



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

Citation: 2011 TMOB 249
Date of Decision: 2011-12-12

**IN THE MATTER OF AN OPPOSITION
by Sperian Eye & Face Protection, Inc. to
application No. 1,304,687 for the trade-
mark GENESIS filed by STC Footwear
Inc.**

Introduction

[1] On June 8, 2006 STC Footwear Inc. filed application No. 1,304,687 to register the trade-mark GENESIS (the Mark) based on proposed use in Canada in association with safety work boots (the Wares).

[2] The application was advertised on May 30, 2007 in the *Trade-marks Journal* for opposition purposes. Bacou-Dalloz Eye & Face Protection, Inc. (Bacou) filed a statement of opposition on July 30, 2007 which was forwarded by the Registrar on August 14, 2007 to the Applicant. The Applicant filed a counter statement on December 4, 2007 in which it denies all grounds of opposition listed below.

[3] Bacou filed the affidavits of Philip Johnson while the Applicant filed the statutory declaration of Hugh John Fox and the affidavit Lisa Saltzman. Bacou filed as reply evidence the affidavits of Fiona Li and Karen E. Thompson. The Applicant obtained permission on August 6, 2009 to file as additional evidence a second affidavit of Fiona Li. As it will become obvious from a reading of this decision, I did not consider the

content of the Li affidavits as they describe facts that took place after the relevant dates associated with the grounds of opposition assessed hereinafter.

[4] By letter dated July 3, 2008 the agent for Bacou informed the Registrar that Bacou had changed its name to Sperian Eye & Face Protection, Inc. (the Opponent).

[5] Both parties filed written submissions and only the Opponent was represented at the hearing.

The Grounds of Opposition

[6] The grounds of opposition pleaded by the Opponent are:

1. The Application does not comply with the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the “Act”) in that the Applicant knew, is deemed to have known or should have known the rights and reputation attached to the Opponent’s GENESIS trade-mark in Canada by reason of its use, advertisement and reputation in relation to “spectacle frames and glasses, sunglasses and sun goggles”. The Applicant could not have been satisfied that it is or was entitled to use the Mark in Canada in association with the Wares in view of the prior use of the Opponent’s GENESIS trade-mark in Canada;
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with the registered trade-mark GENESIS registration number TMA573,808 in association with “spectacle frames and glasses, sunglasses and sun goggles”;
3. The Applicant is not the person entitled to registration of the Mark, pursuant to the provisions of s. 16(3)(a) of the Act, because at the filing date of the application the Mark was confusing with the Opponent’s trade-mark GENESIS previously used in Canada;
4. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive, nor is it adapted to distinguish the Wares from those of the Opponent nor will it be adapted to distinguish the Wares from those of the Opponent, which have been the subject of media advertising and have been sold under the trade-mark GENESIS in Canada.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceeding

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the

Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant Dates

[8] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: the filing date of the application (June 8, 2006);
- Registrability of the Mark under s. 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)];
- Entitlement to the registration of the Mark, where the application is based on proposed use: the filing date of the application (June 8, 2006) [see s. 16(3) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (July 30, 2007) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Section 30 Ground of Opposition

[9] The first ground of opposition, as drafted, is not a proper ground of opposition. Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada. Such a statement is included in the application. The allegation that the Applicant had knowledge of the existence of the Opponent's rights cannot form the basis of a ground of opposition under s. 30(i) of the Act. One may rely

on s. 30(i) in specific cases such as where fraud by the Applicant is alleged [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[10] Under these circumstances, the first ground of opposition is therefore dismissed.

Entitlement

[11] In order to meet its initial burden under this ground of opposition, the Opponent has to prove that it was using the trade-mark GENESIS prior to June 8, 2006 and that it had not abandoned such use on May 30, 2007 [see s. 16(5) of the Act].

[12] Mr. Johnson is the Opponent's Director of Optical Sciences & Quality Assurance. He has been employed by the Opponent for over 18 years. He provides some general corporate background on various legal entities. The relationship between the Opponent and the entities identified by Mr. Johnson in his affidavit is not an issue in these proceedings.

