



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

Citation: 2010 TMOB 214
Date of Decision: 2010-12-01

**IN THE MATTER OF AN OPPOSITION
by Effigi Inc. to application No. 1,219,465
for the trade-mark FIG CLOTHING &
Design in the name of ZAM Urban
Dynamics inc.**

[1] On June 8, 2004, ZAM Urban Dynamics inc. (the Applicant) filed an application to register the trade-mark FIG CLOTHING & Design (the Mark), shown below, on the basis of use in Canada since December 1, 2003.



[2] During prosecution of the application, the Applicant amended the statement of wares of the application to read “clothing namely pants, shorts, vests, skirts, blouses, shirts, underwear, exercise wear, casual wear, outdoor winter clothing, skiwear, sleepwear, rainwear, beachwear, sportswear, prêt-à-porter, yoga wear, travel wear, climbing wear; accessories namely belts, purses, wallets, passports holders, arm warmers, leg warmers, socks, gloves, mittens, hats, caps, scarves, cravats, bracelets, costume jewelry, ear-rings, hair bands” (the Wares).

[3] The Applicant has disclaimed the right to the exclusive use of the word CLOTHING apart from the Mark.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 19, 2006.

[5] On July 19, 2006, Effigi Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) since:
 - 1.1 the Applicant did not use the Mark in association with the Wares as stated in the application;
 - 1.2 the trade-mark alleged to be used is not the Mark;
 - 1.3 the alleged use of the Mark has been discontinued either entirely or in part;
 - 1.4 the Applicant falsely made the statement that it is entitled to use the Mark in Canada in view of the allegations contained in the statement of opposition, including the Applicant's knowledge of the Opponent's rights;
 - 1.5 contrary to s. 30(a) of the Act, the wares "underwear, exercise wear, casual wear, outdoor winter clothing, skiwear, sleepwear, rainwear, beachwear, sportswear, prêt-à-porter, yoga wear, travel wear, climbing wear" are not defined specifically in ordinary commercial terms;
 - 1.6 the amended statement of wares is broader than the statement of wares contained in the original application contrary to s. 30 of the Act and Rule 31(e) of the *Trade-marks Regulations*, SOR/96-195 (the Regulations).
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with Opponent's trade-mark EFFIGI of registration No. TMA547,858.
3. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16 of the Act since:
 - 3.1 contrary to s. 16(1)(a) of the Act, at the relevant time, the Mark was confusing with the trade-mark EFFIGI previously used in Canada by the Opponent, its predecessors-in-title (or for their benefit by licensees) in

association with its wares, services and business in the field of clothing and fashion accessories;

3.2 contrary to s. 16(1)(c) of the Act, at the relevant time, the Mark was confusing with the trade-name EFFIGI (or EFFIGI NC.) previously used in Canada by the Opponent or its predecessors-in-title in association with its wares, services and business in the field of clothing and fashion accessories;

3.3 contrary to the introductory paragraph of s. 16(1) of the Act:

3.3.1 the application does not conform to s. 30 of the Act;

3.3.2 the Mark is not a used one but rather a proposed or discontinued one;

3.3.3 the Mark is not registrable or does not function as a trade-mark.

4. The Mark is not distinctive because:

4.1 it does not distinguish the Wares from the wares of others, including those of the Opponent;

4.2 the Applicant has allowed third parties, such as Riverstone Sports and Aventure Nouveau Monde, to use the Mark in Canada outside the scope of the licensed use provided by s. 50 of the Act;

4.3 as a result of a transfer of the Mark more than one person, such as Riverstone Sports, Aventure Nouveau Monde, CDEC and Melanie Ellezam, had rights into the Mark and exercised them contrary to s. 48(2) of the Act.

[6] The Applicant filed and served a counter statement essentially denying each allegation contained in the statement of opposition.

