cardigans, shirts, jackets, dresses, jumpsuits, caps, hats, swim suits, headbands, culottes, undergarments, sweaters, socks, suspenders, tights, vests, belts, blazers, coats and spencers; Soaps, perfumery, namely eau de toilette, perfume and eau de Cologne essential oils; cosmetics; nail care products (note: this list is not as exhaustive as the list appearing in Mr. Nezri's affidavit but includes the wares that are the most relevant to this case) totalled more than \$350,000,000. These clothes are sold wholesale in Canada by MEXX Canada to department stores such as The Bay and the Ailes de la Mode and to more than 800 clothing boutiques across Canada. It is not clear from the affidavit if these are boutiques operating under the trade-mark MEXX. However, Mr. Mehta, in his affidavit, at paragraph 7, refers to the sale of clothing bearing the Mark MEXX in MEXX boutiques operated in Canada.

Several colour photocopies of clothing samples upon which there are tags bearing the trade-mark MEXX, MEXX and design, XX BY MEXX and XX and design were appended to the Mr. Nezri's affidavit as exhibit A. Mr. Nezri states that these tag samples indicate how the Opponent's Marks are used on clothing sold in Canada.

Since 1985, MEXX Canada has spent more than \$30,000,000 to promote wares bearing the MEXX trade-mark in Canada. The media used are: television, radio, the press and the Internet. Advertising samples that appeared in Elle Québec magazine to promote the sale of wares bearing the trade-mark MEXX were filed with Mr. Nezri's affidavit as exhibit C. This evidence cannot be very useful because no information was provided concerning the distribution of this magazine in Canada. Pages from the website address www.mexx.com were also filed under the same tab. It must be noted,

however, that the affidavit does not mention when this website was created, the number of Canadians who have visited it since it was created, and the date that these pages appeared. For these reasons, these documents will not be of much use.

Mr. Mehta is the Opponent's Corporate Vice-President. He explains the origin of the choice of the trade-mark MEXX. It is a combination of two trade-marks that the Opponent had used before, MOUSTACHE and EMMANUELLE, and the letters "XX" representing two kisses. Mr. Mehta refers to the adoption of a number of marks, such as MEXX Bags, MEXX Bed & Bath, MEXX Eyes, MEXX Jewels, MEXX Scents, MEXX Shoes, MEXX Socks and MEXX Time. None of these Marks is alleged in support of the statement of opposition and, accordingly, I will not take these Marks into consideration. Moreover, there is no evidence in the record of the use of these Marks in Canada, within the meaning of section 4 of the Act.

Essentially, he repeats the same allegations as those described above, which are found in Mr. Nezri's affidavit concerning the contractual relationship between MEXX Canada and the Opponent. He also explains that the Opponent creates a collection of wares that it submits for consultation to, *inter alia*, MEXX Canada, which gives its input and orders the different wares that interest it. The Opponent arranges the quality control inspections of wares manufactured for it and which will bear the Opponent's marks. At paragraph 12 of his affidavit, he refers to the registrations of the Opponent's Marks in Canada, but without producing a certificate of authenticity for each of them. There is therefore a deficiency in the Opponent's evidence. However, the caselaw has held that the Registrar can consult the Trade-marks Register to confirm the existence of these certificates of registration that are alleged in support of the grounds of opposition based on paragraph 12(1)(d) of the Act. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410]. I checked the register and can confirm the existence of the registration of the Opponent's Marks and that they are still valid.

The other allegations of his affidavit concern the importance of the trade-mark MEXX to the Opponent and the association that the consumer would make between the letters "XX" and the Opponent. There is no reference to the Canadian consumer and no expert's report filed to support this claim about this association. It is therefore hearsay evidence that is inadmissible.

Mr. Poulin is the Applicant in this case. He alleges that he has read the affidavits of Messrs. Nezri and Mehta. He alleges that there is no resemblance between the Mark and the Opponent's Marks in terms of their appearance or pronunciation. He states that the Mark does not cause confusion with the Opponent's marks. These allegations are of very little use when they come from a party with an interest in the litigation. Moreover, this is a statement of law and not of fact, which is a matter for the Registrar. I must therefore disregard these allegations.

