



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

Citation: 2012 TMOB 106
Date of Decision: 2012-05-29

**IN THE MATTER OF AN OPPOSITION
by Rebel Slacks Co. Ltd. to application
No. 1,307,249 for the trade-mark DOM
REBEL THREADS & Design in the name
of Couture Dom Rebel S.E.N.C.**

[1] On June 28, 2006, Couture Dom Rebel S.E.N.C. filed an application to register the trade-mark DOM REBEL THREADS & Design set out below (the Mark) on the basis of its proposed use in Canada.



The wares, as revised, are set out below. A disclaimer to the exclusive use of the word THREADS has been entered with respect to some of the wares.

T-shirts, polo shirts, tank tops, sweaters, jeans, hats, belts, jackets, underwear, sunglasses, footwear namely, shoes, sneakers, boots and sandals; perfume, necklaces, jewellery, watches, wristbands, chain wallets, buttons, energy drinks, bottled water (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 20, 2007.

[3] On July 9, 2007, Rebel Slacks Co. Ltd. (the Opponent) filed a statement of opposition pleading the grounds summarized below. The specific provisions of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) allegedly contravened are set out in brackets.

- (a) the Applicant knew or should have known that it was not entitled to use the Mark due to the prior use of the Opponent's REBEL mark and Rebel Slacks Co. Ltd. trade-name (section 30(i));
- (b) the Applicant was using the Mark on the date of filing the application (section 30(b));
- (c) the Mark is not a trade-mark as defined by section 2 of the Act (section 30(e));
- (d) the Mark is not registrable because it is confusing with the Opponent's reg. Nos. TMA274,255 and TMA663,298 (section 12(1)(d));
- (e) the Applicant is not the person entitled to registration of the Mark because it is confusing with the Opponent's REBEL and UR REBEL trade-marks used and made known prior to the date of filing the application (section 16(3)(a));
- (f) the Applicant is not the person entitled to registration of the Mark because it is confusing with the Opponent's trade-name Rebel Slacks Co. Ltd. used and made known prior to the date of filing the application (section 16(3)(c)); and
- (g) the Mark is not distinctive (section 2 of the Act).

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of David Schnapp. The Applicant filed an affidavit of Justin Svatina. Both affiants were cross-examined and the transcripts, exhibits and undertakings form part of the record.

[6] Both parties filed a written argument and attended a hearing held on January 17, 2012.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is however an initial 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 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 at 422 (FCA)];
- sections 38(2)(c)/16(3) - the filing date of the application [see s. 16(3)]; and
- 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 at 324 (FC)].

Grounds of Opposition

Section 30 Grounds of Opposition

Section 30(i)

[9] The Opponent alleges that on the filing date of the application the Applicant knew or should have known that it was not entitled to use the Mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances, the section 30(i) ground is dismissed. The failure to perform a search which would have located the Opponent's trade-mark is not an

exceptional circumstance or indicative of bad faith [see, for example, *Advance Magazine Publishers Inc v Farleyco Marketing Inc*; 2007 CarswellNat 2301 (TMOB) at para 32].

Section 30(b) – Use Prior to Filing

[10] The Opponent alleges that the application does not comply with section 30(b) of the Act. The evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with this section of the Act is a light one and can be met by reference not only to the Opponent's evidence, but also to the Applicant's evidence [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. To do so, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the claims set forth in the application.

[11] The Applicant filed as its evidence the affidavit of Justin Svatina, its President and Head Designer. Mr. Svatina sets out in his affidavit that the Applicant has been selling clothing in association with the Mark since filing its application on June 28, 2006 (para 8). The Mark appears on hang tags attached to the Applicant's clothing and accessories (Exhibit B) and on invoices (Exhibit C).

[12] The Opponent submits that Mr. Svatina's evidence shows that the Applicant commenced use of the Mark prior to June 28, 2006, the filing date of the application. During the cross-examination on his affidavit, the agent for the Opponent showed Mr. Svatina a print-out of the application and indicated that he would refer to the Mark as the "subject trade-mark" (Qs 52-53). In the answers to undertakings, the Applicant indicates that Exhibit G includes invoices "showing sales of t-shirts with hang tags and labels with the subject mark". Exhibit G includes invoices addressed to Toxik-Champlain Mall (March 10, 2005) and Boutique Oclan (March 27, 2006) both which pre-date June 28, 2006. Furthermore, in his cross-examination, Mr. Svatina states that he conceived of the Dom Rebel name in 2003 and that the design of the logo and name was used together as early as 2003 on t-shirts (Qs 54, 63, 66). Mr. Svatina further states that between 2003-2008 the Applicant only made T-shirts and did not make any other products for sale (Qs 58-61).

[13] At the oral hearing, the Applicant argued that the evidence summarized above was insufficient to meet the Opponent's burden since Mr. Svatina, who is not a lawyer, wouldn't

have understood the phrase the “subject mark” to mean the Mark rather than the Applicant’s earlier use of different marks with similar elements. I am not persuaded by this argument since the agent for the Opponent showed Mr. Svatina a print-out of the application and advised that the mark applied-for would be referred to as the “subject mark”.