[7] Pursuant to r. 41 of the Regulations, the Opponent filed a certified copy of registration No. TMA547,858 and an affidavit of Lorraine Laquerre, dated April 5, 2007, together with Exhibits LLA-1 through LLA-21. Ms. Laquerre is a lawyer employed by the Opponent's agent since February 2007; she was employed by the Opponent's agent as an articling student from August 2006 to February 2007. Ms. Laquerre was not cross-examined by the Applicant.

[8] Pursuant to r. 42 of the Regulations, the Applicant filed the affidavit of Linda Victoria Thibeault, dated November 6, 2007, together with Exhibits “A” and “B”. Ms. Thibeault, a trade-mark searcher with Trade-Mark Reflections Ltd., was not cross-examined by the Opponent.

[9] Only the Applicant filed a written argument. Both parties were represented at an oral hearing, which was held at the request of the Opponent.

[10] At the oral hearing, the Opponent’s agent advised that his submissions would be restricted to the grounds of opposition based upon s. 30(a) and s. 12(1)(d) of the Act. In fact, the Opponent’s agent did not have comments in reply to questions that I asked and issues that I raised about other grounds of oppositions, including whether the alleged trade-name EFFIGI NC should have read EFFIGI INC. (my underline). In any event, as discussed below, the s. 30(a) and s. 12(1)(d) grounds of opposition are the only ones that have been supported by evidence. I also note that at the oral hearing, the Applicant’s agent recognized that the Applicant incorrectly submitted in its written argument that there was no evidence that the Opponent owned a registration for the trade-mark EFFIGI.

Onus

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its 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.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Material Dates

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

- s. 38(2)(a)/s. 30 – 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(1)(a) and s. 16(1)(c) – the date of first use claimed in the application [see s. 16(1)]; 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.)].

Analysis of the Grounds of Opposition

[13] I will analyze the grounds of opposition in regard to the evidence of record, although not necessarily in the order they were raised in the statement of opposition.

Registrability pursuant to s. 12(1)(d) of the Act

[14] I have exercised the Registrar's discretion to confirm that registration No. TMA547,858 for the trade-mark EFFIGI (the Opponent's Mark) is in good standing as of today's date in the Opponent's name. The Opponent's Mark is registered in association with a broad range of wares, including clothing, clothing accessories, jewelry, and in association with the operation of a business for the distribution and importation of clothing.

[15] Since the Opponent has discharged its initial evidential burden with respect to the registrability ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Mark.

[16] 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.

[17] In applying the test for confusion, I 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.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[18] As will become apparent from my discussion of the surrounding circumstances of this case, the Opponent's contention as to confusion is first and foremost based on the perception of the Mark and the Opponent's Mark by an average French speaking consumer. As stated in *Smithkline Beecham Corporation v. Pierre Fabre Medicament* (2001), 11 C.P.R. (4th) 1 (F.C.A.), once there is a risk of confusion in either of the country's two official languages a trade-mark cannot be registered.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[19] The Opponent's Mark possesses a fair degree of inherent distinctiveness as EFFIGI is an invented word. Although I agree with the Applicant's submission that the Opponent's Mark could be seen as deriving from the word "effigy", or its French equivalent "effigie", this does not lessen its inherent distinctiveness; the word "effigy", which means "a representation of a person in the form of a sculptured figure, dummy, etc." [see *Oxford Canadian Dictionary*], is not suggestive of the Opponent's registered wares and services.

[20] The word FIG is an ordinary word in the English language. In that regard, I refer to the *Oxford Canadian Dictionary* defining this word as "soft pear-shaped fruit with many seeds, eaten fresh or dried". To the extent that CLOTHING is descriptive of some of the Wares, it does

not increase the inherent distinctiveness of the Mark. Also, I find the design feature of the Mark consisting of a pattern of stripes to be somewhat reminiscent of a bar code that functions to communicate data about a product. Thus, I consider that the design feature of the Mark does not significantly increase its inherent distinctiveness.

