

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

**Citation: 2015 TMOB 155**  
**Date of Decision: 2015-08-31**

**IN THE MATTER OF AN OPPOSITION**

|                                     |                    |
|-------------------------------------|--------------------|
| <b>Genfoot Inc.</b>                 | <b>Opponent</b>    |
| <b>and</b>                          |                    |
| <b>Reg Sheffield</b>                | <b>Applicant</b>   |
| <b>1,596,326 for “little rocks”</b> | <b>Application</b> |

[1] On October 1<sup>st</sup>, 2012, Reg Sheffield (the Applicant) filed application No. 1,596,326 to register the trade-mark “little rocks” (shown below) (the Mark). The application is based upon proposed use of the Mark in Canada in association with “children’s tee shirts, hats and hoodies” (the Goods):



[2] Genfoot Inc. (the Opponent) has opposed the application for the Mark under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), based upon the grounds that (i) the application does not conform with the requirements of sections 30(e) and (i) of the Act; (ii) the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with one or more of the Opponent’s registered trade-marks listed in the attached Schedule “A” (as will become apparent

in my analysis below, the Opponent collectively refers to these trade-marks as the INUKSHUK Trade-mark. Accordingly, I will do the same unless indicated otherwise); (iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, because as of the filing date of the Applicant's application, the Mark was confusing with the Opponent's INUKSHUK Trade-mark; and (iii) the Mark is not distinctive within the meaning of section 2 of the Act.

[3] For the reasons explained below, I find that all of the grounds of opposition ought to be dismissed except for the section 30(e) ground.

#### The record

[4] The statement of opposition was filed by the Opponent on July 18, 2013. The Applicant filed and served a counter statement on October 8, 2013 denying each of the grounds of opposition set out in the statement of opposition. I shall note at this point of my decision that I am disregarding those portions of the counter statement that constitute legal argument.

[5] As its evidence, the Opponent filed an affidavit of its President Richard Cook, sworn February 5, 2014 (the Cook affidavit).

[6] As his evidence, the Applicant filed his own affidavit, ultimately sworn on July 7, 2014 [see Office letter dated August 18, 2014 confirming that the Applicant's evidence filed on July 14, 2014 had been made of record].

[7] None of the affiants were cross-examined on their affidavits.

[8] Only the Opponent timely filed written arguments [see Office letter dated March 12, 2015, advising the Applicant that the Registrar will not have regard to the Applicant's submissions contained in his letter of March 4, 2015]. No oral hearing was held.

#### The parties' respective burden or onus

[9] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson*

*Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

### Analysis

#### Ground of opposition based on non-registrability of the Mark under section 12(1)(d) of the Act

[10] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with one or more of the Opponent's registered trade-marks listed in Schedule "A" hereto. I note that the Opponent filed through the Cook affidavit certified copies of these three registrations under Exhibits "A" and "B" attached thereto.

[11] I have exercised the Registrar's discretion to confirm that each of these registrations is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[12] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and one or more of the Opponent's registered trade-marks.

#### The test for confusion

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[14] Thus, this section does not concern the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 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 goods, 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Consideration of the section 6(5) factors

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

[16] I assess the inherent distinctiveness of the parties' marks as about the same, although less so for the Opponent's INUKSHUK Trade-mark as it solely consist of stylized representations of an *inunnguaq* (a stone figure), whereas the Mark also includes the words "little" and "rocks".

[17] In his affidavit, the Applicant attaches as Exhibit "C" excerpts from *The Canadian Encyclopedia* defining the origins and historical significance of the *inukshuk* symbol, including the *inunnguaq* symbol as follows:

Figures made of stone called inuksuit (singular inuksuk, also spelled inukshuk) are among the most important objects created by the INUIT, who were the first people to inhabit portions of Alaska, Arctic Canada and Greenland. The term *inuksuk* (in Inuktitut) means "to act in the capacity of a human." [...]

