



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

Citation: 2013 TMOB 72
Date of Decision: 2013-04-16

**IN THE MATTER OF AN OPPOSITION
by Boutique Jacob Inc. to application
No. 1,369,868 for the trade-mark JACOB
COHEN COMPANY & Design in the
name of Playtime Image Rights Limited**

[1] On October 30, 2007, Playtime Image Rights Limited (the Applicant) filed an application to register the trade-mark JACOB COHEN COMPANY & Design (the Mark), shown below, on the basis of use in Canada since at least as early as August 7, 2007.



[2] The statement of wares of the application of record, as revised on December 3, 2009, reads “jeans and trousers”.

[3] The application was advertised in the *Trade-marks Journal* of July 16, 2008.

[4] Basco IP, L.P. (Basco) filed a statement of opposition on December 16, 2008. The Applicant filed a counter statement essentially denying the grounds of opposition.

[5] Each party filed evidence and a written argument. Both parties attended a hearing.


[6] On September 25, 2012, that is after the filing of the written arguments but prior to the hearing, Boutique Jacob Inc. requested leave to file an amended statement of opposition to reflect its ownership of the trade-marks alleged in the original statement of opposition further to corporate reorganization of Basco and the assignment of the trade-marks to Boutique Jacob Inc., as well as to remove references to some trade-mark registrations. The Registrar granted leave to file the amended statement of opposition on November 27, 2012.

[7] Unless indicated otherwise, my subsequent use of the term “Opponent” is a reference to the opponent at the relevant time, i.e. Basco or Boutique Jacob Inc.

Alleged Grounds of Opposition

[8] The grounds of opposition raised under the *Trade-marks Act*, RSC 1985, c T-13 (the Act) allege, in summary, that:

- a) the application does not conform with sections 30(b), (h) and (i) of the Act;
- b) the Mark is not registrable under section 12(1)(a) of the Act because it is primarily merely the name or surname of an individual who is living or has died within the preceding thirty years;
- c) the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
JACOB	TMA261,827 and TMA679,745
JACOB MAISON	TMA529,769
	TMA588,281 and TMA679,746

	TMA589,276 and TMA679,738
JACOB OUTLET	TMA671,841 and TMA672,063
	TMA679,747
JACOB LINGERIE	TMA679,748

- d) the Applicant is not entitled to registration of the Mark under section 16(1)(a) of the Act in view of confusion with the Opponent's trade-marks JACOB, JACOB JR., JACOB CONNEXION, JACOB LINGERIE and JACOB OUTLET previously used in association with clothing items and/or the retail sale of clothing items;
- e) the Applicant is not entitled to registration of the Mark under section 16(1)(c) of the Act in view of confusion with the Opponent's trade-names JACOB, JACOB JR., JACOB CONNEXION, JACOB LINGERIE, JACOB OUTLET and BOUTIQUE JACOB previously used in association with the retail sale of clothing items; and
- f) the Mark is not distinctive under section 2 of the Act.

Onus on the Parties

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, an initial burden on the Opponent to provide sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

Overview of the Evidence

[10] I provide below an overview of the parties' evidence that I will discuss further in my analysis of the grounds of opposition, where appropriate. In considering the evidence, I disregard any individual's opinions that go to the questions of fact and law to be determined by the Registrar in this proceeding.

Opponent's Evidence

[11] The Opponent filed certified copies of 7 of the 11 trade-mark registrations alleged in support of the opposition, which at the time were owned by Basco.

[12] The Opponent also filed an affidavit of Joseph Basmaji, dated September 2, 2009, with its Exhibits "JB-1" to "JB-11". Mr. Basmaji has not been cross-examined.

[13] As Mr. Basmaji introduces the evidence by collective reference to the Opponent's trade-marks consisting of or involving the word JACOB, I will refer to these marks collectively as the JACOB Marks. I will distinguish the JACOB Marks when necessary.

[14] At the time of his affidavit, Mr. Basmaji was President of Basco, 9101-2096 Québec Inc. (9101-2096) and Boutique Jacob Inc. (Boutique Jacob), all members of the Jacob group of companies.

