



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

Citation: 2011 TMOB 139
Date of Decision: 2011-08-10

**IN THE MATTER OF AN OPPOSITION
by Retail Royalty Company and
American Eagle Outfitters, Inc. to
application No. 1,345,073 for the trade-
mark HAWKE & CO. OUTFITTER &
Bird Design in the name of Hawke &
Company Outfitters LLC**

[1] On April 26, 2007, Hawke & Company Outfitters LLC (the Applicant) filed an application to register the trade-mark HAWKE & CO. OUTFITTER & Bird Design, as shown hereafter (the Mark):



[2] The Mark has been applied for registration based on proposed use in Canada in association with “clothing, namely casual clothing, athletic attire, business attire, children's clothing, formal wear, lounge wear, sleep wear, outdoor summer, spring, fall and winter wear, rainwear, undergarments, swimwear, beachwear, socks, gloves, belts; footwear, namely boots, shoes, sandals and slippers” (the Wares).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 2, 2008.

[4] On September 2, 2008, Retail Royalty Company (RRC) and American Eagle Outfitters, Inc. (AEO) filed a statement of opposition. Unless otherwise stated, all references to the Opponent hereafter are references to RRC and AEO collectively. I am summarizing hereafter the grounds of opposition pleaded pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. The application does not conform to the requirements of s. 30(e) of the Act as the Applicant did not, in fact, intend to use the Mark in Canada in association with all of the Wares.
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act since it is confusing with the registered trade-mark AMERICAN EAGLE OUTFITTERS (No. TMA536,829) owned by RRC for clothing and accessories and retail store services for clothing and accessories.
3. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(b) of the Act since it is confusing with the trade-mark of RRC, shown below, previously used and made known in Canada in association with clothing and retail clothing store services:

 AMERICAN EAGLE OUTFITTERS

(hereafter the trade-mark AMERICAN EAGLE OUTFITTERS & Design)

4. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and (b) of the Act since it is confusing with the trade-marks of RRC identified in the attached Schedule A, which have been previously used or made known in Canada and subject of previously filed applications.
5. The Mark is not distinctive, nor is it adapted to distinguish the Wares from the wares and services of RRC.

[5] The Applicant filed a counter statement denying each ground of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Rebecca Gibbs, sworn April 10, 2009, with Exhibits “A” to “S”. In support of its application, the Applicant filed the affidavit of Aron Rosenberg, sworn July 16, 2009, with Exhibits “A” to “F”. The affiants were not cross-examined.

[7] Both parties filed written arguments and were represented at the oral hearing where I dealt with two preliminary issues, as discussed hereafter.

[8] First, I accepted that the reference to s. 16(3)(b) of the Act in the third ground of opposition was a clerical error and was meant as a reference to s. 16(3)(a) of the Act. It is apparent that the Applicant had understood that the ground of opposition was based upon prior use and made known of the trade-mark AMERICAN EAGLE OUTFITTERS & Design.

[9] Second, I noted to the Applicant’s agent that Mr. Rosenberg identifies himself as President of Hawke Company Outfitters LLC rather than Hawke & Company Outfitters LLC (my emphasis). The Applicant’s agent explained that there is a clerical error in the Rosenberg affidavit, which explanation was accepted by the Opponent’s agent. Under these circumstances, I confirm accepting that the reference to Hawke Company Outfitters LLC in the Rosenberg affidavit is meant as a reference to the Applicant.

Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the application complies with the requirements of the Act. However, there is 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 onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) (*Christian Dior*); *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Material Dates

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

- s. 38(2)(a)/s. 30(e) – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3) – the filing date of the application; and
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Opponent's Evidence

[12] Ms. Gibbs has been Chief Counsel-Intellectual Property with AEO since September 2007. She has direct responsibility for the monitoring, maintenance and protection of the trade-marks owned, used or licensed by AEO and its related subsidiary corporations, including RRC. Ms. Gibbs has access to relevant business records that are kept by AEO and its related and subsidiary corporations in their normal course of business [par. 1].

[13] Ms. Gibbs files printouts of the registration and applications alleged in the statement of opposition and owned by RRC, a wholly-owned subsidiary of AEO [Exhibits “A” to “J”].

[14] For a better understanding of my analysis of the Opponent's evidence, I note accepting that the references to the “EAGLE Design” trade-mark or the “EAGLE logo” in the Gibbs affidavit are references to the following design:



[15] I also note that Ms. Gibbs introduces the evidence of use and advertisement by referring to RRC's trade-marks sometimes as the AMERICAN EAGLE OUTFITTERS mark, the EAGLE Design mark (EAGLE logo), the AMERICAN EAGLE mark, the AMERICAN EAGLE OUTFITTERS and the EAGLE Design trade-marks or the AMERICAN EAGLE OUTFITTERS trade-marks. Unless indicated otherwise, I will refer to these marks as the RRC's trade-marks.

