

IN THE MATTER OF AN OPPOSITION by
Revolt Clothing Design Inc./Design du Vetement
Revolt Inc. to application No. 670,841 for the
trade-mark ENERGIE & Design filed by Zanhas S.R.L.

On November 20, 1990, Zanhas S.R.L. filed an application to register the mark ENERGIE & Design, illustrated below, based on proposed use of the mark in Canada.

The application was subsequently amended to change the basis for the application to use and registration of the mark in Italy (under the Italian regn. No. 460,484). After further amendments, the application now of record covers the wares

clothing namely, trousers, pants, skirts, T-shirts, coats, overcoats,
jackets, blouses, pullovers, jumpers, scarves, suits and dresses;
footwear namely, shoes; and headgear namely, hats

The colours red, yellow, black and white are claimed as features of the mark. In this respect, the predominant colours are red for the letters, yellow for the background and black for the border.

The subject application was advertised for opposition purposes in the Trade-marks Journal issue dated June 2, 1993. Revolt Clothing Design Inc. filed a statement of opposition on August 19, 1993, a copy of which was forwarded to the applicant on October 1, 1993. The applicant responded by filing and serving a counter statement. Both parties filed a written argument and both were represented at an oral hearing.

The first and second grounds opposition, pursuant to Section 30 of the Trade-marks Act, allege that the applicant could not have been satisfied as to its entitlement to

register the mark ENERGIE & Design as the applicant was aware of the opponent's previous use of its registered marks ENERGIE (regn. No. 276,103) and ENERGIC (regn. No. 319,560) for clothing.

The third ground of opposition alleges that the applied for mark ENERGIE & Design is "not a trade-mark as defined in Section 2 of the Act" because the mark is not distinctive of the applicant's wares. The fourth ground alleges that the applicant is not entitled to register the applied for mark because it is confusing with the opponent's above-mentioned marks previously used by the opponent in Canada. The fifth ground alleges that the applied for mark is not distinctive.

I note that the fifth and third grounds of opposition, as pleaded, are essentially equivalent, and that each of the grounds pleaded by the opponent in the instant case require the opponent to establish use of, or a reputation for, its mark(s). Further, I note that the opponent has not pleaded Section 12(1)(d) of the Act. As will be seen later, the failure to plead Section 12(1)(d) is significant because an opponent who is relying on Section 12(1)(d) need not show use of, or a reputation for, its registered mark(s).

The applicant's evidence consists of the affidavit of Generosa Castiglione, an employee of the firm representing the applicant, which affidavit merely serves to introduce into evidence, by way of exhibits, extracts from Trade-mark Office files. Those exhibits reveal that regn. No. 276,103 for the mark ENERGIE was expunged from the register on July 2, 1992 pursuant to Section 45 of the Act.

The opponent's evidence consists of the affidavit of Albert Elkaim, President of the opponent company. His affidavit evidence, sworn on March 8, 1994, may be summarized as follows.

The opponent is the registered owner of the trade-marks ENERGIE, regn. No. 276,103 and of the trade-mark ENERGIC, regn. No. 319,560. The opponent has used and continues to use its marks in association with men's and ladies' clothing. The opponent sells its wares to retailers across Canada. Each garment sold has attached thereto a label or tag of the type depicted below. Style booklets used to solicit orders for the summer and fall of 1989 bear the title ENERGIE. The opponent enjoys considerable goodwill in its marks and the applicant is not justified in attempting to diminish that goodwill.

(label)

(label)

(hang tag)

It may not be apparent from the depiction above that the words "Produced by Charles Fox" appear at the bottom centre of the hang tag.

The opponent's evidence is remarkable for particulars that are omitted. For

example, there is no indication when the opponent began to use its marks; what items of clothing are sold under the marks; how much clothing, in dollar value, is sold under the marks at either the retail or wholesale level; the identity of the retailers selling the opponent's clothing, or where such retail outlets are located. There is no explanation why the phrase "Produced by Charles Fox" appears on hag tags for clothing purportedly sold by the opponent Revolt Clothing Design Inc. Further, the opponent's evidence is incorrect in referring to a mark as registered after it has been expunged from the trademarks register.

In *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R.(3d) 289 at 293 (F.C.T.D.), the Court said as follows concerning the burden on a registrant to show use of its mark when answering a notice issued by the Registrar pursuant to Section 45 [formerly Section 44] of the Act:

In *Lewis Thomson & Sons Ltd. v. Rogers, Bereskin, & Parr* (1988), 21 C.P.R.(3d) 483 at 486 (F.C.T.D.), the Court stated as follows concerning the burden on a registrant in a Section 45 proceeding:

It seems to me that what is required is that the registrant establish a *prima facie* case of use and that is all that is expected of him.

The *dicta* of the Court referred to above applies equally to an opponent in an opposition proceeding who is relying on the use of its mark regardless of whether the mark is registered or not registered. In my view, the opponent in the instant case has failed to establish use of, or a reputation for, its marks in Canada and thus there is no support for any of the grounds of opposition. In other words, the opponent has not met the evidential burden on it to put the grounds of opposition pleaded in the statement of opposition in issue.

In view of the above, the opposition is rejected.

DATED AT HULL, QUEBEC, THIS 30 DAY OF OCTOBER, 1996.

Myer Herzig,
Member,
Trade-marks Opposition Board