

IN THE MATTER OF AN OPPOSITION
by Don Green and Michael Budman,
trading as Brian-Joel and Natural
Footwear Limited to application
No. 604,657 for the trade-mark
PUTTING DOWN ROOTS FOR THE FUTURE
& Design filed by Mark A. Joron
trading as For Us Trees

On April 13, 1988, the applicant, Mark A. Joron trading as For Us Trees, filed an application to register the trade-mark PUTTING DOWN ROOTS FOR THE FUTURE & Design (illustrated below) for "sweat shirts" based on use in Canada since December of 1987. The application was advertised for opposition purposes on September 28, 1988.

The opponents, Don Green and Michael Budman, trading as Brian-Joel and Natural Footwear Limited, filed a statement of opposition on January 30, 1989, a copy of which was forwarded to the applicant on February 15, 1989. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the first opponent's trade-mark ROOTS registered under No. 196,071 for the following wares:

- (1) footwear, namely shoes, slippers and boots
- (2) saddle soap, water repellent spray and shoe polish
- (3) footwear, namely golf shoes
- (4) luggage, handbags, hosiery, scarves, belts, T-shirts, sweat-shirts, gloves, wallets, key cases and key chain
- (5) clothing of all types namely slacks, shirts, socks, ties, suits, jackets, coats, dresses, blouses, skirts, jeans

and with the services of operating a retail outlet selling these wares.

The applicant filed and served a counter statement. As their evidence, the opponents filed the affidavit of Donald Green. The applicant filed the affidavit of Mark A. Joron. Both the opponents and the applicant filed written arguments but no oral hearing was conducted.

As for the ground of opposition based on the registered mark ROOTS, the material time for considering the circumstances is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks at issue are both inherently distinctive. The applicant did not evidence use of his mark and I must therefore conclude that it had not become known at all in Canada as of the material time. The Green affidavit, on the other hand, evidences extensive use and advertising of the mark ROOTS. Mr. Green indicates that sales revenues

for the years 1985 to 1988 were in excess of \$80 million. Although Mr. Green did not provide a breakdown of those sales by particular item, he did indicate that ROOTS sweat shirts were sold in retail stores in 19 different Canadian cities. Thus, I am able to conclude that the registered mark ROOTS had become well known in general throughout Canada for the wares and services listed in the registration and that it had acquired at least some reputation in association with sweat shirts.

The length of time the marks have been in use clearly favors the opponents. The wares are identical since the registration covers the very wares for which the applicant seeks registration. Of particular note is the sample sweat shirt which the applicant submitted with his letter of December 23, 1989. The applicant's mark appears in a large decorative format on the front of the shirt. Mr. Green states in paragraph 5 of his affidavit that the registered mark ROOTS is commonly used in the same manner on sweat shirts.

I must also conclude that the trades of the parties would, or could, be the same. The applicant has submitted that the "target markets" of the parties are different. However, the applicant's statement of wares contains no such distinction and that is what governs: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.).

As for Section 6(5) (e) of the Act, there is at least some degree of resemblance between the marks visually, phonetically and in the ideas suggested since the applicant's mark contains the entirety of the registered mark ROOTS and it contains a representation of tree roots. However, the word "roots" in the applicant's mark is used simply as one minor part of an overall mark comprising a six word slogan and a design component. This tends to de-emphasize the degree of resemblance between the marks.

As an additional surrounding circumstance, I have considered that the opponents have used the trade-mark ROOTS in a variety of design formats, many of which incorporate other words. Some of the design marks also incorporate elements from nature such as a representation of a beaver and a representation of tree branches. Finally, the Green affidavit evidences some minor use of the mark ROOTS on advertising material having an environmental theme. All of this suggests that consumers are accustomed to seeing the registered mark ROOTS in various design formats, including ones with a natural or environmental theme. To a limited extent, this increases the likelihood of consumers perceiving some connection between the marks at issue.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. As noted above, I have also considered that the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. What that means is that if, after of all of the evidence has been considered, a determinate conclusion cannot be reached on the issue, it must be resolved against the applicant. In the present case, in view of the identity of the wares and trades of the parties, in view of the reputation associated with the mark ROOTS and in view of the fact that there is at least some resemblance between the marks, I find that I am left in a

state of doubt as to the issue of confusion. I must therefore resolve that doubt against the applicant and find that the ground of opposition based on the registered mark ROOTS is successful. It is therefore unnecessary to consider the remaining grounds.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF May, 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.