[14] The Opponent has shown that the Applicant’s evidence is clearly inconsistent with section 30(b) of the Act for the wares described as t-shirts since it appears use of the Mark commenced with t-shirts in advance of the filing date. The Applicant, therefore, has not met its legal burden of proving its application was in compliance with section 30(b) with respect to these goods. Having regard to the line of decisions of the Registrar of Trade-marks which refused proposed use applications where actual use of the trade-mark was evidenced prior to the filing date, I find that this ground of opposition is successful with respect to t-shirts [see *Tone-Craft Paints Ltd v Du-Chem Paint Co* (1969), 62 CPR 283 (TMOB); *Airwick Industries Inc v Metzner* (1982), 74 CPR (2d) 55 (TMOB); *Frisco-Findus SA v Diners Delite Foods Ltd* (1989), 26 CPR (3d) 556 (TMOB); and *Nabisco Brands Ltd - Nabisco Brands Ltée v Cuda Consolidated Inc* (1997), 81 CPR (3d) 537 (TMOB)].

Section 30(e) – Mark is Not a Trade-mark

[15] The Opponent also alleges that the Mark is not a trade-mark as defined by section 2. The Opponent has not met its evidential burden of demonstrating that the Mark was not or will not be used for the purposes of distinguishing the Applicant’s wares from the wares of others. As such, this ground of opposition is dismissed.

Section 12(1)(d) – Non-registrability

[16] The section 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent’s REBEL mark, registration No. TMA274,255 as it is more similar in appearance to the Mark as compared to the UR REBEL mark, registration No. TMA663,298. The Opponent’s registration No. TMA274,255 covers the following wares and services:

Jeans, skirts, slacks, pants, overalls, including coveralls, men’s, ladies’ and

children's clothing wares namely jackets, shirts, shorts, coats, sweaters, tops and dresses

Operation of a business dealing in the distribution and sale of clothing wares

[17] I note that the Opponent's initial burden with respect to the section 12(1)(d) ground has been satisfied because registration No. TMA274,255 is in good standing.

test for confusion

[18] 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 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. 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 or trade-names and the extent to which they have become known; b) the length of time each has 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. These enumerated factors need not be attributed equal weight.

[19] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Degree of resemblance between the trade-marks

[20] The Opponent argues that the Mark is likely to be identified as DOM REBEL which is confusing with its mark. The Opponent further submits that the design and other elements of the Mark are peripheral and secondary and would not come into play when the Mark is pronounced or viewed, particularly on a first impression basis. However, the degree of resemblance with the

Opponent's mark is to be assessed not only by examining the text portions of the Mark but rather by assessing the totality of the effect of the Mark, including the script in which it is written and the surrounding design [*Mattel, supra* at para 76].

[21] I can take judicial notice of dictionary definitions [see *Envirodrive Inc v 836442 Alberta Ltd*, 2005 ABQB 446 (CanLII), 2005 ABQB 446 (Alta QB); *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29]. The Opponent's mark REBEL consists of a dictionary word defined in the *Canadian Oxford Dictionary* (1998 ed), in part, as "1- a person who fights against, resists, or refuses allegiance to the established government; 2 – a person who resists authority, control or convention". Given this definition, the Opponent's mark is suggestive of the type of person or attitude of the person who will ultimately wear or purchase its clothes. In contrast, the Mark features the words DOM REBEL THREADS and a prominent wing design. The definition of Dom is a "1- title prefixed to the names of some Roman Catholic dignitaries ... 2- the Portugese equivalent of Don [a Spanish title prefixed to a man's forename]" and is from the latin *dominus* for master [*Canadian Oxford Dictionary, supra*]. The Mark appears to suggest a fanciful idea – clothing from the master of a rebellion or a master rebel. Therefore, I find that the Opponent's mark and the Mark suggest different ideas.

[22] I agree with the Applicant's submissions that the large artistic wing design is the most dominant and striking feature of the Mark due to its prominence [*Masterpiece, supra* at paras 64, 84]. Furthermore, the use of DOM REBEL in the same size and font in the Mark signals to consumers that this is a unitary phrase. It has previously been held that confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Chalet Bar-B-Q (Canada) Inc v. Foodcorp Ltd.* (1982), 66 CPR (2d) 56 (FCA) at 73]. In this case, I find the large artistic wing design and use of DOM REBEL are such a dominant difference. Finally, I find that the parties marks sound different due to the fact that DOM is the first word element of the Mark and is likely to be emphasized by consumers.

[23] Given the differences in appearance, sound and ideas suggested by the marks, I do not find that the marks have a high degree of resemblance.

Inherent distinctiveness and extent that the mark has become known

[24] The Mark has a higher degree of inherent distinctiveness than the Opponent's mark REBEL due to the large artistic wing design element and the use of the phrase DOM REBEL.

