

Editor's Note: Corrigendum released on July 21, 2011. Original judgment has been corrected with text of corrigendum appended.



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

Citation: 2011 TMOB 88
Date of Decision: 2011-05-31

**IN THE MATTER OF AN OPPOSITION
by Monsoon Accessorize Limited to
application No. 1,245,313 for the trade-
mark ACCESSORIZE ME in the name of
Accessorize Me Inc.**

Introduction

[1] On January 28, 2005 Accessorize Me Inc. (the Applicant) filed application No. 1,245,313 to register the trade-mark ACCESSORIZE ME (the Mark) based on use in Canada since October 11, 2001. It covers the following services:

The operation of a retail store selling clothing and accessories to the public, but excluding clothing and accessories for stuffed and plush toy animals and dolls (the Services).

The restriction in the description of the services came after an office action was issued citing a conflicting application.

[2] The application was advertised on February 22, 2006 in the *Trade-marks Journal* for opposition purposes. Monsoon Accessorize Limited (the Opponent) filed a statement of opposition on July 24, 2006 which was forwarded by the Registrar on August 15, 2006 to the Applicant.

[3] The Applicant filed a counter statement on August 23, 2006 denying in essence the grounds of opposition pleaded by the Opponent.

[4] The Opponent filed the affidavits of Peter Simon and Margot Franssen together with certified copies of trade-mark registrations TMA617,925 for the trade-mark ACCESSORIZE and TMA536,534 for the trade-mark MONSOON ACCESSORIZE while the Applicant filed the affidavits of Helen Hastings, Jonathan Burkinshaw and Robert White.

[5] Only the Applicant filed written submissions and there was no oral hearing.

The Grounds of Opposition

[6] The grounds of opposition raised by the Opponent can be summarized as follows:

1. The application does not comply with the requirements of s. 30(b) of the Trade-marks Act, R.S.C. 1985 c. T-13 (the “Act”) in that the Applicant and/or predecessor-in-title has not used the Mark in Canada in association with the Services as of the date of first use claimed in the application;
2. The application does not comply with the requirements of s. 30(i) of the Act in that the Applicant could not have stated that it was satisfied that it was entitled to use the Mark in Canada in association with the Services in view of the Applicant’s knowledge of the Opponent’s prior use and making known of the confusingly similar trade-marks and trade-names;
3. The Mark is not registrable under s. 12(1)(d) of the Act as it is confusing with the Opponent’s registered trade-marks:
 - ACCESSORIZE: registration TMA617,925;
 - MONSOON ACCESSORIZE, registration TMA536,534.
4. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(1)(a) of the Act because at the alleged date of first use of the Mark, it was confusing with the trade-marks ACCESSORIZE and MONSOON ACCESSORIZE previously used or made known;
5. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(1)(c) of the Act because at the alleged date of first use of the Mark it was confusing with the trade-names ACCESSORIZE, MONSOON ACCESSORIZE and MONSOON

ACCESSORIZE LIMITED used by the Opponent in association with their businesses;

6. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive in that the Mark does not actually distinguish the Services from the wares and services of the Opponent, nor is it adapted so to distinguish them in light of the Opponent's prior use and making known in Canada and internationally in respect of its trade-marks and trade-names detailed above.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[8] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: The filing date of the application (January 28, 2005);
- Entitlement to the registration of the Mark, where the application is based on use: The date of first use alleged in the application (October 11, 2001) [see s. 16(1) of the Act];
- Distinctiveness of the Mark: The filing date of the statement of opposition (July 24, 2006) is generally accepted to be the relevant date [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-*

Goldwyn-Meyer Inc. v. Stargate Connections Inc. (2004), 34 C.P.R. (4th) 317 (F.C.T.D.).

Section 30 Grounds of Opposition

[9] The Opponent has an evidential burden when alleging non-compliance with s. 30(b) of the Act but it has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant itself [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156]. However such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in its application [See *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (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)].

[10] The Opponent has not filed any evidence that could support its allegation that the Applicant has not used the Mark as of the claimed date of first use mentioned in the application. The evidence filed by the Applicant, as it will be more fully described hereinafter does support the claimed date of first use alleged in the application. Therefore the first ground of opposition is dismissed for failure by the Opponent to meet its initial burden of proof.