Inuksuit are placed on the temporal landscape acting as "helpers" to the Inuit. Among their many practical functions, they are used as hunting and navigational aids, act as coordination points, serve as various indicators (eg, where food was cached), and act as message centers. In addition to their earthly functions, certain inuksuk-like figures have spiritual connotations, and are objects of veneration, often marking the threshold of the spiritual landscape of the *Inummariit* – the Inuit who know how to survive on the land living their traditional way. [...]

The Inuit also construct a stone figure called an *inunnnguaq*, which means “in the likeness of a human”. This familiar stone figure with head, body, legs and arms is mistakenly referred to as an inuksuk which it is not. Its purpose is more symbolic than functional. Because of its humanoid appearance in the likeness of a little person, its image has become a popular cross cultural symbol, and it now adorns the new flag of NUNAVUT.

[my underlining]

[18] In the same vein, the Applicant further attaches under Exhibits “D”, “E”, “M”, “N” and “O” printouts from various third party websites concerning the origins and historical significance of the inukshuk symbol. The Opponent has objected to the admissibility and reliability of these third party websites on the basis that they are either hearsay or are simply not pertinent to the present opposition. I find it is not necessary to discuss any of these third party websites further.

[19] Suffice it to say that the Opponent’s own evidence introduced through the Cook affidavit acknowledges that the Opponent’s INUKSHUK Trade-mark was inspired by the inuksuit as per the following passage taken from Exhibit “J” attached to the Cook affidavit, among others:

JOURNEY ON. Our brand identity, like our product, was inspired by the Canadian North. Our logo is made up of a whalebone – which symbolizes protection – over a stone landmark, that the Inuit people called an Inukshuk. Inukshuks have stood for centuries in some of the harshest, most unforgiving places on earth. And like a lighthouse in a storm, they serve as a beacon to travelers journeying through the great Arctic wilderness, and were built for guidance and the assurance of safe passage.

The Inukshuk is a familiar outdoor symbol that stands for strength, protection, and guidance. When you see it on our products, it lets you know that they’ve been built to be just as though. [...]

[20] As the parties’ marks are made up of stylized representations of a universal symbol of the Inuit culture, I find they are not inherently strong marks, especially the Opponent’s INUKSHUK Trade-mark.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. This brings me to review the evidence on this point filed through the Cook and the Applicant’s affidavits respectively.

[22] I shall note at this point of my analysis that I am not affording weight to any of the statements made by the affiants that constitute personal opinion on the likelihood of confusion

between the parties' marks. The likelihood of confusion is a question of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

The Opponent's evidence filed through the Cook affidavit

[23] Mr. Cook states that the Opponent is a privately held Canadian company dealing in the manufacturing and sale of clothing and footwear for men, women and children. He states that the Opponent was established in 1898 and has become a recognized global leader in the footwear industry [para 3 of the affidavit].

[24] Mr. Cook states that in or about 1997, the Opponent developed and began using a design comprising a stylized representation of a stone man, also known as an Inukshuk, to identify its line of clothing and footwear. This Inukshuk design is the subject of registration Nos. TMA547,579 and TMA555,198 reproduced in Schedule "A" hereto [para 4 of the affidavit; Exhibit "A"].

[25] Mr. Cook states that the Opponent, seeking to modernize the look of its Inukshuk figure, adopted a slightly modified version of its original Inukshuk design. This modified design is the subject of registration No. TMA664,253 also reproduced in Schedule "A" hereto [para 5 of the affidavit; Exhibit "B"].

[26] Mr. Cook states that both the original Inukshuk design and the modified Inukshuk design are used extensively by the Opponent in association with clothing and footwear for men, women and children. Mr. Cook thereafter collectively refers throughout his affidavit to the original and modified Inukshuk designs as the INUKSHUK Trade-mark [para 6 of the affidavit].