[21] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. However, in the present case, the Applicant has not furnished evidence of use of the Mark. There is also no evidence of use of the Opponent's Mark. The most that I can presume from the mere existence of registration No. TMA547,858 is that there has been *de minimis* use of the Opponent's Mark in Canada [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.) (*Entre Computer*)].

[22] In the end, I find that the Opponent's Mark possesses a greater degree of inherent distinctiveness than the Mark. However, the evidence before me does not allow me to determine the extent to which either mark has become known in Canada.

The length of time each trade-mark has been in use

[23] The application is based upon use of the Mark in Canada in association with the Wares since December 1, 2003. Depending on the wares and services, the Opponent's Mark has been registered on the basis of use in Canada or further to the filing of a Declaration of Use. In particular, the Opponent's Mark was registered in association with clothing on the basis of use in Canada since at least as early as 1991 and in association with the operation of a business for the distribution and importation of clothing since at least as early as August 27, 1987.

[24] If one accepts that the Opponent's Mark has been used in Canada since the dates stated in the registration, this factor would favour the Opponent. However, as there is no evidence directed to the use of the Opponent's Mark, which as a result is assumed to be only *de minimis*, the length of time the trade-marks have been in use is not a significant factor in this case.

The nature of the wares, services or business

[25] When considering the nature of the wares and the nature of the trade of the parties, it is the statement of wares in the application and the statement of wares or services in the

Opponent's registration that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[26] I find that the Wares are identical to or overlap with the following wares identified in registration No. TMA547,858:

(1) Vêtements, nommément: chandails, t-shirts, camisoles, vestes, cardigans, cols roulés, robes, sous-vêtements, culottes, brassières, jupons, pantalons, jeans, jackets, bermudas, shorts, jupes, complets-vestons, jumpsuits, salopettes, chapeaux, bonnets, bérets, bandeaux, bandanas, cache-oreilles, foulards, blouses, combinaisons de ski, blazers, habits de ski, nommément: blousons de ski, manteaux de ski, pantalons de ski, vestes de ski, gants de ski, mitaines de ski, paletots, parkas, anoraks; imperméables, cirés; chandails à capuchon, jerseys, ensembles de jogging, nommément: pantalons, t-shirts, chandails coton ouaté; mitaines, gants, cravates, pyjamas, chemises de nuit, nuisettes, jaquettes, robes de chambre, peignoirs, grenouillères, dormeuses, bavoirs, tuques, casquettes, uniformes, tenues de plage, nommément: chemises et robes de plage; paréos, maillots de bain, léotards, manteaux, bandeaux, débardeurs, chemises polo, boxers et ceintures.

[...]

(3) Sacs de diverses formes et dimensions, nommément: [...] sacs à main [...].

[...]

(5) [...] bijoux.

[27] To the extent that the articles of clothing are concerned, there is also an overlap between the Wares and the statement of services of registration No. TMA547,858, which reads:

Exploitation d'une entreprise de distribution et d'importation de vêtements, nommément: chandails, t-shirts, camisoles, vestes, cardigans, cols roulés, robes, sous-vêtements, culottes, brassières, soutiens-gorge (sic), pantalons, jeans, jackets, bermudas, shorts, jupes, vestons, complets-veston, jumpsuits, salopettes, chapeaux, foulards, blouses, combinaisons de ski, blazers, habits de ski, chandails à capuchon, jerseys, ensembles de jogging, jupons, mitaines, gants, cravates, pyjamas, tuques, casquettes, uniformes, tenues de plage, maillots de bain, imperméables, léotards, pantoufles, robes de chambre, manteaux, bandeaux, débardeurs, chemises (sic) polo, boxers et ceintures

The nature of the trade

[28] There is no evidence of record regarding the nature of the parties' trade. Further, neither the application nor the registration includes a restriction on the channels of trade. Thus, given the direct overlap in the wares, for the purposes of assessing confusion, I conclude to an overlap in the nature of the trade.

