



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

Citation: 2015 TMOB 2
Date of Decision: 2015-01-09

**IN THE MATTER OF AN OPPOSITION
by McGregor Industries Inc. to
application No. 1,426,231 for the trade-
mark NEXTLIFE in the name of Nextlife
Holdings, LLC**

[1] On January 30, 2009, Nextlife Holdings, LLC (the Applicant) filed an application to register the trade-mark NEXTLIFE for the following goods and services, on the following bases:

Goods (1) Copying inks; dry inks; filled ink cartridges for printers made from new materials; filled ink cartridges for printers made from recycled materials; filled ink jet cartridges made from new materials; filled ink jet cartridges made from recycled materials; printing compositions, namely, ink jet printer ink; printing ink; printer and photocopier toner; photocopier toner in cartridges made from new materials; photocopier toner in cartridges made from recycled materials; cartridges made from new materials containing printer or photocopier toner; cartridges made from recycled materials containing printer or photocopier toner; components for laser toner cartridges, namely, replacement drums and rollers made from new materials; components for laser toner cartridges, namely, replacement drums and rollers made from recycled materials; ink jet printers made from new materials; ink jet printers made from recycled materials; ink-jet color printers made from new materials; ink-jet color printers made from recycled materials; computer printers made from new materials; computer printers made from recycled materials; laser printers made from new materials; laser printers made from recycled materials; photo printers made from new materials; and photo printers made from recycled materials; computer printer ink ribbons and duplicating ink. *Based on proposed use.*

Goods (2) Bed pillows, bed mattresses, window blinds, sleeping bags, plastic card keys, plastic crates, plastic lids for plastic storage containers, plastic storage containers for commercial or industrial use, plastic tubs, recycled plastic used for landscaping; housegoods, namely, baskets for waste, bath products, bathroom pails, bowls, buckets,

clothes drying hangers, clothes pins, containers for household use, coasters, cooking utensils, cutting boards, cups, dust pans, egg separator trays, flower bowls, flower pots, flasks, flower vases, garbage cans, mugs, plastic cups, pails, plastic bath racks, plastic bottle, plastic buckets, plastic coasters, plastic cups, plastic egg holders, plastic hand held shopping baskets, plastic lids, plastic dinner plates, plastic safety caps, plastic spray nozzles, plastic storage containers, plastic water bottles, portable plastic containers for storing household and kitchen goods, rails and rings for towels not made of precious metal, recyclable flexible plastic pouches sold empty for holding water or nutritional liquids, refuse bins, salad bowls not made of precious metal, salad spinners, salt and pepper shakers, scoops, scoops for the disposal of pet waste, shoe horns, shower caddies, sieves for household purposes, soap dishes, soap dispensers, soap holders and boxes, spoon rests, toilet brushes, toilet brush holders, toilet paper dispensers, toothbrush cases, toothbrush holders, towel rails and rings, training cups for babies and children, trash cans, trash containers for household use, trays, namely, serving trays, giftware trays and coffee trays, waste baskets, wastepaper baskets, watering cans, water bottles; clothing, namely, bath slippers, beach footwear, beach shoes, flip flops, golf spikes, plastic baby bibs; hats, shoes, socks; clothing accessory belts; lace, buttons, artificial flowers of plastic, shoe laces, patches for clothing made of plastic, belt buckles not of precious metal; toys, namely, action figures and accessories therefore, baby rattles, baby toys, bath toys, cases for toys, crib mobiles, crib toys, cups for dice, dice, disc toss toys, discs for playing disc golf, gaming equipment, namely, poker chips, game tables, infant toys, pet toys, plastic toy hoops, playground equipment, namely, climbing units, sandboxes, and slides and swings, sleds for use in downhill amusement rides, snow saucers, tossing disc toys, toy building blocks, toy building blocks capable of interconnection, toy construction blocks, toy guns, toys for domestic pets, return tops; sporting goods, namely, aerobic steps, bags for sports equipment, bowling deflectors, divot repair tools, fishing rods, fishing tackle boxes, football helmets, football shoulder pads, golf bag tags, golf ball markers, golf tee markers, golf tees, kicking tees, knee guards for athletic use, shin guards for athletic use, ski cases, ski poles, skis, storage racks for athletic equipment, storage racks for ski and sports equipment, throat protectors for athletic use. *Based on proposed use.*

