

TRADUCTION/TRANSLATION

**In the matter of the opposition of Cluett,
Peabody Canada Inc to the application
for registration number 898749 for the
trade-mark AEROPEAK BY
DE UNGAVA filed by Effigi Inc**

On December 4, 1998, Effigi Inc (the “Applicant”) filed an application for registration of the trade-mark AEROPEAK BY DE UNGAVA based on a proposed use in association with:

Clothing, namely: sweaters, T-shirts, camisoles, vests, cardigans, turtlenecks, dresses, underclothing, culottes, midriff tops, slips, pants, jeans, jackets, Bermuda shorts, shorts, skirts, suits, jumpsuits, overalls, hats, berets, headbands, bandannas, ear muffs, scarves, blouses, one-piece ski suits, blazers, ski suits, namely: waist-length ski jackets, ski coats, ski pants, ski jackets, ski gloves, ski mitts, overcoats, parkas, anoraks; raincoats, rain slickers; hooded sweaters, jerseys, jogging outfits, namely: pants, T-shirts, sweatshirts; mitts, gloves, neckties, pajamas, nightgowns, baby dolls, nighties, peignoirs, bathrobes, toques, peak caps, uniforms, beach wear, namely: beach shirts and beach dresses; beach wraps, swim suits, raincoats, leotards, dressing gowns, coats, headbands, slipovers, polo shirts, boxers and belts; bags of various shapes and sizes, namely: sports bags allpurpose, athletic bags, gym bags, hand bags, shoulder bags, backpacks, school bags, fabric bags, fanny packs, carryall bags, carry-on bags, duffel bags; eyeglasses, sunglasses, sport glasses; perfumes for children; watches for children; jewellery for children. (the “Wares”)

The application for registration was published in the *Trade-Marks Journal* on August 16, 2000. On January 16, 2001, Cluett, Peabody Canada Inc (the “Opponent”) filed a statement of opposition in which it alleges the following grounds of opposition:

1. the Mark is not registrable under the provisions of paragraph 12(1)(d) of the *Trade-marks Act* (the “Act”) since it is confusing with the following registered trade-marks:

Trade-mark: ARROW & DESIGN, TMA284523

Trade-mark: ARROW & DESIGN, TMA275180
Trade-mark: ARROW FOR HER!; DESIGN, TMA281782
Trade-mark: ARROW POUR ELLE!; DESIGN, TMA283581
Trade-mark: ARROW FOR HER, TMA278391
Trade-mark: THE ARROW COMPANY, TMA209439
Trade-mark: ARROW & DESIGN, TMA187626
Trade-mark: ARROW DESIGN, TMA184864
Trade-mark: ARROW, TMA184863
Trade-mark: ARROW ARCHIVES, TMA481749
Trade-mark: ARROW NATURALS, TMA454429
Trade-mark: RIVER BRAND BY ARROW, TMA486884
Trade-mark: PASTIME BY ARROW, TMA476765
Trade-mark: BRADSTREET BY ARROW, TMA425350
Trade-mark: ARROW RUGGED WEAR, TMA425665
Trade-mark: GOLDEN ARROW, TMA464123
Trade-mark: ARROW SPORTS & SPIRITS & DESIGN, TMA428022
Trade-mark: RUGGED WEAR BY / PAR ARROW, TMA488529
Trade-mark: ARROW & DESIGN, TMA116797
Trade-mark: SILVER ARROW, TMA113598
Trade-mark: LADY ARROW, LCD046938
Trade-mark: REPRESENTATION OF AN ARROW, LCD027723
Trade-mark: GOLDEN ARROW, LCD027722
Trade-mark: ARROW, TMAD053871
Trade-mark: ARASMOOTH, TMA111625
Trade-mark: ARROW & Design TMA294418
Trade-mark: INT INTERNATIONALIST BY ARROW & Des TMA192161
Trade-mark: THE ARROW COLLARMAN SHIRT TMA358103
Trade-mark: ARROW DESIGN, TMAD008292;

2. The Applicant is not the person entitled to the registration of the Mark under the provisions of paragraph 16(3)(a) of the Act, in that as of the date of filing of the application, the Mark was confusing with the various ARROW trade-marks referred to above and previously used in Canada by the Opponent in association with the wares referred to in the said certificates of registration;
3. For the above reasons, the Mark is not distinctive within the meaning of section 2 of the Act.

On February 1, 2001, the Applicant filed a counter-statement of opposition in which it denies the grounds of opposition and alleges that the third ground is argued contrary to law since it is vague and ambiguous and does not allow the Applicant to defend against the opposition.

The Opponent filed a written argument and the two parties were represented at the hearing.