[11] The second ground of opposition as drafted is not a proper ground of opposition. Section 30(i) only requires that the Applicant declares itself satisfied that it is entitled to the registration of the Mark. Such statement is included in the application. The mere knowledge of the Opponent's trade-marks is not sufficient to succeed under this ground of opposition. The allegation that the Applicant had knowledge of the existence of the Opponent's prior use and making known of confusingly similar trade-marks and trade-names cannot form the basis of a ground of opposition under s. 30(i) of the Act. Prior use and making known of confusingly similar trade-marks or trade-names is covered by the ground of opposition detailed in s. 16 of the Act and commonly known as "entitlement".

[12] Section 30(i) can be the basis of a ground of opposition in specific cases such as where fraud by the Applicant is alleged [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R. (2d) 152]. Under these circumstances, the second ground of opposition is dismissed.

Entitlement

[13] In order to consider a ground of opposition based on s. 16(1)(a) of the Act the Opponent has an initial evidential burden to prove that its trade-marks ACCESSORIZE and MONSOON ACCESSORIZE had been used or made known in Canada prior to the claimed date of first use of the Mark in Canada by the Applicant, namely October 11, 2001.

[14] Margot Franssen has been the President of Bibelot Inc. (Bibelot), the Opponent's Canadian franchisee, in respect of the operation of ACCESSORIZE brand retail stores in Canada.

[15] She states that ACCESSORIZE brand retail stores are very popular in the United Kingdom and internationally. She describes each store as a giant dressing room wherein one can find all sorts of clothing accessories such as hats, purses, jewellery, belts, scarves, shoes, gloves, hair ornaments and style aids, hosiery, sunglasses, umbrellas, ponchos, lingerie and cosmetics.

[16] She states that Bibelot started operating ACCESSORIZE brand retail outlets in Canada in key locations under license from the Opponent in 2004. There are currently 11 ACCESSORIZE brand retail outlets in Canada located in Vancouver, Toronto, Edmonton, Calgary and Ottawa. They have plans to significantly expand the number of stores in the near future.

[17] From this portion of the Opponent's evidence I cannot conclude that the Opponent had used its trade-marks in Canada prior to October 11, 2001. It is clear that any evidence of use on the part of Bibelot occurred after the relevant date. Therefore, for

this ground of opposition, there is no need to summarize the evidence of use of the Opponent's trade-marks by Bibelot in Canada.

[18] Peter Simon is the founder, Chairman and majority shareholder of Monsoon plc., the parent of UK based international retailer, and wholly owned subsidiary, Monsoon Accessorize Limited all referred to in his affidavit as "My Company" (in my decision whenever Mr. Simon is using My Company I shall use "his Company"). Any ambiguity as to which of these companies he is referring to in his affidavit shall be interpreted against the Opponent.

[19] He provides a background of his Company that first opened in 1973 in London, England. It was a MONSOON brand boutique described as a women's fashion retailer of ethnic fashions.

[20] He states that in 1984, a new format store was created under ACCESSORIZE brand which evolved in an adjoining shop to the MONSOON Covent Garden Piazza branch for jewellery and decorative/accent fashion items. A second store opened in 1986 and the first one outside London in 1992 in Manchester. Thereafter his Company began an aggressive store-opening program, averaging 16 new ACCESSORIZE brand stores each year. There are 416 international stores (not including stores in the UK), 294 are freestanding ACCESSORIZE brand retail stores with another 112 stores selling goods under the ACCESSORIZE brand in various other retail formats. There are 150 freestanding ACCESSORIZE brand stores in the UK and 99 dual MONSOON/ACCESSORIZE brand stores. There is no reference to Canadian stores in this portion of Mr. Simon's affidavit.

[21] He states that his Company throughout the world has opened freestanding MONSOON brand and ACCESSORIZE brand retail outlets as well as "dual" MONSOON/ACCESSORIZE brand store formats whereby the two stores are adjacent to one another. Some MONSOON stores sell goods under the trade-mark ACCESSORIZE such that there are, in the UK alone, 249 stores selling ACCESSORIZE brand items in some capacity. He provides some details of the worldwide picture of ACCESSORIZE brand retail outlets by providing a list per country of the store locations of

ACCESSORIZE brand retail outlets except for the UK. However, again in this portion of the Opponent's evidence there are no specific references to any use of those trade-marks in Canada.