Services (1) Pick-up, delivery, and storage, namely, recyclable material, namely film, plastic, papers, textiles and metal; recycling. *Based on use and registration in the US and proposed use.*

Services (2) Refilling of toner cartridges. *Based on proposed use.*

[2] The application claims a priority filing date of January 29, 2009 based on a US application. The application was advertised for opposition purposes in the *Trade-marks Journal* of January 12, 2011.

[3] On June 13, 2011, McGregor Industries Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) the Mark is not registrable because it is confusing with the Opponent’s registered trade-mark NEXT, subject to registration Nos.
 - i. TMA419,119 for “socks”; and
 - ii. TMA520,870 for “legwear, namely hosiery, pantyhose, stockings, tights, leggings; slippers; leotards; underwear, lingerie; loungewear and sleepwear, namely pajamas, robes, caftans”;
- pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date the Mark was confusing with the Opponent’s trade-mark NEXT previously used in Canada by the Opponent and its predecessors in title in connection with articles of clothing including, without limitation, legwear and footwear such as socks, tights and leggings;
- pursuant to sections 38(2)(d) of the Act, the Mark is not distinctive within the meaning of section 2. In particular, the Mark does not actually distinguish and is not adapted to distinguish the Goods from the Opponent’s goods, namely, clothing, without limitation, legwear and footwear such as socks, tights, and leggings, sold by the Opponent and its predecessors under the trade-mark NEXT.

[4] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Doreen Hardy-Smith.

[6] The Applicant did not file any evidence in support of its application.

[7] Only the Opponent filed a written argument and was represented at an oral hearing.

Onus and Material Dates

[8] 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 CPR (3d) 293 (FCTD) at 298].

[9] The material dates that apply to the grounds of opposition are as follows:

- section 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- section 38(2)(c)/16(3)(a) – the date of filing the application [section 16(3) of the Act; ; in this case the date is January 29, 2009 considering the priority date claimed pursuant to section 34 of the Act];
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Non-registrability Ground - section 12(1)(d) of the Act

[10] An opponent’s initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and note that the registrations for the Opponent’s registered NEXT trade-mark remain extant. Thus the Opponent has met its evidential burden. I must now assess whether the Applicant has met its legal onus.

[11] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[12] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[13] The parties' marks, both made up of dictionary words, share the same low degree of inherent distinctiveness.

[14] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[15] The Applicant has not provided any evidence of use or reputation for the Mark such that I can only infer that it has not become known to any extent.

[16] In her affidavit, Ms. Hardy-Smith provides photocopies of "a specimen pair of socks", "a specimen set of leggings" both of which display the trade-mark NEXT on the label (Exhibits B and C) as well copies of "certain catalogues and price lists relating to certain McGregor NEXT legwear products" (Exhibit D). Regarding these documents, Ms. Hardy-Smith states that she reviewed an affidavit sworn in another proceeding by Jordan Lipson, president of the Opponent. As a result, she states that she is "informed and verily believes that Exhibits B and C are representative of such products sold across Canada by the Opponent; and that the catalogues and price lists of Exhibit D were distributed by McGregor and used by its customers in Canada in connection with certain NEXT products and that such catalogues and price lists contain accurate descriptions and illustrations of the NEXT products listed therein".