[16] According to Ms. Gibbs's statements, at the date of her affidavit (April 10, 2009), AMERICAN EAGLE OUTFITTERS stores had been operated in Canada for over eight years; there were over 75 stores in operation in Ontario, Quebec, British Columbia, Alberta, Saskatchewan, Manitoba, Newfoundland, Nova Scotia and New Brunswick [par. 4, Exhibit "K"]. The stores are operated by a subsidiary, American Eagle Outfitters Canada Corporation, which is licensed by RRC to use its trade-marks and RRC exercises strict control over the use, advertisement and display of its trade-marks by the licensee [par. 5]. Since the opening of the first Canadian store, the trade-mark AMERICAN EAGLE OUTFITTERS has been continuously used and displayed at all of the stores, as well as on labels and hang tags attached to all of the wearing apparel, footwear and accessories sold in Canada [par. 6].

[17] According to the Gibbs affidavit, annual sales of AMERICAN EAGLE OUTFITTERS wearing apparel, footwear and accessories at the Canadian stores have ranged from over US\$129 million to over US\$269 million from 2004 to 2008 [par. 7].

[18] Photographs of various stores [Exhibit "L"] as well as samples of internal signage and point of sale materials displayed within each of the stores [Exhibit "M"] are appended to the affidavit as representative specimens of use of RRC's trade-marks in association with retail clothing store services in Canada. Hangtags and labels are appended to the affidavit [Exhibit "N"] as representative specimens of use of RRC's trade-marks in association with wearing apparel, footwear and accessories sold in Canada or shipped to Canadians by means of on-line sales, as discussed below. Finally, photographs of wearing apparel, footwear and accessories are appended to the affidavit [Exhibit "O"] to show the display of RRC's trade-marks on the wares themselves in addition to hand tags and labels attached to them.

[19] Ms. Gibbs files excerpts of the website *www.ae.com* [Exhibit "P"]. She states that the website, launched in May 1998, is operated by AE Direct Co. LLC., a subsidiary which is

licensed by RRC to use its trade-marks and RRC exercises strict control over the use, advertisement and display of its trade-marks by the licensee [par. 12].

[20] According to the Gibbs affidavit, wearing apparel, footwear and accessories have been purchased online by Canadians since at least as early as 2003; the website attracted in excess of 16 millions “hits” from Canadians from November 17, 2006 to March 14, 2009 [par. 13]. An excerpt of the Canadian online store operated as part of the website is appended as Exhibit “Q” to the affidavit. I note that the excerpt does not show any date and Ms. Gibbs does not indicate when the excerpt was printed. As such, I conclude that the excerpt is representative of the Canadian online store at the date of the Gibbs affidavit.

[21] Paragraphs 14 through 16 of the Gibbs affidavit relate to advertising and promotion of RRC’s trade-marks in Canada. Advertising activities include the website, in-store activities, direct mail advertising to Canadians and print advertising. Ms. Gibbs files representative specimens of direct mail advertising material [Exhibit “R”] and of print advertising that appeared in magazines circulated and sold in Canada, such as *Seventeen*, *In Style*, *Maxim* and *Cosmo Girl* [Exhibit “S”]. The total advertising expenses incurred by and in connection with the Canadian operations exceeded US\$3 million each year for at least the last five years prior to the date of the Gibbs affidavit.

Applicant’s Evidence

[22] Mr. Rosenberg is President of the Applicant, a company engaged in the manufacture, importation, sale and distribution of adult and children’s outerwear and accessories [par.1]. He has been President of the Applicant since its inception in March 2006; prior to that he was President of Daron Fashions Group [par. 2].

[23] Mr. Rosenberg states that Daron Fashions Group and Daron Fashions Inc. (the Daron Corporations) are companies associated with the Applicant and are licensed to sell the Applicant’s products including those bearing the Mark [par. 3]. Clothing for children and adults associated with the Mark are offered for sale through the Daron Corporations [par. 10].

[24] According to the Rosenberg affidavit, the Applicant's approximate sales (USD) for Canada amounted to \$11,220 in 2007, \$54,335 in 2008 and \$100,000 in 2009 [par. 11]. The Applicant "has been selling its products continuously in Canada since as early as Fall 2007" [par. 13]. The Applicant's products are sold in Canada at Winners stores [par. 12].

[25] Copies of invoices to Winners is appended as Exhibit "C" to the affidavit. I note that these are invoices for the years 2007 and 2008 issued by Daron Fashions Inc. to Winners in Ontario. Also appended to the affidavit are copies of "work sheets" from Winners for the Applicant's goods [Exhibit "D"], an extract from the Applicant's catalogue with "six styles which bear" the Mark [Exhibit "E"], and copies of photographs of clothing items sold to Winners and showing the Mark on the label of each item" [Exhibit "F"].

[26] Mr. Rosenberg files a copy of the report issued during the examination of the application by the Canadian Intellectual Property Office (CIPO) [Exhibit "B"]. He notes that the RRC's trade-marks were not cited against the application and that the objections based on a registration for the trade-mark HAWK & Design (No. TMA345,334) and an application for the trade-mark HAWK (No. 1,091,076) were successfully overcome [par. 5]. I note that in addition to the examiner's report, Exhibit "B" includes print-outs of registration No. TMA345,334 and No. TMA712,362, which issued from application No. 1,091,076. These registrations are owned by third parties.

