



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

**Citation: 2013 TMOB 22**  
**Date of Decision: 2013-02-08**

**IN THE MATTER OF AN OPPOSITION  
by MAPA GmbH to application  
No. 1,412,579 for the trade-mark  
NUKNUUK & Design in the name of  
2956-2691 Quebec Inc.**

File Record

[1] 2956-2691 Quebec Inc. (the Applicant) filed on September 29, 2008 an application to register the trade-mark NUKNUUK & Design as illustrated hereinafter:



(the Mark)

It was filed based on use in Canada since at least as early July 29, 2002 in association with:

Nautical equipment, namely, neoprene suits, socks, gloves, life jackets; outdoor camping equipment, namely, tents, sleeping bags, sleeping mats, tarpaulins, first aid kits, binoculars, knives, snowshoes, shovels; luggage, namely, backpacks, duffle bags, tote bags, suitcases, bicycle saddle bags, money belts, men's and ladies wallets, purses, money clips, fanny packs, cosmetic bags and cosmetic cases and briefcases; eyewear, namely, sunglasses; novelty items, namely, flags, calendars, candles, picture frames, lamps, license plates, car wash mitts, car and truck seat covers, mail boxes, umbrellas, lunch

boxes and lunch bags; jewellery namely, necklaces, watches, rings and earrings; printed publications, namely, books, sticker books, colouring books; stationery, namely, writing paper and envelopes, all occasion cards, greeting cards, post cards, paper napkins, paper tablecovers, paper plates and cups, back to school vinyl book covering, gift wrap and ribbon, Christmas tree ornaments and figurines; toys, namely, plush animals and animal character figurines; housewares, namely, door mats, cushions, place mats, rugs; dinnerware, namely, plates, cups, saucers, bowls, mugs, coffee pots, tea pots, glasses, beer mugs, beer glasses, napkin rings, salt and pepper shakers, salad bowls; bedding, namely, pillows, sheets, pillow cases, quilts, comforter covers, blankets, throws and bedspreads, linen, namely sheets, blankets, mattress covers, mattress toppers, duvets, duvet covers, bedspreads, comforters, pillow shams, bedskirts, pillows and cushions, towels, face cloths, bath towels and beach towels; toiletries, namely, soaps, shampoos and hair conditioner; footwear, namely, men's, women's and children's shoes, boots, sandals, slippers and moccasins; clothing, namely, men's, women's and children's socks, mitts, hats, headbands, ear muffs, scarves, underwear, thermal underwear, ties, belts, suspenders, pajamas, nightgowns, nightshirts and robes, leotards, stockings, leggings, coats, namely, sport jackets, wind breakers, parkas, ponchos, trench coats, ski jackets, ski pants, vests, rain coats, rain pants and snowsuits, shirts, t-shirts, sweaters, cardigans, pants, dresses, skirts, shorts, bermuda shorts, jeans, bathing suits, bathing caps, beach cover ups; infant wear, namely, mittens, caps, hats, cover ups, coveralls, overalls, rompers, shorts, shirts, t-shirts, coats, jackets, raincoats, dresses, socks, pyjamas, sleepers, shoes and slippers; infant accessories, namely, car seats, play parks, cribs, high chairs, strollers and crib bedding (the Wares);

and since August 19, 2002 in association with:

Operation of a business offering the wholesale and retail sale of sports clothing and accessories for men, women and children.; operation of a business offering the wholesale and retail sale of camping equipment and travel accessories and repair and service centres for sports equipment and clothing (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 2, 2009. MAPA GmbH-Und Plastikwerke, which subsequently changed its name to MAPA GmbH (the Opponent), filed a statement of opposition on May 3, 2010.

[3] The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of section 30(i) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares and Services in light of prior use and registration in Canada of the Opponent's trade-mark NUK;
2. The Application does not comply with the requirements of section 30(b) of the Act as the Applicant has not used the Mark in association with each

of the general classes of the Wares and Services since the alleged date of first use;

3. The Application does not comply with the requirements of section 30(i) of the Act since the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares and Services, as the use of the Mark contravenes section 22 of the Act;
4. The Mark is confusing with one or more of the Opponent's registered trade-marks NUK registration TMA176140; NUK registration TMA193029; and NUK registration TMA322411;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(a) of the Act in that at the filing date of the application the Mark was confusing with one or more of the Opponent's trade-marks and the registrations pertaining thereto, which had been previously used by the Opponent in Canada;
6. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive in that it does not distinguish and it is not adapted to distinguish the Wares from the Opponent having regard to the registration and use of the trade-marks of the Opponent.

[4] In its counter statement filed on July 19, 2010 the Applicant essentially denied all grounds of opposition.

