

**IN THE MATTER OF TWO OPPOSITIONS**  
**by Joop! GmbH and Joop! Jeans USA, L.P.,**  
**a partnership, to application nos. 799,546 and**  
**799,547 for the trade-marks OOPS! and OPPS! DESIGN,**  
**respectively, filed by Taboh Holdings, Inc.**

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On December 12, 1995, the applicant, Taboh Holdings, Inc., filed an application to register the mark OOPS! based on use in Canada since March 1995 in association with “footwear” and related retail selling services. Objections to the application were raised at the examination stage namely, that (i) the term “footwear” should be defined specifically in ordinary commercial terms and (ii) the applied for mark was confusing with the registered mark Oops! & Design, regn. no. 403,693. The applicant overcame the above-mentioned objections by successfully arguing against the second objection and by amending the subject application to specify the wares and services as follows:

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| wares:    | footwear, namely, men's, women's and children's shoes of all types, sandals, slippers and boots. |
| services: | retail services associated with the sale of men's, women's and children's footwear.              |

The subject application was advertised in the *Trade-marks Journal* issue dated December 4, 1996 and was opposed by Joop! GmbH and Joop! Jeans USA, L.P., a partnership, on April 28, 1997. A copy of the statement of opposition was forwarded to the applicant on May 13, 1997. The applicant responded by filing and serving a counter statement.

The statement of opposition pleads that the first opponent Joop! GmbH is the owner of the registered marks JOOP (covering, inter alia, the design of clothing) and JOOP! (covering, inter alia, hats and shoes), as well as the owner of three pending trade-mark applications namely, JOOP! JEANS & Design for clothing; JOOP! DESIGN for stationery; and JOOP! LE BAIN for perfumery, cosmetics and other personal care products.

Further, the statement of opposition pleads that the second opponent Joop! Jeans USA is the owner of two registered design marks, illustrated below, covering various items of clothing.

The first ground of opposition, pursuant to Section 30(i) of the *Trade-marks Act*, alleges that the applicant cannot be satisfied that it was entitled to use the applied for mark OOPS! in view of the above-mentioned trade-mark registrations and applications owned by the opponents. The second ground of opposition alleges that the applied for mark OOPS! is not registrable, pursuant to Section 12(1)(d), because it is confusing with each of the above-mentioned trade-mark registrations. The third ground of opposition alleges that the applicant is not entitled to register the applied for mark OOPS! pursuant to Sections 16(1)(a) and (b) since, at the time of the claimed date of first use of the applicant's mark OOPS!, it was confusing with (i) the aforementioned marks JOOP, JOOP!, and the two ! DESIGN marks previously used in Canada, and (ii) the aforementioned pending applications previously filed by the first opponent Joop! GmbH. The final ground of opposition, pursuant to Sections 2 and 38(2)(d) of the *Act*, alleges that the applied for mark OOPS! does not distinguish the applicant's wares and services from the opponents' wares and services provided under the opponents' above-mentioned marks.

The opponents' evidence consists of certified copies of their trade-marks registrations and applications relied upon in their pleadings, as well as the affidavit of Daniel De Costa, a senior executive with the second opponent. The applicant elected not to file any evidence in support of its application. Both parties submitted a written argument, however, only the opponent was represented at an oral hearing.

Mr. De Costa's affidavit evidence may be summarized as follows. The second opponent, Jeans USA, is a licensee of the first opponent JOOP! GmbH (presumably with respect to the trade-marks owned by JOOP! GmbH). Sales of clothing in Canada, under the marks owned by the first opponent, amounted to about \$ 430,000 U.S. for the years 1994 -1998 inclusive. Advertising expenses for the two year period 1995-1996 was in excess of sales, amounting to about \$665,000 U.S. The exhibit material attached to Mr. De Costa's affidavit leads to the

inference that the combination marks shown below, or variations thereof, are used most often in association with the sale and advertising of the opponents' jeans and shirts.

With respect to the first ground of opposition, the opponents allege that the applicant could not have been satisfied that it was entitled to use the trade-mark OOPS! in Canada in association with the wares and services covered in the present application in that, as of the applicant's filing date, the applicant was aware, or should have been aware, of the opponents' above-mentioned trade-mark registrations and applications. While the legal onus is on the applicant to show that its trade-mark application complies with Section 30(i) of the *Act*, there is an initial evidentiary burden on the opponents in respect of the Section 30 ground: see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325 at 329-330. However, no evidence has been filed by the opponents to show that the applicant was aware, or ought to have been aware, of the opponents' trade-mark registrations and applications. Thus, the opponent has failed to meet the evidentiary burden upon it in respect of this ground. In any event, even had the applicant been aware of the opponents' trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark OOPS! in Canada on the basis *inter alia* that its mark OOPS! is not confusing with any of the opponents' trade-marks.

The second ground of opposition alleges that the applied for mark OOPS! is not registrable because it is confusing with one, or more, of the first opponent's registered marks namely, JOOP and JOOP!. I will first consider whether the applied for mark OOPS! is not registrable because it is confusing with the registered mark JOOP! covering the wares

cosmetics namely lotions, shampoos, shaving lotions, deodorants, soaps; clothing namely belts, hats and caps and shoes.

The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision: see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (TMOB).