The evidence

The Opponent filed the affidavit of Mary Anne Lefebvre, a legal secretary employed by the Opponent's agents, which consists solely of the production of copies of the registrations of the trade-marks listed above with the exception of the following marks:

Trade-mark: ARROW & DESIGN, TMA116797

Trade-mark: GOLDEN ARROW, LCD027722

However, I can consult the state of the Register when the Opponent alleges that the Mark is not registrable because it is confusing with some registered marks for which the certificates of registration have not been put in evidence. (See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410.) After checking the Register, I am able to confirm that these marks appear in the Register and are still in force.

The Applicant filed a certificate of authenticity of the registration number TMA420961 for the trade-mark UNGAVA.

The law

In proceedings involving an opposition to the registration of a trade-mark, the Opponent must present sufficient evidence concerning the grounds upon which it is relying to indicate that there are facts that support these grounds of opposition. If this task is accomplished, the burden of proof shifts to the Applicant, who will have to persuade the Registrar that the grounds of opposition should not preclude the registration of its trade-mark. [See *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited*, (1990), 30 C.P.R.

(3d) 293.] The Registrar must then be reasonably persuaded on a balance of probabilities that the registration is not likely to create confusion. [*Christian Dior, S.A. and Dion Neckwear Ltd* [2002] 3 F.C. 405.]

The relevant date for the purpose of analyzing the ground of opposition based on paragraph 12(1)(d) of the Act is the date of the decision. [See *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.).] The relevant date for the purpose of analyzing the ground of opposition based on subsection 16(3) of the Act is the date of filing of the application for registration (December 4, 1998). The relevant date for the purpose of analyzing the ground of opposition based on the Mark's lack of distinctiveness is generally recognized as the date of filing of the opposition (January 16, 2001). [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at page 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., op. cit.*]

The lack of proof of use of the Opponent's trade-marks means that it has not discharged its initial burden of proof in relation to the second and third grounds of opposition. The Opponent argues, however, that it need not prove use of its registered trade-marks since it has produced evidence that it was the owner of a series of registered trade-marks all of which contain the word ARROW as a component.

It refers to the following passage in *McDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 in support of its position:

Thus when trade marks which have common characteristics are registered in the name of one owner as in the case of the marks EGG MCMUFFIN, MACSUNDAE, MCCHEESE and MCFEAST, that circumstance gives rise to the presumption that such marks form a series of marks used by the one owner and the registration of such marks is tantamount to a single registration combined of those several marks.

By that I mean that a mark which would be confusing with the registered marks is not confusing with those marks if the applicant therefore (sic) is the owner of all such trade marks. This well-known principle is recognized and perpetuated in s-s. 15(1) of the Act and which identifies such marks as "associated trade marks".

An application for a trade mark made by an applicant other than the registered owner of those trade marks which embodies the common characteristics thereof would be conflicting therewith and should be refused. That consideration does not apply when the applicant is the owner of the series and wishes to add to the series.

The fact of the registration of trade marks giving rise to the presumption of a series of marks existing is a most material consideration which the Registrar of Trade Marks must take into account upon an application for the registration of a mark embodying the common characteristics.

However, it is important to note that this passage is followed by the following observations of Mr. Justice Cattanach:

The fact of the registration of trade marks giving rise to the presumption of a series of marks existing is a most material consideration which the Registrar of Trade Marks must take into account upon an application for the registration of a mark embodying the common characteristics.

(...)

While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family." (Emphasis added)

This judgment has often been cited as proof of the principle that an opponent who bases its opposition on the ownership and use of a series of marks must prove the use of each of its registered marks if the Registrar is to consider this argument. [See, by way of example: *Warnaco v. Manufacturiers de bas de nylon Doris Ltée*, (2003) 28 C.P.R. (4th) 401, *Andres Wines Ltd v. T.G.Bright & Co., Ltd*, (1983) 79 C.P.R. (2d) 94 and *McDonald's Corp et al v. Peter MacGregor Ltd*, (1987) 15 C.P.R.(3d) 433.]

The language of subsection 16(3) of the Act is clear. There must be unequivocal evidence of the previous use of the Opponent's trade-marks if the initial burden of proof is to be reversed and the Applicant is to have to prove that there is no danger that the Mark could cause confusion with the trade-marks previously used by the Opponent. [See *Sequa Chemicals Inc. v. United Color and Chemicals Ltd.*, (1992) 44 C.P.R. (3d) 371.] In the absence of any evidence of use of the Opponent's trade-marks, I reject the second and third grounds of opposition.

