



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

Citation: 2013 TMOB 115
Date of Decision: 2013-06-20

**IN THE MATTER OF AN OPPOSITION
by Nada Fashion Designs Inc. to
application No. 1,487,129 for the trade-
mark NADA in the name of Joanna B.
Ghodsí**

Introduction

[1] This opposition filed on February 18, 2011 relates to an application filed by Joanna B. Ghodsí (the Applicant) on June 30, 2010 to register the trade-mark NADA (the Mark) in association with perfumes and colognes (the Wares).

[2] The grounds of opposition raised by the opponent Asset Inc. (the Opponent) in its statement of opposition appeared in Schedule A annexed to this decision. However those still in issue are: sections 12(1)(d), 16(3)(b) and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13 (the Act) as the Opponent informed the Registrar at the hearing that it was withdrawing the grounds of opposition based on sections 30(i), 16(3)(a) and (c) of the Act.

[3] The first issue to be determined is whether the Registrar was *functus officio* after issuing his letter dated August 30, 2011 informing the Opponent that its opposition ‘will be treated as withdrawn pursuant to Section 38(7.1) of the *Trade-marks Act*. If he was, then this opposition is considered to have been withdrawn.

[4] If it is not the case, then I would have to decide if the Mark was distinctive at the relevant date. The Applicant argues that the relevant date to determine the distinctiveness of the Mark is

the filing date of the application and that in any event the Opponent has not met its initial burden to prove sufficient use of its trade-mark NADA so that it would negate any distinctiveness of the Mark. Thirdly I would have to determine if the Mark is registrable and finally, if the Applicant was entitled to the registration of the Mark.

[5] On the first issue I conclude that the Registrar had the authority to reconsider his decision of August 30, 2011. With respect to distinctiveness, the case law is to the effect that the relevant date is the filing date of the statement of opposition. However as of that date there was not sufficient evidence to enable me to conclude that the Opponent's mark was sufficiently known to negate the distinctiveness of the Mark. On the issue of registrability of the Mark, I conclude in favour of the Applicant and as such the Mark is registrable pursuant to s. 12(1)(d) of the Act. Finally the Applicant is entitled to the registration of the Mark.

Validity of the Registrar's decision of September 22, 2011

[6] On May 5, 2011 the Applicant filed its counterstatement. Consequently the Opponent had until September 6, 2011 to file its evidence under section 41(1) of the *Trade-marks Regulations* (Regulations) as September 5, 2011 was a statutory holiday. On August 30, 2011 the Opponent requested leave for an extension of time to file its evidence. By letter dated August 30, 2011 the Registrar refused the extension of time on the basis that the Opponent had not raised exceptional circumstances nor had the consent of the Applicant. It was in that context that the Registrar indicated to the Opponent that 'the present opposition will be treated as withdrawn....' (my underline).

[7] On September 6, 2011, within the Opponent's deadline to file its evidence, the Opponent requested that the refusal be reconsidered in view of the supplemental facts described in its aforesaid letter. By letter dated September 22, 2011 the Registrar reconsidered his decision of August 30, 2011 and granted the Opponent an extension of time to file its evidence.

[8] I fail to see how the Registrar would have been *functus officio* after his letter of August 30, 2011. Firstly the Registrar stated that the opposition 'will be treated as withdrawn'. The use of the future tense left the door open for the Registrar to reconsider his decision if additional relevant facts were brought to his attention before recording on the register that the opposition

was deemed withdrawn pursuant to the provisions of section 38(7.1) of the Act. Those additional facts were brought to his attention within a week after his letter of August 30, 2011. Moreover the delay for the Opponent to file its evidence or request an extension of time had not yet expired on August 30, 2011. It was still open for the Opponent to file within the prescribed time limit a further request for an extension of time to file its evidence provided that the criteria under section 47(1) of the Act were met. Consequently the Registrar was not *functus officio* on September 22, 2011 when he granted the extension of time requested by the Opponent to file its evidence.