[27] In support of his statements of use of the INUKSHUK Trade-mark Mr. Cook attaches as Exhibit "C" to his affidavit a sampling of clothing and footwear bearing the INUKSHUK Trade-mark and a sampling of labels and hangtags bearing the INUKSHUK Trade-mark that are affixed to clothing and footwear. He also attaches under Exhibit "D" a representative sampling of invoices for clothing and footwear bearing the INUKSHUK Trade-mark sold by the Opponent for the years 2000-2013 [paras 6 and 8 of the affidavit].

[28] Upon review of Exhibit "C", I note that the samplings provided concern mainly footwear.

The only images of clothing are for a “kid’s artic fleece pullover”, a “kid’s long sleeve crew neck T-shirt” and “men’s long sleeve crew neck” apparently printed from the Opponent’s website at <http://www.kamik.com/GenfootWeb> on February 25, 2009, and a few undated photographs of winter outdoor clothing. As for Exhibit D, the product descriptions indicated on the invoices do not enable me to determine what they consist of.

[29] Mr. Cook states that sales of footwear bearing the INUKSHUK Trade-mark have been continuous throughout Canada since 1997. He explains that these sales are made through national retail store chains such as Canadian Tire, Mark’s Work Warehouse, Sears and The Bay as well as through regional and/or local clothing, footwear and sporting goods stores such as Kiddie Cobbler, Kiddytown, SoftMoc, TSC Stores, Bushtukkah, the Expedition Shop, Baron, Sports and Sportmania. He further states that at the time of swearing his affidavit, footwear bearing the INUKSHUK Trade-mark could be found in over 2600 locations throughout Canada [para 7 of his affidavit]. I note that no similar information is provided with respect to the Opponent’s clothing.

[30] Mr. Cook states that in Canada, the Opponent’s largest market, annual sales of clothing and footwear bearing the INUKSHUK Trade-mark for the years 2000-2013 have ranged from CAD\$11 million to CAD\$20 million. During this fourteen year period, the average dollar value of annual sales in Canada was over \$CAD15 million [para 9 of the affidavit]. I note that no breakdown of the Opponent’s total sales by product category has been provided.

[31] Mr. Cook states that the INUKSHUK Trade-mark has become well-known in Canada by way of extensive advertising (print and television) and in-store promotion [para 10 of the affidavit].

[32] More particularly, in terms of in-store promotion, Mr. Cook states that the INUKSHUK Trade-mark is displayed on product sign cards, brand cubes, in-stores posters, boot toppers, floor mats, dealer stickers and posters, window decals, shoe/boot stands, shoe/boot slatwall shelves and sign cards [para 10 of the affidavit]. In support of this statement, he attaches under Exhibit “E” copies of a representative sampling on in-store promotional products that have been displayed at retail locations in Canada selling the Opponent’s clothing and footwear. Upon review of this exhibit, I note that the in-store promotional products apparently pertain to

footwear only.

[33] In terms of print advertising, Mr. Cook states that the Opponent promotes its clothing and footwear in association with the INUKSHUK Trade-mark through product catalogues, some of which are directed specifically to children's wear [para 11 of the affidavit]. In support of this statement, he attaches under Exhibit "F" copies of the Opponent's product catalogues for the years 1998, 2003, and 2009 to 2013 which are distributed to retailers throughout Canada and internationally to all of the Opponent's distributors. Upon review of this exhibit, I note that all of the catalogues apparently pertain to footwear only.

[34] Mr. Cook states that the Opponent also promotes its INUKSHUK Trade-mark through advertisements appearing in printed publications such as The Toronto Star, The Globe and Mail, Backpacker magazine, Chatelaine, National Parks, Fitness Plus, Outside Traveler, Travel & Leisure, Men's Health, Sports Illustrated Women and Footwear News [para 12 of the affidavit]. In support of this statement, he attaches under Exhibit "G" copies of a representative sampling of advertisements that have appeared in printed publications circulated within Canada over the period of 2003 to 2013. Upon review of this exhibit, I note that all of the ads apparently pertain to footwear only.

