IN THE MATTER OF AN OPPOSITION by Rebel Slacks Co. Ltd. to application No. 765,508 for the trade-mark REBELSTOKE filed by Max McConnell, and presently standing in the name of Rebelstoke Inc.

On October 4, 1994, the applicant, Max McConnell, filed an application to register the trade-mark REBELSTOKE based upon use of the trade-mark in Canada since February 1, 1994 in association with "*Casual clothing for men and women, namely, leather jackets, shirts, pants, jeans, socks and sweaters*".

The applicant's trade-mark was advertised for opposition purposes in the ***Trade-marks Journal*** of May 31, 1995 and the opponent, Rebel Slacks Co. Ltd., filed a statement of opposition on July 20, 1995, a copy of which was forwarded to the applicant on September 22, 1995. The applicant served and filed a counter statement in response to the statement of opposition on October 11, 1995. The opponent submitted as its evidence the affidavit of David Schnapp while the applicant submitted as its evidence the affidavit of Max McConnell. Max McConnell was cross-examined on his affidavit, the transcript of the cross-examination and the responses to undertakings given during the cross-examination, forming part of the opposition record. Further, during the opposition proceeding, the applicant assigned the trade-mark REBELSTOKE to Rebelstoke Inc., the current applicant of record. Both parties submitted written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Subsection 30(b) of the ***Trade-marks Act***, the opponent alleging that the present application does not contain the correct date from which the applicant or its predecessor(s)-in-title, if any, have used the trade-mark REBELSTOKE in Canada in association with each of the general class of wares described in the application. Further, the opponent alleged that if the trade-mark REBELSTOKE has been used in Canada, it has not been continuously used in Canada since the claimed date of first use in association with each of the general classes of wares described in the application. As its second ground, the opponent asserted that the applicant could not be satisfied as to its entitlement to use the trade-mark REBELSTOKE in Canada in association with the wares covered in its application since, at the date of filing the

present application, the applicant was well aware of the opponent's trade-mark and trade-name described in the statement of opposition and of the opponent's continued use thereof.

With respect to the first two grounds, the legal burden is on the applicant to show that its application complies with Section 30 of the ***Act***. This includes both the question as to whether or not the present application formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. However, to the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an initial evidential burden on the opponent to prove those allegations [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see ***John Labatt Limited v. The Molson Companies Limited***, 30 C.P.R. (3d) 293, at p.298]. Also, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the ***Act*** is the filing date of the present application [see ***Georgia-Pacific Corp. v. Scott Paper Ltd.***, 3 C.P.R.(3d) 469, at p.475].

Considering initially the Subsection 30(b) ground, there is, as noted above, an initial evidential burden on the opponent to establish the facts relied upon by it in support of this ground. In this regard, the evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b) of the ***Act*** is a light one [see ***Tune Masters v. Mr. P's Mastertune***, 10 C.P.R.(3d) 84, at p.89]. Furthermore, Subsection 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed [see ***Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership***, 67 C.P.R.(3d) 258, at p.262 (F.C.T.D.)]. Also, with respect to the issue of use of a trade-mark from a claimed date of first use in respect of the specific wares identified in a general class of wares, I would note the following comments in ***Parfums Christian Dior v. Lander Company Canada Limited***, (trade-mark FASCINATION, application No. 799,920, dated March 3, 2000, yet unreported):

> " ... I agree with the applicant that all of the wares identified in a general class

> of wares need not have been used in Canada since the date of first use claimed for that general class. However, since the applicant has claimed that its mark has been used in association with the general class of wares, the trade-mark FASCINATION must have been used in association with each of the specific wares identified in the general class prior to the applicant's filing date although the date(s) when such use commenced with respect to each of the specific wares in the general class may vary [see in this regard, ***McCarthy Tétrault v. Hilary's Distribution Ltd.***, 67 C.P.R. (3d) 279, at p.284]. Moreover, as noted above, such use of the trade-mark FASCINATION in association with each of the specific wares in the general class must also have been continuous 'use' in the normal course of trade."