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[29] The remaining criterion is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested. In most instances, it is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.*, (1980) 47 C.P.R. (2d) 145 (F.C.T.D.); aff'd 60 C.P.R. (2d) 70 (F.C.A.)].

[30] While the Mark and the Opponent's Mark must be assessed in their entirety, it is still possible to focus on a particular feature of the Mark that may have a determinative influence on the public perception of it [see *United Artists Corp. v. Pink Panther Beauty Corp* (1998), 80 C.P.R. (3d) 247 (F.C.A.)]. I agree with the Opponent that the FIG element of the Mark would have a determinative influence on the public's perception of the Mark as visually it forms the most memorable component of the Mark. As I previously noted, the design feature of the Mark consisting of a pattern of stripes is somewhat reminiscent of a bar code and thus not highly distinctive. Nonetheless, there are important differences between the Mark and the Opponent's Mark in appearance.

[31] The Opponent submits that because FIG is not a word in the ordinary French language, the average French speaking consumer would pronounce FIG letter by letter, rather than as one word, resulting in FIG sounding like the Opponent's Mark. Likewise, the Opponent contends there is similarity between the ideas suggested when considering an average French speaking consumer.

[32] When considering the pronunciation of FIG by an average French speaking consumer, I am guided by the following comment of Member Carrière in *Essilor International (cie générale d'optique) v. Rampage Clothing Co.* (2004), 36 C.P.R. (4th) 37:

It would appear therefore that, in the absence of evidence on the pronunciation in the French language of the letter R and the word AIR, I can use my own knowledge of my mother tongue to determine their pronunciation especially in cases such as this one where the comparison is between a letter of the alphabet and a single syllable word. I refer to *Sopinka and Lederman, The Law of Evidence in Canada, 2d ed.* (Toronto: Butterworths, 1999) at p. 1055 where 'judicial notice' is defined in as "the acceptance by a court or judicial tribunal, in a civil or criminal proceeding, without the requirement of proof, of the truth of a particular fact or state of affairs". The following excerpts are instructive:

Facts which are (a) so notorious as not to be the subject of dispute among reasonable persons, or (b) capable of immediate and accurate demonstration by resorting to readily accessible sources of indisputable accuracy, may be noticed by the court without proof of them by any party (p. 1055).

There are some facts which, although not immediately within the judge's knowledge, are indisputable and can be ascertained from sources to which it is proper for the judge to refer. These may include texts, dictionaries, almanacs and other reference works, previous case reports, certificates from various officials and statements from various officials and statements from witnesses in the case (p. 1058).

[33] The Opponent has not introduced any evidence supporting its contention that an average French speaking consumer would pronounce FIG letter by letter because it is not a word in the ordinary French language. I consider it appropriate to exercise my own knowledge of my mother tongue to consider the pronunciation of FIG by a Francophone.

[34] I can find no support for the Opponent's contention as there is no evidence that FIG is what is called in French "un sigle" (translation: initialism). In that regard, I note that the *Multidictionnaire de la langue française*, 4^e éd., defines the word "sigle" as « abréviation constituée par les initiales de plusieurs mots et qui s'épelle lettre par lettre » (translation: abbreviation made up of the initial letters of several words and pronounced letter by letter). I wish to add that if there were any merits to the Opponent's argument as to the pronunciation of the word FIG by a Francophone, then one could argue that a Francophone would pronounce the Opponent's Mark letter by letter because "effigi" is not a word in the ordinary French language.

The Opponent's contention does not resist analysis. In my view, it is more than reasonable to conclude that a Francophone would pronounce FIG as one word and no other way, even more so as FIG is phonetically equivalent to the French word "figue" (translation: fig).

[35] In its written argument, the Applicant submits that the Mark is "evocative of the garden of Eden where the first clothing of man kind was fig leaves". Whether or not the Applicant's submission has any merits is not determinative. Indeed, I consider the Opponent's Mark suggestive of an effigy, which is clearly not an idea suggested by the Mark.