[27] I note in passing that I am not affording any significance to the fact that the application for the Mark did not encounter any objections based upon RRC's trade-mark registration and previously filed trade-mark applications alleged in the statement of opposition. Suffice it to say that decisions by the Examination Section of CIPO are not binding and have no precedential value in determining the registrability of a trade-mark in an opposition proceeding [see *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.OB)].

[28] I am also not affording any significance to Mr. Rosenberg's statements that the Mark is known in Canada, that it is distinctive and not confusing with the trade-marks alleged by the Opponent [pars. 8 and 18]. These are all questions of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

[29] In concluding my review of the Applicant's evidence, I wish to address the Opponent's submissions as to ambiguities in the Rosenberg affidavit with respect to the evidence of use of the Mark in Canada. At the oral hearing, the Opponent's agent submitted that it is "completely unclear" whether the Canadian sale figures provided in the Rosenberg affidavit relate to wares associated with the Mark nor can it be concluded that such is the case. In that regard, the Opponent's agent submitted that Mr. Rosenberg's statement that the Applicant's wares sold in Canada by the Daron Corporations include those bearing the Mark (my emphasis) must lead to the conclusion that not all of the Applicant's wares sold in Canada by the Daron Corporations are wares bearing the Mark. While a more complete picture of the Canadian sales of the Wares would likely have been elicited by cross-examination, the Opponent elected to forgo cross-examination. Further, despite deficiencies and lack of specificity, based on a fair reading of the Rosenberg affidavit as a whole, I am satisfied that it establishes use of the Mark in Canada since November 2007 in association with clothing, in particular outdoor fall and winter wear. I am also satisfied that the Daron Corporations merely act as sales agent for the Applicant.

Analysis of the grounds of opposition

[30] At the outset, I dismiss the ground of opposition based upon non-conformity to s. 30(e) of the Act as I find that the Opponent has not discharged its evidential burden with respect thereto.

[31] All of the remaining grounds of opposition turn on the issue of confusion between the parties' marks. I am analyzing these grounds hereafter, although not necessarily in their order of pleading.

Non-entitlement pursuant to s. 16(3)(a) of the Act

[32] The Opponent has pleaded two non-entitlement grounds of opposition based upon s. 16(3)(a) of the Act. The first s. 16(3)(a) ground of opposition is based on the previous use and making known in Canada of RRC's trade-mark AMERICAN EAGLE OUTFITTERS & Design in association with clothing and retail clothing store services. The second s. 16(3)(a) ground of opposition is based on the previous use or making known in Canada of RRC's trade-marks identified at Schedule A.

[33] Despite the onus resting on the Applicant, the Opponent has the initial burden of proving that RRC's alleged trade-marks were used or had been made known in Canada prior to the filing date of the application for the Mark and had not been abandoned at the date of advertisement of such application [s. 16(5) of the Act].

[34] I will start with the analysis of the ground of opposition based on the previous use and making known in Canada of RRC's trade-mark AMERICAN EAGLE OUTFITTERS & Design in association with clothing and retail clothing store services.

[35] Although Ms. Gibbs does not specifically refer to the trade-mark AMERICAN EAGLE OUTFITTERS & Design, I note that hang tags, labels and photographs of wearing apparel filed with her affidavit do display the EAGLE Design in combination with the words AMERICAN EAGLE OUTFITTERS, as do specimens of direct mail advertising and website pages. In most instances the EAGLE Design is shown above the words AMERICAN EAGLE and the word OUTFITTERS is shown below them. I am satisfied that such display amounts to use of the trade-mark AMERICAN EAGLE OUTFITTERS & Design as pleaded in the ground of opposition [see *Canada (Registrar of Trade Marks) v. Cie internationale pour l'informatique CII Honeywell Bull, S.A.* (1985), 4 C.P.R. (3d) 523 (F.C.A.)].

[36] Based on a fair reading of the Gibbs affidavit in its entirety, I am satisfied that the Opponent has discharged its evidentiary burden of showing the prior use and non-abandonment of the trade-mark AMERICAN EAGLE OUTFITTERS & Design in Canada in association with clothing and retail clothing stores. Thus, the Applicant has the burden to convince the Registrar, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the trade-mark AMERICAN EAGLE OUTFITTERS & Design as of April 26, 2007.

[37] 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.

[38] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 the trade-marks have 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* 2011 SCC 27 (*Masterpiece*) for a thorough discussion of the general principles that govern the test for confusion].

[39] In its written argument, the Applicant refers to several decisions where two trade-marks were found not to be confusing, although the elements of one mark incorporated the second mark in its entirety. Suffice it to say that the likelihood of confusion between the trade-marks at issue is a question of probabilities and surrounding circumstances based on the particular facts of this case. In other words, each case has to be decided upon its own merits.