Mr. Poulin seeks to distinguish the wares listed in this application for registration from those sold in association with the trade-mark MEXX by alleging that they are conceptually different. He also alleges that he was not aware of any cases of confusion between the Mark and those of the Opponent even if they are "used" in the same territory, i.e. the Montreal Urban Community. He alleges he has used the Mark since July 1, 1997, without identifying the wares sold in association with the Mark at that date. He nevertheless alleges that he has used the Mark since May 1, 2000, in association with beach outfits consisting of jackets and swimsuits, men's and women's accessories, namely: slippers and belts.

The word "use" is a legal term defined in section 4 of the Act. This statement by the affiant is a conclusion of law and is therefore not admissible into evidence [See *Conde Nast Publications Inc. v. Union des Éditions Modernes (1979)*, 46 C.P.R. (2d) 183]. It falls upon the Registrar to determine if a mark has been used within the meaning of section 4 of the Act according to the evidence in the record. Evidence of use of a trade-mark in association with wares must be done by demonstrating that the trade-mark appeared on the wares or on their packaging at the time that the ownership of the wares was transferred. [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc. (1980)*, 53 C.P.R. (2d) 62].

The relevant date for the analysis of the different grounds of opposition varies according to the ground of opposition that is raised. So, with reference to the grounds of opposition based on section 30 of the Act, the relevant date is the date of filing of the application (July 17, 1997) [see *Dic Dac Holdings (Canada) Ltd. v. Yao Tsai Co. (1999)*, 1 C.P.R. (4th) 263]. With reference to the ground of opposition based on paragraph 12(1)(d) of the Act, the relevant date is that of my

decision [See *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 (FCA)]. When the ground of opposition is based on subsection 16(3) of the Act, the date of filing of the application for registration (July 17, 1997) is the reference date as stipulated in that subsection. If the ground of opposition is based on subsection 16(1) of the Act, the date of first use of the Mark (July 1, 1997) becomes the reference date, as stipulated in that subsection. Finally, it is generally recognized that the date of filing of the opposition (February 24, 2000) is the relevant date for the analysis of the ground of opposition based on the mark's lack of distinctiveness. [See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d) 126 (F.C.A.) at page 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., op.cit.*].

For the purposes of procedure, in matters involving an opposition to the registration of a trade-mark, the Opponent must present sufficient evidence about the grounds upon which it is based so that it is apparent that there are facts that support these grounds of opposition. If this task is accomplished, the burden of proof shifts to the Applicant, who will have to persuade the Registrar that the grounds of opposition should not preclude the registration of its trade-mark [See *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984)*, 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited, (1990)*, 30 C.P.R. (3d) 293].

From the evidence summarized above, it appears that the Opponent has not discharged its initial burden of proof relating to the ground of opposition (b), described above. In effect, there is no evidence that the Applicant did not intend to use the Mark in association with beach outfits consisting of jackets and swimsuits, men's and women's accessories: slippers and belts. This ground of opposition is therefore unsuccessful.

The Opponent claims that the Applicant could not have been using the Mark in Canada since July 1, 1997, in association with men's and women's clothing, namely: undergarments and specifically boxer shorts, socks, sleepers, women's pyjamas, bathrobes, waist-cloth, sports shorts, and casual coordinates, because this date falls on a statutory holiday. It should be noted that the Opponent did not present any evidence to contest this date of first use of the mark. Nevertheless, the Opponent can refer to the evidence filed in the record by the Applicant to

support its allegations. [See *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Hearst Communications Inc. v. Nesbitt Burns Corp.*, (2000) 7 C.P.R. (4th) 161 (T.M.O.B). *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) and *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)].

In *Thomson Research Associates Ltd. v. Daisyfresh Creations Inc.*, (1983) 81 C.P.R. (2d) 27, Mr. Martin, a member of the Trade-marks Opposition Board, concluded that the reference to a date of first use of a trade-mark that corresponds to a statutory holiday raises a doubt about the veracity of this claim especially when there is no evidence of use of the Mark on that date. This doubt is enough to shift the burden of proof onto the Applicant, who must establish that the Mark was used beginning on July 1, 1997 [See *Hearst Communications Inc. v. Nesbitt Burns Corp.*, (2000) 7 C.P.R. (4th) 161 (T.M.O.B.)]. As there is no evidence of use of the Mark beginning on July 1, 1997, I must find that the first ground of opposition, described above, is successful with respect to the following wares: beach outfits consisting of jackets and swimsuits, men's and women's accessories, namely: slippers and belts.

