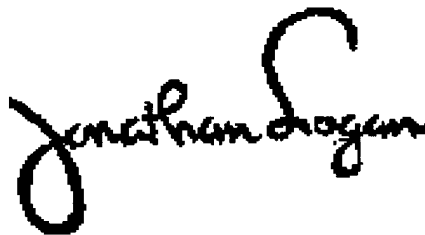


**IN THE MATTER OF AN OPPOSITION
by JCorp Inc. to application
no. 1105486 for the trade-mark
JONATHAN LOGAN Design
filed by One Step Up Ltd.
(successor in title to Delan Enterprises, Inc.)**

On June 6, 2001, Delan Enterprises, Inc. filed an application to register the trade-mark JONATHAN LOGAN Design, shown below, based on (1) proposed use of the mark in Canada in association with women's dresses, pant suits; jumpers; ladies' sportswear; ladies' shorts; shorts; skirts; blouses; coats; watches and jewelry, (2) use and registration (no. 0549924) of the same mark in the United States in association with women's dresses, (3) use and registration (no. 0937651) of the same mark in the United States in association with women's dresses, pant suits, pants, shorts, culottes, blouses, jackets, vests and coats. The applicant also claims the benefit of a convention priority date, pursuant to Section 34 of the *Trade-marks Act*, based on the filing of a corresponding application in the USA, no. 76/204572, on February 5, 2001.

A handwritten signature in black ink that reads "Jonathan Logan". The signature is written in a cursive, flowing style with a large, prominent 'J' at the beginning and a decorative flourish at the end.

The Examination Section of the Trade-marks Office raised a number of objections to the application which the applicant successfully overcame. The applicant was also required to file certified copies of USA trade-mark registration nos. 0549924 and 0937651, which the applicant

provided to the Office on June 9, 2003.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 27, 2003 and was opposed by JCorp Inc. on October 24, 2003. A copy of the statement of opposition was forwarded by the Registrar to the applicant on November 4, 2003. The applicant responded by filing and serving a counter statement. Only the opponent submitted evidence namely, the affidavit of Marc Serero, Chief Financial Officer of the opponent company. Neither party filed a written argument, however, both parties were represented at an oral hearing. During the course of this proceeding, the subject application was assigned from the original applicant Delan Enterprises, Inc. to One Step Up Ltd.

STATEMENT OF OPPOSITION

The statement of opposition may be summarised as follows.

- (A) The application is not in compliance with Section 30(b) of the *Trade-marks Act* because the applicant used the applied for mark before the filing date of the application (that is, before the priority filing date February 5, 2001).
- (B) The application is not in compliance with Section 30(d) of the *Trade-marks Act* because the applicant had not used and registered the applied for mark in the USA in association with women's dresses, pant suits, pants, shorts, culottes, blouses, jackets, vests and coats before the filing date of the application (that is, before the priority filing date February 5, 2001).
- (C) The application is not in compliance with Section 30(e) of the *Act* because the applicant did not intend to use the applied for mark in Canada in association with women's dresses, pant suits; jumpers; ladies' sportswear; ladies' shorts; shorts; skirts; blouses; coats; watches and jewelry as of the filing date of the application (that is, as of the priority filing date February 5, 2001).
- (D) The applied for mark is not registrable, pursuant to Section 12(1)(d), because it is

confusing with the opponent's registered marks JONATHAN G Design, regn. no. 285114, covering the wares jeans and JONATHAN G Design, regn. no. 451591 covering the wares sunglasses, watches, jewellery, belts, handbags, luggage, hats, clothing namely; jeans sweaters, underwear, socks, outerwear namely; coats, capes, ponchos, jackets, anoraks, raincoats, pants, blouses, dresses, t-shirts, sweatshirts, sweatpants, sneakers, blazers, skirts, shorts, footwear namely; casual canvas shoes, slippers, sandals.



regn. no. 285114



regn. no. 451591

(E) The applicant is not entitled to register the applied for mark because, pursuant to Sections 16(2)(a) and 16(3)(a), at the priority filing date the applied for mark was confusing with the opponent's above mentioned marks previously used in Canada.

(F) (see below)

(G) The applied for mark is not distinctive of the applicant's wares.

Ground (F) of the statement of opposition is based on Sections 16(2)(b) and 16(3)(b) of the *Act*. However, the pleadings contain egregious errors which were discussed by the applicant in its counter statement. As the opponent did not amend its pleadings, I find that ground (F) does not raise a valid ground of opposition.

The opponent's two marks namely, regn. nos. 285114 and 451591, are so similar that one may be considered to be a variation of the other. Hence, I will sometimes simply refer to the marks in the singular as JONATHAN G.