Apart from the above, the opponent's evidential burden can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard***, Labatt Brewing Company Limited v. Molson Breweries, a Partnership***, 68 C.P.R.(3d) 216, at p.230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application. In the present opposition, the opponent's evidence does not address its Subsection 30(b) ground. However, the opponent has submitted that the applicant's evidence and the transcript of the McConnell cross-examination, as well as the responses to undertakings furnished by the applicant, are sufficient to meet its evidential burden.

At page 13 of the transcript of his cross-examination, the following questions were put to Mr. McConnell, Director of Rebelstoke Inc., and the following responses were received:

> Q. Has your company to date sold any socks in association with the Rebelstoke trademark?
>
> A. No.
>
> Q. Sweaters?
>
> A. No.
>
> Q. Jeans?
>
> A. No.
>
> Q. Pants?
>
> A. No.
>
> Q. Would I then be correct in stating that, as of this date, your company has only sold jackets and vests?
>
> A. Yes, and bags.

Also, at pages 33 and 34 of the transcript, the following questions were asked and responses received from Mr. McConnell:

> Q. Have you any explanation to offer why two years have gone and, to date, you have apparently not used the market [sic] association with socks or sweaters or pants or, in fact, any of the other wares, other than jackets?
>
> A. Our leather products were selling well and we were asked by customers to go into other leather products like bags and, eventually, boots, so that I didn't have enough capital to make those other wares.
>
> Q. Would you have an explanation to offer as to why your application states that you have used the trademark Rebelstoke in association with pants and sweaters and socks since February 1, 1994 when, in fact, that is not so?
>
> A. It says "wares including leather jackets", and those other items, and we have used it for leather jackets.
>
> Q. But I am asking you in particular: Why would your application have specified that you have used it, let us take, for example, in association with socks and sweaters?
>
> A. Because we were intending on using it for those in the future.

Having regard to the foregoing, I find that the applicant has not used its trade-mark REBELSTOKE in association with any of the wares covered in the present application with the exception of "leather jackets". Since the applicant has claimed that its mark has been used in association with the general class of wares, the trade-mark REBELSTOKE must have been continuously used in the normal course of trade in association with each of the specific wares identified in the general class prior to the applicant's filing date although the date(s) when such use commenced with respect to each of the specific wares may vary [see ***Parfums Christian Dior v. Lander Company Canada Limited***, referred to above]. As a result, the present application does not comply with Subsection 30(b) of the ***Trade-marks Act*** in relation to the wares identified in the present application as: " shirts, pants, jeans, socks and sweaters".

With respect to the applicant's "leather jackets", the opponent has asserted that the applicant has not used its trade-mark REBELSTOKE in association with these wares since the claimed date of first use of February 1, 1994. In this regard, the opponent has relied upon the following excerpt from the transcript of Mr. McConnell's cross-examination beginning at page 9, line 11:

Q. Now, what took place on February 1, 1994?

A. I started selling to buyers with sample jackets and with some literature that's part of this affidavit.

Q. When you say you started selling to buyers, do you mean you started to offer for sale, or did you actually sell on that date?

Q. I can't recall the actual date. It was around February 1st that I started selling, and whether I had a meeting on February 1st, I'm not actually sure, but that was the month that I started seeing buyers.

Q. And you refer to samples; who made those samples?

A. A contractor.

Q. Would you have any documentation in your records to enable us to determine when those samples, the first sample or samples, were made?

A. The samples, I'm not sure if I still have that. I could possibly see if my contractor has a copy of that.

Q. Would you please, through your attorney, as Undertaking No. 1, attempt to furnish us with any documentation that might exist relating to the manufacture of your first merchandise that you say was sold or offered for sale in association with Rebelstoke.

Me SILVANA CONTE:

Yes.