Distinctiveness Ground of Opposition

[9] The Opponent argues that the Mark is not distinctive as it does not and never did actually distinguish nor is it, or was it ever, adapted to distinguish, the Wares from the wares and services of the Opponent and/or the Opponent's predecessor in title.

i) The Relevant date

[10] The first issue raised by the Applicant under this ground is what the relevant date for assessing distinctiveness should be. The Registrar and the Courts have referred in many instances to *Re Andres Wines Ltd et E & J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd et al* (1991), 37 CPR (3d) 41(FCA) to support the proposition that the distinctiveness, or lack thereof, of the mark applied for should be determined at the filing date of the statement of opposition. I am bound by the decisions of the Federal Court of Appeal and I shall assess this ground as of that date, namely February 18, 2011. However in view of the representations made by the Applicant, I would like to make some comments as it will appear from a review of the evidence, that the relevant date could have had a serious impact on the outcome of this ground of opposition.

[11] Firstly, in *Andres Wines* the Federal Court of Appeal determined that the relevant date associated with the ground of distinctiveness was the filing date of the statement of opposition without making an in-depth analysis of this issue. In fact the Court mentioned that the results would have been the same if it used the filing date of the application. In our case the results would not be the same as any evidence of use of the Opponent's trade-mark NADA in association with perfumes occurred after the filing date of the present application.

[12] As for *Park Avenue*, even though reference was made to *Andres Wines*, the Federal Court of Appeal had to determine the relevant date associated to the ground of registrability under section 12(1)(d) of the Act.

[13] We can find a good review of the case law on this issue in *Big Apple Ltd v Bab Holdings Inc* (2002), 16 CPR (4th) 427 (FCTD). In that case the opponent suggested another possible relevant date: the date of the Registrar's decision, to be in line with the principle enunciated in *Park Avenue* that if the relevant date is not mentioned in the Act it should be the date of the Registrar's decision.

[14] The Applicant argues that this ground of opposition should be determined as of the filing date of the application as the scheme of the Act is to crystallize the applicant's rights as of the filing date of its application unless the applicant relies on an earlier date of first use or an earlier priority date. There are obviously some uncertainties for an applicant if the relevant date is a date subsequent to the filing date of its application. As in the case before me, an opponent may rely on its subsequent use of an identical trade-mark to negate the distinctiveness of the mark applied for. If the relevant date had been the filing date of the application, such subsequent use would have no effect on the distinctiveness of the trade-mark applied for.

[15] While I am sympathetic to the Applicant's position, I am bound by the Federal Court of Appeal judgments on this issue until such time as it is revisited by the Courts.

ii) The Opponent's initial onus

[16] As for any grounds of opposition, there is an initial evidential burden on the opponent to file sufficient admissible evidence from which it could reasonably be concluded that there exist sufficient facts to support each ground of opposition pleaded. If those facts exist, then the applicant must show that the application complies with the provisions of the Act and the grounds of opposition raised by the opponent should not prevent the registration of the trade-mark applied for [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].

[17] Therefore the Opponent has the initial evidential burden to prove that its trade-mark NADA had become sufficiently known in Canada on February 18, 2011 to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD) and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. Once this initial burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely creating confusion with the Opponent's trade-mark NADA at the relevant date such that it was adapted to distinguish or actually did distinguish throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[18] The Opponent's evidence consists of the affidavit of Nada Shepherd. She is the founder and the Opponent's President. She alleges that the Opponent ceased in the summer 2011 doing business from a physical retail store located in Toronto. Ms. Shepherd states that while the retail store was opened, the trade-mark NADA appeared on the interior and exterior signage of the physical retail store and she filed as exhibit B pictures of those signs. However we have no evidence of the promotion and advertising of such store prior to February 18, 2011. No sales figures have been provided to measure the business activities of the Opponent, prior to the relevant date, in association with that retail store.

[19] Ms. Shepherd affirms that in November 2010 the Opponent began offering perfume for sale in Canada in the normal course of trade in association with the trade-mark NADA. To support such allegation she filed pictures of the bottle bearing the trade-mark NADA as the letters N-A-D-A appears sequentially on each of the lateral faces of the cube shaped bottle. She states that the perfume is promoted by the Opponent on its website and she filed the relevant webpage. She also filed 3 sales receipts evidencing the sale of perfume in association with the trade-mark NADA: two in December 2010 totaling approximately \$335 and one dated in April 2011, subsequent to the relevant date.