[22] I note that exhibit 1 to Mr. Simon's affidavit is a list of the Opponent's stores around the world as of March 9, 2007. On that list appears also the opening date for each one of them. There are 11 stores located in Canada identified on that list but the earliest date of opening for those stores is December 5, 2004 which is subsequent to our relevant date of October 11, 2001.

[23] He states that for every ACCESSORIZE brand retail store, in all jurisdictions, his Company's trade-mark ACCESSORIZE is used extensively and prominently both on in-store materials and advertising and promotion.

[24] He states that his Company owns a Community trade-mark and international registrations through the Madrid Protocol as well as registrations in numerous countries including Canada and the United States. He does provide a list of all those other countries.

[25] He alleges that the trade-mark ACCESSORIZE has been featured prominently above the stores' entrance ways, on the front windows and walls and on the stores' sidewalk signs. He filed pictures of store front signage in various countries including Canada. However we have no information as to when the picture illustrating the store front signage located in Canada was taken and, even more important, when such store front signage was first used in Canada.

[26] His Company ensures the consumers' experience of an ACCESSORIZE brand retail outlet in one country is the same as it would be anywhere else in the world. His company supplies all of the merchandise sold under the ACCESSORIZE brand and controls the character and quality of the services provided under the brand and directs the manner in which the ACCESSORIZE trade-mark is used. He provides photos of samples of royalty cards, loyalty cards, store business cards, hang tags, plastic bags, store coupons, contest promotions, belt hangers, store pins, store shirts worn by sales clerks

and sales receipts all bearing the trade-mark ACCESSORIZE and used in various countries around the world.

[27] Each of his Company's ACCESSORIZE brand retail outlets offer a vast array of merchandise, with each store grouping more than 1500 items by themed colour combinations for easy browsing. The products include: bags, hats, purses, jewellery, belts, scarves, shoes, gloves, hair ornaments and style aids, hosiery, sunglasses, umbrellas, ponchos, lingerie stationary and cosmetics.

[28] He states that the trade-mark ACCESSORIZE appears prominently printed on the items themselves or on a label sewn into the article or on swing tickets, hangtags, sock riders, printed hangers, packaging, plastic display plates, and/or bags. He filed photos showing such various use of the trade-mark ACCESSORIZE.

[29] He provides in paragraph 28 of his affidavit the annual sales figures in the UK of merchandise bearing the trade-mark ACCESSORIZE which totaled for the period of 2000 to 2005 more than £750,000,000 and breaks down these numbers by category of items namely: hats, bags, jewellery, scarves and lifestyle. The international sales for the same period were in excess of £250,000,000. He also provides a breakdown of the sales figures for the same period by country including Canada. There are no sales figures for Canada before 2004 as the information provided is limited to the Opponent's franchisee Bibelot.

[30] He states that his company was using the ACCESSORIZE trade-mark well before October 11, 2001 in Canada. However it is a bald statement as there is no documentary evidence to support such evidence. In any event "use" is a legal term defined in s. 4 of the Act. There must be evidence that leads to such a conclusion. There is no information as to when the Opponent began operating stores in Canada, by itself or through a licensee, under the trade-marks ACCESSORIZE and/or MONSOON ACCESSORIZE or selling merchandise in Canada under any of those trade-marks. If the Opponent had been using in Canada the trade-mark ACCESSORIZE and/or MONSOON ACCESSORIZE in Canada prior to October 11, 2001 as alleged, one would have expected to see in the chart

at paragraph 28 of Mr. Simon's affidavit sales figures for the years 2000 to 2003 inclusive, which is not the case.

[31] Then he describes the events that led to the launching of the ACCESSORIZE ANGELS brand collection in October 2001 that features precious items and clothing geared towards little girls aged three to eight years old. He provides in paragraph 20 of his affidavit a list of items sold in association with the ACCESSORIZE ANGELS brand since 2001. However this trade-mark is not alleged in the Opponent's statement of opposition. Consequently, I shall not take into consideration any evidence of use of that trade-mark, if any, in Canada. In any event neither Mr. Simon nor Ms. Fransen mentioned a date of first use in Canada of that trade-mark. Mr. Simon does state in paragraph 19 of his affidavit that there are currently six ACCESSORIZE brand retail stores in Canada where the line of products bearing the trade-mark ACCESSORIZE ANGELS is available.