The applicant's response to this undertaking appears to be photocopies of two invoices, one for "3 Samples" to RENEGADE dated May 20, 1994 from an entity which appears in handwriting as 'Creation Fondas' and a second invoice from Horween Leather Company located in Chicago, Illinois to 'RENEGADE' and dated "05/06/94". No explanation has been furnished by the applicant by way of further evidence in this opposition as to the entity identified as RENEGADE in the two

invoices. However, even if RENEGADE is a trading style for the original applicant, Max McConnell, the invoices are dated May 20, 1994 and either May 6 or June 5, 1994, both more than three months subsequent to the claimed date of first use. Moreover, the applicant has not provided any explanation which might point to the samples covered by either of the invoices as having been delivered to the applicant prior to February of 1994. Further, I would note the following excerpt from the McConnell cross-examination beginning at page 11, line 21:

> Q. Would you please produce, through your attorney, copies of any invoices of merchandise that you sold during February to June of 1994, of merchandise in association with the Rebelstoke trademark.
>
> A. Sales for the fall are done in February. So our delivery into the stores was not until August, which means our invoices would be dated August. So, no, I can't.
>
> Q. What you're saying is, then, you would not have any invoices prior to August of 1994?
>
> A. Correct.
>
> Q. Would you then, as your second undertaking, through your attorney, furnish us with two or three invoices reflecting your very first sales of merchandise in association with Rebelstoke"
>
> A. Yes.

The response to the second undertaking comprises photocopies of four documents identified as being Purchase Orders dated between May 26, 1994 and June 9, 1994 and a photocopy of a fifth document dated May 31, 1994 in which the words Purchase Order are replaced by the handwritten words 'Packing Slip'. All five documents appear to relate to jackets and include reference to RENEGADE without any explanation provided by the applicant as to the identity of RENEGADE.

In view of the foregoing, I find that the opponent has met its evidential burden in relation to the first ground as applied to "leather jackets". Furthermore, the applicant has not met the legal burden upon it of showing that it has used its trade-mark REBELSTOKE in Canada in association with "leather jackets" since February 1, 1994. As a result, the Subsection 30(b) ground is also successful in relation to the applicant's "leather jackets".

The opponent has also alleged that the present application does not comply with Subsection 30(i) of the ***Trade-marks Act*** in that the applicant could not have stated that it was satisfied that it was entitled to use the trade-mark REBELSTOKE in Canada as the applicant was well aware of the opponent's trade-mark and trade-name and of the opponent's continued use thereof. However, no evidence has been furnished by the opponent to show that the applicant was well aware of the opponent's trade-mark and trade-name as of the filing date of the present application or that the applicant considered its trade-mark to be confusing with the opponent's trade-mark or trade-name. I have therefore dismissed this ground of opposition.

As its third ground, the opponent alleged that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the ***Trade-marks Act*** in that the trade-mark REBELSTOKE is confusing with the opponent's registered trade-mark REBEL, registration No. 274,255, covering "Jeans. Skirts. Slacks, pants, overalls, including coveralls. Men's, ladies' and children's clothing wares namely jackets, shirts, shorts, coats, sweaters, tops and dresses", as well as the "Operation of a business dealing in the distribution and sale of clothing wares". In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the ***Trade-marks Act***. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date. With respect to the ground of opposition based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the material date is the date of my decision [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the applicant's trade-mark REBELSTOKE as applied to "Casual clothing for men and women, namely, leather jackets, shirts, pants, jeans, socks and sweaters" appears to be a coined word and, as such, is inherently distinctive. Likewise, the opponent's trade-mark as applied to the wares and services covered in registration No. 274,255 is inherently distinctive in that the mark REBEL is neither descriptive nor suggestive as applied to clothing, nor does it appear to possess any other

significance which would detract from its inherent distinctiveness.

