



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

Citation: 2016 TMOB 141
Date of Decision: 2016-08-16

IN THE MATTER OF OPPOSITIONS

Strellson AG **Opponent**

and

Madis Imports Inc. **Applicant**

1,596,956 for JOOL **Applications**

1,596,957 for JOOL COMFORT

[1] Madis Imports Inc. (the Applicant) has applied-for registration of the trade-marks JOOL and JOOL COMFORT for use in association with shoes, boots, sandals and slippers for men, women and children (the Goods). The Applicant's applications are based on the proposed use of these trade-marks in Canada.

[2] Strellson AG (the Opponent) has opposed these applications on the basis that (i) the JOOL and JOOL COMFORT trade-marks are confusing with its previously filed application for the trade-mark JOOP! covering various types of footwear and (ii) that the Applicant did not intend to use the JOOL or JOOL COMFORT trade-marks in Canada.

[3] For the reasons that follow, I find that the oppositions should be rejected.

Application No. 1,596,956

[4] I will first consider the Opponent's opposition to application No. 1,596,956.

Background

[5] On October 4, 2012, the Applicant filed an application for the trade-mark JOOL (the Mark) based on the proposed use of the Mark in Canada in association with the Goods.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 7, 2013. JOOP! GmbH filed a statement of opposition on December 6, 2013. Following a transformation and merger of JOOP! GmbH into the Opponent, Strellson AG, the statement of opposition was amended to reflect the Opponent's updated name and address. The grounds of opposition pleaded are as follows:

- (a) the application does not comply with section 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because the Applicant has not at any time intended to use the Mark in Canada; and
- (b) the Applicant is not the person entitled to registration of the Mark in view of section 16(3)(b) of the Act since it was confusing with the Opponent's application No. 1,404,483 for JOOP!.

[7] The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[8] The Opponent filed as its evidence a certified copy of application No. 1,404,483. The Applicant filed as its evidence the affidavit of Issy Joffe. Both parties filed a written argument. A hearing was not requested.

Onus and Material Dates

[9] 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 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

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

Grounds of Opposition

Section 30(e) Ground of Opposition

[11] As the Opponent advised in its written argument that it is no longer relying on this ground of opposition (para 3), it will not be considered further.

Section 16(3)(b) Ground of Opposition

[12] The Opponent has alleged that the Applicant is not the person entitled to registration of the Mark in view of section 16(3)(b) of the Act since the Mark is confusing with the Opponent's application No. 1,404,483 for JOOP!

[13] To discharge its evidential burden, the Opponent must show that its application for JOOP! was (i) filed prior to the filing date of the application for the Mark and (ii) pending at the date of advertisement of the application for the Mark [section 16(4) of the Act]. The certified copy of application No. 1,404,483 for JOOP! filed by the Opponent is sufficient to meet its evidential burden. Since the Opponent has met its burden, the Applicant must now show, on a balance of probabilities, that there was no likelihood of confusion between the Mark and the

Opponent's trade-mark. Attached as Schedule A are the goods and services in application No. 1,404,483 for JOOP! as of the material date.

[14] 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.

[15] 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), 92 CPR (4th) 361 (SCC).]

[16] Finally, the test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer with an imperfect recollection of the Opponent's trade-mark who sees the Goods bearing the Mark, would think they emanate from or are sponsored by or approved by the Opponent.

Inherent distinctiveness of the trade-marks

[17] Both marks are highly inherently distinctive. The parties' marks are coined words which do not appear to describe or suggest the goods associated with each mark.

Extent known and length of time in use

[18] Neither the Opponent or the Applicant has evidenced that their trade-marks have acquired any distinctiveness through use or promotion as of the material date.

The nature of the goods and their channels of trade

[19] This factor favours the Opponent as the nature of the goods appears to be identical as the Opponent's application includes footwear such as shoes, boots, motorists' shoes, lace boots, esparto shoes and sandals, half-boots, gymnastic shoes, and beach shoes. Given the overlap in goods, I infer the nature of trade is also likely to overlap.

Degree of resemblance

[20] In the present case, the marks resemble each other in appearance because they both begin with the same three letters, i.e. "JOO" and are only four letters long. The marks, however, do not possess the same degree of resemblance in sound, because of their very different endings (OOP vs OOL). With respect to ideas suggested, while both trade-marks suggest a coined word, I find that the Mark suggests the similar sounding word "jewel" when sounded, whereas the Opponent's trade-mark does not have the same connotation.

