IN THE MATTER OF AN OPPOSITION by Essilor International (compagnie générale d'optique) to Application No. 862514 for the Trade-mark R-WEAR filed by Rampage Clothing Company

On November 24 1997, Rampage Clothing Company (the «Applicant»), filed an application to register the trade-mark R-WEAR (the «Mark») in association with:

> Shirts, skirts and dresses; skin and beauty treatments, make-up and bath care products, namely foundation, facial powder, eye shadow, eyeliner, eye pencil, eyebrow pencil, mascara, blush, lipstick, lip gloss, lip pencil, make-up brushes and false eyelashes, body lotion, hand lotion, body oil, eye cream/gel, lip balm, shampoo, conditioner, hair gel/spray, bath gel, bar soap, skin exfoliant, bubble bath soap, bath oil, cuticle cream, neck and throat cream, facial cleanser, facial toner, body talc, facial cream, facial scrub, facial mask, body mask, mud packs, fragrances and perfume; eyewear, namely ophthalmic frames for prescription lenses and sunglasses; jewellery; leather goods, namely wallets, coin or change purses, credit card cases, key ring holders, day-timers, day-planners, calendars, organizers, fanny packs, back packs, clutches, small leather purses; leather apparel, namely jackets, coats, car coats, bomber jackets and motorcycle jackets; umbrellas; chairs and pillows; laundry bags; bed linen, namely sheets, blankets, mattress covers, duvets, dust ruffles, and pillow shams, bath linen, namely towels, face cloths, mats, toilet seat covers and toilet lid covers, household linen, namely tablecloths, dish towels, oven mitts and table linen, namely coasters, napkins and place mats; shoes; and hair accessories, namely headbands, bows, combs, hair ties, twisters, snoods and scarves.

based on proposed use. The application was subsequently advertised on October 14, 1998 for opposition purposes in the ***Trade-marks Journal.***

On April 13, 1999 Essilor International (compagnie générale d'optique) (the «Opponent») filed a Statement of Opposition. The Applicant served and filed on June 4, 1999 a Counter Statement in response to the Statement of Opposition, in which it denied each and every ground of opposition raised by the Opponent in its Statement of Opposition. Both parties filed written arguments and a hearing took place on September 19, 2003 during which both parties made oral representations.

The grounds of opposition can be summarised as follows inasmuch as they relate only to eyewear namely ophthalmic frames for prescription lenses and sunglasses (the«Wares»):

a) The Mark applied for is not registrable in view of section 38(2)(a) of the Trade-marks Act (the «Act»), as the Mark does not comply with the requirements of section 30. In particular:

i. The Applicant already used the Mark in Canada in whole or in part;
ii. The Applicant never had the intention to use the Mark in Canada or abandoned the Mark, in whole or in part;
iii. The application does not comply with section 30(a) in that it does not contain a statement in ordinary commercial terms of the specific wares with which the Mark has been used;
iv. The Applicant falsely declared that it was entitled to registration of the Mark for the reasons hereinafter set forth;

b) The Mark applied for is not registrable in view of section 38(2)(c) in that the Applicant is not the person entitled to registration of the Mark under Subsection 16(3) of the Act in that:

i. at the date of filing of the application the Mark was confusing with the trade-mark AIRWEAR previously used or made known in Canada by the Opponent or its predecessor-in-title in association with eyeglass lenses; eyeglass lenses made of organic material; treated eyeglass lenses; pucks and blanks for eyeglass lenses; cases for all of the above wares (the «Opponent's Wares»);
ii. at the date of filing of the application the Mark was confusing with the trade-mark AIRWEAR for which an application was filed, number 859171, with a priority date of April 22, 1997, in association with the Opponent's Wares;
iii. the application doesn't comply with the provisions of Section 30 of the Act and the mark is not a proposed use trade-mark but rather used or abandoned.

c) The Mark applied for is not registrable in view of section 38(2)(d) as the Mark is not, and at all material times has not been and could not be, distinctive of the Wares within the meaning of Section 2 of the Act in that it was not apt to distinguish the Applicant's Wares from the Opponent's Wares in view of:

i. The use and making known of the Opponent's famous trade-mark;
ii. Having regard to section 50, the Applicant has allowed the Mark to be used in Canada by third parties without the appropriate licence;
iii. Subsequent to its transfer, there remained rights to two or more entities to the use of the Mark, and those rights were exercised by them concurrently the whole contrary to Subsection 48(2) of the Act.

