



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

Citation: 2014 TMOB 144
Date of Decision: 2014-07-14

**IN THE MATTER OF AN OPPOSITION
by William Adams to application
No. 1,515,644 for the trade-mark I AM &
Design in the name of Sven Bullaert**

[1] William Adams opposes registration of the trade-mark I AM & Design (the Mark), shown below, applied for registration under serial No. 1,515,644 based upon proposed use in Canada in association with, among others, purses, wallets, handbags, and several other types of bags, including sport and travel bags. The full statement of wares of the application is reproduced in Schedule “A” to my decision.



[2] The application, which was originally filed by Didiworld Company Ltd. on February 17, 2011, currently stands in the name of Steven Bullaert further to an assignment recorded by the Canadian Intellectual Property Office on March 8, 2012. The term “Applicant” shall be used throughout to refer to the owner of the application for the Mark at the relevant time.

[3] The statement of opposition was filed by William Adams (the Opponent) on July 16, 2012. Three of the five grounds of opposition are premised on allegations that the application does not comply with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The two other grounds of opposition are premised on allegations of confusion between the Mark and the Opponent’s trade-mark I AM alleged to have been used and made known in

Canada by the Opponent in association with different types of wares including, among others, jewellery, watches, wallets, purses, all-purpose carrying bags and several other types of bags, clothing, footwear and headwear.

[4] In support of his opposition, the Opponent filed his own affidavit and an affidavit of Paul Alexander Bost.

[5] The Applicant did not conduct cross-examination and elected not to file evidence in support of his application.

[6] Only the Opponent filed a written argument and was represented at the hearing.

[7] Despite the Applicant's apparent lack of interest in this proceeding, for the reasons that follow, I find that the opposition ought to be rejected.

Legal Onus and Evidential Burden

[8] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to his pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Grounds of Opposition Alleging Non-compliance with Section 30 of the Act

[9] The material date for considering a ground of opposition based upon non-compliance with section 30 of the Act is the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[10] Although none of the three grounds of opposition, as pleaded, references a specific subsection of section 30 of the Act, it is apparent that the Opponent is alleging non-compliance with sections 30(a), 30(e) and 30(i) of the Act respectively.

[11] Each of these grounds of opposition is summarily dismissed for the reasons that follow.

Non-compliance with section 30(a) of the Act

[12] The Opponent did not file evidence in support of the ground of opposition alleging that the statement of wares contained in the application does not describe specific wares and did not make any submissions about it. Thus, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.

Non-compliance with section 30(e) of the Act

[13] The Opponent did not file any evidence in support of the ground of opposition alleging that the Applicant did not intend to use the Mark in Canada. However, in his written argument the Opponent submits at paragraph 56:

[...] The Opponent could not force the Applicant to be cross-examined in this proceeding and therefore it is reasonable to have expected the Applicant to provide evidence that it intended to use the Mark in Canada with all of the wares in the Application and then give the Opponent the opportunity to cross-examine the Applicant. This did not occur and therefore it is submitted that the application should be rejected on this ground.

[14] As the application contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada, it formally complied with section 30(e) of the Act as of February 17, 2011. The question becomes whether or not the application substantially complied with section 30(e) of the Act, namely: Was the Applicant's statement that it intended to use the Mark true? [See *Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

[15] An applicant does not have to evidence use of a proposed trade-mark and there is no requirement to use a proposed trade-mark until it is approved. As there is no evidence

establishing that the Applicant falsely made the statement required by section 30(e) of the Act, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.

Non-compliance with section 30(i) of the Act

[16] Section 30(i) of the Act requires an applicant to include in the application a statement that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[17] As the Applicant provided the required statement and there is no evidence of bad faith in the present case, the ground of opposition is dismissed.

Grounds of Opposition Alleging Confusion with the Opponent's trade-mark I AM

[18] The two grounds of opposition premised on allegations of confusion between the Mark and the Opponent's trade-mark I AM raise the following issues:

1. Was the Applicant the person entitled to the registration of the Mark as of the filing date of the application?
2. Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?

[19] I will analyze these issues in turn.

Was the Applicant the person entitled to the registration of the Mark as of the filing date of the application?

[20] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark in view of confusion with the Opponent's trade-mark I AM allegedly used and made known in Canada by the Opponent since at least as early as June 2009 in association with different types of wares including, among others, jewellery,

watches, wallets, purses, all-purpose carrying bags and several other types of bags, clothing, footwear and headwear.

[21] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of establishing that his alleged trade-mark I AM had been used or made known in Canada prior to the filing date of the application for the Mark [section 16(3)(a) of the Act] and had not been abandoned at the date of advertisement of the application, namely May 16, 2012 [section 16(5) of the Act].

[22] The Opponent has not made any submissions to the effect that his evidence shows that his trade-mark I AM had been “made known” in Canada prior to February 17, 2011 within the definition of “made known” set out in section 5 of the Act. However, the Opponent contends that his own affidavit and the affidavit of Mr. Bost, both sworn on May 9, 2013, evidence the use of his trade-mark I AM in Canada prior to February 17, 2011 and its non-abandonment in Canada. Thus, I shall review the evidence, starting with the Opponent’s own affidavit.