[21] The Opponent relies on *Conde Nast Publications Inc. v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD) for the principle that the first portion of a trade-mark is the most important for assessing the likelihood of confusion and argues that the Applicant has appropriated the first and very distinctive portion of its trade-mark JOOP! which suggests that the average Canadian consumer would find that these marks as a whole are confusing (Opponent's Written Argument, paras 28-29). Confusion, however, will be unlikely in situations where marks share common features but also feature dominant differences such that the differences are a sufficient signal to the public that the products associated with each mark have different sources [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)]. I find the different endings of the trade-marks to be such a dominant difference. Further, when resemblance is assessed from the point of view of whether there is an aspect of the trade-mark that is particularly striking or unique [*Masterpiece*, 64], I do not find that the trade-marks resemble each other to a significant degree solely on the basis that they share the same beginning. Rather the striking element in each case is the coined word that the marks consist of in their entirety. Finally, the Opponent's focus on the individual parts of the Mark that are the same as its mark, appears to involve a side-by-side comparison of the type warned against by the

courts [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23 at para 20; *International Stars SA v Simon Chang Design Inc*, 2013 FC 1041 at para 9].

Surrounding Circumstance: Applicant Commenced Use Prior to Opponent

[22] The evidence of Mr. Joffe, the President of the Applicant, shows that the Applicant commenced use of the Mark in Canada in 2013 and between March 2013 and October 2014 sold over \$325,000 worth of JOOL and JOOL COMFORT brand shoes in Canada (Joffe affidavit, paras 3,7 Exhibits A, B1-B3). In its written argument, the Applicant submits that the fact that it has commenced use while the Opponent has not is a relevant surrounding circumstance (at para 39):

In our respectful submission, important surrounding circumstances should also be considered. The evidence clearly sets out that the Applicant is a Canadian company that has diligently penetrated the Canadian marketplace almost as soon as it filed the Application. The Opponent, on the other hand, is a German-based company that faltered for seven years before actually penetrating the Canadian market. In fact, the Applicant's use-based trade-mark rights supersede the Opponent's by two years.

I do not agree with these submissions. As there is no requirement for a party filing a trade-mark application on the basis of proposed use to show use of a trade-mark prior to the filing of the declaration of use, the fact that there is no evidence the Opponent has begun to use its trade-mark JOOP! is not relevant. Furthermore, since the Applicant's use of the Mark occurred after the material date, the fact that the Applicant has commenced use is likewise not relevant.

Surrounding Circumstance: Deletion of Overlapping Goods

[23] In its written argument, the Applicant submits that the Opponent's application has now matured to registration and does not include "footwear" of any kind (Applicant's Written Argument, para 17). Even if such a deletion had occurred and was in evidence, I would not have found it to be a relevant surrounding circumstance. I draw the Applicant's attention to the analogous case *ConAgra Inc v McCain Foods Ltd* (2001), 14 CPR (4th) 288 at 312-320 (FCTD) where Justice Blais found that the subsequent abandonment of an opponent's application or goods in an application in support of a section 16(3)(b) ground is not relevant if it occurs after the material date.

Surrounding Circumstance: Scope of Protection Afforded to Broad Trade-marks

[24] While I agree with the Opponent's submissions at para 26 of its Written Argument that when a trade-mark is a unique or a created name referring only to one thing, it is given a larger scope of protection, this principle does not extend so far as to automatically result in a likelihood of confusion with another trade-mark which shares the same first letters.

Conclusion

[25] I find that the Applicant has met the onus on it to show that the balance of probabilities weighs in its favour on the issue of confusion. Having regard to the above, in particular the degree of resemblance, as a matter of first impression and imperfect recollection, I find a consumer purchasing JOOL Goods would not infer such goods were manufactured, sold or otherwise emanate from or were licensed, approved or sponsored by the Opponent. As such, this ground of opposition is rejected.

Application No. 1,596,957 for JOOL COMFORT

[26] Application No. 1,596,957 for the trade-mark JOOL COMFORT was also filed on October 4, 2012, and is based on the Applicant's proposed use in Canada in association with the Goods.

[27] The grounds of opposition, issues, material dates and evidence are entirely analogous to those discussed with respect to application No.1,596,956. In its written argument, the Opponent indicates it is not relying on the section 30(e) ground of opposition. For the section 16(3)(b) ground of opposition, with respect to the section 6(5)(e) factor degree of resemblance, I note that the term COMFORT is a descriptive term and it adds little distinctiveness to the applied-for mark. It follows that I make the same findings with respect to the section 16(3)(b) ground of opposition in application No. 1,596,657 for JOOL COMFORT and application No. 1,595,656 for JOOL. Accordingly, I reach the same conclusion and this ground of opposition is rejected.