[13] Mr. Johnson alleges that the Opponent has marketed and sold GENESIS branded safety eyewear in Canada since at least as early as August 1, 2000 to various Canadian distributors, to stores ranging from large multinationals with a presence across Canada to small businesses.

[14] He provides the yearly sales figures of products in association with the trade-mark GENESIS in Canada from 2001 to 2008 which vary from over \$1.5 million to in excess of \$4.5 million. These figures represent over 100,000 units of eyewear products sold each year in Canada in association with the trade-mark GENESIS.

[15] The Opponent's products bearing the trade-mark GENESIS have been advertised across Canada since August 1, 2000 in magazines, brochures, in trade shows, newspapers, through distribution of press releases and various in-store promotional and point of sale signage. Mr. Johnson provides the annual advertising expenditures in Canada from 2001 to 2003 inclusive that vary from over \$5000 to in excess of \$23,000.

He filed samples of such advertising as well as samples of brochures circulated by the Opponent's distributors in Canada.

[16] Mr. Johnson filed extracts of three of the Opponent's websites where the Opponent's safety eyewear products bearing the trade-mark GENESIS are advertised. Those websites are available to Canadians and the sampling filed ranged from 2001 to 2004 inclusive. He has also provided a sampling of articles reported via the Internet and available in Canada featuring GENESIS products dating from 2001 to 2008 as well as press releases issued by the Opponent.

[17] Finally he lists the trade shows attended in Canada by the Opponent and its distributors to promote various safety products including the GENESIS safety eyewear products.

[18] From this evidence I conclude that the Opponent has used the trade-mark GENESIS in association with safety eyewear in Canada since August 1, 2001 and that such use was not abandoned on May 30, 2007. Consequently the Opponent has met its initial burden of proof.

[19] Accordingly, the Applicant has now the burden to prove, on a balance of probabilities, that the use of the Mark in association with the Wares is not likely to cause confusion with the Opponent's trade-mark GENESIS. The test to determine this issue is set out in s. 6(2) of the Act. I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks 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 in appearance, or sound or in the ideas suggested by them.

[20] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. In its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 S.C.C. 27 the Supreme Court of Canada has clearly indicated that the most

important factor amongst those listed under s. 6(5) of the Act is often the degree of resemblance between the marks.

The inherent distinctiveness of the marks and the extent that they have become known

[21] “Genesis” is a common word of the English language. However it does not have a clear or obvious relationship with the Opponent’s wares nor with the Wares. As such the parties’ trade-marks do possess some degree of inherent distinctiveness.

[22] The distinctiveness of a trade-mark may be enhanced through use or promotion in Canada. The evidence described above shows that the Opponent’s trade-mark GENESIS was known to some extent in Canada on June 8, 2006. Because the application is based on proposed use, any evidence of use of the Mark subsequent to the filing date of this application cannot be considered under this ground of opposition. This factor favours the Opponent.

Length of time the marks have been used

[23] The Opponent has been using in Canada its trade-mark GENESIS since August 1, 2001 while the present application is based on proposed use. This factor clearly favours the Opponent.

Nature of the wares and their channels of trade

[24] The Applicant argues that the wares are different and would travel through different channels of trade. It states in its written argument: “Both categories of wares are very specific and will not travel through the same channels of trade and will certainly not be associated even if occasionally, they are found on the same premises”. One has to wonder why they would be found in the same premises if not for the fact that they fall in the same general category of wares, namely protective or safety equipment. In fact the Opponent’s evidence, through the affidavit of Mr. Johnson, shows that they are offered for sale through the same channels of trade. He filed extracts of safety equipment providers’ websites (see exhibit D and E) wherein both the Applicant’s work boots and GENESIS safety eyewear are offered for sale.

[25] Mr. Johnson explains in his affidavit that the Opponent's safety eyewear are directed and utilized by a wide range of industries such as the manufacturing, construction, telecommunications, medical and public service sectors as well as the everyday person in need of eye protection when undertaking a potentially hazardous task. Unfortunately the Applicant has not provided any information on the purpose of the Wares. The description of the wares is however self-explanatory: safety work boots. Both parties' wares are safety equipment to be used by the same type of consumer, namely the person who is looking for protective equipment to accomplish hazardous tasks.

