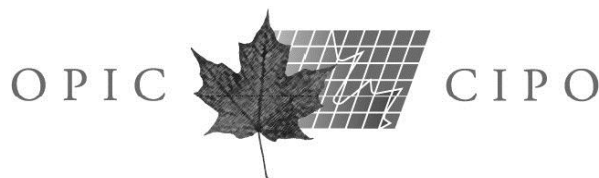


TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 245
Date of Decision: 2011-12-07

**IN THE MATTER OF AN OPPOSITION
by The Forzani Group Ltd. to application
No. 1,282,700 for the trade-mark BLACK
MOUNTAIN ONYX & Design in the
name of Effigi Inc.**

[1] On December 13, 2005, Effigi Inc. (the Applicant) filed an application for registration of the trade mark BLACK MOUNTAIN ONYX & Design (the Mark), reproduced below, on the basis of proposed use of the Mark in Canada in association with the following wares (as amended during the examination of the application):



[TRANSLATION]

(1) Clothing, namely: sweaters, t-shirts, camisoles, jackets, cardigans, turtlenecks, dresses, underwear, panties, bras, slips, pants, jeans, suit jackets, Bermuda shorts, shorts, skirts, suits, jumpsuits, overalls, hats, berets, headbands, bandanas, ear muffs, scarves, blouses, snowsuits, blazers, ski clothing, namely: ski jackets, ski coats, ski pants, ski jackets, ski gloves, ski mittens, overcoats, parkas, anoraks; raincoats, rain slickers; hooded sweatshirts, jerseys, jogging outfits, namely: pants, t-shirts, fleece pullovers; mittens, gloves, neckties, pyjamas, nightgowns, baby dolls, night dresses, dressing gowns, robes, romper suits, sleepers, bibs, toques, caps, beachwear, namely: beach dresses and shirts; beach wraps, swimsuits, leotards, coats, headbands, slippers, polo shirts, boxers, and belts.

(2) Bags of various shapes and sizes, namely: all-purpose sports bags, athletics bags, gym bags, hand bags, shoulder bags, backpacks, school bags, fabric bags, fanny packs, carryall bags, carry-on bags, duffel bags, diaper bags, infant carriers.

(3) Eyeglasses, sunglasses, sport glasses.

(4) Perfume, watches, jewellery.

(5) Footwear for men, women and children, namely: shoes, boots, slippers, boot liners, track and field shoes, basketball shoes; sports shoes, namely sneakers, running shoes, walking shoes, tennis shoes, cross-training shoes, cleats and golf shoes, sandals and rubbers. (The Wares)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 17, 2007.

[3] The Forzani Group Ltd. (the Opponent) filed a statement of opposition to this application on July 17, 2007. On April 21, 2008, the Opponent applied for leave to amend its statement of opposition. Leave was granted on October 3, 2008. The grounds of opposition can be summarized as follows:

1. The application for registration does not meet the requirements of s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the Act), in that some of the Wares listed in the application are not defined in ordinary commercial terms.
2. The application does not meet the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark, for the reasons set out in the rest of the statement of opposition; and
3. The Mark is not distinctive of the Applicant's Wares within the meaning of s. 2 of the Act in that it is not adapted to distinguish and does not actually distinguish these wares from the wares of other persons, among others Lorne Nadler Sales, owner of the trade-mark ONYX in use and registered in Canada under No. TMA599,265 in association with the same type of wares; the Opponent's licensee, Intersport North America Inc., which has been using a trade-mark containing the component "ONYX" in association with clothing since at least as early as October 2005; and the Opponent, which has been using a trade-mark "ONYX" in association with clothing in Canada since at least as early as February 2006. The Opponent further contends that "ONYX footwear is a brand of REEF Sandals in Canada".

[4] The Applicant filed a counter statement denying all the grounds of opposition.