[17] Firstly, I note that the evidence of use of the NEXT trade-mark in association with the Opponent's goods is hearsay, as Ms. Hardy-Smith, a legal secretary for the Opponent's agent, does not have direct knowledge of the Opponent's business activities. Furthermore, even if I were to accept the evidence despite its hearsay nature, there is nothing in the affidavit which establishes the extent to which the Opponent's NEXT trade-mark has become known (sales figures, etc.).

[18] Lastly, the mere existence of registration Nos. TMA419,119 and TMA520,870 can establish no more than *de minimis* use of the trade-mark [see *Entre Computer Centres, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[19] Based on the foregoing, I find that this factor does not favour either party.

Section 6(5)(b) – the length of time each has been in use

[20] As discussed above in the analysis of the section 6(5)(a), neither party has provided admissible evidence of use of their respective trade-marks such that this factor does not favour either party.

Section 6(5)(c) and (d) – the nature of goods, services or business and trade

[21] The Applicant’s goods defined as “clothing, namely, bath slippers, beach footwear, beach shoes, flip flops, golf spikes, plastic baby bibs; hats, shoes, socks; clothing accessory belts; lace, buttons, artificial flowers of plastic, shoe laces, patches for clothing made of plastic, belt buckles not of precious metal” share some degree of overlap with the Opponent’s registered goods such that this factor favours the Opponent with respect to these goods (the Overlapping Goods).

[22] However, the remainder of the applied-for goods and all of the applied-for services share no similarity whatsoever with the Opponent’s registered goods. In fact, the difference in the nature of the parties’ goods and services with respect to these remaining goods and services is so vast that I find this factor to be determinative of the confusion issue for these goods and service.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[23] The parties’ marks share a significant degree of similarity in appearance and sound by virtue of the fact that the Applicant has incorporated the entirety of the Opponent’s mark as the first element of the Mark. The addition of the word “life” does create a somewhat different idea suggested for the Mark – that is, the idea of a subsequent life.

[24] When considered as a whole, this factor favours the Opponent.

Conclusion

[25] I have considered the issue of confusion as a matter of first impression based on all the surrounding circumstances. I find that the similarity in the nature of the parties’ goods with

respect to the Overlapping Goods combined with the degree of resemblance between the parties' marks is such that the Applicant has failed to meet its burden of establishing no likelihood of confusion between the parties' marks on a balance of probabilities. As a result, I find the ground of opposition based on section 12(1)(d) to be successful with respect to the Overlapping Goods.

[26] However, with respect to the remaining goods and services, I find that the complete lack of similarity between the parties' goods and services is sufficient to shift the balance of probabilities in the Applicant's favour and the ground of opposition based on section 12(1)(d) is dismissed with respect to the remaining goods and services.

Non-entitlement Ground – sections 38(2)(c) and 16(3)(a) of the Act

[27] The Opponent is under an initial evidential burden to establish use of the trade-mark NEXT prior to the filing date for the application for the Mark and non-abandonment at the date of advertisement.

[28] As discussed further above in the analysis of the 12(1)(d) ground of opposition, the only evidence of use provided by the Opponent is inadmissible hearsay evidence and any reference to use in the Opponent's registrations is not sufficient to satisfy the Opponent's evidential burden under section 16(3)(a) of the Act [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[29] Based on the foregoing, the ground of opposition based on section 16(3)(a) is dismissed on account of the Opponent's failure to meet its evidential burden.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[30] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods and services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[31] The Opponent is under an obligation to show that, as of the filing of the statement of opposition, its NEXT trade-mark had become known sufficiently to negate the distinctiveness of

the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[32] As the Opponent has not filed any evidence that meets its initial burden, this ground of opposition is dismissed.

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark with respect to “clothing, namely, bath slippers, beach footwear, beach shoes, flip flops, golf spikes, plastic baby bibs; hats, shoes, socks; clothing accessory belts; lace, buttons, artificial flowers of plastic, shoe laces, patches for clothing made of plastic, belt buckles not of precious metal” and I reject the opposition with respect to the remaining goods and services pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office