The evidence filed by the Opponent consists of a certification of authenticity of its application number 859171, for the trade-mark AIRWEAR while the Applicant filed the affidavit of Linda Victoria Thibeault dated June 23, 2000. In reply, the Opponent filed the Affidavit of Patrick Sartore dated October 17, 2000. The Applicant objected in its written representations to the admissibility of such Affidavit, on the basis that it didn't constitute proper reply evidence. I shall deal with this objection when I will review its content.

The Affidavit of Linda Victoria Thibeault reveals that she is a trade-mark searcher who was asked by the Applicant's agents firm to search the Register to locate trade-mark applications or registrations which have the word AIR as a component in connection with eyewear. The results of such search were filed as Exhibit A to her affidavit. It contains 14 citations including the Opponent's application. She filed as Exhibit B a copy of the corresponding certificates of registration or of the applications of the citations listed in her report Exhibit A.

She conducted a second search of the Register to locate trade-mark applications or registrations which have the word WEAR as a component in connection with eyewear. The results of such search were filed as Exhibit C to her affidavit. It contains 37 citations including the Opponent's application. She filed as Exhibit D a copy of the corresponding certificates of registration or of the applications of the citations listed in her report Exhibit C.

She finally searched the Register to locate trade-marks similar phonetically. The results of such search were filed as Exhibit E to her affidavit. She filed as Exhibit F a copy of the corresponding certificates of registration or of the applications of the citations listed in her report Exhibit E.

The Opponent's reply evidence consists of the affidavit of Patrick Sartore. He was, at the time of the execution of his affidavit, a student-at-law employed by the Opponent's agents firm. He consulted the French dictionary Le Petit Robert, Dictionnaire Alphabétique et Analogique de la Langue Française, to determine the pronunciation in the French language of the word AIR and the letter R. He filed as Exhibit PS-1 to his affidavit the pertinent extracts of such dictionary. He alleges that, according to PS-1, the word AIR and the letter R are pronounced the same way in French.

The Applicant argued that such evidence couldn't constitute proper reply evidence, as the Affidavit of Linda Victoria Thibeault was merely a State of the Register search. The Opponent should not be permitted to split its case in this way. The Applicant referred to ***London Life Insurance Co. v. Manufacturers Life Insurance Co., (1996), 67 C.P.R. (3d) 563 (TMOB).*** In such decision, Board Member Herzig stated:

> «It is evidence that should [page567] have been submitted as part of the opponent's evidence in chief pursuant to s. 43 of the Trade Marks Regulations, C.R.C. 1978, c. 1559, or the opponent might have requested leave to submit it as additional evidence under s. 46(1). As noted by Board Member Martin in ***R.J. Reynolds Tobacco Co. v. Philip Morris Products Inc.*** (July 31, 1995, yet unreported, re. appln. No. 630,981 for the mark DE-NIC) [now reported ***64 C.P.R. (3d) 395***], s. 45 of the Regulations is not a vehicle to correct deficiencies in the opponent's evidence-in-chief. I have therefore disregarded Mr. Kennedy's testimony.»

The Opponent argued at the hearing that it should be considered as proper reply evidence in view of the content of Exhibit F to Thibeault's affidavit which contains certificate of registration 384330 for the trade-mark AIR-FOAM and certificate of registration number 330456 for the trade-mark R-FOAM. The Thibeault affidavit would suggest that these trade-marks would be phonetically similar and still were permitted to co-exist. I must refer to the Statement of Opposition filed by the

Opponent to resolve this issue. The Opponent did allege that the Applicant was not entitled to the registration of the Mark as it was confusing with the Applicant's trade-mark AIRWEAR. The test for confusion described in section 6 of the Act does refer to the degree of resemblance of the marks in issue in appearance or sound or in the ideas suggested by them (Subsection 6(5)(e) of the Act).If the Opponent wanted to establish that the marks in issue are phonetically identical, it should have done so by way of its evidence in chief. The content of Sartore's affidavit shall therefore be disregarded.