[35] In terms of television advertising, Mr. Cook states that that such advertising includes the prominent display of product bearing the INUKSHUK Trade-mark on advertisements shown on The Weather Network/Météo Média [para 13 of the affidavit]. In support of this statement, he attaches under Exhibit "H" printouts of advertisements featuring footwear bearing the INUKSHUK Trade-mark that were shown on The Weather Network/Météo Média in 2008, 2010 and 2011, along with a sampling of invoices for these advertisements. I note that no similar advertisement is provided with respect to the Opponent's clothing.

[36] Mr. Cook further states that the Opponent has sponsored numerous sport organizations, including the Montreal Allouettes football club of the Canadian Football League [para 14 of the affidavit]. In support of this statement, he attaches under Exhibit "I" copies of selected pages from the Montreal Allouettes cheerleaders calendar for 2008/2009 along with a screenshot of a promotional spot that appeared on television in the 2008-2009 season. The INUKSHUK Trade-mark is apparently displayed on its own as opposed to in association with the Opponent's



footwear or clothing.

[37] Mr. Cook states that since 1996, the Opponent has been operating a commercial website accessible at *www.kamik.com*. He states that the website, which is continuously updated with current information, provides a company history, photographs and information about available products, information about product warranties and product technology, and a dealer locator tool. In support of this statement, he attaches under Exhibit “J” screenshots of a representative sampling of pages from such website. I note that the products featured therein all consist of footwear only.

[38] To sum up, I am satisfied from my review of the Cook affidavit that the Opponent’s INUKSHUK Trade-mark has become known to a significant extent in Canada in association with footwear, thereby reinforcing the distinctiveness of the Opponent’s mark with respect to these goods. However, I am not satisfied that the same holds true with respect to the Opponent’s clothing.

[39] Indeed, except for a few images of clothing displaying the INUKSHUK Trade-mark filed under Exhibit “C”, none of the exhibits and statements of facts contained in the Cook affidavit provide any satisfactory indication with respect to the use made of the INUKSHUK Trade-mark in association with clothing, and much the less, the extent of such use, if any.

The Applicant’s evidence filed through his own affidavit

[40] As indicated above, the Applicant’s application for the Mark is based upon proposed use.

[41] At paragraph 10 of his affidavit, the Applicant states the following:

[...] at the time of filing the application for registration of the [Mark], it was my intent to use the [Mark] in Canada in association with the wares listed in the application. I also declare that I began retailing these wares and made them available to the public, bearing the [Mark] in July of 2012. Attached is Exhibit “P”, a copy of the invoice from Venture Graphics (tee shirt decal producer, 5-8005 Alexander Rd, Delta BC [...]), citing Reg Sheffield as the order recipient of plastisol heat transfers, or tee shirt decals, to be affixed to children’s tee shirts while bearing the [Mark]. Also attached is Exhibit “Q”, a copy of the LITTLE ROCK decal design as ordered by myself from Venture Graphics. I have prepared children’s tee shirts bearing the [Mark] and I have been selling them at my retail store (Niagara Escarpment Outfitters, 220 Hurontario Street, Collingwood, ON, Canada)

since July of 2012. It has always been my intent to use the [Mark] in Canada in association with the wares listed in the application and at the time of filing, I was satisfied that I was entitled to use [the Mark] in Canada in association with the wares listed in the [a]pplication.

[42] This is all that we have with respect to the use of the Mark.

[43] As noted by the Opponent, the Applicant has not provided any evidence indicative of the extent to which the Mark has been used or become known in Canada, such as sales figures or advertising expenditures. The Applicant has indicated that he sells the Goods bearing the Mark at his retail store location in Collingwood, Ontario. He has not indicated whether the Goods are sold in any other locations in Canada.

[44] To sum up, I cannot conclude that the Mark has become known in Canada to any extent.