[32] He states that considerable sums of money are spent internationally to advertise and promote the ACCESSORIZE brand. He does provide amounts of money so spent including for Canada. He files representative samples of his Company's international promotion of its products and services in association with the trade-mark ACCESSORIZE which includes print advertisements from the UK, Japan, Norway, Canada, Greece, Holland, South Africa, Singapore and Korea. Exhibit 10 Tab D consists of photocopies of print advertisements showing products placements from Canada. We have no information as to when those ads would have been used in Canada. There is no information as to whether the print advertisements from other countries ever circulated in Canada and if so when and how.

[33] He states that his Company lands A-list names to be associated with the ACCESSORIZE brand. A new international celebrity is chosen for each new collection such as: Claudia Schiffer, Mischa Barton, Naomi Campbell, Sophie Dahl, Elizabeth Jagger and Kelly Osbourne.

[34] He alleges that using glamorous international celebrities to promote the ACCESSORIZE brand further solidifies the brand "fashion-forward" image in the minds

of the purchasing public. He filed samples of advertisement used around the world featuring celebrities. With respect to the advertising and promotion using celebrities' images in association with the trade-mark ACCESSORIZE in Canada, for those where a date is printed on the document filed, they issued subsequent to October 11, 2001.

[35] From this evidence I conclude that the Opponent has not discharged its initial evidential burden to prove that its trade-marks were used or made known in Canada prior to October 11, 2001 nor that its trade-names were ever used in Canada prior to the aforesaid relevant date.

[36] Under these circumstances I have no alternative but to dismiss the fourth and fifth grounds of opposition on the basis that the Opponent failed to meet its evidential burden.

Distinctiveness

[37] To meet its initial burden under this ground of opposition the Opponent had to prove that its trade-marks ACCESSORIZE and/or MONSOON ACCESSORIZE had become sufficiently known in Canada on July 24, 2006, the filing date of the statement of opposition, to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

[38] As mentioned previously, Ms. Franssen asserts that Bibelot started operating ACCESSORIZE brand retail outlets in Canada in key locations, under license from the Opponent, in 2004. To evidence such use she filed representative photos of the storefronts on which we see a sign bearing the trade-mark ACCESSORIZE. There are also sidewalk signs bearing the trade-mark ACCESSORIZE facing the street nearby the location of one of the stores.

[39] The trade-mark ACCESSORIZE appears on signs placed inside the stores, on letterhead, loyalty card, plastic bag, hangers, sales receipt, gift card holder and gift card, sewn-in label, swing tickets/hangtags, plastic jewellery display plates. Sometime, depending on the nature of the product, the mark appears on the item itself (shoes for example).

[40] She provides the sales figures by store location and by year in paragraph 17 of her affidavit. The sales in Canada for the period of December 4, 2004 to September 19, 2006 totalled well over \$6 million. There is also a breakdown by category of items such as bags, hats, jewellery, scarves, lifestyle and gift bags. There have been nearly 530,000 items sold under the trade-mark ACCESSORIZE in Canada as of September 19, 2006.

[41] She also provides the sums of money spent by Bibelot for the promotion and advertising of the ACCESSORIZE brand in Canada. For 2004 and 2005, Bibelot spent close to \$150,000 in advertising and marketing in Canada to promote the trade-mark ACCESSORIZE.

[42] She filed a representative advertisement for the ACCESSORIZE brand featuring Naomi Campbell that appeared in the issue of April 2005 of Flare Magazine, a Canadian publication as well as one appearing in TV Guide (for Canada) dated November 2005 featuring Mischa Barton. Prior to the opening of the first store in Canada, Bibelot engaged the services of a public relations firm to assist in putting together a program for the ACCESSORIZE brand which included the distribution of media kits.

[43] Regional brand visibility is emphasized through community newspapers, television and radio. She provides a detailed description of the public relations campaign for the period of December 2004 to September 2005 as well as for the period of June 2005 to December 2005. She filed a DVD showing a representative sample of television coverage in respect of the ACCESSORIZE brand broadcasted in Canada.

[44] Then she provides a list of publications that circulated in Canada wherein print advertisements were placed between December 2004 and March 2006. However I am not taking into consideration the circulation figures appearing on the top of each page. We have no information on the origin of these figures. It constitutes inadmissible hearsay evidence.

[45] From this portion of the Opponent's evidence I conclude that it has met its initial evidential burden to show that its trade-mark ACCESSORIZE was known in Canada to some extent as of July 24, 2006. Consequently the Applicant has a legal onus to show, on

a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted at the relevant date to distinguish or actually distinguished throughout Canada the Services from the Opponent's wares and services [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)].