[15] Mr. Basmaji introduces evidence about the use and advertisement of the JACOB Marks in association with clothing, jewellery, sunglasses, handbags and other fashion accessories and with the operation of a chain of retail stores. Mr. Basmaji throughout his affidavit identifies these wares and services by collective reference to the JACOB Products and the JACOB Services respectively.

[16] Mr. Basmaji explains that Boutique Jacob was the original owner of the JACOB Marks and that Boutique Jacob assigned them to 9101-2096, which in turn assigned them to Basco. He also explains that the JACOB Marks have been used in Canada since at least as early as 1976 by Boutique Jacob, either as their original owner or as licensee of 9101-2096 and Basco successively.

[17] In his affidavit, Mr. Basmaji expressly states that Boutique Jacob was granted a licence by 9101-2096 and Basco successively for the use of the JACOB Marks in association with the JACOB Products and JACOB Services. Also, he expressly states that the licensed use of the JACOB Marks by Boutique Jacob had been at the knowledge and under the supervision and control of 9101-2096 and Basco. I find it reasonable to give full weight to Mr. Basmaji's statements, which have not been challenged by cross-examination. To the contrary, at the hearing the Applicant indicated that it does not dispute that the licensed use of the JACOB Marks by Boutique Jacob met the requirements of section 50(1) of the Act, which requires the owner of a trade-mark to control, either directly or indirectly, the character or quality of the wares or services in order to benefit from the use of its trade-mark by a licensee. Accordingly, I accept the affidavit of Mr. Basmaji as sufficient to establish that the licensed use of the JACOB Marks by Boutique Jacob enured to the benefit of 9101-2096 and Basco successively.

Applicant's Evidence

[18] The Applicant filed affidavits of Gay Owens, Jayda Sutton and Aaron Maxwell. The Opponent cross-examined Ms. Sutton and Mr. Maxwell. The transcript of both cross-examinations and the reply to undertakings given during Mr. Maxwell's cross-examination form part of the record. I will refer to the cross-examinations of Ms. Sutton and Mr. Maxwell to the extent that they are relevant to my review of their affidavits and the parties' submissions.

[19] Ms. Owens, a trade-mark searcher employed by the Applicant's trade-marks agent, files the results of a state of the register search for trade-marks associated with clothing and containing the element JACOB.

[20] Ms. Sutton, an articling student with the firm acting as the Applicant's trade-marks agent, files the results of Internet searches that she carried out.

[21] At the time of his affidavit of December 23, 2009, Mr. Maxwell was a chartered accountant with the law firm Belluzo and Associati. Also, he had been employed by the Applicant for less than one year and had held the position of Director since April 2009.

[22] In his affidavit, Mr. Maxwell essentially affirms the following:

- the Applicant is the owner of the application for the Mark;
- the Mark has been used in Canada since at least as early as August 7, 2007;
- he files as Exhibit “A” invoices showing sales of jeans and trousers in association with the Mark to the Canadian importer Se.Ce. Apparel Ltd., which handles sales to Canadian consumers; and
- the jeans and trousers sold to Se.Ce. Apparel Ltd. displayed the Mark on a label.

[23] On cross-examination, Mr. Maxwell testifies that:

- he has knowledge of what the Applicant does; he is involved in the Applicant’s day-to-day activities, which are that of owning the rights to the Mark and exploiting those rights; the Applicant is not involved in the marketing and branding process of the Mark [pp 12-13 of the transcript];
- Exhibit “A” to his affidavit consists of one single invoice dated August 7, 2007 from Giada S.P.A. (Giada), a company licensed by the Applicant to use the Mark [pp 21-23 of the transcript];
- his written testimony that the Mark has been used in Canada since at least August 7, 2007 and that the invoice appended as Exhibit “A” to his affidavit relates to the sale of jeans and trousers were based on information provided to him by Modiano, an Italian firm specializing in trade-marks [pp 13, 15-16 and 24 of the transcript]; and
- he does not know which one of the two marks shown at the top of the invoice was used with the wares listed on the invoice [pp 25-26 of the transcript]. I note that none of these two marks, which were described in cross-examination as “Jacob Cohën with a big J” and “Jacob Cohën Company with a sewing machine”, is identical to the Mark.