I must nevertheless proceed with an analysis of the other grounds of opposition. The question of whether the Mark causes confusion with the Opponent's Marks or its trade name is the key element of the other grounds of opposition that must be addressed (grounds of opposition (c) to (h) inclusive, described above). In order to determine if the use of the Mark would be likely to cause confusion with the Opponent's Marks I must turn to the approach prescribed by section 6 of the Act, which reads as follows:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

(2) 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 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.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services

are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- (b) the length of time the trade-marks or trade-names have been in use;
- (c) the nature of the wares, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

It has been clearly established that the list of circumstances set out in subsection 6(5) of the Act is not exhaustive and that it is not necessary to give each area of inquiry the same weight [see, for example *Clorox Co. v. Sears Canada Inc. (1992)*, 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon (1996)*, 66 C.P.R. (3d) 308 (F.C.T.D.)]. The Honourable Mr. Justice Cattanach described the confusion test as follows in *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975)*, 25 C.P.R. (2d) 1:

To determine whether two trade Marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

In considering the similarity of trade Marks it has been held repeatedly that it is not the proper approach to set the Marks side by side and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression. I therefore propose to examine the two Marks here in dispute not for the purpose of determining similarities and differences but rather to

assess the attitude of the average reasonable purchaser of the wares as a matter of first impression.

(i) the distinctiveness of the marks

The Opponent's trade-mark MEXX is a word invented by combining the words "Moustache" and "Emmanuelle" and the letters "XX". This trade-mark does not have any connotation with clothes. Moreover, the evidence in the record — tags, sales and advertising figures — enables me to conclude that there has been an exhaustive use of this Mark in Canada, since at least 1985, in association with men's and women's clothing. It is obvious that this trade-mark is distinctive.

The Applicant's Mark is made up of the article "Les" and the French word "Mecs" which is defined in *Le Petit Larousse, dictionnaire de la langue française* as follows:

homme énergique, viril.

[Translation] energetic, virile man.

Although the Mark is not descriptive of wares that the Applicant counts on selling in association with this, it nonetheless suggests the type of people to whom the wares will be targeted. This factor therefore favours the Opponent.

(ii) the period during which the trade-marks or trade-names have been in use

There is no evidence of use of the Mark by the Applicant, while the evidence summarized above supports the finding that the trade-mark MEXX has been in use in Canada in association with clothing since at least 1985. This factor therefore also favours the Opponent.

(iii) the nature of the wares, services or business

The list of wares set out in certificates of registration numbers 334906 and 337047 for the Opponent's trade-marks MEXX and MEXX and design covers, *inter alia*, pants, Bermuda shorts, shorts, t-shirts, sweaters, suit jackets, coats, raincoats, scarves, socks, men's shirts, to name only a few. The list of wares set out on certificate of registration number 442683 for the Opponent's trade-mark MINI MEXX includes not only some of the clothing mentioned above, but also undergarments.

The Applicant admits, in its written submissions, that there are some wares listed in this application for registration that are identical to those listed in certificates of registration numbers 334906, 337047 and 442683, but it claims that these wares are conceptually different. This argument does not hold. The identity of the wares at issue is one of the elements that could cause confusion among consumers. It is sufficient that these wares could be sold in the same type of business for there to be a risk of confusion. [See *Cartier Men's Shops Ltd. v. Cartier Inc. (1981)*, 58 C.P.R. (2d) 58]. The appearance or concepts suggested by the clothing cannot help the Applicant's case and this factor therefore favours the Opponent.

(iv) the nature of the trade

The Opponent creates, manufactures, or has its clothing manufactured according to its specifications. Then its clothing, bearing its trade-marks, is sold in Canada in department stores or in stores bearing the MEXX name. There has been no evidence submitted by the Applicant to explain the nature of its commercial activities and thus attempt to distinguish them from those of the Opponent. It must be presumed that the Applicant's wares could also be sold in the same type of business that sells the wares bearing the Opponent's trade-marks. This factor also favours the Opponent.