[23] The Opponent affirms, among others, that:

- he is professionally known in Canada and throughout the world as will.i.am, which is his stage name;
- he is globally recognized as a performer, musician, entertainer, songwriter, producer, philanthropist and entrepreneur;
- he is the front man of the Grammy-award winning musical group The Black Eyed Peas;
- he first used the trade-mark I AM on clothing in 2000 and he wore clothing bearing the trade-mark in public;
- in early 2009, he decided to launch a men’s wear collection “under the i.am clothing label in collaboration with i.am je suis inc., a division of a Montreal-based company known as Manhattan International” (Manhattan International);
- he first used the trade-mark I AM for clothing in Canada in June 2009;

- he owns the domain name *iamclothing.net*, which hosts a website dedicated to his “i.am clothing label”;
- he was interviewed on the television programs *Entertainment Tonight Canada* and CTV’s *eTalk* regarding his “i.am clothing line in 2009”. Internet printouts and a DVD containing these interviews are appended to the affidavit as Exhibit A;
- on June 21, 2009, The Black Eyed Peas performed at the Much Music Awards in Toronto, Ontario. At that event, he wore a jacket with a metal arm band “bearing the logo of his clothing line”. Exhibit B to the affidavit are two photographs taken at the event with an enlargement of the logo on the metal arm band, which I reproduce below;



- Manhattan International launched the “i.am clothing line” during the August/September 2009 MAGIC apparel trade show (the MAGIC show) in Las Vegas, Nevada, which is attended by apparel companies, prospective customers and vendors from the United States and abroad, including Canada. More than 100,000 invitations containing the I AM mark were sent out for the event hosted by Manhattan International at Planet Hollywood restaurant. A copy of the invitation is appended as Exhibit C to the affidavit;
- he has used the trade-mark I AM himself and through Manhattan International since as early as June 2009;
- the trade-mark I AM “is used” on rivets, buttons, buckles, hooks, cord locks, hangtags, neck tags, spare button envelopes, and badges attached to the clothing; on the wares themselves, on removable tie pins and ribbons attached to the wares; on hangers displaying the wares; on background screens used during interviews; on display cases and displays; and
- the I AM wares are sold through retail stores in Canada.

[para 2-10 of the affidavit]

[24] Exhibits A to C to the Opponent's affidavit are of no assistance to establish use of the trade-mark I AM in Canada in association with clothing within the meaning of section 4(1) of the Act. As a matter of fact, the Opponent did not file any documentary exhibits to support his assertions of use of the trade-mark I AM in association with clothing, which was acknowledged by the Opponent's agent at the hearing. However, the Opponent's agent reiterated the submissions found in the Opponent's written argument based on the absence of cross-examination. More particularly, the Opponent submits that his assertions of use of the trade-mark I AM in Canada must be taken as true because they have not been challenged by the Applicant.

[25] An analogous argument was addressed by Member Carrière in *H-D Michigan Inc v The MPH Group Inc.* (2004), 40 CPR (4th) 245 (TMOB). I make mine the following comments of Member Carrière at page 254:

... [A]ccording to the Opponent, if statements are unchallenged by the other party, they should be taken as is. I can't subscribe to such theory. One should not lose track of the fact that the term "use" is a legal term defined in Section 4 of the Act. If the Opponent based its opposition on the ground that the applicant is not the person entitled to registration because, at the time of filing of the application, the trade-mark applied for was confusing with a trade-mark previously used in Canada, as set out in Section 16 of the Act, we must refer to Section 4 of the Act for the meaning of such term. Reference to such Section to determine if there has been proper evidence of "use" of a trade-mark is not uncommon in opposition proceedings. [See for example *Bombardier Ltd. v. British Petroleum Co. Ltd.*, *Bombardier Ltd. v. British Petroleum Co. Ltd.*, (1973), 10 C.P.R. (2d) 21, *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R.(2d) 183 and *Hughes Aircraft Co. v. Fairchild Camera & Instrument Corp.* (1990), 33 C.P.R. (3d) 500]. The Applicant may have decided not to challenge the statements contained in the Opponent's affidavits on the basis that they didn't constitute proper evidence of use as argued in its written submissions.

[26] It was the responsibility of the Opponent to file evidence enabling me to conclude that he had *in fact* used or made known his alleged trade-mark I AM in Canada in association with clothing before February 17, 2011. The Opponent failed to do so through his own affidavit.

[27] In turning to the evidence filed by Mr. Bost, I note that I will only discuss the evidence concerning the trade-mark I AM as I see no need to discuss the evidence concerning the Opponent's musical endeavors and the musical group The Black Eyed Peas.

[28] Mr. Bost, who resides in the United States and is an associate at the law firm of Sheppard Mullin Richter & Hampton LLP, counsel for the Opponent, states at paragraph 3 of his affidavit:

Mr. Adams is involved in a lawsuit with Manhattan International entitled *I Am Je Suis, d/b/a I Am Clothing, a division of Manhattan International, Inc. v. William Adams*, pending in Superior Court of the State of California for the County of Los Angeles, Case No. BC 482703 (“the Lawsuit”). In connection with the Lawsuit, Manhattan International has produced its business records relating to the I AM clothing line and accessory line to Will Adams. I have reviewed the relevant business records to prepare this Affidavit.