Consideration of the s. 6(5) factors

[40] At the oral hearing, the Opponent's agent submitted that the word "outfitter" is not a generic word. I disagree. Indeed, the *Oxford Canadian Dictionary* provides the following definition for "outfitter": "*N Amer.* 1. a supplier of equipment for outdoor activities such as hiking trips etc. 2. a person who acts as guide on wilderness trips etc." That said, I assess the inherent distinctiveness of the parties' marks as about the same. The strength of a trade-mark may be increased by means of it becoming known through promotion or use. Obviously, the Mark had not acquired any distinctiveness at the material date. It is somewhat difficult to assess with precision the acquired distinctiveness of the trade-mark AMERICAN EAGLE OUTFITTERS & Design, *per se*. Still, considering the annual Canadian sales and advertising expenses provided in the Gibbs affidavit along with the specimens of use, I accept that the trade-mark AMERICAN EAGLE OUTFITTERS & Design had become known to a fair extent in Canada at the material date. Hence, the overall consideration of the s. 6(5)(a) factor favours the Opponent. The length of time the parties' marks had been in use as of the material date also favours the Opponent.

[41] The Applicant does not debate that there is an overlap between the wares associated with the parties' trade-marks. However, the Applicant seemingly debates the Opponent's position as to the overlap between the parties' nature of trade. Indeed, in oral argument, the Applicant's agent submitted that a consumer looking for the Opponent's wares would go to the Opponent's stores. In reply, the Opponent's agent argued that there is no evidence that the wares associated with the mark AMERICAN EAGLE OUTFITTERS & Design are only sold in the AMERICAN EAGLE OUTFITTERS retail stores. I recognize that the Gibbs affidavit establishes that the Opponent's wares can be purchased on-line. However, when considering sales in Canadian retail stores, I find it reasonable to infer from the Opponent's evidence that the wares are sold only in stores operated by the Opponent's licensee, although I acknowledge that the Opponent is not prevented to sell these wares in other stores than the AMERICAN EAGLE OUTFITTERS stores. In any event, both parties provide their wares by means of retail clothing stores and so I conclude to an overlap between the nature of the trade.

[42] The Supreme Court of Canada in *Masterpiece* recently reiterated that the degree of resemblance in appearance or sound or in the ideas suggested "is often likely to have the greatest effect on the confusion analysis". It is trite law that when assessing the degree of resemblance between two marks they are to be looked at in their entirety and not dissected [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 56 (Can. Ex. Ct.), affirmed (1946), 5 C.P.R. 71 (S.C.C.)]. When assessing the resemblance between trade-marks, Mr. Justice Rothstein stated in *Masterpiece*, at paragraph 64: "While the first word may, for the purposes of distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique."

[43] In the present case, the points of similarity between the marks are found in the word "OUTFITTER" and the design of a bird.

[44] While the word "OUTFITTER" cannot be said to be a highly distinctive element of the parties' marks, it is found as the last element of both marks. Also, there is no evidence to conclude that such word, at the material date, was commonly adopted as a component of trade-marks used in association with clothing and accessories.

[45] The Applicant submits that the words “HAWKE & CO.” at the beginning of the Mark result in the Mark being visually and phonetically distinct. At the oral hearing, the Applicant’s agent argued differences between the bird designs. More particularly, he argued that the bird in the Mark “is in flight” whereas the bird in RRC’s mark “is landing”. By contrast, the Opponent argues that the bird designs are similar in that they both consist of the silhouette of a bird with outstretched wings and talons.

[46] Although I agree with the Applicant that there exist significant differences between the trade-marks when sounded, I disagree that there are also significant differences between the marks when viewed. For one thing, when considering the Mark in its entirety, I find that the bird design is as striking as the words “HAWKE & CO”. In other words, I disagree with the Applicant’s position that the words “HAWKE & CO” are predominant in the Mark. Further, I find that the designs of the bird in the parties’ marks show a fair degree of resemblance in that they both depict the silhouette of a bird of prey with outstretched wings. Also, I find that there is a fair degree of resemblance between the ideas suggested by the parties’ marks.

[47] This leads me to address the Applicant’s submissions that “similar bird designs have been allowed to co-exist [in the fashion industry] and as a result small differences are enough to distinguish the marks”. The Applicant filed as Exhibit “A” to its written argument examples of “only some of the marks that have been allowed” to co-exist on the register. I am disregarding Exhibit “A” to the Applicant’s written argument since state of the register evidence should have been filed by way of affidavit or statutory declaration, as required by the *Trade-marks Regulations*, SOR/96-195. Moreover, in opposition proceedings, the Registrar does not exercise his discretion to have regard to anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant. Also, given that print-outs of two registrations owned by third parties were filed as part of Exhibit “B” to the Rosenberg affidavit, I note that the mere existence of two registrations is insufficient to make any inference about the state of the marketplace [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[48] In the end, the Applicant has failed to provide any evidence establishing that trade-marks involving the design of a bird are commonly adopted and used in Canada association with clothing and accessories.