[24] Copies of the licence agreement and of the renewal and supplementary agreement between the Applicant and Giada were provided in answers to undertakings, together with English translations.

[25] The overview of Mr. Maxwell's cross-examination leads me to turn to the Opponent's submissions that his affidavit constitutes hearsay evidence and should either be disregarded or not afforded any probative value.

Admissibility of the Affidavit of Mr. Maxwell

[26] The Opponent submits that the affidavit of Mr. Maxwell constitutes hearsay evidence and does not meet the exceptions of necessity and reliability because:

- he does not have personal knowledge of the matters to which he deposed;
- his statements are based on information obtained from a third party; and
- the Applicant did not explain why an individual with personal knowledge of the use of the Mark in Canada, for instance an employee of Giada, could not file an affidavit.

[27] At the hearing, the Applicant submitted that Mr. Maxwell, as Director of the Applicant, is in a position to provide evidence on its behalf. It also submitted that Mr. Maxwell's cross-examination establishes his knowledge of the Applicant's activity, which is that of owning the rights to the Mark.

[28] I agree with the Applicant that, as Director of the Applicant, Mr. Maxwell can provide evidence on the Applicant's behalf. However, the cross-examination of Mr. Maxwell reveals that his statements that the Mark has been used in Canada since at least August 7, 2007 and that the invoice of August 7, 2007 relates to the sales of jeans and trousers associated with the Mark are based on information provided to him by Modiano, which is a third party. As such, these statements are prima facie inadmissible hearsay evidence. The question becomes whether they satisfy the criteria of necessity and reliability, which will also determine the weight to be accorded to the evidence [see *Labatt Brewing Company Limited v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. Since Mr. Maxwell does not explain why it was necessary for him to obtain the information from Modiano instead of obtaining it from the Applicant's own business records or reports to him by other individuals within the Applicant, I find that little weight, if any, can be afforded to that part of his testimony.

[29] That said, Mr. Maxwell's oral testimony as to the licensed use of the Mark by Giada is corroborated by the copies of the agreements provided in answers to his undertakings. Furthermore, I find it reasonable to infer that the copies of these agreements come from the Applicant's business records. Accordingly, I accept to afford significance to this part of the Applicant's evidence.

[30] I now turn to the analysis of the grounds of opposition.

Grounds of Opposition Summarily Dismissed

[31] The grounds of opposition raised under sections 30(h), 30(i) and 12(1)(a) of the Act can be summarily dismissed for the reasons that follow.

[32] Unless the application is for a word or words not depicted in a special form, section 30(h) requires an applicant to include a drawing of the trade-mark and such number of accurate prescribed representations. The Opponent alleges that the representation of the Mark, as submitted in the application, is not an accurate representation of the trade-mark used in Canada since the claimed date of first use. I find that the Opponent's allegation does not support a ground of opposition based on non-conformity with section 30(h) of the Act and so the ground of opposition is improperly pleaded. In my opinion, the Opponent's allegation can be more appropriately and directly raised under a section 30(b) ground of opposition. In fact, as discussed later on, the Opponent's submissions about the section 30(b) ground of opposition are partly based on its contention that the trade-mark used in Canada is not the Mark.

[33] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Those circumstances do not exist in the present case.

[34] The section 12(1)(a) ground of opposition is dismissed for the Opponent's failure to meet its evidentiary burden. The Opponent did not file any evidence and did not make any submissions in support of this ground of opposition. In fact, at the hearing the Opponent agreed with the Applicant's position that the Mark does not contravene section 12(1)(a) of the Act.

Non-conformity with Section 30(b) of the Act

[35] The Opponent alleges that the application does not comply with section 30(b) of the Act in that the Applicant did not use the Mark in Canada in association with each of the wares described in the application since the alleged date of first use, or at any relevant time. Alternatively, the Opponent submits that the Applicant has abandoned the Mark by way of non-continuous use.