[29] I note that my subsequent use of the terms “I AM Wares” reflects the use of these terms by Mr. Bost as a collective reference to the wares listed at paragraph 8 of his affidavit. This list of wares is reproduced in Schedule “B” to my decision.

[30] Based on the business records of Manhattan International, Mr. Bost affirms, among others, that:

- after the MAGIC show, “Manhattan International shipped samples of the I AM Wares to its showrooms in New York and in Los Angeles”. Copies of “commercial invoices showing” the shipment of wares are appended as Exhibit D;
- after the MAGIC show, “Manhattan International had more than 8,747 units of I AM clothing and other products made and delivered to its offices in Canada for resale”. Redacted copies of the invoices “relating to those purchases” are appended as Exhibit E;
- more than 50 retailers purchased I AM Wares from Manhattan International;
- since June 2009, the sales of I AM Wares in Canada have exceeded approximately Can\$800,000;
- Mr. Adams and Manhattan International have advertised, marketed and promoted the trade-mark I AM through issuance of press releases, personal appearances, line sheets given to prospective customers, and trade shows. Retailers that sell the I AM Wares have also promoted and advertised the products through press releases and publicity in various magazines. Among the specimens of advertising filed with the

affidavit are “copies of a collection of advertising and promotional material which has been distributed in Canada” filed as Exhibit F; and

- from 2009 to the date of his affidavit, Manhattan International spent at least \$250,000 in advertising, promoting and marketing the I AM Wares in Canada.

[para 5-11 of the affidavit].

[31] The statements made by Mr. Bost on the basis of Manhattan International’s records are *prima facie* inadmissible hearsay evidence. The question becomes whether these statements satisfy the criteria of necessity and reliability, which will also determine the weight to be accorded to the evidence [see *Labatt Brewing Company Limited v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. It should be noted that the Opponent’s agent at the hearing declined my invitation to make submissions on the hearsay issue.

[32] I do not doubt that Mr. Bost reviewed the business records of Manhattan International filed in connection with the Lawsuit for the purposes of his affidavit. However, there is nothing to indicate that it was necessary to provide the information through his affidavit rather than directly through an affidavit of a representative of Manhattan International.

[33] Even if I were to infer that the Opponent could not obtain an affidavit of a representative of Manhattan International because of the Lawsuit, there is nothing to indicate why it was necessary for Mr. Bost to provide the evidence rather than the Opponent himself. After all, the Opponent filed an affidavit in this proceeding, which is notably silent on the Lawsuit. I find it is reasonable to conclude that the Opponent would have had access to any information available in Manhattan International’s business records relating to the use and advertisement of his trade-mark I AM and there is nothing in the Opponent’s own affidavit to suggest otherwise.

[34] In the end, I conclude that the statements made by Mr. Bost based on Manhattan International’s business records do not meet the first criterion of the hearsay rule, namely necessity. Accordingly, I disregard the evidence introduced by Mr. Bost concerning the use and advertisement of the Opponent’s trade-mark I AM.

[35] In view of the above, I conclude that the Opponent has failed to provide evidence establishing use of his trade-mark I AM in Canada prior to February 17, 2011. Accordingly, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.

Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?

[36] This issue arises from the ground of opposition alleging non-distinctiveness of the Mark and revolving around the likelihood of confusion between the Mark and the Opponent's alleged trade-mark I AM.

[37] The Opponent has failed to provide evidence showing that, as of July 16, 2012, his alleged trade-mark had become known to any extent in Canada to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[38] Accordingly, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.

Disposition

[39] Having dismissed every ground of opposition, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Statement of Wares of Application No. 1,515,644, as amended on January 23, 2012

Purses, wallets, ladies handbags, backpacks, all purpose (*sic*) athletic bags, messenger bags, all purpose (*sic*) sport bags other than shaped to contain specific sports apparatus, beach bags, hand-held travel bags, clutch bags, duffel bags, leather shopping bags, overnight bags, school bags, shoulder bags, textile shopping bags, tote bags, travel bags, garment bags for travel, shoe bags for travel, attaché cases, briefcases, suitcases, luggage trunks, luggage, key cases, passport cases, credit-card cases, briefcase-type portfolios, travel bags, tool bags, envelopes and drawstring pouches of leather for packaging, umbrellas and walking sticks, leather book covers.

Schedule “B”

Wares Collectively Referred to as the I AM Wares in the Affidavit of Paul Alexander Bost

Jewelry, leather and imitations of leather, and goods made of these materials and not included in other classes; trunks; travelling bags; all-purpose carrying bags, money clips, back packs, wallets, purses, key cases, luggage, messenger bags, leather key chains; handbags; shoulder bags; carrier bags; hair accessories; backpacks; casual bags; eyewear; clothing, namely blazers, jackets, jeans, loungewear, neckwear, sweaters, pants, scarves, shirts, socks, t-shirts, and vests; belts; footwear; and headwear.