[49] The Applicant advances the absence of “any evidence at all of any single incident of confusion” between the parties’ marks as an additional surrounding circumstance supporting a finding of no likelihood of confusion. An opponent is under no obligation to submit evidence of instances of actual confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. That said, if there is evidence of extensive concurrent use, an absence of evidence of actual confusion over a relevant period of time may entitle one to draw a negative inference about the likelihood of confusion [see *Christian Dior, supra*]. As there was no use of the Mark in Canada at the material date, no adverse inference concerning the likelihood of confusion can be drawn from the lack of evidence of instances of confusion.

[50] The Opponent advances RRC’s family of “other Bird Designs trade-marks” as an additional circumstance enhancing the likelihood of confusion between the trade-marks at issue. In order to claim the benefit of a family of marks, the Opponent must prove use of each mark in the alleged family [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)].

[51] The Opponent submitted in its written argument that RRC’s Bird Design marks have been extensively used and promoted, both individually and in combination with the trade-mark AMERICAN EAGLE OUTFITTERS. At the oral hearing, the Opponent’s agent submitted that several exhibits to the Gibbs affidavit evidence the use of the EAGLE Design mark individually. However, the Opponent’s agent conceded that except for bird designs displayed at the bottom of a few pages of the website (Exhibit O to the Gibbs affidavit), there is no evidence directed to the use or advertisement in Canada of each of the Bird Design marks of application Nos. 1,341,663; 1,336,782 and 1,336,780. In the end, I find that the Bird Design marks of RRC do not form a family. For one thing, the EAGLE Design mark differs substantially from the remaining Bird Design marks of application Nos. 1,341,663; 1,336,782 and 1,336,780, as shown in Schedule A. Moreover, there is no evidence of use of the remaining Bird Design marks, and a family typically consists of more than two marks.

Conclusion on the likelihood of confusion

[52] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Weighing all of the factors and their relative importance together, I arrive at the conclusion that the probabilities of confusion between the marks at issue are evenly balanced between a finding of confusion and of no confusion. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark was not confusing with the trade-mark AMERICAN EAGLE OUTFITTERS & Design at the filing date of the application, I accept the first non-entitlement ground of opposition based upon s. 16(3)(a) of the Act.

[53] Since I accept the first s. 16(3)(a) ground of opposition, I see no need to address the second one based on the previous use or making known in Canada of the trade-marks identified at Schedule A.

Non-distinctiveness

[54] In order to meet its initial burden with respect to this ground of opposition, the Opponent has to show that the alleged trade-marks of RRC had become known sufficiently as of September 2, 2008 to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[55] To the extent that this ground of opposition is based upon confusion with each of the Bird Design marks of application Nos. 1,341,663; 1,336,782 and 1,336,780, it is dismissed for the Opponent's failure to meet its evidential burden. As discussed above, the Opponent has failed to evidence use of these trade-marks.

[56] However, I am satisfied that the Opponent's evidence establishes that the trade-mark AMERICAN EAGLE OUTFITTERS & Design had become known sufficiently as of September 2, 2008 to negate the distinctiveness of the Mark.

[57] Because the difference in relevant dates does not substantially affect my analysis above under the first s. 16(3)(a) ground of opposition, I find that the Applicant has not discharged its

onus to establish on a balance of probabilities that the Mark, as of September 2, 2008, was not confusing with the trade-mark AMERICAN EAGLE OUTFITTERS & Design.

[58] As I accept the non-distinctiveness ground of opposition based upon the trade-mark AMERICAN EAGLE OUTFITTERS & Design, I do not find it necessary to address the non-distinctiveness ground of opposition based upon the AMERICAN EAGLE OUTFITTERS mark and the EAGLE Design mark of RRC.


[59] Since I have already found in favour of the Opponent under two grounds of opposition, I will not address the s. 38(2)(b)/s. 12(1)(d) and the s. 38(2)(c)/s. 16(3)(b) grounds of opposition.



Disposition



[60] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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