[25] The Opponent's affiant, David Schnapp, the President of the Opponent, states that the Opponent has been manufacturing, distributing, advertising and selling clothing in Canada since at least as early as 1971 (para 3). The REBEL trade-mark appears on hang tags and fabric tags and on the Opponent's catalogues, stationary and invoices (Exhibits 4,5, 8, and 10). In 2008, the Opponent had \$5,000,000 in total sales of all of its clothing brands (Q 46) although not all sales were of REBEL brand clothing (Qs 49-50). Mr. Schnapp refused to identify what percentage of total sales were of REBEL branded clothes, therefore, I am drawing an adverse inference and find that the majority of clothes sold by the Opponent are not necessarily REBEL branded.

[26] The Applicant's affiant, Mr. Svatina, provides the history of the Applicant stating that it has increased the production of its menswear pieces from 120 shirts in 2003 to 45,000 pieces in 2008 (para 5). Mr. Svatina explains that the Applicant advertises clothing in association with the Mark through its web-site which had over 1,000,000 successful page views from January 1, 2008 to October 27, 2009 (para 15, Exhibit E).

[27] In view of the fact that the parties both appear to have considerable sales as of the material date, this factor does not favour one party significantly over the other.

the length of time each trade-mark has been in use

[28] The length of time that each mark has been in use favours the Opponent. Mr. Schnapp states that there has been use of the REBEL mark from 1971 onwards (para 3) and provides evidence of use from 1986 onwards (para 7; Exhibit 3).

the nature of the wares, services or business; the nature of the trade

[29] It is the Applicant's statement of wares versus the Opponent's registered wares and services that govern my determination of this factor [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB) at 98-99].

[30] I find that the nature of the wares and channels of trade of the Wares described as T-shirts, polo shirts, tank tops, sweaters, jeans, hats, belts, jackets, and underwear, overlap with the Opponent's wares and services since there is no restriction on the type of apparel, such as inexpensive or high fashion, in the registered wares and services or applied-for wares. As such, the fact that the parties appear to target their wares and/or services at different markets does not lessen the overlap with the Opponent's wares and services.

[31] With respect to the wares sunglasses, footwear namely, shoes, sneakers, boots and sandals; perfume, necklaces, jewellery, watches, wristbands, chain wallets, buttons, energy drinks, bottled water, I do not consider the potential for overlap to be significant given the difference in the nature of these wares and the Opponent's wares and services [see for example, *Gemcraft Ltd v Cerruti 1881 SA* (1987), 17 CPR (3d) 156 (TMOB) at 159; *88766 Canada Inc v Ego Sport Hungaria Kreskedelmi Korlatolt Felelosségu Tarsasag* (2006), 56 CPR (4th) 442 (TMOB) at 452; *Advance Magazine Publishers Inc v Ailes De La Mode Inc.*; 2010 CarswellNat 3485 (TMOB) at para 25].

conclusion re likelihood of confusion

[32] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's REBEL mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, (2006), 49 CPR (4th) 401 at para 20].

[33] I conclude that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Opponent's REBEL mark and the Mark for use in association with the Wares given the differences between the parties' marks. Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Section 38(2)(c)/16(3) Entitlement

[34] The Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to section 16(3)(a) of the Act on the basis that the Mark is confusing with the

Opponent's marks REBEL and UR REBEL. There is an initial burden on the Opponent to evidence use of its marks prior to the Applicant's filing date and non-abandonment of its marks as of the date of advertisement of the Applicant's application [s. 16]. As there is no evidence of use of the UR REBEL mark, the Opponent has not met its burden with respect to this mark. For the reasons set out above in the discussion of the section 12(1)(d) ground, I do not find that the Mark was confusing with the Opponent's use of the REBEL mark as of the relevant date (June 28, 2006). My conclusion is the same even if the relevant date for consideration of the wares described as t-shirts is taken as 2003-2004 pursuant to my earlier findings regarding non-compliance with section 30(b).

[35] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to section 16(3)(c) of the Act on the basis that the Mark is confusing with the Opponent's trade-name Rebel Slack Co. Ltd. The only appearance of Rebel Slack Co. Ltd. name in the evidence of Mr. Schnapp, around the material date, is in a field on the invoices indicating to whom the invoiced amount is payable (Exhibit 3). As these invoices feature in the top left corner Compagnie International Rebel Jeans along with an address, I find that consumers are likely to believe this is the trade-name under which the business of the Applicant is carried on [see section 2 of the Act]. As such, the Opponent has not met its burden with respect to the Rebel Slack Co. Ltd. trade-name and this ground of opposition is dismissed.

Section 38(2)(d)/(2) – Non-Distinctiveness

[36] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to have shown that as of the date of filing the statement of opposition its trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. To do so, the Opponent must establish that its mark is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles, supra* at para 33]. While the Opponent's evidence of use of the REBEL trade-mark around July 9, 2007, the material date, is sufficient to meet its burden, the conclusion reached on the issue of likelihood of confusion between the Mark and the Opponent's trade-marks and trade-name under the other grounds of opposition are equally applicable to this ground of opposition. Consequently the Mark is adapted

to distinguish and actually distinguishes the Wares from the Opponent's wares and services. Accordingly, this ground of opposition is also dismissed.

Disposition

[37] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,307,249 with respect to t-shirts and I reject the opposition with respect to the remainder of the wares and services, pursuant to section 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Natalie de Paulsen
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Trade-marks Opposition Board
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