OPPONENT'S EVIDENCE

Mr. Serero's evidence may be summarized as follows. The opponent is a family-run

business which began operating in 1959 as a wholesaler and importer of socks and underwear. At present, the opponent designs a wide range of clothing for men, women, boys and girls under various brand names. The clothes are manufactured for the opponent and then sold on a wholesale basis to retailers across North America. Mr. Serero testifies that the JONATHAN G brand was created in the late 1970's, however, I note that the exhibit material attached to Mr. Serero's affidavit indicates that regn. no. 285114 was first used in 1983 while regn. no. 451591 was first used in 1995. It may simply be that the JONATHAN G brand was used since the 1970's but not on wares covered in the opponent's registrations.

Since 1994 the opponent has sold about \$135 million worth of clothing under its brand JONATHAN G. The opponent has sold JONATHAN G clothing to many national retailers including Eaton's, K-Mart, The Bay, Giant Tiger and Zellers. The opponent's mark JONATHAN G (in script form or in block letter form) has appeared prominently on hangtags attached to items of clothing, on stationery employed by the opponent and in various forms of print advertising. The JONATHAN G label has been recognized as one of the leading "made-in-Canada" brands since 1997. The opponent has registered various domain names incorporating the component "jonathan-g" and has utilized its website to advertise the JONATHAN G brand of clothing.

OPPONENT'S EVIDENTIAL BURDEN

While the legal onus is on the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of the Section 30 grounds: see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3

C.P.R. (3d) 325, at pages 329-330. To meet the evidential burden in respect 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. In the instant case, no evidence was submitted by the opponent in respect of the first three grounds of opposition. The opponent has failed to meet the evidential burden on it in respect of the Section 30 grounds of opposition which are therefore rejected.

MAIN ISSUE

The determinative issue, with respect to the remaining grounds of opposition, is whether the applied for mark JONATHAN LOGAN Design is confusing with the opponent's mark JONATHAN G. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the ground of opposition alleging non-registrability; (ii) the date of opposition (October 24, 2003) with respect to the ground of opposition alleging non-distinctiveness; and (iii) the date of filing the application (that is, the priority filing date February 5, 2001) with respect to the grounds of opposition alleging non-entitlement: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). However, in the circumstances of this case, nothing turns on whether the issue of confusion is determined at a particular material date.

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) of the *Trade-marks Act*, between the applied for

mark JONATHAN LOGAN Design and the opponent's mark JONATHAN G. 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. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Trade-marks 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 the 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.).

SECTION 6(5) FACTORS

The opponent's mark JONATHAN G does not possess a high degree of inherent distinctiveness because the first component would be recognized as a first name and the second component is merely a letter of the alphabet. Similarly, the applied for mark JONATHAN LOGAN Design does not possess a high degree of inherent distinctiveness because it would be perceived as the name of a real or fictional person. The cursive script design feature of the mark does not add to its inherent distinctiveness: see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961) 37 C.P.R. 89 (Ex. C.). I am prepared to infer from Mr. Serero's affidavit

evidence, at least in the absence of cross-examination and despite some lack of specificity in his testimony, that the opponent's mark JONATHAN G acquired a significant reputation in Canada in association with clothing at all material times. There is no evidence that the applied for mark acquired any reputation at any material time. The length of time that the marks in issue have been in use favours the opponent. The nature of the parties' wares are essentially the same, however, the opponent has not evidenced any use of its marks for wares other than clothing. In the absence of evidence to the contrary, I assume that the parties' wares would travel through the same or overlapping channels of trade.

The marks in issue resemble each other to a fair extent visually and in the ideas that they suggest, although the resemblance is somewhat less from a phonetic aspect. In this respect, both marks are prefixed by the component JONATHAN and it is the first portion of a trade-mark that is the most relevant for purposes of distinction: see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 at 370 (F.C.T.D.). Further, there is some similarity in the cursive font forming the parties' marks and the marks in issue suggest the name of a real or fictional person (albeit different persons). In other words, the overall visual impacts of the marks in issue are similar. There is a distinct difference in the marks when they are sounded in their entireties, however, as noted above, it is the first portion of a trade-mark that is the most relevant for purposes of distinction. On the other hand, I am aware that when marks are inherently weak, comparatively small differences may suffice to distinguish one mark from another: see *GSW Ltd. v. Great west Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 (F.C.T.D.).

DIVIDED DECISION

In view of the above, and keeping in mind the differences between the marks in issue, I nevertheless find that the applicant has not met the onus on it to show, on a balance of probabilities, that the marks in issue are not confusing in respect of the applicant's wares comprising items of clothing. The subject application is therefore refused in respect of all items of clothing.

However, as the opponent has not established any reputation for its marks in respect of the wares "watches and jewelry," the opposition is rejected in respect of those wares.

Authority for a divided decision is found in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.).

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 1st DAY OF DECEMBER, 2006.

Myer Herzig,
Member,
Trade-marks Opposition Board