Disposition

[28] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition to both applications.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Agates, jewellery, namely amulets, pins, bracelets; watch bands, wristwatches, ingots of precious metal, charms, jewellery of yellow amber, brooches, busts of precious metal, chronographs, chronometers, chronoscopes, diamonds, threads of precious metal, precious stones, clocks and watches, ivory, cases for clock- and watch making, figurines of precious metal, clock cases, watch cases, watch glasses, gold thread, silver thread, semi-precious stones, necklaces, hat ornaments of precious metal, jewellery chains, watch chains, cuff links, tie clips, medals, medallions, coins, ornament pins, earrings, pearls, platinum, pearls made of ambroid, rings, key rings, shoe ornaments of precious metal, spun silver (silver wire), sun dials, spinel (precious stones), stopwatches, paste jewellery, watches, clocks, cases for watches, alarm clocks; document files; photograph albums; announcement cards; cabinets for stationery; paintings framed or unframed; paper sheets; pencils; pencil sharpeners; pencil sharpening machines; stationery pads; paperweights; letter trays; writing paper; pamphlets; books; bookends; penholders; fountain pens; greeting cards; envelopes; folders for papers; passport holders; hat boxes of cardboard; calendars; coasters of paper; cardboard; lithographic works of art; bookmarkers; office perforators; office punches; magazines; paper knives; scrapers (erasers) for offices; pencil leads; pencil lead holders; note books; wrapping paper; face towels of paper; towels of paper; table napkins of paper; handkerchiefs of paper; conical paper bags; photographs; photo-engravings; posters; portraits; postcards; prospectuses; rubber erasers; rosaries; boxes of cardboard or paper; signboards of paper or cardboard; patterns for dressmaking; pen cases; inkstands; writing instruments; writing or drawing books; writing cases; place mats of paper; table cloths of paper; table linen of paper; table mats of paper; cardboard articles, namely hat boxes, boxes, signboards, advertising signs, cartons and containers; drawing pads; drawing boards; drawing sets; drawing instruments, namely brushes, paper, pencils, rulers, templates, pads and boards; graphic prints; periodicals; newspapers; cigar bands; attaché cases, backpacks, bags for campers, envelopes, pouches of leather, for packaging; beach bags, briefcases, canes, card cases, leather and leather board cases, leather cases for pens, chain mesh purses, fur skins, leather trimmings for furniture, hunting game bags, garment bags for travel, handbags, haversacks, key cases, goatskin, kidskin and kid leather, net bags for shopping, parasols, pocket wallets, purses, school satchels, shopping bags, suitcases, tool bags of leather, travelling bags, travelling trunks, umbrella covers, umbrellas, valises, vanity cases, wheeled shopping bags; clothing, namely suits and layettes, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas, clothing of imitations of leather and clothing of leather, namely coats, collar protectors, corselets, corsets; cyclists clothing; dressing gowns, ear muffs, esparto shoes and sandals, furs, garter belts, gloves, gymnastic shoes, half boots, headbands, hosiery, jackets, jerseys, knitwear clothing, namely cardigans, sweaters, pullovers, shirts; lace boots, layettes, motorists' clothing namely jackets, belts, trousers, shoes and gloves; muffs; fittings of metal for shoes and boots, teddies, brassieres, clothing, namely belts and gloves, clothing for gymnastics, gymnastic shoes, half-boots, scarves, slippers, jumpers, shirts, trousers, suspenders, hats, jackets, jerseys, pockets for clothing, camisoles, corsets, neckties, clothing bibs; underwear, coats, corselets, dressing gowns, caps, outerclothing and waterproof clothing, namely aprons, money belts, boas (necklets), coats, fishing vests, jackets, maniples, mantillas, pelisses, smocks, top coats, vests, rain coats and waterproof rainwear, ear muffs, parkas, pelerines, furs, petticoats, pullovers, pyjamas, cyclists' clothing; skirts, sandals, collar protectors, sashes for wear, veils, wimples, breeches forwear, lace

boots, shoes, overalls, ski boots, underpants, socks, sock suspenders, boots for sports, boots, headbands, esparto shoes or sandals, shawls, beach clothes, beach shoes, garters, stockings, tights, sweaters, tee-shirts, togas, knitwear, singlets, overcoats, pants, wet suits for water-skiing, waistcoats, hosiery.

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Fogler, Rubinoff LLP

FOR THE APPLICANT

Fetherstonhaugh & Co.

FOR THE OPPONENT