The Opponent argues that the Mark is not registrable because it is confusing with its registered trade-marks listed above. It is therefore necessary to determine whether the use of the Mark could create confusion with the Opponent's registered trade-marks, following the approach prescribed in section 6 of the Act, and account for all the relevant circumstances, including: the inherent distinctiveness of the trade-marks or trade-names, and the degree to which they have become known, the length of time during which the trade-marks or trade-names have been in use, the nature of the wares, services or undertakings, the nature of the trade and the degree of resemblance between the trade-marks or trade-names in the presentation or sound or in the ideas suggested by them. It is settled law that the list of circumstances enumerated above is not exhaustive and that it is not necessary to assign equal weight to each of these criteria. [See for example *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) et *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.).]

The most relevant of the Opponent's registered marks for the purposes of this case are:

- (a) ARROW, registration certificate TMDA053781 in association with clothing accessories and for dresses, T-shirts, sweaters, blouses and socks;
- (b) ARROW, registration certificate TMA184863 in association with a long list of clothing for men, ladies and children.

(collectively designated "the ARROW marks")

Needless to say, if I conclude that there is no risk of confusion between the Mark and the ARROW marks, there could not be any risk of confusion between the Mark and the other registered trade-marks of the Opponent.

The Mark, although formed of words from the English language (AERO and PEAK) and from a place (UNGAVA), when taken together and in association with the Wares, has a certain distinctiveness. The ARROW marks, for the same reasons, also have a certain distinctiveness. I have no evidence of use of the trade-marks by either of the parties and consequently I am unable to determine to what degree they have become known.

In Cartier Men's Shops Ltd. v. Cartier Inc. (1981), 58 C.P.R. (2d) 68 at 71 (F.C.T.D.)

Mr. Justice Dubé approved the approach taken by the Registrar, in the context of analyzing the circumstances described in subsection 6(5) in order to determine whether the mark is registrable, of referring to the statements contained in the certificate of registration of a trade-mark in order to find that this mark had been used in the context of the analysis of the criterion described in paragraph 6(5)(b) of the Act. The registration of the ARROW mark, registration certificate TMDA053781, was obtained on the basis of a use of this mark since July 14, 1949, while the one issued under number TMA184863 described the use of the ARROW mark in association with shirts since 1902. It appears, therefore, that this second criterion favours the Opponent.

At the hearing the Applicant conceded that the criteria enumerated in paragraphs 6(5)(c) and (d) favour the Opponent. So the remaining step is to analyze the degree of resemblance in terms of their presentation or their sound or in the ideas suggested by them.

Because of the similarity of the Wares with those described in registration certificates TMDA053781 and TMA184863, the criterion set out in paragraph 6(5)(e) becomes doubly important. Moreover, the criterion of resemblance between the marks has been held to be the dominant factor in most of the cases. [See *Beverley Bedding & Upholstery Co v. Regal*

Bedding & Upholstering Ltd. (1980), 47 C.P.R. (2d) 145 and Export/Import Clic Inc. v. Effem Foods Ltd. (1993), 53 C.P.R. (3d) 200.]

Visually, the Mark is distinguishable from the Opponent's ARROW marks. The Opponent argues that the pronunciation in English of the first component of the Mark, AERO, is similar to the pronunciation of the word ARROW. There is no evidence as to the pronunciation of these words by an Anglophone, Francophone or bilingual individual. Because of the presence of more than one syllable in each of these words, more than one pronunciation is conceivable for each of these words. In the circumstances, therefore, it is impossible for me to find in favour of the Opponent. Furthermore, it must be kept in mind that the degree of resemblance between the marks in dispute must be assessed in terms of the average consumer with an imperfect memory of the Opponent's ARROW marks. And the marks in dispute should not be dissected for the purpose of establishing points of commonality and differences. Mr. Justice Décarý has described the appropriate approach as follows, in *Christian Dior, S.A. v. Dion Neckwear Ltd. [2002] 3 F.C. 405*:

... the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier.

The ideas suggested by the marks are also different. ARROW signifies an arrow, while the coined term AEROPEAK is the combination of the words AERO, which signifies aeronautical, and PEAK, which signifies summit.

By comparing the Mark as a whole with any of the Opponent's marks, I am unable to find any resemblance such that the average consumer might think that the Wares sold in association with the Mark originate with the Opponent. This circumstance favours the Applicant.

Conclusion

I conclude, therefore, that the Applicant has discharged its onus to demonstrate, on a balance of probabilities, that the Mark does not risk creating confusion with the marks of the Opponent. Accordingly, I am unable to subscribe to the first ground of opposition raised by the Opponent.

In the circumstances, pursuant to the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I reject the Opposition by the Opponent, under the provisions of subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THE 15th DAY OF JUNE 2004.

Jean Carrière
Member,
Trade-marks Opposition Board