[36] Having regard to the foregoing, I conclude to significant differences in appearance and sound between the Mark and the Opponent's Mark when considered in their entirety. I also conclude that there is no similarity between the ideas suggested by the trade-marks.

Conclusion on the likelihood of confusion

[37] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I am satisfied that the Applicant has met its burden to show that there is no probability of confusion between the Mark and the Opponent's Mark. Although the inherent distinctiveness of the Opponent's Mark, the nature of the wares or services and the nature of the trade favor the Opponent, I find the differences between the Mark and the Opponent's Mark in sound, appearance and the ideas suggested are more than sufficient to make confusion unlikely.

[38] Having regard to the foregoing, I dismiss the ground of opposition based upon s. 12(1)(d) of the Act.

Non-entitlement

[39] From the outset, I dismiss the ground of opposition based solely upon the introductory wording of s. 16(1) of the Act as I consider it to be without legal basis under s. 38(2)(c) of the Act. I would add that there would seem to be no cases in which allegations that an application does not conform to s. 30 of the Act, that a trade-mark is not registrable and that it does not function as a trade-mark could not be more directly and appropriately raised as grounds of opposition under s. 38(2)(a), (b) and (d) of the Act respectively.

Non-entitlement pursuant to s. 16(1)(a) the Act

[40] There is an initial evidential burden on the Opponent to establish use of the Opponent's Mark prior to December 1, 2003 and non-abandonment at the date of advertisement of the application [s. 16(5) of the Act]. The allegations of use contained in the registration alleged in support of the registrability ground of opposition are insufficient to support the Opponent's evidential burden with respect to the non-entitlement ground of opposition [see *Entre Computer, supra*].

[41] Given the Opponent's evidence of record, or lack thereof, I find that the Opponent has not discharged its evidentiary burden. Accordingly, I dismiss the ground of opposition based upon non-entitlement pursuant to s. 16(1)(a) of the Act.

Non-entitlement pursuant to s. 16(1)(c) the Act

[42] There is an initial evidential burden on the Opponent to establish use of its alleged trade-name EFFIGI or EFFIGI NC prior to December 1, 2003 and non-abandonment at the date of advertisement of the application [s. 16(5) of the Act].

[43] Since there is no evidence of use of the trade-name EFFIGI or EFFIGI NC, I find that the Opponent has not discharged its evidentiary burden. Accordingly, I dismiss the ground of opposition based upon non-entitlement pursuant to s. 16(1)(c) of the Act.

Non-distinctiveness

[44] The ground of opposition based upon non-distinctiveness appears to be pleaded as a three-pronged ground of opposition.

[45] With respect to the first part of the pleading, I note that the Opponent did not refer to any trade-marks or trade-names nor did it specify wares or services. Deciding on the sufficiency of the pleading by considering both the evidence and the statement of opposition [see *Novopharm Ltd. v. Astrazeneca et al* (2002), 21 C.P.R. (4th) 289 (F.C.A.)], it could at the utmost be inferred that the Opponent was pleading that the Mark was not distinctive in view of confusion with the Opponent's Mark.

[46] There is an initial burden on the Opponent to show that the Opponent's Mark had become known sufficiently as of July 19, 2006 to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. Here also, the allegations of use contained in the registration alleged in support of the registrability ground of opposition are insufficient to support the Opponent's evidential burden [see *Entre Computer, supra*]. Thus, in the absence of any evidence directed to the use or promotion of the Opponent's Mark, I find that the Opponent has failed to satisfy its initial evidentiary burden.

[47] Likewise, given the Opponent's failure to furnish evidence to support the allegations in the second and third parts of the pleading, I find that the Opponent has failed to satisfy its initial evidentiary burden.

[48] Having regard to the foregoing, the ground of opposition based upon non-distinctiveness is dismissed.