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of such grounds of opposition. Once this initial burden is met, the burden shifts to the Applicant who must prove that the particular grounds of opposition should not prevent registration of the Mark [See ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325***, at ***pp. 329-330***; and ***John Labatt Ltd. v. Molson Companies Ltd., 30 C.P.R. (3d) 293].***

The Opponent's evidence only supports ground of opposition b) ii) above and corollary ground a) iv). Therefore all other grounds of opposition raised by the Opponent in its statement of opposition are dismissed for failure to meet its initial evidential burden.

The issue of non-entitlement based on Subsection 16(3)(b) of the Act must be addressed as of the date of filing of the Applicant's application (November 24, 1997) [Section 16 of the Act].

The filing of a certification of authenticity of application number 859171 for the trade-mark AIRWEAR establishes a filing date of October 20, 1997, which is prior to the date of filing of the Applicant's application. Therefore the legal burden shifts to the Applicant who must prove on the balance of probabilities that the Mark is not confusing with the Opponent's trade-mark AIRWEAR [***See Christian Dior, S.A. v. Dion Neckwear Ltd [2002]3 C.F.405***]. In order to determine whether trade-marks are confusing, Subsection 6(5) of the Act directs that the Registrar is to have regard to all of the surrounding circumstances, including:

i) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

ii) the length of time the trade-marks or trade-names have been in use;

iii) the nature of the wares, services, or business;

iv) the nature of the trade; and

v) the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

In ***Pernod Ricard v. Molson Breweries (1992), 44 C.P.R. (3d) 359 at 369***, Mr. Justice Deneault summarized the test to determine if there is a likelihood of confusion between two trade-marks in the following way:

> «The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole: Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd. (1965), 44 C.P.R. 189 at pp. 191-2, 53 D.L.R. (2d) 1, [1965] S.C.R. 734; Oshawa Group Ltd. v. Creative Resources Co. (1982), ***[page370]*** 61 C.P.R. (2d) 29 at p. 35, 46 N.R. 426 sub nom. Oshawa Group Ltd. v. Registrar of Trade Marks (F.C.A.); Cantine Torresella S.r.l. v. Carbo (1987), 16 C.P.R. (3d) 137 at p. 146, 14 C.I.P.R. 234 (F.C.T.D.).
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> Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade mark is the most relevant for purposes of distinction: Molson Companies Ltd. v. John Labatt Ltd. (1990), 28 C.P.R. (3d) 457 at p. 461, 32 F.T.R. 152, 19 A.C.W.S. (3d) 1369 (F.C.T.D.); Conde Nast Publications Inc. v. Union Des Editions Modernes (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188. I believe the following words of President Thorson in the case of British Drug Houses Ltd. v. Battle Pharmaceuticals (1944), 4 C.P.R. 48 at pp. 57-8, [1944] 4 D.L.R. 577, [1944] Ex. C.R. 239 (Ex. Ct.), to be particularly useful in explaining why attention should be drawn to the first portion of the appellant's mark in this case:
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> > ... the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person

> would be likely to think that the goods on which the later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar.»

In the case of ***Battle Pharmaceuticals v. British Drug House Ltd., [1946] S.C.R.50***, the Honorable Mr Justice Kerwin cited the following extract of the decision rendered by the Privy Council in ***Aritoc Limited v. Rysta Limited [1945] A.C. 68:***

> «The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of s. 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.»