Conclusion regarding this first factor

[45] In view of the foregoing, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent but only to the extent that its footwear is concerned.

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

[46] In view of my comments above, this factor favours the Opponent but only to the extent that its footwear is concerned.

[47] Indeed, while the registrations for the INUKSHUK Trade-mark refer to declarations of use dating back to the years 2001 and 2006, they do not evidence by themselves use of the Opponent's INUKSHUK Trade-mark in association with clothing. The mere existence of a registration can establish no more than "de minimis" use and cannot give rise to an inference of significant or continuing use of the mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

The nature of the goods, services or business; and the nature of the trade

[48] When considering the nature of the goods and the nature of the trade, I must compare the

Applicant's statement of goods with the statement of goods in the registrations referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[49] The Opponent's registrations for the INUKSHUK Trade-mark cover a wide variety of clothing and footwear for men, women and children, including t-shirts and hats. The Applicant's Goods are clearly identical to, or overlapping with the Opponent's clothing goods.

[50] While the Applicant states in his affidavit that the Goods are sold through his retail store, the application for the Mark does not include any restriction on the channels of trade through which the Goods may travel. Neither do the Opponent's registrations for the INUKSHUK Trade-mark.

[51] Absent a restriction in the statement of goods, the Registrar cannot, when considering the issue of confusion, take into consideration the fact that the Applicant may only be selling his Goods in a particular geographic area in Canada or that such goods were only available through a particular type of retail outlet or through a particular channel of trade [see *Henkel Kommanditgesellschaft Auf Aktien v Super Dragon Import Export Inc, supra*].

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

[52] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion".

[53] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece*, above, at paragraph 64].

[54] Applying those principles to the present case, I find there are significant differences between the parties’ marks.

[55] Their only point in common is that they are both made of stylized representations of an inunnguaq. While the inunnguaq design is necessarily the dominant element of each of the Opponent’s design marks, it is not in the case of the Mark. Not only does the phrase “little rocks” dominate the Mark when sounded but visually it appears in bold characters and supersedes the inunnguaq design element, which is faded out.

[56] When the Mark is considered as a whole in the context of the Goods, that is the inunnguaq design element together with the play on words “little rocks”, the Mark conveys the idea of a fanciful representation of a child.

[57] By comparison, the idea conveyed by the Opponent’s INUSKHUK Trade-mark is that of a more conventional or traditional representation of an inunnguaq below an arch shape that the Opponent explains conveys the idea of protection.

#### Additional surrounding circumstances

[58] In his affidavit, the Applicant puts great emphasis on the fact that the Mark was examined and allowed by the examination section of the Trade-marks Office having regard to, among others, the Opponent’s registered trade-marks [see paragraphs 2 and 5 of his affidavit]. The Applicant also points out that the inukshuk symbol is widely used by other entities in Canada and

around the globe [see paragraph 7 of his affidavit and Exhibits “H”, “I”, “J”, “K”, and “L” attached thereto].

[59] I find it is not necessary to consider these additional surrounding circumstances in order to find in the Applicant’s favour.

Conclusion regarding the likelihood of confusion

[60] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar “need not be satisfied beyond doubt that confusion is unlikely. Should the ‘beyond doubt’ standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity.”

[61] Given my analysis above, I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent’s INUKSHUK Trade-mark would be unlikely to conclude that the Applicant’s Goods originate from the same source or are otherwise related to or associated with the Opponent’s registered goods.

[62] I find that the differences existing between the parties’ marks are determinant in themselves and more than sufficient to outweigh the factors favouring the Opponent in this case. As indicated above, neither of the parties’ mark is inherently strong. While the distinctiveness of the Opponent’s INUKSHUK Trade-mark has been reinforced through use and promotion, such reputation has been established with respect to the Opponent’s footwear only. In other words, the Opponent has not established that its INUKSHUK Trade-mark deserves a wide ambit of protection with respect to the clothing goods covered by its registrations, which overlap with the Applicant’s Goods.