(v) the degree of resemblance between the trade-marks

With regard to this factor, it is appropriate to recall the remarks of Mr. Justice Cattanach in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd. (1980)*, 47 C.P.R. (2d) 145, *conf. 60 C.P.R. (2d) 70*:

Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.

The Marks must be analysed as a whole and not be dissected to find similarities or differences. The test is still that of the imperfect recollection of the average consumer. [*Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975)*, 25 C.P.R. (2d) 1].

The Applicant placed a great deal of emphasis on the fact that, phonetically, the Mark is different than the MEXX trade-mark. It is possible, for a Francophone, that the pronunciation of the word “mecs” is different than that of the invented word “mexx”. I must point out that I do not have any evidence from either party on the pronunciation of these words in English or in French which could have been useful to me in the analysis of this factor.

The analysis of the phonetic resemblance must not be limited to only one of the official languages of Canada. Thus, it is not sufficient to show that a unilingual Francophone would not pronounce the Marks at issue in the same way. There must not be a phonetic resemblance from the standpoint of the three types of average Canadian consumer: the unilingual Francophone, the unilingual Anglophone and the bilingual consumer. [See *Smithkline Beecham Corporation v. Pierre Fabre Médicament, (2001) 11 C.P.R. (4th) 1*].

In the absence of an expert's report on the subject, I must place myself in the shoes of each type of consumer in order to determine if there is a phonetic resemblance between the Mark and MEXX. It is conceivable that there would be a risk of confusion for a unilingual Anglophone, who would not be at all familiar with the word “mecs”. This type of consumer could conclude that there is a phonetic resemblance between the Opponent's trade-mark MEXX and the Applicant's mark. This factor therefore favours the Opponent.

The Applicant raises the lack of cases of confusion between the Mark and the Opponent's marks. This additional factor was already taken into consideration to support the finding that there was no risk of confusion. In the cases where this additional factor was retained, there was evidence in the record that the Marks at issue had coexisted for several years. As mentioned earlier, the Applicant did not submit any evidence of use of the Mark in Canada. I cannot find, therefore, that there is coexistence of the Marks at issue. Further, the absence of cases of confusion is not in itself determinative. It is sufficient that there is a risk of confusion by consumers in order to find in favour of the Opponent. [See *Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd. (1981)*, 55 C.P.R. (2d) 39]

I therefore find that the ground of opposition (c), described above, is also well founded with respect to MEXX marks, certificate of registration 334906, MEXX and design, certificate of registration 337047, MEXX and design, certificate of registration 374394 and MINI MEXX, certificate of registration 442683 since there is a risk of confusion between these Marks and the Applicant's mark. As for the other trade-marks belonging to the Opponent, the difference between the nature of the wares listed in certificates of registration 472051, 433299, 475638 and 466266 and those described in this application for registration is sufficient to find that there is no risk of confusion.

The evidence in the record shows that the Opponent did not abandon the use of its trade name MEXX or its trade-marks MEXX, certificate of registration 334906, MEXX and design, certificate of registration 337047, MEXX and design, certificate of registration 374394 and MINI MEXX, certificate of registration 442683, at the time that the application for registration was published in the *Trade-marks Journal* [ref. subsection 16(5) of the Act]. Under the circumstances, I also hold that the grounds of opposition (d), (e), (f) and (g), described above, are also successful solely in connection with the Opponent's trade-marks and trade name.

Having found that the Mark may cause confusion with certain trade-marks and the trade name of the Opponent, I find that the Mark is not likely to distinguish the Applicant's wares from the wares sold in association with the Opponent's registered trade-marks, certificate of registration

numbers 334906, 337047, 374394 and 442683 and the Opponent's trade name, MEXX.
Consequently, I also find that the ground of opposition (*h*), described above, is successful.

In accordance with the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I find that the Opponent's opposition is successful and therefore refuse the Applicant's application for registration for the Mark LES MECS under the provisions of subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THE 22 DAY OF JANUARY 2004.

Jean Carrière

Member

Trade-marks Opposition Board