SCHEDULE A

Appl. No. Filing Date	Trade-mark	Wares/Services
1,285,941 Jan. 13, 2006		<p>After-shave lotions, non-medicated lip balm, bath oil, bath powder, non-medicated bath salts, bubble bath, beauty masks, body cream, body oil, body powder, cologne, perfume, toilet water, cosmetic pencils, hand cream, eye cream, night cream, shaving cream, skin cleansing cream, skin cream, deodorant soap, personal deodorants, antiperspirants, combination deodorants/antiperspirants, emery boards, essential oils for personal use, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliners, face powder, facial scrubs, foundation makeup, bath gel, shaving gel, shower gel, lip gloss, lipstick, hair conditioners, hair gel, hair rinses, hair spray, skin lotion, facial lotion, body lotion, makeup, facial makeup, mascara, massage oil, skin moisturizer, nail enamel, nail polish, rouge, sachets, hair shampoo, shaving balm, shaving lotion, skin cleansing lotion, skin soap, skin toners, liquid soaps for hand, face and body, and cosmetics, including compacts; candles; eyewear, including sunglasses; jewelry, including belt buckles of precious metal for clothing, ankle bracelets, bracelets, identification bracelets, bracelets of precious metal, brooches, watch chains, charms, ear clips, earrings, costume jewelry, cuff-links, necktie fasteners, tie fasteners, necklaces, ornamental pins, pendants, lapel pins, pins, and rings; watches, including stop watches, wrist watches; money clips made of precious metal; clocks; stationery, posters, pictorial, art and color prints, calendars, travel diaries, pens, pencils, portfolios, notepads, greeting cards, note cards; athletic bags, all-purpose athletic bags, all-purpose sports bags, backpacks, barrel bags, beach bags, book bags, clutch bags, duffel bags, gym bags, leather shopping bags, shoulder bags, tote bags, travel bags, billfolds, briefcases, business card cases, calling card cases, credit card cases, attache cases, document cases, key cases, overnight cases, passport cases, passport wallets, passport holders, credit card holders, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty, change purses, clutch purses, coin purses, drawstring pouches, waist packs, handbags, leather key fobs, knapsacks, luggage, luggage tags, pocketbooks, briefcase-type portfolios, purses, rucksacks, satchels, suitcases, and wallets; clothing and accessories, namely, blazers, vests, sweaters, turtleneck sweaters, sweater coats, skirts, skorts (combination skirt and shorts), pants, jeans, shorts, shirts, t-shirts, sport shirts, pull-overs, overalls, blouses, shortalls, polo shirts, rugby shirts, halters, halter tops, sweatshirts, sweatpants, and fleecewear, swimwear, beach cover-ups, sleepwear, pajamas, robes; underwear, namely bras, panties, boxer shorts, shell bra tanks, undershirts; outerwear, namely</p>

Appl. No. Filing Date	Trade-mark	Wares/Services
		<p>jackets, vests, parkas, coats, pea cotats, ski pants and ski jackets, 3-in-1 system coats, snowboarding pants and jackets, anoraks, gloves, ear muffs, scarves and mittens; ties; belts; footwear, namely socks, shoes, slippers, leather boots, rubber boots, insoles, sandals, flipflops, sneakers, clogs, slides, and hosiery; athletic footwear, namely athletic shoes, trail and hiking shoes and boots, canvas shoes and rollerskates; headwear, namely hats, hoods, caps, baseball caps, visors, sun visors, headbands, babushkas, head and wrist sweatbands, headscarves, and berets; Retail store services, electronic retail commerce over the Internet/world wide web, catalog retail sales, mail order and phone order retail sales, all for: fragrances, cosmetics and personal care goods; candles; sunglasses; jewelry and wristwatches; stationery, posters, pictorial, art and color prints, calendars and travel diaries, pens, pencils, portfolios, notepads, greeting cards and note cards; bags, namely wallets, handbags, purses, shoulder bags and luggage, school bags, backpacks, daypacks, waist packs, duffle bags, general purpose sport bags, laundry bags, and portfolios; umbrellas; and wearing apparel and clothing accessories.</p>
<p>1,341,663 Mar. 30, 2007</p>		<p>Bags and luggage namely, athletic bags, backpacks, beach bags, book bags, duffel bags, tote bags, travel bags, clutches, purses, coin purses, shoulder bags, fanny packs, wallets, business, calling and credit card cases, passport wallets, toiletry cases sold empty, luggage and luggage tags; umbrellas; Wearing apparel, clothing and clothing accessories, namely coats, bathing suits, beachwear, clothing belts, blouses, bottoms, capes, foul weather gear, gym suits, tops, hosiery, jackets, jeans, jerseys, dresses, leg warmers, lingerie, loungewear, outerwear, pyjamas, pants, sweat pants, ponchos, pullovers, robes, sashes, scarves, shawls, shirts, sweat shirts, shorts, skirts, slacks, sleep wear, socks, sweaters, swim wear, underwear and vests; footwear namely athletic shoes, boots, espadrilles, clogs, shoes, sandals, and socks; headwear namely bandannas, visors, head bands, hats, hoods and sweat bands.</p>
<p>1,336,782 Feb. 23, 2007</p>		<p>Tote bags; Lingerie, loungewear, pyjamas, robes, sleep wear, underwear, footwear, namely, athletic shoe, boots, esparilles, clogs, shoes, sandals, and socks; headwear, namely, bandannas, visors, head bands, hats, hoods and sweat bands; Retail store services, mail order services, catalogue sales services, electronic retail store services using a global computer and/or communications network, all in the field of wearing apparel, loungewear, underwear, lingerie, pyjamas and nightgowns, footwear, namely, athletic shoe, boots, esparilles, clogs, shoes, sandals, and socks; headwear, namely, bandannas, visors, head bands, hats, hoods and sweat bands, bags.</p>