[36] The material date to assess the ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In addition, section 30(b) requires that there be continuous use of the trade-mark applied for in the normal course of trade since the date claimed in the application [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)].

[37] To the extent that the relevant facts are more readily available to the Applicant, the evidentiary burden on the Opponent under this ground of opposition is lower [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. The Opponent's evidentiary burden can be met by reference to the Applicant's evidence [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, the Opponent must show that the Applicant's evidence is clearly inconsistent with the claim set forth in the application [see *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), *aff'd* 11 CPR (4th) 489 (FCTD)].

[38] There are two prongs to the Opponent's submissions based on the Applicant's evidence. First, the Opponent submits that the Applicant cannot claim use of the Mark in Canada through its licensee Giada because the licence did not extend to Canada. At the hearing, the Applicant declined my invitation to comment on the territory covered by the licence.

[39] Alternatively, the Opponent submits that the trade-mark as used in Canada is not the Mark. I do not need to consider the Opponent's alternative submission to find in its favour.

[40] Indeed, I agree with the Opponent that the licence granted to Giada by the Applicant did not extend to Canada for the following reasons:

- article 1.2 of the licence agreement dated February 20, 2006 defines the term "Territory" as the states detailed in Enclosure B to the agreement. Canada does not appear in the list of countries described in the enclosure.
- article 2.3 of the licence agreement provides that except for prior and *specific written authorization* of the Applicant, and despite any possible other contrary provisions contained in the agreement, Giada may not use the Mark outside the Territory;
- article 12 of the licence agreement provides that it is the entire agreement between the parties and any amendment must be made in writing; and
- the renewal and supplementary agreement dated December 11, 2008 did not change the Territory.

[41] Since the licence did not extend to Canada, the Applicant cannot claim that it has used the Mark in this country through Giada as its licensee. In other words, the use of the Mark by Giada in Canada did not enure to the benefit of the Applicant under section 50(1) of the Act.

[42] I am satisfied that the Opponent has met its burden to show that as of October 30, 2007, the Mark had not been used in Canada *by the Applicant* since August 7, 2007. Without submissions from the Applicant to convince me otherwise, I find that the Applicant did not meet its legal onus to show that the application complies with section 30(b) of the Act.

[43] The section 30(b) ground of opposition succeeds.

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

[44] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[45] Having exercised the Registrar's discretion, I confirm that each of the alleged registrations is extant in the name of Boutique Jacob Inc. and so the Opponent met its evidentiary burden. The issue becomes whether the Applicant has satisfied its legal onus to show that the Mark is not reasonably likely to cause confusion with any of the Opponent's registered trade-marks.

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

[47] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 wares, 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. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (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.]

[48] At the hearing, the Opponent focused on the likelihood of confusion between the Mark and the mark JACOB of registration Nos. TMA261,827 and TMA679,745. I shall do the same because I find that comparing the Mark and the mark JACOB will effectively decide the ground of opposition, especially since evidence of use or advertisement of the trade-mark JACOB & Design (TMA589,276 and TMA679,738) may serve as evidence of use or advertisement of the mark JACOB. In other words, if confusion is not likely between the Mark and the registered mark JACOB, then confusion would not be likely between the Mark and any of the other registered trade-marks alleged by the Opponent.

Section 6(5)(a): the inherent distinctiveness of the trade-marks and the extent to which they have become known

[49] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' marks, favours the Opponent.

[50] The Applicant does not dispute that the Mark does not possess much inherent distinctiveness. In fact, the Applicant states that the Mark is a weak mark.

[51] Likewise, the inherent weakness of the mark JACOB is conceded by the Opponent. It recognizes that "Jacob" may correspond to a given name or surname and as such the mark JACOB is inherently weak.

[52] Hearsay deficiencies aside, the affidavit of Mr. Maxwell provides no information to conclude that the Mark has become known in Canada. In fact, the Applicant does not argue that the Mark benefits from acquired distinctiveness.