[20] Ms. Shepherd filed copies of articles that were published on websites. I will only refer to those that were allegedly published prior to the relevant date, namely the article dated November 25, 2010 on the website FLAIR.com, the article dated November 29, 2010 published on the website www.stylebistro.com and finally the one published on the website

www.alamodecanada.com on December 10, 2010. I note that no information has been provided on the number of Canadians who would have visited these websites prior to the relevant date and read these articles. Also we have no information on the period of time the articles were made available to Canadian consumers on these websites.

[21] We have no details on the volume of sales made by the Opponent in Canada between December 2010 and February 18, 2011, except for the two sales mentioned earlier.

[22] I conclude that this evidence falls short of establishing that the Opponent's trade-mark NADA used in association with perfumes was sufficiently known in Canada to negate any distinctiveness of the Mark at the relevant date. Consequently the Opponent has failed to meet its initial burden and the ground of opposition based on lack of distinctiveness of the Mark is dismissed.

Registrability under Section 12(1)(d) of the Act

[23] The Opponent argues that the Mark is confusing with its following registered trade-marks:

NADA, certificate of registration TMA 565,840
NADA NUFF, certificate of registration TMA 478,859

[24] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue, supra*].

[25] The Opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Certified copies of these registrations have been filed. I exercised my discretion and checked the register and note that these registrations remain extant. Consequently the Opponent has met its initial burden of proof.

[26] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks 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)].

[27] Mr. Justice Binnie of the Supreme Court of Canada commented on the assessment of these criteria [see *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]. The most important factor is the degree of resemblance. Also I must compare the Mark with each of the Opponent's registered trade-marks [see *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

i) NADA

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

[28] The word 'nada' is defined in the *Canadian Oxford Dictionary* as: informal nothing. The Opponent argues that its trade-mark is inherently distinctive as it is meaningless when used in association with the wares covered by its registration namely: jewellery namely chains, charms, bracelets, earrings, rings, cufflinks, pins and pendants made of 10K, 14K and 18K gold, sterling silver. However the same is true with respect to the Mark when used in association with the Wares.

[29] The Applicant argues that the Opponent's trade-mark is a weak trade-mark as it represents the first name of the Opponent's President. I have no evidence that the average Canadian consumer would associate the word 'nada' to a female first name. In any event if I

were to conclude that the trade-mark NADA is a weak trade-mark such conclusion would equally apply to the Mark as it is identical to the Opponent's trade-mark.

[30] A trade-mark may acquire distinctiveness through use or promotion in Canada. However in the present case there is no evidence of use or promotion in Canada of the Opponent's registered trade-mark in association with any of the wares listed in its certificate of registration. As for the use of the Mark, there is no evidence in the record. While it is true that the Opponent's registration claims use in Canada since May 1, 1999, at most this entitles me to assume *de minimis* use of the Opponent's NADA trade-mark [see *Entre Computer Centers Inc. v. Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the Opponent's trade-mark NADA had become known to any significant extent. This factor does not favour any of the parties.

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

[31] 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]. As discussed further above in the analysis of the section 6(5)(a) factor, the Opponent's registration only enables me to assume *de minimis* use of the Opponent's trade-mark NADA. While it may be true that *de minimis* use is more than no use, in the absence of evidence of use of either party's marks, this factor does not significantly favour either party.

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

[32] Since the marks in issue are identical, this factor will have a significant impact on my decision. I must compare the Wares (perfumes) to the wares covered by the Opponent's registration (jewellery). In *Omnium de la Parfumerie de Luxe v First Jewellery Co of Canada* (1992), 41 CPR (3d) 444 (TMOB), Mr. Partington concluded that jewellery and perfumes differ. I see no reason why I would conclude differently in this case. There is no evidence in the record that would prove that there exists a connection between jewellery and perfumes.

[33] I have evidence in the record that the Opponent sells its jewellery through the Internet. I have no evidence of the Applicant's channels of trade.

Additional surrounding circumstances

[34] The Opponent has submitted state of the register evidence. Such evidence is part of Ms. Shepherd's affidavit. Ms. Shepherd attaches to her affidavit the results of a search of the Canadian Intellectual Property Office online trade-marks database for the word 'NADA' in the search field 'TM Lookup'. The Applicant submits that this portion of the evidence is inadmissible as Ms. Shepherd did not describe her searcher qualifications, if any, and furthermore the particulars of the citations have not been provided.