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1,336,780 Feb. 23, 2007		<p>Personal care products and cosmetics, namely shaving balm, shaving cream, shaving gel, shaving lotion, shower gel, non-medicated lip balm, lip gloss, lipstick, bath oil, bath powder, beauty masks, body cream, bubble bath, cosmetic compacts, hair conditioners, skin cream, deodorants and antiperspirants, nail polish, eye makeup, facial scrubs, facial lotions, body lotions, makeup, facial makeup, face powder, hair shampoo, skin clarifiers, skin lotions, soap, sun block preparations, fragrances, perfume and cologne; Athletic bags, backpacks, beach bags, book bags, duffel bags, overnight bags, tote bags, clutch purses, purses, coin purses, waist packs, pocketbooks, rucksacks, shoulder bags, drawstring pouches, and briefcases; wallets, business card cases, calling card cases, document cases, passport cases, holders or wallets, and credit card cases; toiletry cases sold empty; luggage, luggage tags; umbrellas; Clothing, and clothing accessories, namely bathing suits, beachwear, clothing belts, blouses, bottoms, coats, dungarees, fleece pants, tops, hosiery, jackets, jeans, jerseys, jumpers, kerchiefs, lingerie, loungewear, pajamas, pants, robes, scarves, shifts, shirts, sweat shirts, shorts, skirts, sleep wear, sweat suits, sweaters, swim wear, footwear, namely, athletic shoes, boots, espadrilles, clogs, shoes, sandals and socks; headwear, namely, bandannas, visors, head bands, hats, hoods and sweat bands; Retail store services, mail order services, catalog sales services, and electronic retail store services using a global computer and/or communications network, all in the field of footwear namely, athletic shoes, boots, espadrilles, clogs, shoes, sandals; hosiery, socks, belts, headwear, namely, bandannas, visors, head bands, hats, hoods and sweat bands; scarves, luggage, backpacks, purses, wallets, umbrellas, perfume and fragrances, toiletries, cosmetics, hair care preparations, skin lotions, body soaps and cleansers, sunglasses, candles, toys, games, sporting goods, wristwatches, jewelry, stationery, calendars and travel diaries, pens, pencils, portfolios, notepads, greeting cards, note cards, audio players and recorders.</p>
1,303,172 May 29, 2006		<p>Equipment used in providing telecommunications services, namely, telephones, mobile radios, two-way radios, cellular telephones, digital cellular telephones, mobile telephones, wireless telephones, pagers, mobile dispatch radios, wireless handheld communication devices, namely, handheld personal computers and digital personal assistants (PDAs), to transmit, receive, or otherwise access communications networks, mobile data receivers and transmitters and handheld units for the wireless receipt and transmission of voice, data, video, music and pictures, namely, handheld units for the wireless receipt and transmission of entertainment media, namely, pictures, videos, movies, television shows, computer game programs and handheld computer game devices; Accessories for phones, cellular</p>

Appl. No. Filing Date	Trade-mark	Wares/Services
		<p>telephones, wireless telephones, and portable communications equipment, namely, batteries, battery chargers, power adapters, cigarette lighter adapters, hands-free dialers, microphones and speakers, audio receivers, transceivers, modems, PCMCIA data cards, and electrical cables, phone cradles, RF electrical cables, antennas, antenna adapters, carrying cases for the foregoing goods and holsters and pouches adapted for use with the foregoing goods, carrying clips for wireless telephones; machine readable magnetically encoded calling cards, caller identification cards; and caller identification units; Retail store services featuring telephones, wireless phones, wireless hand-held devices for access to global computer networks, pagers, personal digital assistants, and related accessories and equipment;</p> <p>Telecommunication services, namely, electronic, electric and digital transmission of voice, text, images, data, pictures, music, games, movies, video and information via wireless networks, two-way radio dispatching services, electronic transmission of voice, text, images, data, music, games, movies, video and information by means of telephones, mobile radios, two-way radios, cellular telephones, digital cellular telephones, mobile telephones, wireless telephones, pagers, mobile dispatch radios, mobile data receivers and transmitters and handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; paging services; mobile telephone communication services; wireless Internet access services; and wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, videos, games, movies, information, text, numeric messaging and text messaging and for accessing a global communications network</p>
1,003,280 Jan. 27, 1999	AMERICAN EAGLE OUTFITTERS	<p>Clothing and accessories, namely jackets, parkas, coats, blazers, sweaters, skirts, pants, jeans, shorts, shirts, t-shirts, sweatshirts, sweatpants, anoraks, vests, underwear, fleecewear, caps, hats, ties, belts and hosiery; footwear, namely slippers, leather boots, rubber boots and insoles; hair and body shampoo; soap; soap on a rope; moisturizing body lotion; bath salts; and shower gel; candles; compasses and portable personal thermometers for measuring environmental temperature; flashlights; stationery-type portfolios, engagement calendars, travel diaries, pocket planners and memo planners; jewellery, namely necklaces, earrings and wristwatches; waterproofing chemical compositions for leather; leather care products, namely cork and leather sealants and preservatives; conditioners for leather; hair and body shampoo; soap; soap on a rope; moisturizing body lotion; bath salts; and shower gel; candles; compasses and portable personal thermometers for measuring environmental temperature; flashlights; stationery-type portfolios, engagement calendars,</p>