[5] In support of its opposition, the Opponent filed a first affidavit by Tom Sampson, sworn on December 18, 2008, and an affidavit by Douglas A. Hayes, sworn on April 11, 2008. The Applicant obtained a cross-examination order against each of those affiants. At the Opponent's request, Mr. Douglas' affidavit was removed from the record and replaced with a second affidavit by Mr. Sampson, sworn on December 18, 2008. However, both of Mr. Sampson's affidavits were also removed from the record and returned to the Opponent, in accordance with Rule 44(5) of the *Trade-marks Regulations* (SOR/96-195). Consequently, there is no evidence in the record filed on the Opponent's behalf. In support of its application for registration, the Applicant filed the certificates of authenticity for registrations No. TMA595,233 (ONYX & Design) and No. TMA599,265 (ONYX), formerly in the name of Lorne Nadler Sales Inc., and TMA419,649 (ONYX), showing that these registrations have all been expunged.

[6] Only the Applicant filed a written argument and participated in an oral hearing.

Analysis

[7] The onus is on the Applicant to show that its application meets the requirements of the Act. However, it is up to the Opponent to ensure that each of its grounds of opposition is duly argued and to meet its initial evidentiary onus by establishing the facts supporting its grounds of opposition. Once this initial burden is met, it is up to the Applicant to prove, on a balance of probabilities, that none of these grounds of opposition impedes the registration of the Mark [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] Applying those principles to this case, each of the grounds of opposition is summarily dismissed for the following reasons:

· Section 30(a) ground

[9] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. It merely asserts the following in its statement of opposition:

We respectfully submit that the following wares which appear in the application do not appear in ordinary commercial terms and are not found in the *Wares and Services Manual* as acceptable :

- Gloves
- Baby dolls
- Slipovers
- Belts
- Fabric bags
- Carryall bags
- Infant carriers

The wares as stated are arbitrary [*sic*] and do not permit a clear understanding as to the real nature of the products.

[10] As the Applicant quite rightly pointed out at the hearing, the application for registration is drafted in French. Therefore, this ground of opposition must be considered in respect of the official version of the statement of Wares, that is, the French version. However, there is no evidence in the record supporting the conclusion that the corresponding wares, that is, those described in French as “gants”, “nuisettes”, “débardeurs”, “ceintures”, “sacs en tissu”, “fourre-tout” and “sacs porte-bébés” are not, in the context of the statement of Wares, acceptably described in ordinary commercial terms. From the Opponent’s mere allegation that the Wares listed in its ground of opposition are not found in the English version of the Canadian Intellectual Property Office’s *Wares and Services Manual*, it does not necessarily follow that the wares, as set out in French in the statement of wares, are unacceptably described. The Manual contains a representative list of acceptable wares and services under s. 30(a) of the Act. This list is not exhaustive. Furthermore, the Manual indicates that the entries it contains may be used as analogies for wares and services that are not listed, as such, in the Manual.

[11] Given that the Opponent has failed to meet its initial burden of proof with respect to this ground of opposition, I am of the opinion that there is no need to rule on the Applicant’s

submission that this ground of opposition is, furthermore, improperly argued since it refers to the English version of the Wares rather than to the official version, in French.

- Non-distinctiveness ground

[12] The Opponent has failed to meet its initial burden of proof with respect to this ground of opposition. The Opponent had to show that one or more of the “ONYX” trade-marks alleged in support of this ground of opposition had become sufficiently known in Canada at the filing date of the statement of opposition to negate the distinctiveness of the Mark [see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.); and *Bojangles’ International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[13] However, as previously stated, no evidence in the record to this effect was filed on the Opponent’s behalf. What is more, and although this is not truly relevant, the Applicant’s evidence shows that the registrations for Lorne Nadler Sales Inc.’s trade-marks ONYX and ONYX & Design have been expunged.

- Section 30(i) ground

[14] This ground of opposition, as argued, is invalid in that it alleges only that the Applicant could not have been satisfied of being entitled to use the Mark as alleged in its application, “[f]or all of the reasons expressed” in the rest of the statement of opposition. All that is required of an applicant under s. 30(i) of the Act is to provide a statement that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares or services described in its application. The Applicant has formally complied with this provision. I would also add that is well established in the case law that a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where it has been established that there is bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at page 155]. However, nothing establishes that there is bad faith on the part of the Applicant in this case.

Decision

[15] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition under s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Sarah Burns, Translator