[35] In *Quebec Maple Products Inc. v Stafford Foods Ltd* (1988), 20 CPR (3d) 404 (TMOB) the Registrar concluded that although such a method of proof is acceptable, the summary of the results of the particular search conducted must be given less weight because it provides incomplete particulars of the registrations and applications located. For example in the present case some entries are stated to be design marks without illustrating them, and all citations do not contain the list of wares or services associated with the trade-mark. I do not consider this evidence to be an important factor in this decision because of the little probative value given to it.

Conclusion

[36] Despite the fact that the marks in issue are identical, there is no evidence that the Opponent's trade-mark NADA has become highly distinctive. There is no evidence of actual use of the Opponent's trade-mark in association with the wares covered by its registration. Finally and more importantly, the parties' wares differ and in the absence of evidence to the contrary I must assume that their channels of trade would also differ.

[37] In all, I am satisfied that the Applicant has met its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trade-mark NADA, certificate of registration TMA565,840 when it is used in association with the Wares.

ii) NADA NUFF

[38] The trade-mark NADA NUFF is more inherently distinctive than the Mark with the addition of the coined word NUFF. The certificate of registration TMA478,859 makes reference to the use of the trade-mark NADA NUFF since June 19, 1997 in association with a line of women's clothing/apparel namely, jeans, shirts, skirts, jackets, pants, vests, shorts, sweaters, sweat shirts, t-shirts, tank tops and hats. However there has been no evidence of such use in the record.

[39] As for the potential relationship that may exist between clothing and perfumes I adopt the following comments made by Mr. David Martin in *St. Lawrence Textiles Ltd v Leo Chevalier International Ltd* (1985), 7 CPR (3d)511 (TMOB):

Although, in general, it can be said that "... cosmetics and clothing are both part of the fashion industry ..." (see *Esprit de Corp. v. S.C. Johnson & Son Inc.* (1984), 3 C.P.R. (3d) 451 at 456 (T.M. Opp. Bd.)); this observation does not apply in respect of all clothing items. It is clearly applicable in situations such as the *Esprit de Corp.* case where the opponent's wares were "high fashion women's wear" and would undoubtedly have been applicable in the present case if the opponent could have shown more than de minimis use of its mark CHEVALIER for certain of the specific wares listed in its registration.

[40] Despite the fact that the Mark resembles the Opponent's registered trade-mark NADA NUFF as it is identical to the first component of the Opponent's trade-mark, I conclude in favour of the Applicant for reasons similar to those described in my assessment of the registrability of the Mark, considering the Opponent's registered trade-mark NADA. The Applicant has met its burden to prove that the Mark is not likely to cause confusion with the Opponent's registered trade-mark NADA NUFF.

[41] Consequently the registrability ground of opposition is also dismissed.

Entitlement under Section 16(3)(b) of the Act

[42] The ground of opposition as pleaded only refers to the Opponent's registered trade-marks NADA (TMA565,840) and NADA NUFF (TMA478,859). The applications that correspond to

those registrations were no longer pending at the advertisement date of the present application [see section 16(4) of the Act]. Therefore this ground of opposition is dismissed.

[43] I am fully aware of the fact that, in the introductory paragraphs of its statement of opposition, the Opponent made reference to application 1,363,611. No reference is made to such application in paragraph 1(vii)(b) of the statement of opposition which forms the basis of this ground of opposition. In its written argument the Opponent argues under its s. 16(3)(b) ground of opposition that the Applicant is not entitled to the registration of the Mark in view of this previously filed application. Should I be wrong in my strict interpretation of paragraph 1(vii)(b) of the statement of opposition, I would still have dismissed the ground of opposition for the following reasons.

[44] The Opponent filed a certified copy of application 1,363,611 and therefore it would have met its initial onus had this application be specifically mentioned in paragraph 1(vii)(b) of the statement of opposition. I have exercised my discretion to check the register and confirm that this application remained pending at the advertisement of the application for the registration of the Mark. Application No. 1,363,611 covers:

- (1) Clothing, namely casual clothing, athletic clothing, dress clothing, blazers, coats, fur coats, jackets, raincoats, rain jackets, capes, capelets, overcoats, pants, shorts, skirts, skorts, shirts, blouses, tops, t-shirts, polos, tank tops, sweaters, turtlenecks, vests, hats, jumpsuits, overalls, dresses, evening gowns, gloves, belts, shoes, sandals, hats.
- (2) Boots, sport shoes, hand bags, purses, luggage, wallets, change purses, knapsacks, jewellery, scarves, hair accessories, socks, stockings, hosiery, ties.

and the following services:

- (1) Fashion design services, manufacturing of clothing, display of clothing as part of trade-exhibitions and fashion shows, operation and organization of fashion shows.
- (2) Operation of an internet website and online retail store both in the field of fashion.