It is with these principles in mind that I shall analyse the criteria enumerated in Section 6(5) of the Act and any other relevant surrounding circumstances.

i inherent distinctiveness

The English word «WEAR» is the suffix of both trade-marks in issue. The letter R is the prefix of the Mark while the word «AIR» is the prefix of the Opponent’s trade-mark. The position taken by the parties on this issue doesn’t differ that much as the Applicant is stating that both marks have some distinctiveness while the Opponent argues that the marks in issue have approximately the same degree of inherent distinctiveness. This factor doesn’t advantage any party.

ii length of time the trade-marks have been in use

There hasn't been any evidence filed by either party on the use of their respective trade-mark. As such this criteria doesn't favour any of the parties.

iii & iv the nature of the wares and trade

As the opposition is limited to the registration of the Mark in association with the Wares, I shall only consider those for the purpose of my decision.

The Opponent argues that the Wares and the Opponent's Wares are in the same general class of wares, namely eyewear. Therefore they would circulate through the same channels of trade. The Applicant is arguing that, because the Mark is proposed to be used in association with a broad list of clothing, cosmetics, bath products, clothing accessories and household items and the term R-WEAR has some meaning in relation with the Applicant's corporate name «Rampage Clothing Company», it is clear that the Applicant intends to use the mark in the context of a designer mark on a broad range of fashion-related items and accessories. The Applicant in its written submissions and during the oral hearing did present various assumptions in order to distinguish the nature of the trade of its Wares from the Opponent's Wares. In the absence of evidence to support any of the Applicant's probable scenarios, I can't conclude in favour of any of the parties when analyzing the nature of the trade, but I'm able to conclude however, by using common sense, that the Wares and the Opponent's Wares are in the same general class of wares, namely eyewear.

v degree of resemblance

With respect to this criteria, Mr. Justice Cattanach stated in ***Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd. (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70:***

> "Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances**."**

The degree of resemblance between the trade-marks in issue must be assessed in terms of their appearance or sound or the ideas suggested by them. There exists a difference in the appearance of the trade-marks in issue and the ideas suggested by them. The central issue is whether there is a phonetical resemblance between them. The Applicant argues that there is no expert evidence to enable me to conclude that a francophone would pronounce both trade-marks the same way. As I have excluded from the record the affidavit of Patrick Sartore, there is no evidence in the record as to the pronunciation in French of the words «RWEAR» and «AIRWEAR».

The Opponent is relying on the case of ***Thorold Concrete Products Ltd. v. Registrar of Trade-Marks, (1961) 37 C.P.R. 166*** to support the proposition that the Registrar could refer to dictionaries to determine the pronunciation of words. In that case the parties filed pertinent extracts of dictionaries to establish the pronunciation, in the English language, of a word. To reach its decision, the court referred to an American dictionary, but it is not clear if such extract was filed as evidence by one of the parties or if the court on its own initiative cited such reference. In ***Molson Breweries, Apartnership v. John Labatt Ltd, 3 C.P.R.(4th) 543*** and in ***Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co. (1999) 2 C.P.R.(4th) 103,*** Mr. Gary Partington, as he was Chairman of the Trade-marks Opposition Board, did refer to a dictionary to determine the meaning of a word, even though the pertinent extracts were not part of the evidence filed in these files.

The question that I have to answer is: does the pronunciation of words need to be established by way of expert affidavit or can judicial notice be taken of their pronunciation? The Applicant position is that the pronunciation of words must be established by way of expert affidavit. To support its contention the Applicant is referring to ***Etablissements Léon Duhamel v. Créations K.T. M., (1986) 9 C.I.P.R. 60.*** It should be noted that in that case Chairman G.W. Partington had to rule on the admissibility of expert evidence to establish the pronunciation of words. He found such evidence admissible and referred to the following quote from Mr. Justice Walsh in ***Ethicon Inc. et al v. Cyanamid of Canada Ltd., 35 C.P.R. (2nd) 126*** to support his ruling:

> «With respect to the affidavits relating to the pronunciation of the word "Ethicon", reference was made by respondent to the case of Home Juice Co. v. Orange Maison Ltée (1976), 52 C.P.R. 175, [1968] 1 Ex. C.R. 163, 36 Fox Pat. C. 111, in which