[26] Mr. Johnson also points out that both parties attended the same trade shows in Canada as exhibitors.

[27] Those factors favour the Opponent.

Degree of resemblance

[28] The marks are identical.

Additional surrounding circumstances

[29] Ms. Saltzman has been the director of the trade-mark searching department with Onscope™, a division of Marque d'Or since July 1995. Part of her responsibilities is to review and search files and records of the Canadian Intellectual Property Office. She provides details of the database used by Marque d'Or.

[30] She received a mandate from the Applicant's agent on January 13, 2009 to perform a trade-mark search of the Canadian trade-mark database for "Genesis", "Genesys" or "Genese". "Only active trade-mark statuses were to be searched" as expressed in her affidavit. She performed the search on January 14, 2009, after the relevant date, and filed the results.

[31] As reply evidence the Opponent filed the affidavit of Ms. Thompson. She has been a trade-mark searcher for over 31 years. She reviewed the affidavit of Lisa Saltzman and states that her search revealed 119 trade-mark registrations and applications.

However only 3 trade-mark registrations and applications are comprised of only the term GENESIS, GENYSIS or GENESE and cover goods and/or services related to clothing and non-sport protective wear, namely the Opponent's registration, the present application and registration TMA345,075 owned by Dimatt Investment Inc. covering "operation of a retail store for the sale of men's clothing". This is certainly distinguishable from safety equipment such as "boots" or "eyewear".

[32] I do not see how the state of the register evidence would be a relevant factor in this case favouring the Applicant.

Conclusion

[33] The Applicant failed to meet its evidential burden to prove, at the filing date of the application, on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent's trade-mark GENESIS when the Mark is used in association with the Wares.

[34] Therefore I maintain the third ground of opposition.

Distinctiveness

[35] Under this ground of opposition the Opponent has the initial evidential burden to prove that its trade-mark GENESIS had become sufficiently known on July 30, 2007, the filing date of the statement of opposition, to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted at the relevant date to distinguish or actually distinguished throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[36] The evidence of the Opponent's use of the trade-mark GENESIS prior to July 30, 2007 described under the previous ground of opposition is sufficient to conclude that the Opponent has met its initial burden of proof. Consequently the burden shifts on the

Applicant that has to prove, on a balance of probabilities, that the Mark was apt to distinguish the Wares from the Opponent's wares at the relevant date.

[37] The later relevant date allows me to consider any facts proven that occurred prior to July 30, 2007. In this case the Applicant's evidence of use of the Mark prior to such date must be taken into consideration.

[38] Mr. Fox is the Applicant's Vice-President Marketing. He has been in charge of marketing for seven years, which includes the marketing in Canada of the safety work boots sold in association with the Mark.

[39] Mr. Fox states that in 2006, a little after the filing of the application to register the Mark in Canada, the Applicant began selling safety work boots in Canada under the Mark. He provides the number of units sold in Canada for the years 2006, 2007 and 2008 which ranges from over 7,000 units to over 24,500 units. He filed a picture illustrating various safety work boots bearing the Mark sold in Canada by the Applicant. Mr. Fox has not provided any information on the extent of the Applicant's promotion activities in association with the Mark.

[40] Those facts prove that the Mark was known to some extent in Canada at the relevant date. However the sales figures of the Opponent and its promotional activities were more extensive than the Applicant's and thus, even at such subsequent relevant date the Opponent's trade-mark GENESIS was more known in Canada than the Mark. Consequently the first factor under s. 6(5) would still favour the Opponent. So does the second factor as the Applicant only began its use of the Mark in 2006.

[41] As for the remaining factors, even considering the state of the register evidence, which would still be outside the relevant period, their analysis would generate the same results as those described under the entitlement ground of opposition.

[42] Consequently I conclude that the Applicant failed to meet its burden to establish, on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent's trade-mark GENESIS on July 30, 2007. Therefore the Mark was not distinctive at the relevant date. I maintain as well the fourth ground of opposition.

Registrability

[43] The Opponent having been successful under two separate grounds of opposition, there is no need to rule on this ground of opposition.

Disposition

[44] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse pursuant to s. 38(8) of the Act the application to register the Mark.

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