Non-conformity to s. 30 of the Act

[49] From the outset, I dismiss the last pleading of the ground of opposition based on non-conformity to s. 30 of the Act, which reads:

[...] les modifications apportées à l'état déclaratif des marchandises postérieurement à la production de la demande sous opposition sont illégales et contraires aux dispositions de l'article 30 et de la règle 30e puisque élargissant le libellé d'origine.

[50] In my view an allegation that the application was amended contrary to r. 31(e) of the Regulations is not a proper ground of opposition under s. 30 of the Act. By way of analogy, I note the decision *Ipex Inc. v. Royal Group* (2009), 77 C.P.R. (4th) 297 (T.M.O.B.) (*Ipex*) where it was found that an allegation that the application was amended contrary to r. 31(b) of the Regulations was not a proper ground of opposition under s. 30 of the Act. I wish to add that I raised the *Ipex* decision at the oral hearing, giving both parties the opportunity to comment thereon. The Opponent's agent did not make any submissions.

Non-conformity to s. 30(b) of the Act

[51] It is apparent that the first three pleadings of the grounds of opposition relate to non-compliance with s. 30(b) of the Act

[52] The Opponent has not furnished any evidence in support of its allegations. Furthermore, this is clearly not a case where the Opponent may rely upon the Applicant's evidence to meet its onus with respect to this ground of opposition [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[53] In view of the above, I find that the Opponent has failed to satisfy its initial evidentiary burden and I dismiss the ground of opposition based on non-conformity to s. 30(b) of the Act.

Non-conformity to s. 30(i) of the Act

[54] The fourth pleading of the ground of opposition relates to non-compliance with s. 30(i) of the Act. There is no evidence that the Applicant may have been aware of the prior rights alleged by the Opponent. In any event, mere awareness of prior rights alleged by an opponent does not preclude an applicant from truthfully making the statements required by s. 30(i) of the Act. Where an applicant has provided the statement required by s. 30(i) of the Act, the ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As this is not such a case, I dismiss the ground of opposition based upon non-compliance with s. 30(i) of the Act.

Non-conformity to s. 30(a) of the Act

[55] The fifth pleading of the ground of opposition is to the effect that the application does not contain a statement in ordinary commercial terms of specific wares in association with which the Mark has been used. More particularly, the Opponent pleads:

[...] les termes “underwear, exercise wear, casual wear, outdoor winter clothing, skiwear, sleepwear, rainwear, beachwear, sportswear, prêt-à-porter, yoga wear, travel wear, climbing wear” ne répondant pas dans le contexte de la demande sous opposition au degré de spécificité requis par la Loi.

[56] In oral argument, the Opponent submitted that the disputed wares do not conform to s. 30(a) of the Act because each of the disputed wares describes a general class of wares, and not specific wares. In that regard, the Opponent referred to the decisions *Spirits International N.V. v. SC Prodal 94 SRL* (2005), 50 C.P.R. (4th) 199 (T.M.O.B.) (*Spirits*) and *Scotch Whisky Assn. V. Mark Anthony Group Inc.* (1990), 31 C.P.R. (3d) 55 (T.M.O.B.) (*Scotch Whisky*). Suffice it to say that there are no common grounds between the disputed wares and the wares at issue in *Spirits* and *Scotch Whisky*. In addition, each case has to be decided upon its own facts. If I am to consider precedents without regard to the particular facts of the case, I would note that “sleepwear” was accepted as a specific ordinary commercial term in *Effigi Inc. v. HBI Branded Apparel Limited, Inc.* 2010 T.M.O.B. 160 (T.M.O.B.) (*Effigi*).

[57] The Opponent further relies on the Laquerre affidavit, which introduces the results of searches of the register of trade-marks and of the Internet, as evidencing that the disputed wares do not conform to s. 30(a) of the Act.