[46] The test to determine this issue is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[47] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel Inc. v. 3894207 Canada Inc.* [2006]1 S.C.R. 772 (S.C.C.)].

[48] The Applicant's written argument is not very helpful on the assessment of the various criteria to determine if there is a likelihood of confusion between the parties' trade-marks. It contends that the Opponent's trade-mark ACCESSORIZE is not distinctive, being commonly adopted and used, per se, by many others in the fashion industry.

[49] Jonathan Burkinshaw was, at the time of execution of his affidavit, employed by the Applicant's agent firm as an Articling Student. Part of his evidence includes extracts of various dictionaries for the word "accessorize" which is defined in the *Canadian Oxford Dictionary*, Second edition as: "choose to wear accessories to suit (clothing etc.)". Therefore the trade-mark ACCESSORIZE is a weak trade-mark being suggestive when used in association with clothing accessories. As such, it is only entitled to a narrow ambit of protection [see *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)]. The Mark is also inherently weak for similar reasons. The first portion of the first criteria listed in s. 6(5)(a) does not appear to favour either of the parties.

[50] The distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. I already described the Opponent's use of its trade-mark ACCESSORIZE in Canada in order to determine if it had met its initial burden of proof under this ground of opposition. I shall now describe the evidence filed by the Applicant with respect to its use of the Mark during the relevant period.

[51] Helen Hastings is the Applicant's owner. The Applicant's first store opened on October 11, 2001 in Toronto, Ontario. A second location opened in June 2003 in Port Credit, Ontario. Those stores sell fashion items and accessories for women, men and children. She filed photos of the stores' signage on which appear the Mark.

[52] She states that the Mark appears on business cards, hangtags and labels. She filed samples and/or photos of them. They have been used since 2001 in Canada. The Mark also appears on store receipts and stationary and she also filed samples of those. It has also appeared on bags and gift boxes used in Canada since 2001. Photos of them were also annexed to her affidavit.

[53] She states that the retail stores operated under the Mark advertise in various local newspapers such as the Villager/Annex Guardian and Evening Out. She produces a sample of such advertising. However we have no information on the extent of their circulation. The Mark also appears on promotional and sales flyers distributed to customers and potential customers. Between 15,000 to 20,000 of each of these flyers were distributed in the Greater Toronto Area. A sample has been filed in the record.

[54] The ACCESSORIZE ME retail stores are promoted in *Fashion* magazine in Canada by way of co-op advertising. She filed samples of those advertisements. However, because of the relevant date I can only consider those published in May and September 2005 as well as the one published in the winter of 2006. Mr. White of the Audit Bureau of Circulation has provided the circulation figures across Canada of that magazine during the publication period of these advertisements. There were at least 142,000 copies of each issue in which an advertisement of the Applicant's Services in association with the Mark that circulated during the relevant period.

[55] She alleges that the ACCESSORIZE ME brand stores have been promoted on various third-party websites and she filed samples of those advertisements. However for those extracts bearing a date, they were published after the relevant date associated with this ground of opposition. She states that the Applicant spent over \$40,000 in advertising between 2001 and 2006. She provides the yearly sales figures which total over \$2.5 million during the same period.

[56] This evidence leads me to conclude that the Applicant's mark was known to some extent in Canada as of July 24, 2006. The question remains: which trade-mark was more known? The Opponent used its trade-mark ACCESSORIZE in Canada starting in December 2004 through its licensee Bibelot while the Applicant had been using the Mark in Canada since October 2001. However it would appear that the Applicant has been operating only two stores, both located in Ontario, while the Opponent, through its licensee, has been operating 11 stores located in Ontario, Alberta and British Columbia at the relevant date. The sales figures of the Opponent were over \$6.5 million between December 5, 2004 and September 19, 2006. I acknowledge that the latter date is outside the relevant period but less than two months after the relevant date. It is hard to imagine that the bulk of those sales would have occurred during those two months.

[57] As for the advertisement expenditures, Bibelot spent approximately \$150,000 in Canada to promote and advertise the ACCESSORIZE brand while the Applicant has spent over \$40,000 in total to advertise the Mark in Canada between 2001 and 2006.