With respect to the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] and the length of time the marks have been in use [Para. 6(5)(b)], the Schnapp affidavit establishes that the opponent has used its trade-mark REBEL in association with clothing since 1971 and that its mark has become known in Canada in association with men's, ladies' and children's clothing with sales throughout Canada since 1987 exceeding $7,000,000 annually. On the other hand, the McConnell affidavit arguably points to the applicant having commenced use of its trade-mark REBELSTOKE in Canada some time subsequent to its claimed date of first use although the exact date is not clearly established by the applicant's evidence. Furthermore, the McConnell affidavit fails to provide any evidence as to the volume or dollar value of the applicant's sales of its leather jackets in association with its trade-mark. Thus, the trade-mark REBELSTOKE has become known to only a minor extent in Canada in association with leather jackets. As a result, both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use weigh in the opponent's favour.

As for the nature of the wares and services of the parties [Para. 6(5)(c)] and the nature of the trade associated with the trade-marks at issue [Para. 6(5)(d)], it is the wares and services covered in the present application and in the opponent's registration which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground since these statements of wares and services determine the scope of the monopoly being claimed by the parties in relation to their marks [see ***Mr. Submarine Ltd. v. Amandista Investments Ltd.***, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); ***Henkel Kommanditgesellschaft v. Super Dragon***, 12 C.P.R.(3d) 110, at p.112 (F.C.A.); and ***Miss Universe, Inc. v. Dale Bohna***, 58 C.P.R.(3d) 381, at pp.390-392 (F.C.A.)]. 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. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in an application or registration [see, in this regard, ***McDonald's Corporation v. Coffee Hut Stores Ltd.***, 68 C.P.R.(3d) 168, at p.169 (F.C.A.)]. In the present opposition, there is no ambiguity as to the wares and services covered in the present

application and the opponent's registration. Further, and considering that the monopoly accorded a trade-mark registration covers all of Canada, the fact that the applicant currently sells its wares to retail outlets which differ from the retail outlets where the opponent's REBEL clothing is sold is of limited relevance to the determination of the Paragraph 12(1)(d) ground.

The present application covers "Casual clothing for men and women, namely, leather jackets, shirts, pants, jeans, socks and sweaters" which overlaps the opponent's "Jeans. Skirts. Slacks, pants, overalls, including coveralls. Men's, ladies' and children's clothing wares namely jackets, shirts, shorts, coats, sweaters, tops and dresses" covered in registration No. 274,255. As well, the applicant's wares are closely related to the opponent's "Operation of a business dealing in the distribution and sale of clothing wares". In view of the overlap in the wares of the parties, I would expect that there could be a potential overlap in the respective channels of trade of the parties.

With respect to the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the applicant's trade-mark REBELSTOKE and the opponent's registered trade-mark REBEL bear some similarity in appearance and in sounding although the marks do not suggest any readily apparent ideas in common.

The applicant submitted that the absence of evidence of instances of actual confusion between the trade-marks at issue is a relevant surrounding circumstance in assessing the issue of confusion in this opposition. However, in view of the limited use by the applicant of its trade-mark REBELSTOKE in Canada to date, I consider this issue to be of little relevance to the determination of the likelihood of confusion between the trade-marks at issue.

In view of the fact that there is some similarity in appearance and in the sounding of the trade-marks REBELSTOKE and REBEL as applied to overlapping wares which could travel through the same channels of trade, and bearing in mind that the opponent has shown that its trade-mark REBEL has become known in Canada, I am of the view that the the average consumer might well conclude that the applicant's REBELSTOKE as applied to leather jackets is a new line of the opponent's REBEL clothing. Thus, I find that the applicant has failed to meet the legal burden upon

it in respect of the issue of confusion. As a result, the applicant's trade-mark REBELSTOKE is not registrable in view of Paragraph 12(1)(d) of the ***Trade-marks Act***.

Having regard to the foregoing, I find that the applicant has also failed to meet the legal burden on it of showing that there would be no reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's claimed date of first use or the date of opposition, the material dates for considering the non-entitlement and non-distinctiveness grounds of opposition. Thus, these grounds of opposition are also successful.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the ***Trade-marks Act***, I refuse the applicant's application pursuant to Subsection 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MARCH, 2000.

G.W. Partington
Chairperson
Trade-marks Opposition Board.