[58] Ms. Laquerre states that she carried out searches of the Onscope database, which contains all active and inactive trade-marks on the register of trade-marks, for registered or pending trade-marks containing the following phrases in their statement of wares:

- i) “sleepwear, namely”, which search carried out on September 14, 2006 returned 359 marks;
- ii) “underwear, namely”, which search carried out on September 30, 2006 returned 298 marks;
- iii) “exercise wear, namely”, which search carried out on March 26, 2007 returned 43 marks;
- iv) “casual wear, namely”, which search carried out on March 26, 2007 returned 60 marks;
- v) “skiwear, namely”, which search carried out on March 26, 2007 returned 107 marks;
- vi) “rainwear, namely”, which search carried out on March 26, 2007 returned 371 marks;
- vii) “beachwear, namely”, which search carried out on March 26, 2007 returned 155 marks;

- viii) “travel wear, namely” or “travelwear, namely”, which search carried out on March 26 and April 2, 2007 returned 4 marks;
- ix) “yoga wear, namely” or “yogawear, namely”, which search carried out on March 26, 2007 returned 5 marks;
- x) “prêt-à-porter” followed with “nommément”, which search carried out on April 2, 2007 returned 9 marks;
- xi) “outdoor winter clothing, namely”, which search carried out on March 26, 2007 did not return any marks;
- xii) “climbing wear, namely”, which search carried out on March 26, 2007 did not return any marks.

[59] Ms. Laquerre files the results of the searches identified from i) through x) above [Exhibits LLA-1]. She further provides for each of these searches a summary chart listing each trade-mark, the registration or application number, and the statement of wares that followed the terms searched [Exhibits LLA-2 through LLA-11].

[60] The Opponent submits that the number of trade-marks disclosed by Ms. Laquerre’s searches shows that businesses deemed it necessary to more specifically define disputed wares. I am unwilling to make such an inference from the evidence. While it might be logical to infer that many of the located trade-marks were on the register at the material date, namely June 8, 2004, I am unable to ascertain on the face of the evidence whether the respective owners of the registrations and applications voluntarily specified the wares or if they were asked to do so during the trade-mark examination process.

[61] Further Ms. Laquerre’s searches were voluntarily restricted to statement of wares containing the disputed wares followed by “namely”. In other words, she did not search statement of wares with the disputed wares not followed by “namely”. Yet, the Applicant’s evidence establishes the existence of registered trade-marks with a statement of wares in which disputed wares not followed by “namely” can be found. Indeed, Ms. Thibeault files the results of her search of the register of trade-marks conducted on or about November 2, 2007, through the CDNameSearch Corp database, to locate “a sample listing of trade-marks registered or allowed from February 2006” to the date of her affidavit “wherein the statement of wares includes any or all” of the disputed wares. She files a search report listing 19 trade-mark registrations noted

during the course of her search [Exhibit “A”] and copies of those trade-mark registrations [Exhibit “B”]. A review of their respective statements of wares indicates that they contain “underwear”, “exercise wear”, “casual wear”, “outdoor winter clothing”, “ski-wear”, “sleepwear”, “rainwear”, “beachwear”, “sportswear”, “vêtement prêt-a-porter” and “yoga wear” not followed by “namely”, as the case may be.

[62] In view of the above, I find the state of the register evidence introduced by the Laquerre affidavit to be of limited value, if any, to support the Opponent’s position, even more so when considering the Thibeault affidavit.

[63] Insofar as her Internet searches are concerned, Ms. Laquerre provides printouts from a number of websites that she accessed further to searches she conducted on the dates and for the products identified hereafter:

- i) September 27 and September 28, 2006 for “sleepwear” [Exhibit LLA-12];
- ii) October 5, 2006 for “underwear” [Exhibit LLA-13];
- iii) March 30, 2007 for “travel wear” [Exhibit LLA-14];
- iv) March 30, 2007 for “yoga wear” [Exhibit LLA-15];
- v) March 30, 2007 for “prêt-à-porter” or “ready to wear” [Exhibit LLA-16];
- vi) March 27, 2007 for “exercise wear” [Exhibit LLA-17];
- vii) March 29 and 30, 2007 for “beachwear” [Exhibit LLA-18];
- viii) March 29, 2007 for “rainwear” [Exhibit LLA-19];
- ix) March 29, 2007 for “skiwear” [Exhibit LLA-20];
- x) March 29, 2007 for “casual wear” [Exhibit LLA-21].