[53] By contrast, although the affidavit of Mr. Basmaji is open to criticism, if only due to his collective references to the JACOB Marks and the JACOB Products, I agree with the Opponent that it allows me to conclude that the mark JACOB benefits from significant acquired distinctiveness. Indeed, based on a fair reading of the affidavit of Mr. Basmaji as a whole, I am satisfied that it establishes significant use and promotion of the mark JACOB in Canada.

[54] Since the Applicant does not seem to dispute the acquired distinctiveness of the mark JACOB, I will not detail extensively the supporting evidence. Suffice it to say that besides providing representative specimens of use and advertisement of the mark JACOB in association with the JACOB Products and the JACOB Services, Mr. Basmaji provides the following evidence:

- at the date of his affidavit (September 2, 2009), there were 161 retail stores operated by Boutique Jacob under the banner JACOB, JACOB CONNEXION, JACOB LINGERIE or JACOB OUTLET. The JACOB Products were sold in these stores located in the Provinces of Quebec, Alberta, Ontario, British Columbia, Manitoba and Nova Scotia;

- during the last ten years, Boutique Jacob spent annually \$3 million for the promotion and advertisement of the JACOB Marks; and
- from 1980 to the date of his affidavit, the annual long-term growth of sales of JACOB Products associated with the JACOB Marks has exceeded 5%. At the date of the affidavit, the annual long term growth of sales was between \$150 million to \$400 million.

Section 6(5)(b): the length of time each trade-mark has been in use

[55] Since this factor clearly favours the Opponent, it does not need further discussion.

Section 6(5)(c): the nature of the wares, services or business; and Section 6(5)(d): the nature of the trade

[56] When considering sections 6(5)(c) and (d) of the Act, it is the statement of wares in the application for the Mark and the statement of wares and services in the Opponent's registration Nos. TMA261,827 and TMA679,745 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)]. These factors favour the Opponent.

[57] The statement of wares of each of the Opponent's registrations includes *jeans and pants*; the Mark is associated with *jeans and trousers*.

[58] The application for the Mark does not contain any restrictions with respect to the markets for the distribution of the Applicant's wares. In the present state of affairs, it appears unlikely that the Applicant's wares would be carried in the Opponent's stores. However, in attempting to establish confusion, it is not necessary to prove that the parties' wares are sold in the same outlets, as long as the parties are entitled to do so [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD)].

Section 6(5)(e): the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[59] When considering the degree of resemblance between trade-marks, the law is clear that they must be considered in totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks.

[60] In *Masterpiece, supra*, the Supreme Court of Canada discusses the importance of the degree of resemblance between trade-marks in conducting an analysis of the likelihood of confusion. In the reasons for judgment, Mr. Justice Rothstein states at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), 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. The other factors become significant only once the marks are found to be identical or very similar [...].

[61] For the reasons that follow, I find that the differences between the marks when considered as a whole are significant enough to outweigh any similarity owing to their common element JACOB.

[62] In his discussion of the approach in assessing the resemblance between trade-marks, Mr. Justice Rothstein states, at paragraph 64: “While the first word may, for the purposes of distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.”

[63] I do not consider that JACOB is a particularly striking component of the Mark. For one thing, JACOB does not stand alone; it is in close proximity to COHËN COMPANY and in the same typeface. In my view, the Mark will be pronounced JACOB COHËN COMPANY or, at the very least, JACOB COHËN. In other words, I believe that a consumer is unlikely to pronounce the Mark only by reference to JACOB.

[64] Further, although the words JACOB COHËN COMPANY arguably dominate the Mark, the representation of the sewing machine is not an insignificant component of the Mark. It does assist in distinguishing the Mark from the mark JACOB in terms of appearance.

[65] Finally, I believe that consumers are likely to react to the sewing machine found in the Mark by thinking of a sewing machine used decades ago by a tailor or a seamstress. In my view, the representation of the sewing machine in combination with JACOB COHEN COMPANY suggests the idea of a company founded several years ago by a tailor named Jacob Cohen. By contrast, the idea suggested by the Opponent's mark can only be that of the first name or surname Jacob.