> Jackett, P., as he then was, held that expert evidence as to the meaning of the words "Orange Maison" was not admissable (sic) since the meaning of words, apart from words having a special meaning in a particular trade, science, industry, or other particular element of society, is a matter for the Court with such aids to interpretations as are available to it and cannot be the subject-matter of opinion evidence. However, in the present case it is not the meaning of words which is an issue but the pronunciation of them in one of the official languages and Fox, Canadian Law of Trade Marks and Unfair Competition, 3rd ed. (1972), states at p. 172:
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> > Evidence of pronunciation is admissible in the French as well as the English languages. These rules are particularly opposite in the case of multisyllabic words. It has generally been accepted in a number of reported cases that there is a tendency to slur the termination of words and that the first syllable of a word mark is generally the most important. But this rule is subject to exception: it depends to a large extent on the nature of the word. Thus, it has been pointed out in Aristoc Ltd. v. Rysta Ltd. (1945), 62 R.P.C. 65, that it is often customary in the English language to slur a word beginning with the letter "a". But this principle cannot be carried too far. There is a limit to the letters that will normally be slurred. Not only slurring of prefixes but also mispronunciation and careless pronunciation must always be considered in the case of word marks.
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> While it is the Court which must always make the decision and this might perhaps be made without the benefit of evidence in the event that the motion is heard on the merits by a Judge whose mother tongue is French, it would appear that evidence of pronunciation is admissable.»(sic)

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).

I therefore come to the conclusion that I can take judicial notice of the fact that a Francophone would pronounce the words «RWEAR» and «AIRWEAR» in the same way.

The last question that I have to answer on that topic is which segment of the Canadian population I should take into consideration? In ***Smithkline Beecham Corporation v. Pierre Fabre Médicament, (2001) 11 C.P.R. (4th) 1*** the Federal Court of Appeal ruled that if there is a risk of confusion in either of the country's two official languages, a trade-mark cannot be registered. Therefore I conclude that the Mark is phonetically identical to the Opponent's trade-mark

vi other surrounding circumstances

The Applicant's evidence consists of extracts of the State of the Register to argue that the prefix «AIR» and the suffix «WEAR» are common to many trade-marks owned and used by different entities in Canada in association with eyewear. In paragraph 14 of its written submissions the Applicant lists seven (7) applications or registrations as the more pertinent references incorporating the word AIR as a component of a trade-mark in which eyewear, in general, is part of the list of wares covered by those citations. There is no evidence in the record as to the use of any of these trade-marks.. The number of applications or registrations is insufficient to allow me to infer that the word AIR is widely used in the trade in association with eyewear. [see ***Scott Paper Co. V. Wyant & Co. (1995), 61 C.P.R. (3d) 546, Welch Foods Inc. v. Del Monte Corp. (1992), 44 C.P.R. (3d) 205*** and ***T. Eaton Co. v. Viking GmbH& Co. (1998), 86 C.P.R. (3d) 382***].

The Applicant, in its written submissions, lists 13 trade-mark applications or registrations taken from the Thibeault Affidavit, as the most pertinent citations that contain the word WEAR as a suffix, in which eyewear is included in their list of wares. The word WEAR is not the distinctive

element of each of these citations. In fact, it is interesting to note that the prefix of each of these trade-marks is their distinctive element.

Taking into consideration all the above surrounding circumstances, I come to the conclusion that the Applicant has not discharged its onus to show, on the balance of probabilities, that the Mark would not likely cause confusion with the Opponent's trade-mark AIRWEAR when used in association with the Wares. The Opponent's ground of opposition b) ii) described above is maintained. Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, and applying the principles enunciated in the case of ***Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH 10 C.P.R. (3d) 482,*** I refuse the Applicant's application for the registration of the Mark, only with respect to the following wares:

« eyewear, namely ophthalmic frames for prescription lenses and sunglasses»

the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 23rd DAY OF FEBRUARY 2004.

Jean Carrière,
Member,

Trade-marks Opposition Board