[5] The Opponent filed as its evidence certified copies of registrations TMA176140, TMA193029 and TMA322411 as well as a certified copy of the file history of registration TMA566312 while the Applicant chose not to file any evidence. As additional evidence the Opponent filed a certified copy of the statutory declaration of Robert Shamis dated December 17, 2010 filed in response to a section 45 notice sent by the Registrar to the Applicant with respect to registration TMA566312.

[6] Neither party filed a written argument and only the Opponent was represented at a hearing.

#### Legal Onus and Burden of Proof

[7] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts

alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

#### Grounds of Opposition Summarily Dismissed

[8] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada in association with the Wares and Services. Such a statement is included in the application. An opponent may rely on section 30(i) in specific cases such as where fraud by the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect. The first ground of opposition is dismissed.

[9] As for the third ground of opposition I make mine the comments made by my colleague Natalie de Paulsen in *Euromed Restaurant Limited v Trilogy Properties Corporation* 2012 TMOB 19 at paragraph 13:

Neither the Registrar, nor the Federal Court has ruled on whether a s. 30(i) ground of opposition based on the violation of s. 22 is a valid ground of opposition [*Parmalat Canada Inc. v Sysco Corp.* (2008), 69 C.P.R. (4th) 349 (F.C.) at paras. 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of s. 22 [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) at paras. 46, 63-68], it would have no chance of success. Accordingly, this ground of opposition is dismissed.

Consequently the third ground of opposition is also dismissed.

[10] As for the fifth and sixth grounds of opposition (entitlement and distinctiveness), the Opponent has an initial burden to prove that it has used or made known in Canada its trade-mark(s) prior to the claimed date of first use in so far as the entitlement ground is concerned [see section (1) of the Act]; as for distinctiveness it must prove that, at the advertisement date of this

application, its trade-mark(s) was (were) known to some extent in Canada [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[11] As the Opponent has not filed any evidence of use of any of its trade-marks the fifth and sixth grounds of opposition are dismissed for failure by the Opponent to meet its initial burden.

#### Compliance to the Provisions of Section 30(b) of the Act

[12] The relevant date for this ground of opposition is the filing date of the application (September 29, 2008) [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1989), 24 CPR (3d) 274 (TMOB)]. The Opponent has an evidential burden with respect to its allegation that the Applicant had not used the Mark at the alleged date of first use claimed in the application in association with each of the Wares and Services. Such burden has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant itself [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. However in our case the Applicant has not filed any evidence.

[13] The Opponent is relying on the statutory declaration dated December 17, 2010 filed by Mr. Robert Shamis, the Applicant's President filed in response to a Section 45 Notice sent to the Applicant by the Registrar on September 10, 2010 with respect to registration TMA566312 for the trade-mark NUKNUUK & Design as well as the Registrar's decision in *MAPA GmbH Gummi-und Plastikwerke v 2956-2691 Quebec Inc*, 2012 TMOB 192 dated October 24, 2012, deleting from registration TMA566312 all the services and limiting the registration to the following wares: footwear, namely men's, women's slippers.

[14] The trade-mark covered by registration TMA566312 is identical to the Mark. The list of wares and services covered by registration TMA566312 prior to the aforesaid decision is identical to the list of Wares and Services. Certificate of registration TMA566312 shows that a declaration of use was filed on July 29, 2002 for the wares and on August 19, 2002 for the services. Those dates correspond to the dates of first use mentioned in the present application.

[15] The Opponent has brought to my attention paragraphs 23 to 25 inclusive of Mr. Shamis' statutory declaration:

23. That at least within three (3) years preceding the date of Section 45 Notice issued by the Registrar of Trade-marks, the difficult economic situation prevalent in Canada has prevented TM Owner 2956-2691 [Quebec Inc] from making use of the trade-Mark in association with the entirety of the wares and/or services described in the extract of the Trade-Marks Register pertaining to the Trade-mark (Exhibit No.,2)

24. That TM Owner 2945-2691 intends on making use of the Trade-mark in association with the entirety of the wares and/or services described in the extract of the Trade-Marks Register pertaining to the Trade-Mark (Exhibit No. 2), and same in the near future, the economic situation permitting.

25. That accordingly, TM Owner 2956-2691 respectfully submits that it has the right to request, and does request, that the registration of the Trade-Mark be maintained in its entirety and that TM Owner 2956-2691 be afforded a delay of One (1) year from the date of the decision of the Registrar of Trade-Marks to intervene herein to make use of the Trade-Mark in association with the entirety of the wares and/or services identified on the extract of the Trade-Marks Register pertaining to the Trade-Mark (Exhibit No. 2).

[16] As mentioned earlier, the Registrar deleted all the services from the registration and kept only “footwear, namely men’s and women’s slippers” based on the evidence of use filed and the admission made by Mr. Shamis of the non-use of the trade-mark NUKNUUK & Design in association with most of the wares and all the services.