[63] Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Ground of opposition based on non-entitlement under section 16(3)(a) of the Act

[64] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act because, as of the date of filing of the application, the

Mark was confusing with the Opponent's INUKSHUK Trade-mark that had been previously used in Canada by the Opponent in association with the Opponent's goods set out in Schedule "A" hereto.

[65] An opponent meets its evidentiary burden with respect to a section 16(3)(a) ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. As per my review above of the Cook affidavit, the Opponent has met its evidentiary burden insofar as its footwear is concerned. It has not with respect to its clothing goods.

[66] The difference in relevant dates does not affect my analysis above under the section 12(1)(d) ground of opposition. In fact, the Opponent's case is weaker under the non-entitlement ground of opposition than it is under the non-registrability ground in that the section 6(5)(c) factor now favours the Applicant in view of the intrinsic differences existing between the Applicant's clothing goods and the Opponent's footwear.

[67] Accordingly, the non-entitlement ground of opposition is dismissed.

Ground of opposition based on non-distinctiveness of the Mark under section 2 of the Act

[68] The Opponent has pleaded that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish, nor is it adapted to distinguish the Goods of the Applicant from those of the Opponent.

[69] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case July 18, 2013) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Cook affidavit, the Opponent has met its evidentiary burden insofar as its footwear is concerned. It has not with respect to its clothing goods.

[70] The difference in relevant dates does not affect my analysis above under the section 12(1)(d) ground of opposition. In fact, the Opponent's case is weaker under the non-

distinctiveness ground of opposition than it is under the non-registrability ground in that the section 6(5)(c) factor now favours the Applicant in view of the intrinsic differences existing between the Applicant's clothing goods and the Opponent's footwear.

[71] Accordingly, the non-distinctiveness ground of opposition is dismissed.

Ground of opposition based on non-compliance of the application under section 30(i) of the Act

[72] The Opponent has pleaded that the application for the Mark does not comply with the provisions of section 30(i) of the Act because, at the date of filing of the application and all times thereafter, the Applicant could not have been satisfied that it was the person entitled to use the Mark in Canada in association with the Goods because the Mark is confusing with the Opponent's INUKSHUK Trade-mark.

[73] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no such evidence in the present case.

[74] Accordingly, the section 30(i) ground of opposition is dismissed.

Ground of opposition based on non-compliance of the application under section 30(e) of the Act

[75] The Opponent has pleaded that the application for the Mark does not comply with the provisions of section 30(e) of the Act because, at the date of filing of the application and all times thereafter, the Applicant did not and does not intend to use the Mark in Canada in association with the Goods.

[76] More particularly, the Opponent submits in its written argument that the Applicant's sworn statements contained in paragraph 10 of his affidavit (reproduced above in paragraph 42 of my decision) unequivocally confirm that he began retailing (selling) the Goods bearing the Mark to customers in Canada in July of 2012, more than two months prior to the filing date of

the application. In other words, the Mark is not a proposed use trade-mark in that the Applicant had used it prior to the date of filing of the present application.

[77] The material date to assess this ground of opposition is the date the application was filed [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)]. Since the facts regarding the Applicant's intentions are particularly within the knowledge of the Applicant, the initial burden on the Opponent under section 30(e) is lighter than usual [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD); *Canadian National Railway Co v. Schwauss, supra*; and *Green Spot Co v JB Food Industries* (1986), 13 CPR (3d) 206 (TMOB)]. The Opponent can meet its initial burden under section 30(e) by reference not only to its own evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, the Opponent may only successfully rely upon the Applicant's evidence to meet its initial burden if the Opponent shows that the Applicant's evidence is clearly inconsistent with the claims set forth in the Applicant's application [see *Molson Canda v Anheuser-Busch Inc, supra*; *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[78] I agree with the Opponent that the Applicant's own evidence is clearly inconsistent and puts into issue the correctness of the Applicant's claim contained in his application that he intended to use the Mark in association with the Goods as of the filing date of the application.