Additional surrounding circumstances

[66] The Opponent does not rely on *any* additional surrounding circumstances in support of its case. However, the Opponent disputes that the additional surrounding circumstances advanced by the Applicant, namely the absence of evidence of actual confusion as well as the state of the register and of the marketplace evidence, support a finding of no likelihood of confusion.

[67] For the reasons that follow, I conclude that none of the additional surrounding circumstances advanced by the Applicant is of significance in this case.

No evidence of actual confusion

[68] It has often been said that an opponent does not need to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. Absence of evidence of confusion does not relieve an applicant from its burden of proof. Nevertheless, an adverse inference may be drawn from the lack of evidence of actual confusion where the marks have coexisted for a long period of time [see *Mattel, supra* at p 347].

[69] Aside from my previous finding that any use of the Mark in Canada by Giada cannot be deemed to be use by the Applicant, the affidavit of Mr. Maxwell is clearly insufficient to conclude that the Mark has coexisted in the Canadian marketplace with the mark JACOB for a four-year period, as submitted by the Applicant. Accordingly, the absence of evidence of actual instances of confusion is of no assistance to the Applicant's case.

State of the register and of the marketplace

[70] The Applicant submits that the results of the state of the register search [Exhibits “B” to “L” to the Owens affidavit] and Internet searches [Exhibits “A” and “B” to the Sutton affidavit] establish that trade-marks comprising the element JACOB are commonly used by third parties in Canada in association with clothing.

[71] In addition, the Applicant submits that the affidavit of Ms. Sutton shows that trade-marks associated with clothing and are similar to each other, or share similar or identical components, (for instance marks such as KENNETH COLE Design and COLE HAAN Design; TOMMY HILFIGER & Design and TOMMY BAHAMA; JASON ALEXANDER and ALEXANDER MCQUEEN) coexist on the register and on the marketplace in the name of distinct entities [paras 4 to 15, Exhibits “C” to “M”]. I will not further discuss this part of Ms. Sutton’s evidence as I find it not relevant to the issues in this case.

[72] I revert to the evidence filed by the Applicant to show that trade-marks comprising JACOB for clothing are commonly used by third parties, starting with the affidavit of Ms. Owens.

[73] Ms. Owens provides the full particulars of six applications and five registrations for trade-marks disclosed by her search of the register conducted on January 13, 2009.

[74] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where a large number of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[75] In its written argument, the Opponent requested that the Registrar exercise his discretion to confirm that the four allowed applications for the word and design trade-marks HENRY JACOBSON located by Ms. Owens on January 13, 2009 were abandoned in September 2009. I refuse to do so. As I indicated to the Opponent at the hearing, in opposition proceedings the Registrar does not exercise his discretion to have regard to anything appearing on the register

that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB); *Royal Appliance Mfg Co v Iona Appliance Inc* (1990), 32 CPR (3d) 525 (TMOB)].

[76] That said, I agree with the Opponent's oral argument that the HENRY JACOBSON marks are not relevant because they incorporate JACOBSON, not JACOB [Exhibits "B" to "E" to the Owens affidavit].

[77] In addition, I agree with the Opponent that:

- the registered mark JUNE JACOBS is not relevant as the wearing apparel listed in the statement of wares are described as "t-shirts and aprons *for promoting beauty products and services* and socks and gloves *for moisturizing and exfoliation*" (my emphasis) [Exhibit "F"]; and
- the element JACOBS in the registered marks ST. JACOBS COUNTRY and ST. JACOBS COUNTRY & Design as well as in the registered mark WATERLOO-ST. JACOBS RAILWAY appears to refer to a geographical location [Exhibits "J" to "L"].

[78] The remaining marks are LITTLE MARC JACOBS, MARC BY MARC JACOBS and MARC JACOBS [Exhibits "G" to "I"]. Apart from the fact that two of these three marks were only allowed at the time of the search, the marks are owned by the same entity. Even though the Opponent concedes that the registered mark MARC JACOBS is used in Canada in association with clothing, three marks owned by the same entity do not support the drawing of an inference that trade-marks comprising the element JACOB are *commonly used* in Canada by third parties in association with clothing.