[58] Consequently I am of the opinion that the Opponent's trade-mark ACCESSORIZE was more known than the Mark in Canada at the relevant date.

[59] As for the period of time the trade-marks have been used, this factor favours the Applicant.

[60] The Services overlap with the services being offered by the Opponent in association with its trade-mark ACCESSORIZE.

[61] In general, when considering the nature of the trade of the parties, it is the statement of the wares and services in the application that governs. [See *Mr. Submarine*

Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3 (F.C.A.)] Evidence of the actual trades of the parties could be useful in reading the statement of wares and services with a view of determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.)]. It appears from the evidence described above that the parties' channels of trade are very similar.

[62] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.)].

[63] The first component of a trade-mark is generally speaking the most important part of a trade-mark for the purpose of distinguishing it from another trade-mark. However such general principle is much less determinative when the first component consists of a common word. Small differences in those cases are often sufficient to distinguish two trade-marks [see *Maximum Nutrition Ltd. v. Kellogg Salada Canada* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. In the present case the first component of the Mark is the Opponent's trade-mark. The idea conveyed by the Mark is slightly different than the idea suggested by the Opponent's trade-mark. The Mark refers to the action of "accessorizing" a person while the Opponent's trade-mark simply refers to the verb "accessorize".

[64] As an additional surrounding circumstance the Applicant, through the affidavit of Jonathan Burkinshaw, filed certain extracts of websites. The sites visited between October 15 and 26, 2007 where the word "accessorize" appears on the extracts are:

- Roots
- Blue Oasis
- Accessorize West
- Kiso
- Smith's Shoes
- Urban Trendz

all having places of business in Canada. He also visited the websites of Reader's Digest and Weddingbells. This portion of the Applicant's evidence is not relevant as it was obtained after the relevant date.

[65] He filed extracts from the Canada411.ca directory that correspond to the two locations operated by the Applicant under the Mark and Accessorize with Flair. He then printed the results of a search using the website yahoo.ca using the word "accessorize". He printed the first 50 results out of 71, 300 hits. Again this evidence was obtained after the relevant date.

[66] He then visited between October 15 and 26, 2007 the Toronto Reference Library wherein he consulted the ProQuest Canadian Newsstand database which offers access to full text coverage of a collection of over 190 newspapers across Canada, Canadian magazines and leading Canadian and international periodicals. He consulted and filed extracts of the following magazines: Chatelaine, Flare, Maclean's, Newsweek, People, Seventeen and Today's Parent. Most of the articles filed were published prior to the relevant date and the word "accessorize" is used in the text in a descriptive sense.

[67] Extracts of the following newspapers were annexed to his affidavit: Calgary Herald, Edmonton Journal, The Gazette, The Globe and Mail, National Post, The Province (Vancouver), The Record (Kitchener), The Spectator (Hamilton), Star-Phoenix (Saskatoon), Sudbury Star, Toronto Star, The Vancouver Sun and The Windsor Star. The word "accessorize" appears in a descriptive form in those extracts. I note that most of these articles were published prior to the relevant date.

[68] The Applicant takes the position that such evidence shows that the Opponent's trade-mark is a weak trade-mark. But so is the Mark. I have already concluded in such fashion when I assessed the inherent distinctiveness of the parties' trade-marks.

[69] We have a situation where the Mark incorporates the entirety of the Opponent's trade-mark as its first component. However ACCESSORIZE is a suggestive word when used in association with the services of retail sale of fashion accessories. Does the addition of the word "me" to "accessorize" sufficient to to negate any likelihood of

confusion between the marks in issue? From the analysis of the relevant criteria , I am left in a state of doubt. Consequently since the legal onus is on the Applicant to show, on a balance of probabilities, that the Mark was distinctive when used in association with the Services at the filing date of the statement of opposition, I maintain the sixth ground of opposition [see *R.J. Reynolds Tobacco Co. v. Philip Morris Products Inc.* (1995) 64 C.P.R. (3d) 395 (T.M.O.B.)].

Registrability Under s. 12(1)(d)

[70] The Opponent has met its initial burden by filing certificates of authenticity for each of the registered trade-marks identified under that ground of opposition. I checked the register and they are all extant. The most relevant registration is ACCESSORIZE, registration number TMA617,925 covering:

Soaps, shampoos, perfumes, toilet waters, eau de cologne, cosmetics, namely, non-medicated preparations for application to, conditioning and care of skin, scalp and hair, anti-perspirants; talcum powder; aromatherapy oils.