[79] The Applicant expressly states at paragraph 10 of his affidavit that he "began retailing [the Goods] and made them available to the public, bearing the [Mark] in July of 2012", that is more than two months prior to the filing date of the application on October 1<sup>st</sup>, 2012. The invoice dated May 29, 2012 from the tee shirt decal producer attached as Exhibit "P" further supports the Applicant's sworn statement that he has "prepared children's tee shirts bearing the [Mark] and [that he has] been selling them at [his] retail store [...] since July of 2012." While there is no documentary evidence concerning the goods described in the application as children's hats and hoodies, the fact remains that the Affiant does expressly declare that he began retailing the goods listed in the application and made them available to the public in July of 2012.

[80] I find that a parallel can be made between the present case and the one in *Société Nationale Elf Aquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB), in which a



proposed use application was refused by the Registrar in view of the applicant's statement in its counter statement that it had used its trade-mark before the date of the application. [See also *Nabisco Brands Ltd v Cuda Consolidated Inc*, 1997 CanLII 15856 (TMOB), in which a proposed use application was refused by the Registrar in view of the applicant's evidence asserting that it had used its trade-mark before the date of the application.]

[81] In view of the foregoing, I agree with the Opponent that it has met the light evidentiary burden upon it and that the Applicant has failed to satisfy the ultimate burden upon him to establish that his application complied with section 30(e) of the Act as of the filing date of the application.

[82] Accordingly, the section 30(e) ground of opposition succeeds.

#### Disposition




[83] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Schedule "A"

The Opponent's Trade-marks

| Trade-mark  | Reg. No.   | Goods  |
|---|------------|--|
|    | TMA555,198 | <p>Men's, women's and children's clothing and apparel namely coats, sportcoats, parkas, blazers, jackets, ski suits, ski jackets; ski pants, suits, pants, shirts, dresses, sweaters, vests, hats, gloves, scarves, ties, belts, swimsuits, beach coverups, skirts, blouses, blazers, slacks, shawls, jumpers, sunsuits, beachsuits, snowsuits, playsuits, overalls, raincoats, rainjackets, rain suits, wet pants; bath robes, pyjamas, nightgowns, dusters, sleep shirts, dressing-gowns; underwear, negligees, slippers, brassieres; stockings, leggings, socks, pantyhose, knee highs, tights, leotards, body suits; jeans, t-shirts, tank tops, jogging suits, caps, sweat suits, sweat tops, sweat pants, shorts.</p> <p>Declaration of Use filed November 30, 2001.</p>   |
|   | TMA547,579 | <p>Footwear, namely, boots.</p> <p>Declaration of Use filed June 15, 2001.</p>   |
|  | TMA664,253 | <p>Footwear, namely, shoes, athletic shoes, boots, hiking boots, rainboots, work boots, clogs, sandals, slippers; men's, women's and children's clothing and apparel namely coats, sportcoats, parkas, blazers, jackets, ski suits, ski jackets; ski pants, suits, pants, shirts, dresses, sweaters, vests, hats, gloves, scarves, ties, belts, swimsuits, beach coverups, skirts, blouses, blazers, slacks, shawls, jumpers, sunsuits, beachsuits, snowsuits, playsuits, overalls, raincoats, rainjackets, rain suits, wet pants; bath robes, pyjamas, nightgowns, dusters, sleep shirts, dressing-gowns; underwear, negligees, slippers, brassieres; stockings, leggings, socks, pantyhose, knee highs, tights, leotards, body suits; jeans, t-shirts, tank tops, jogging suits, caps, sweat suits, sweat tops, sweat pants, shorts.</p> <p>Declaration of Use filed April 10, 2006.</p> |

No Hearing held

Agents of Record

Cassan MacLean

For the Opponent

No Agent Appointed

For the Applicant