[79] I conclude that the evidence provided by Ms. Owens does not assist the Applicant's case. I turn to the evidence provided by Ms. Sutton.

[80] The evidence consists of print-out of pages from websites accessed by Ms. Sutton further to her Internet searches conducted on December 17, 2009 for “Jacob Clothing” [para 2 and Exhibit “A”] and “Jacobson Clothing” [para 3 and “Exhibit B”].

[81] Although the Opponent concedes that the mark MARC JACOBS referenced in the affidavit is used in Canada in association with clothing, it submits that the affidavit of Ms. Sutton is of no assistance to the Applicant’s case. I agree with the Opponent, but without subscribing to its submissions that the evidence, as introduced, is intended to deliberately mislead the Registrar.

[82] For one thing, while I am satisfied that the websites existed at the time they were accessed by Ms. Sutton, the evidence is not admissible for the truth of its contents since very little information was provided to establish that these may be “official websites” or that the provided information is reliable [see *ITV Technologies, Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 (FCTD) at 192].

[83] Further, even if there may be no reasons to doubt the reliability of the information contained in the websites filed by Ms. Sutton, the evidence does not assist the Applicant’s case for the following reasons:

- ROMY AND JACOB is associated with dog clothes;
- JACOB & CO is associated with watches;
- the website for JACOB ASH/SCHUESSLER, which Ms. Sutton identifies as a wholesale distributor for hunting apparel, shows an address in the United States. Ms. Sutton’s written testimony that JACOB ASH sells and ships goods to Canada constitutes inadmissible hearsay evidence as it is based on a telephone conversation with someone from the company. In oral testimony, Ms. Sutton indicates that she does not remember to whom she spoke and does not what brands of clothing would be sold by the company [pp 20-22 of the transcript];
- since Ms. Sutton states that JACOB ROGERS is the name of a band, it seems reasonable to conclude that the t-shirts displaying JACOB ROGERS are promotional items. In any event, Ms. Sutton does not know whether there has ever been any sales of JACOB ROGERS clothing in Canada [p 22 of the transcript];

- on cross-examination, Ms. Sutton testifies that she did not purchase any products from the company MAX JACOB INTERNATIONAL LTD, which she states specializes in distributing promotion products, advertising specialties and business gifts, including clothing. Further, counsel for the Applicant did not allow her to answer the question whether she knew the brand of clothing sold by the company [pp 22-25 of the transcript];
- the website referencing JACOB CLOTHING INC. indicates that the company is a wholesaler and distributor for used clothes in Los Angeles, California; it is in the clothing business and export sorted goods to Africa, South America and Asia. On cross-examination, Ms. Sutton acknowledges that Canada is not identified on the website and she did not purchase any clothing from this company [p 27 of the transcript]; and
- the name JACOBSON LADIES WEAR LTD. in Sydney, Nova Scotia, involves the element JACOBSON, not JACOB. Further, in oral testimony, Ms. Sutton indicates that she did not know whether the business is still open and did not verify which brands of clothing it would be selling [p 28 of the transcript].

Conclusion on the likelihood of confusion

[84] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Even though my assessment of the circumstances of this case leads me to conclude that the section 6(5)(a) through (d) factors favour the Opponent, in my opinion the differences between the Mark and the mark JACOB in appearance, sound and in the ideas suggested by them are significant enough to shift the balance of probabilities in favour of the Applicant. Hence, I conclude that the Applicant has discharged the legal onus resting upon it to show that confusion between the Mark and the mark JACOB of registration Nos. TMA261,827 and TMA679,745 is not likely. Further, as I previously indicated, I find that comparing the Mark with the Opponent's trade-mark JACOB of registration Nos. TMA261,827 and TMA679,745 effectively decides the outcome of the ground of opposition.

[85] The section 12(1)(d) ground of opposition is dismissed in its entirety.