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark OOPS! and the opponent's registered mark JOOP!. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. In making an assessment as to whether two marks are confusing, all of the relevant surrounding circumstances are to be considered including the factors set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The first opponent's mark JOOP! and the applied for mark OOP! each possess a fairly high degree of inherent distinctiveness. In this regard, the term "joop" is a coined term, and neither mark has any obvious nexus or connection with the parties' wares. The applicant has not filed any evidence to show that its mark OOPS! has acquired any reputation in Canada in association with the applicant's wares. Similarly, the opponent has not filed any evidence to show that its mark JOOP! has acquired any reputation in Canada in association with the wares covered in its registration. However, on a fair review of Mr. De Costa's affidavit evidence, including in particular the exhibit material, it would appear that the mark JOOP! has acquired at least some reputation in Canada in association with men's jeans and shirts. Such a reputation is a surrounding circumstance that favours the opponents. The evidence also shows that the first opponent has been using its mark JOOP! in

association with jeans and shirts since 1994. On the other hand, the applicant has not shown any use of its mark. Accordingly, the length of time that the mark JOOP! has been used in Canada in association with clothing is a surrounding circumstance that favours the opponents.

The applicant applied for mark OOPS! covers the wares “shoes.” The first opponent’s trade-mark registration for JOOP! covers cosmetics, items of clothing, and shoes. In the absence of evidence to the contrary, I assume that the shoes of both parties would be sold through the same channels of trade. Further, shoes and clothing are related wares and thus there is potential for the first opponent’s items of clothing, sold under the mark JOOP!, to travel through the same channels of trade as the applicant’s shoes: see *Salamander Aktiengesellschaft v. Pacific Clothing Exchange Ltd.*, 19 C.P.R. (3d) 349 at 351; *I. Hignell & Associates Ltd. v. H.H. Brown Shoe Co. (Canada) Ltd. - Chaussures H.H. Brown (Canada) Ltée.*, 34 C.P.R. (3d) 569; and *Patagonia, Inc. v. Chaussures André S.A., Société Anonyme*, 55 C.P.R. (3d) 408.

The marks OOPS! and JOOP! resemble each other to a fair degree visually, particularly in respect of the combination of the letters OOP and the exclamation symbol ending each mark. The marks also resemble each other in sounding to the extent that “oops” and “joop” contain the same “oop” sound. The marks in issue do not, however, resemble each other in ideas suggested as the term “joop” is a coined word having no meaning while the word “oops” conveys mild apology or dismay.

The evidence filed by the opponents is somewhat meager and is not without deficiencies. Nevertheless, the opponents’ evidence has not been challenged by cross-examination and is generally supportive of the opponents’ case. On the other hand, the applicant has not filed any evidence to support its own case or to contradict the opponents’ evidence. Having regard to all of the above, I find that the applicant has not met the onus on it to show that the mark OOPS! is not confusing with the mark JOOP!. If I am wrong in so concluding, then I find that I am in a state of doubt whether the aforementioned marks OOPS! and JOOP are confusing. Given that the legal onus is on the applicant, the issue of confusion must again be decided against the applicant.

There is scant evidence that the first opponent has used its registered mark JOOP *per se* and

of course the mark JOOP does not contain an exclamation point as a design feature. Further, the trade-mark registration for the mark JOOP does not cover the wares “shoes.” Accordingly, I find that the opponent does not succeed on the second aspect of the first ground of opposition which relies on its registered mark JOOP.

With respect to the third ground of opposition, I have exercised my discretion (see *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R.(3d) 525 at 529 (TMOB)) to verify the status of certain trade-mark applications relied on by the opponents in their pleadings, in view of submissions in the applicant’s written argument. I have noted that the trade-mark applications for JOOP! DESIGN, no. 701,277, and JOOP! LE BAIN, no. 693,509, were abandoned on January 20, 1999. I do not believe that the opponents are entitled to rely on defunct applications in respect of a ground of opposition based on Section 16(1)(b) of the *Act* : in this regard, see the discussions by the Federal Court of Appeal in *W. R. Grace & Co. v. Union Carbide Corp.* (1987), 14 C.P.R. (3d) 337 at 345 and by the Federal Court, Trial Division in *Molson Breweries v. Labatt Brewing Co.* (1996), 68 C.P.R. (3d) 202 at 210-211. In any event, at the oral hearing the opponent advised the Board that it was not relying on the two above-mentioned defunct trade-marks applications. For essentially the same reasons as discussed earlier, I find that, at the material date March 31, 1995, the applied for mark OOPS! was confusing with the first opponent’s marks JOOP! and JOOP! JEANS & Design. However, I do not find that the mark OOPS! is confusing with any of the remaining marks pleaded under the second ground of opposition.

The last ground of opposition alleges that the applied for mark OOPS! is not distinctive of the applicant’s wares and services. In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in the allegation that the applied for mark OOPS! is not distinctive. As noted earlier, the presence of an evidential burden on the opponent, with respect to a particular issue, means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

The legal onus is on the applicant to show that its mark is adapted to distinguish or actually

distinguishes its wares and services from those of the opponents throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal onus means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case April 28, 1997: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

In the instant case, the issue of distinctiveness turns on whether the applied for mark OPPS! is confusing with the first opponent's mark JOOP! at the material date April 28, 1997. For essentially the same reasons as discussed under the first ground of opposition, I find that the marks are confusing or that I am in a state of doubt about whether the marks are confusing. Accordingly, the last ground of opposition is successful.

The second opposition case concerns application no. 799,547 for the mark OOPS! DESIGN, illustrated below.

The application for the mark OOPS! DESIGN was filed on December 12, 1995 and covers the same wares and services as application no. 799,546 for the mark OOPS! The pleadings, the evidence and the issues to be decided are essentially the same in the two opposition cases. Accordingly, I have arrived at the same conclusions in



respect of the second opposition case.

In view of the above, the applicant's applications for the marks OOPS! and OOPS! DESIGN are refused.

DATED AT HULL, QUEBEC, THIS 15<sup>th</sup> DAY OF NOVEMBER , 2000.

Myer Herzig,  
Member,  
Trade-marks Opposition Board