[17] One must keep in mind that the relevant period in the section 45 proceeding regarding registration TMA566312 was from September 17, 2007 to September 17, 2010. Therefore the use of the trade-mark covered by such registration prior to September 17, 2007 was not an issue. However the relevant period covers a period of time prior to the relevant date associated with this ground of opposition, namely from September 17, 2007 to September 29, 2008.

[18] Clearly from the statutory declaration of Mr. Shamis and the Registrar’s decision hereinabove mentioned, there was no use of the Mark from at least September 17, 2007 to September 29, 2008 in association with the Wares and Services except for men’s and women’s slippers.

[19] In *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (2001), 11 CPR (4th) 489 (FCTD) it was established that in order to meet the requirements of section 30(b) of the Act, an applicant must have continuously used the mark in association with its wares and services in the normal course of trade from the date of first use to the filing date of application.

[20] I consider that the Opponent has met its light initial burden by establishing that the Applicant was not using on a continuous basis the Mark in association with the Wares and Services, except for men's and women's slippers, in the normal course of trade from at least September 17, 2007 to the filing date of this application. Consequently the burden shifts on the Applicant to prove such continuous use.

[21] The Applicant did not file any evidence. Therefore I maintain the second ground of opposition in part. It is successful against all the Services and all of the Wares except for footwear, namely men's and women's slippers.

#### Section 12(1)(d) Ground of Opposition

[22] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[23] The Opponent has met its initial burden of proof by filing certificates of registration TMA176140 and TMA193029 for the trade-mark NUK. Both registrations cover orthodontic pacifiers, nipples and nursers. It also filed a certified copy of registration TMA322411 for the same trade-mark covering:

Orthodontic pacifiers, orthodontic nipples, orthodontic pacifier-exercisers, orthodontic pacifier-teethers, nursers, collars and disks for nursers, nipple hoods for nursers, teething rings, infant toothbrushes, infant toothbrush trainer sets, nursing pads, breast shields, breast pump kits, nasal aspirators, travel kits containing orthodontic pacifiers-exercisers, medi-nursers and nurser bottle holders for disposable bottles.

[24] I checked the register and these registrations are extant.

[25] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the

trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. ). I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) to determine if there is a likelihood of confusion between two trade-marks.

[26] The Opponent has a better chance of success under this ground of opposition with registration TMA322411 for the trade-mark NUK as it covers more products. I will therefore proceed by comparing this registration with the present application. If the Opponent does not succeed under this ground with this registration it would not be successful with the other registrations.

*Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[27] The parties' respective trade-marks are inherently distinctive. They are coined words. The Mark has also a design element. Consequently the Mark is more inherently distinctive.

[28] The distinctiveness of a trade-mark can be enhanced through its use or promotion. There is no evidence of use of the Mark in the record. As for the Opponent's trade-mark it argues that the certificate of registration shows use since at least as early as 1961. However in the absence of evidence of such use it is impossible to determine the extent to which it has become known in Canada.

*The length of time the trade-marks or trade-names have been in use*

[29] It has been held that the Registrar can refer to the certificate of registration to establish a period of use of the Opponent's registered trade-mark [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68]. However I can only presume from such evidence *de minimis* use. This factor favours the Opponent as there is no evidence of use of the Mark. However this finding will not be a determining factor in this decision.



*The nature of the wares, services, or business; the nature of the trade*

[30] I must compare the Wares and Services to the wares covered by the Opponent's registration. In the absence of evidence on the parties' respective channels of trade and businesses, I can only conclude, from the nature of some of the Wares, that there is some connection between the Applicant's infant accessories, namely, car seats, play parks, cribs, high chairs, strollers and crib bedding and the Opponent's orthodontic pacifiers, nipples and nursers.

*The degree of resemblance*

[31] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. In *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359, the Federal Court stated that the first portion of a trade-mark is the most relevant for purposes of distinction.

[32] The first element of the word portion of the Mark is the Opponent's trade-mark. Also it would appear that the second word portion of the Mark is phonetically equivalent to the Opponent's trade-mark NUK. Consequently the Mark is phonetically similar to the Opponent's trade-mark NUK.

[33] This most important factor favours the Opponent.

*Conclusion*

[34] From this analysis of the relevant criteria, I conclude that the Applicant has failed to demonstrate, on a balance of probabilities, that the Mark would not likely cause confusion with the Opponent's trade-mark NUK when used in association with infant accessories, namely, car seats, play parks, cribs, high chairs, strollers and crib bedding. As for the other Applicant's wares and the Services, this ground of opposition is dismissed.

## Disposition

[35] The net result of this opposition is that the Opponent is more successful under the second ground of opposition than the fourth ground, both of which are maintained in part. Consequently pursuant to the authority delegated to me under section 63(3) of the Act and in view of *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision, I refuse the application pursuant to section 38(8) of the Act except for footwear, namely men's and women's slippers.

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