[64] At the oral hearing, the Opponent’s agent directed my attention to some website pages found in Exhibits LLA-12 and LLA-18 through LLA-20 in support of the Opponent’s contention that “sleepwear”, “beachwear”, “rainwear” and “skiwear” all encompass a number of individual products. I note that the Opponent’s agent did not make any submissions on website pages found in Exhibits LLA-13 through LLA-17 and Exhibit LLA-21.

[65] It is not an overstatement to note that the results of the Internet searches are lengthy as the website printouts amount to approximately 1540 pages. This evidence might conceivably have its effect in bolstering the Opponent's position. Still, the website pages found in Exhibits LLA-12 through LLA-21 reflect the situation after the material date for assessing compliance with s. 30(a) of the Act, which the Opponent's agent recognized at the oral hearing. There is no evidence that these websites reflected the same information or were even in existence at the date of filing of the application. Even if one argues that it would be reasonable to infer that some of the websites were in existence at the material date, the mere fact that the disputed wares may encompass a number of individual products does not mean that each of the disputed wares is not sufficiently specific and therefore unacceptable for the purposes of s. 30(a) of the Act [see *Effigi, supra*].

[66] In view of my findings as to the evidentiary value of the Laquerre affidavit, I note that it was found in *McDonald's Corp. v. M.A. Comacho-Saldana International Trading Ltd.* (1984), 1 C.P.R. (3d) 101 (T.M.O.B.) that it is sufficient for an opponent to make a satisfactory argument to meet its initial burden of proof with respect to a ground of opposition based on s. 30(a) of the Act. The Opponent's submission that each of the disputed wares describes a general class of wares, and not specific wares, is sufficient for the Opponent to meet its evidentiary burden. Thus, the Applicant has the burden to prove that this ground of opposition should not prevent registration of the Mark in association with the disputed wares.

[67] I would remark that the disputed wares must be read in the context of the statement of wares of the application. Based on a plain reading of the statement of wares, it appears to me that the disputed wares are specifying the wares falling into the general class of clothing. I would also remark that CIPO's *Wares and Services Manual* (the Manual), which contains a representative listing of acceptable wares, does in fact list "underwear", "casual clothing", "outdoor winter clothing", "ski-wear", "sleepwear", "rainwear", "beachwear", and "sportswear", as acceptable without further specification. Also, the Manual indicates that the listings found therein can be used to indicate by analogy the kind of specification that will be acceptable for wares not covered by the Manual. I disagree with the Opponent's oral argument that I cannot have regard to the Manual. In fact, as rightly submitted by the Applicant, this Board has referred to the Manual in opposition proceedings involving grounds of opposition based upon non-conformity

to s. 30(a) of the Act [see, for example, *International Stars S.A.H. v. Green*, [2006] T.M.O.B. No. 90; *Royal Scenic Holidays Ltd. v. Scenic Holidays (Vancouver) Ltd.*, 2010 T.M.O.B. 36; *Effigi, supra*]. That being said, I note that a decision by an Examiner is not binding on this Board nor does it have precedential value for this Board because both the onus before the Board and the evidence available to it differs from that before an Examiner.

[68] Having considered the evidence of record and the parties' submissions, I am satisfied that the Applicant has met its burden to show, on a balance of probabilities, that the disputed wares conform to the requirement of s. 30(a) of the Act and I therefore dismiss the ground of opposition.

Disposition

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

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