[45] My analysis of the relevant circumstances done under the registrability ground of opposition would be equally applicable in so far as the Opponent's wares listed in this pending

application are concerned because they are similar to those covered by the Opponent's registrations.

[46] As for the Opponent's services, the application is based on proposed use. The relevant date is the filing date of the present application, namely June 30, 2010. There is no evidence of use of the Opponent's trade-mark NADA in association with its services prior to the relevant date. Finally as for the nature of the Opponent's services compared to the Wares I do not see why I would conclude differently than what I already stated under the ground of registrability. The same would apply to the parties' channels of trade.

Disposition

[47] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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

Schedule A

The relevant portions of the Opponent's statement of opposition read as follow:

1.

- (i) The opponent is the owner of the following two trade-mark registrations (and their associated goodwill), both of which are in good standing:

[NADA, registration TMA565,840 for jewellery

NADA NUFF, registration TMA478,859 for line of women's clothing.]

(....)

- (ii) The opponent is also the owner of a pending trade-mark application for NADA, application No. 1,363,611, with a date of first use of March 2002 and a filing date of September 10, 2007...

(...)

- (v) The opponent bases its opposition on the grounds set forth in section 38(2)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereinafter 'the Act') in that the Application does not conform to the requirements of section 30 of the Act. In particular, the Application does not conform to the requirements of section 30(i) of the Act in that the applicant could not have been satisfied that she was entitled to use its trade-mark in Canada in association with the wares described in the application because of the existence of the Opponent's registered trade-marks, unregistered trade-mark, and trade-names, the particulars of which are set out in paragraphs 1(i), 1(ii), and 1(iii) respectively of this Statement of Opposition.

- (vi) The opponent bases its opposition on the grounds set forth in section 38(2)(b) of the Act in that the Applicant's trade-mark is not registrable under section 12(1)(d) of the Act because it is, and was at all relevant times, confusing with the opponent's reregistered trade-marks, the particulars of which are set out in paragraph 1(i) of this Statement of Opposition.

- (vii) The opponent bases its opposition on the grounds set forth in section 38(2)(c) of the Act in that the applicant is not the person entitled to the registration of the trade-mark as set out in the Application. In particular:

- a) Contrary to section 16(3)(a) of the Act, at the date of filing of the Application, and at all material times, it was confusing with the Opponent's registered trade-marks, the particulars of which are set out in paragraph 1(i) of this Statement of Opposition, and the opponent's unregistered trade-mark, the particulars of which are set out in paragraph 1(ii) of this Statement of Opposition, all of which had been previously used and made known in Canada by the opponent and the opponent's predecessor in title;
- b) Contrary to section 16(3)(b) of the Act, at the date of filing of the Application, and at all material times, the trade-mark was confusing with the opponent's registered trade-marks, the particulars of which are set

out in paragraph 1(i) of this Statement of Opposition, whose applications for registration had been previously filed in Canada by the opponent's predecessor in title;

- c) Contrary to section 16(3)(c) of the Act, at the date of filing of the Application, and at all material times, the trade-mark was confusing with the opponent's trade-names, Nada Fashion Designs Inc. and NADA which had been previously used in Canada by the opponent or the opponent's predecessor in title.

(viii) The opponent bases its opposition on the grounds set forth in section 38(2)(d) of the Act in that the applicant's trade-mark is not , and never was distinctive of the applicant; contrary to section 2 of the Act, it does not, and never did, actually distinguish, nor is it, or was it ever, adapted to distinguish, the wares of the applicant from the wares and services of others, including the wares and services of the opponent and/or the opponent's predecessor(s) in title in association with which the opponent's trade-marks as set out in paragraphs 1(i) and 1(ii) of this Statement of Opposition are and were used.