Sunglasses, spectacles, video cameras, photographic cameras, personal computers, laptop computers; audio and visual apparatus and instruments, namely, televisions, videos; pre-recorded CDs, DVDs, tapes and cassettes containing music, information and video.

Jewellery and imitation jewellery, namely, earrings, necklaces, bracelets, anklet chains, brooches, rings, precious stones and watches.

Bags, namely, tote bags, handbags, shoulder bags, shopping bags, cosmetic bags, luggage, rucksacks, backpacks, wallets, purses.

Headwear, namely, hats and caps; neckwear, namely, scarves, ties and cravats; swimwear; beachwear; footwear, namely, boots, shoes, slippers, beach footwear, athletic footwear, children's footwear, exercise footwear, infant footwear, outdoor winter footwear; nightwear; gloves; hosiery; socks; shawls; ponchos; bandanas and belts for wear.

Hair ornaments, hair pins, hair slides, hair ribbons, braids, ribbons, lace, embroidery and badges.

Soaps for personal use, shampoos, perfumes, toilet waters, eau de cologne, non-medicated toilet preparations; non-medicated preparations for application to, conditioning and care of the skin, body and scalp; body sprays; depilatory preparations; non-medicated hair preparations; dentifrices; essential oils; anti-perspirants; preparations for the bath and shower; bath oils; bath salts; talcum powder; aromatherapy oils; fragrances.

Sunglasses, spectacles; frames, lenses, cords and cases all for spectacles and sunglasses; video cameras and photographic cameras, laptop computers, personal computers, audio and video apparatus and instruments, namely,

televisions, videos; pre-recorded CDs, DVDs, tapes and cassettes containing music, information and video.

Earrings, necklaces, jewellery, brooches and imitation jewellery, rings and watches.

Bags, tote bags, shoulder bags, belts, shopping bags, cosmetic bags, luggage, rucksacks, backpacks; umbrellas, wallets and purses.

Belts (clothing), scarves, hats, hosiery, socks, gloves, ponchos, shoe trims in the nature of fashion adornments for shoes; bandannas, shawls, armbands, headbands, and caps.

and the following services:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothing and fashion store, by mail order, from a catalogue, an Internet web site and a television shopping channel, all specialising in clothing and fashion.

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothing and fashion store, from a catalogue, an Internet web site and a television shopping channel, all specialising in clothing and fashion including by means of telecommunications or mail order.

[71] The criteria used to assess the likelihood of confusion between the Mark and the Opponent's trade-mark ACCESSORIZE are the same than those discussed under the distinctiveness ground of opposition. However under this ground of opposition there is an additional fact to take into consideration: the Opponent is the owner of a registered trade-mark.

[72] The relevant date is different, namely the date of my decision. Consequently I must consider some of the evidence disregarded earlier. However such evidence would not have altered my analysis of the extent to which the marks in issue were known in Canada at the date of my decision. Some of the additional evidence to take into consideration would simply confirm that the parties' marks are weak trade-marks.

[73] For the same reasons discussed under the ground of opposition of distinctiveness of the Mark, I conclude that the Applicant has not discharged its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's registered trade-mark ACCESSORIZE. Consequently the third ground of opposition is also maintained.

Disposition

[74] Pursuant to the authority delegated to me under s. 63(3) of the Act I refuse the application the whole in accordance with s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office



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

Citation: 2011 TMOB 111

**IN THE MATTER OF AN OPPOSITION
by Monsoon Accessorize Limited to
application No. 1,245,313 for the trade-
mark ACCESSORIZE ME filed by
Accessorize Me Inc.**

CORRECTED DECISION

[1] I have been informed that there was a clerical error that had slipped into my decision regarding an opposition to the registration of the trade-mark ACCESSORIZE ME, application No. 1,245,313. In paragraphs 69 and 73 of my decision, I clearly indicated that I maintained the grounds of opposition based on non-registrability and non-distinctiveness.

[2] Yet in my conclusion in paragraph 75 of my decision I rejected the opposition.

[3] I therefore corrected paragraph 75 that now reads:

[75] Pursuant to the authority delegated to me under s. 63(3) of the Act I refuse the application the whole in accordance with s. 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 21TH DAY OF JULY 2011

Jean Carrière
Member, Trade-marks Opposition Board