Appl. No. Filing Date	Trade-mark	Wares/Services
		<p>travel diaries, pocket planners and memo planners; jewelry, namely necklaces, earrings, and wristwatches; waterproofing chemical compositions for leather; leather care products namely cork and leather sealants and preservatives; conditioners for leather; footwear, slippers, leather and rubber boots, and insoles; clothing, namely outerwear; namely, coats, vests, parkas, and anoraks, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hosiery, skirts, jackets, blazers, footwear, fleecewear; namely, fleece sweatshirts and fleece jackets; nonprescription sunglasses sold only through American Eagle outfitters retail clothing and footwear stores of applicant or its licensee; Retail store services in the field of clothing, clothing accessories, footwear, jewellery, leather care products and wallets, handbags and luggage; catalog services featuring clothing, clothing accessories, jewelry, leather care products and wallets, handbags and luggage; and internet retail sales services featuring clothing, clothing accessories, footwear, jewelry, leather care products and wallets, handbags and luggage; credit card services; retail clothing store services</p>
<p>1,303,171 May 29, 2006</p>	<p>AMERICAN EAGLE OUTFITTERS</p>	<p>Equipment used in providing telecommunications services, namely, telephones, mobile radios, two-way radios, cellular telephones, digital cellular telephones, mobile telephones, wireless telephones, pagers, mobile dispatch radios, wireless handheld communication devices to transmit, receive, or otherwise access communications networks, mobile data receivers and transmitters and handheld units for the wireless receipt and transmission of voice, data, video, music and pictures, namely, handheld personal computers and personal digital assistants (PDAs), electronic equipment for entertainment namely, receiving pictures, videos, movies, television shows, computer game programs and computer game devices; Accessories for phones, cellular telephones, wireless telephones, and portable communications equipment, namely, batteries, battery chargers, power adapters, cigarette lighter adapters, hands-free dialers, microphones and speakers, audio receivers, transceivers, modems, PCMCIA data cards, and electrical cables, phone cradles, RF electrical cables, antennas, antenna adapters, carrying cases for the foregoing goods and holsters and pouches adapted for use with the foregoing goods, carrying clips for wireless telephones; machine readable magnetically encoded calling cards, caller identification cards; and caller identification equipment; Retail store services featuring telephones, wireless phones, wireless hand-held devices for access to global computer networks, pagers, personal digital assistants, and related accessories and equipment; Telecommunication services, namely, electronic, electric and digital transmission of voice, text, images, data, pictures, music, games, movies, video and information via</p>

Appl. No. Filing Date	Trade-mark	Wares/Services
		wireless networks, two-way radio dispatching services, electronic transmission of voice, text, images, data, music, games, movies, video and information by means of telephones, mobile radios, two-way radios, cellular telephones, digital cellular telephones, mobile telephones, wireless telephones, pagers, mobile dispatch radios, mobile data receivers and transmitters and handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; paging services; mobile telephone communication services; wireless Internet access services; and wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, videos, games, movies, information, text, numeric messaging and text messaging and for accessing a global communications network.
1,233,960 Oct. 15, 2004	AMERICAN EAGLE OUTFITTERS	Baskets of common metals, metal bins, metal curtain rings, decorative boxes made of metal, metal doorknobs, jewellery boxes made of metal; decorative refrigerator magnets; portable electric fans, lamp shades, lamps, electric Chinese lanterns, electric light bulbs, electric lighting fixtures, electric lights for Christmas trees, and electric night lights; alarm clocks, candle holders of precious metal, clocks, wall clocks, clocks incorporating radios; guitars; metallic gift wrap, gift wrapping paper, photograph albums, pictures (art), corkboard pins, plastic place mats, playing cards, posters, stationery, namely envelopes, file pockets, organizers, paper, pencil ornaments, seals, stationery boxes, stationery cases, stationery folders, stationery portfolios, stickers; furniture, namely tables, armchairs, chairs, chests, bed frames, bedroom furniture, beds, benches, bookcases, and desks; plastic boxes; wooden boxes, chair pads, non-metal clothes hooks, decorative bead curtains, decorative curtains, cushions, seat cushions, plastic doorknobs, wood doorknobs, hampers, jewellery boxes not of metal, plastic knobs, wood knobs, lawn furniture, magazine racks, hand-held mirrors, picture frames, pillows, storage racks, shelves, sleeping bags, window blinds, window shades; beverage glassware, bowls, glass bowls, salad bowls, cups, coffee cups, plastic cups, dishes (in general or specific type), flower pots, drinking glasses, mugs, plates, soap dishes, soap dispensers, soap holders, and towel holders; fabric bath mats, bed blankets, bed sheets, bed spreads, comforters, duvet covers, curtains, kitchen towels, pillow cases, pillow shams, textile place mats, pot holders, quilts, dust ruffles, table cloths not of paper, table linen, textile napkins, towels, textile wall hangings; rugs; bulletin boards.
1,226,094 Aug. 5, 2004	AMERICAN EAGLE OUTFITTERS	Financial, financially-related, electronic and on line-implemented financial, and card- implemented services, namely charge card services, credit card services, stored-value card services, smart

Appl. No. Filing Date	Trade-mark	Wares/Services
		card services, funds withdrawal card services, electronic funds transfer services, electronic debit and credit transaction services, electronic cash services, cash disbursement services, electronic deposit services, electronic payment services, electronic currency exchange services, point-of-sale and point-of-transaction electronic payment services; credit card services.