Non-entitlement under Section 16(1) of the Act

[86] In the case of trade-mark applied for registration based on use in Canada, the material date to assess a non-entitlement ground of opposition under section 16(1) of the Act is the date of first use claimed in the application. However, when an opponent successfully challenged an application under a section 30(b) ground of opposition, the material date for assessing a section 16(1) ground of opposition becomes the filing date of the application [see *Record Chemical Co v American Cyanamid Co* (1972), 6 CPR (2d) 278 (TMOB); *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)].

[87] Since the section 30(b) ground of opposition succeeded, the material date for assessing the sections 16(1)(a) and (c) grounds of opposition becomes the filing date of the application for the Mark. That said, in this case nothing turns on whether the claimed date of first use or the filing date of the application is considered as the material date.

Non-entitlement under Section 16(1)(a) of the Act

[88] The Opponent has the initial burden of proving that each of the trade-marks alleged in support of this ground of opposition was used in Canada prior to the material date and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[89] Once again, I find that comparing the Mark with the trade-mark JACOB will effectively decide the ground of opposition. Thus, I find it unnecessary to consider whether the Opponent has discharged its evidentiary burden to establish prior use of its alleged trade-marks JACOB JR., JACOB CONNEXION, JACOB LINGERIE and JACOB OUTLET.

[90] I am satisfied that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of its trade-mark JACOB. Further, assessing each of the section 6(5) factors as of October 30, 2007 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case.

[91] Accordingly, the section 16(1)(a) ground of opposition is dismissed for reasons similar to those expressed under the section 12(1)(d) ground of opposition.

Non-entitlement under Section 16(1)(c) of the Act

[92] The Opponent has the initial burden of proving that its alleged trade-names JACOB, JACOB JR., JACOB CONNEXION, JACOB LINGERIE, JACOB OUTLET and BOUTIQUE JACOB were used in Canada prior to material date and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[93] As the Opponent submits that Mr. Basmaji's affidavit establishes use of the trade-names JACOB or BOUTIQUE JACOB in Canada since at least as early as 1976, the Opponent seems to acknowledge that its evidence does not establish the prior use of the trade-names JACOB JR., JACOB CONNEXION, JACOB LINGERIE and JACOB OUTLET. Further, it is noteworthy that Mr. Basmaji introduces the Opponent's evidence by essentially referencing the JACOB Marks. In other words, the evidence does not distinguish between use of JACOB as a trade-name or as a mark.

[94] That said, if it ought to be found that the evidence, as introduced by Mr. Basmaji, is sufficient for the Opponent discharging its evidentiary burden under the section 16(1)(c) ground of opposition, then it ought to be found that this ground of opposition can be dismissed for reasons similar to those expressed under the previous grounds of opposition based upon confusion with the Mark and the mark JACOB.

Non-distinctiveness

[95] The ground of opposition as pleaded is based upon the likelihood of confusion between the Mark and the Opponent's trade-marks and trade-names alleged in the statement of opposition.

[96] The material date to assess the ground of opposition is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[97] I am satisfied that the Opponent has met its evidentiary burden to establish that its mark JACOB had become known sufficiently in Canada, as of December 16, 2008, to negate the distinctiveness of Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD);

Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd (2006), 48 CPR (4th) 427 (FC)]. As I find that comparing the Mark with the mark JACOB will effectively decide the outcome of this ground of opposition, it is not necessary to consider whether the Opponent has discharged its evidentiary burden for any of its other alleged trade-marks or any of its alleged trade-names.

[98] Assessing each of the section 6(5) factors as of December 16, 2008 does not significantly impact my previous analysis of the surrounding circumstances of this case, for reasons similar to those expressed previously. Accordingly, I am satisfied that the Applicant has discharged the legal onus resting upon it to show that, as of December 16, 2008, the Mark was not reasonably likely to cause confusion with the Opponent's mark JACOB.

[99] The non-distinctiveness ground of opposition is dismissed.

Disposition

[100] Having accepted the ground of opposition that the application does not conform to the requirements of section 30(b) of the Act, 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.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office