

**IN THE MATTER OF AN OPPOSITION
by International Clothiers Inc. to
Application No. 1039377 for the Trade-
mark DËKKER WOMEN & Design filed
by David R'Bibo and Patrick
Forte**

I The Pleadings

On December 10, 1999 David R'Bibo and Patrick Forte filed an application to register the trade-mark DËKKER WOMEN and Design as illustrated hereinafter:



(the “Mark”), application number 1039377, in association with leather, suede, vinyl, plastic and material sportswear and outerwear garments for women, more specifically: outerwear coats, jeans, t-shirts, vests, dresses, skirts, shorts, pants, casual pants, blouses, casual shirts, blazers, and suits (the “Wares”). The application was filed based on use since February 1997.

By office action dated March 28, 2001, the examiner raised several issues, including a request for a disclaimer for the word DËKKER apart from the trade-mark as a whole and advised the applicants that “an application cannot be filed in the name of more than one individual, unless the individuals form a partnership or are engaged in a joint venture... If an application is filed in the name of more than one individual and this is not the case, it will be necessary to file a new application together, with the prescribed \$150 fee, in the name of only one individual/organization”.

In reply to such office action, the Applicant's agent wrote a letter dated June 7, 2001 and filed an application in the name of CODAV/FOREST IMPORT-EXPORT INC. (the "Applicant") for the registration of the Mark containing the disclaimer requested and paid the filing fee. No new application number was assigned to this application. It would appear that it has been treated as an amended application because it bears the same application number.

International Clothiers Inc (the "Opponent") filed on March 11, 2003 a statement of opposition raising the following grounds:

- 1) In virtue of s. 38(2)(a) and s. 30 of the *Trade-Marks Act* R.S.C. 1985, c. T-13, (the "Act") the Applicant is not the owner of the Mark. The purported owner of the Mark is D.B. Thomas & Son Ltd. The Applicant is a distributor for D.B. Thomas & Son Ltd. The application therefore fails to comply with s. 30 of the Act as:
 - i. In virtue of s. 38(2)(a) and contrary to s. 30(b) of the Act, any use in Canada of the Mark since February 1997 did not inure to the benefit of the Applicant as it was a distributor;
 - ii Contrary to s. 30(b) of the Act, the application was originally filed in the name of David R'bibo and Patrick Forte, officers of the Applicant. The application was purportedly transferred to the Applicant even though no assignment has been executed or filed;
 - iii Contrary to s. 30(i) of the Act, the applicant could not have been satisfied that it was entitled to use and apply to register the Mark as it was a mere distributor and not the purported owner of the Mark;
- 2) In virtue of s. 38(2)(c) and 16(1)(a) of the Act the Applicant is not the person entitled to the registration of the Mark as it is not the owner of the Mark but a mere distributor. Any use of the Mark has not been by the purported owner, the Applicant;
- 3) The Mark is not, and cannot, be distinctive of the applicant as the Applicant is not the owner of the Mark. The Applicant is a distributor for the Mark's owner.

The Applicant filed on May 1st, 2003 a lengthy counter statement denying the grounds of opposition and alleging certain facts. Those facts must be proven by way of affidavit or statutory declaration in order to be taken into consideration. [See rule 42 of the *Trade-marks Regulations (1996)*]

II The Parties' evidence and evidentiary issues

The Opponent filed as its evidence a certified copy of the prosecution history of the present application. It contains two relevant letters to the issues raised by the Opponent in its statement of opposition. First, the abovementioned Applicant's agent letter of June 7, 2001, stating:

“Notwithstanding the preceding, our client's application has stated that it is seeking the registration of DĚKKER, having used the trade name and having certain intellectual property rights on the said name since at least 1997, Codav/Foresrt Import-Export Inc. being the exclusive authorized distributor of DĚKKER products in North America as stated in a letter from D.B. Thomas & Son Ltd. dated November 9th, 1999, and appended hereto” (my underlines)

The aforesaid letter of D.B. Thomas & Son Ltd., addressed to the Applicant, contains the following statement:

“We wish to put on record that as far as our company is concerned you are the authorized distributor of all products supplied by our company carrying the DĚkker Label.” (my underlines)

The Applicant filed an affidavit of Mr. Bill Voyatzis, an attorney at the Applicant agent's firm, attesting that he sent to the Opponent's agents, by Fed Ex messenger service, a sealed envelope containing documents. There is in the present file an envelope containing documents and I assume that they are copies of the documents sent to the Opponent's agents. There is no allegation in Mr. Voyatzis' affidavit as to what those documents represent, their purpose, when they were used and by which entity. There might be other relevant issues raised in the statement of opposition, not related to those documents, but suffice to say that those issues have not been addressed by Mr. Voyatzis in his affidavit. Finally, none of the documents have been notarized by a notary public or a commissioner of oaths.

The Opponent's agent was not served with a copy of Mr. Voyatzis' affidavit. It raised at the oral hearing, for the first time, the argument that the Applicant failed to serve its evidence [purportedly the Voyatzis' affidavit] on the Opponent and therefore, as per the provisions of rule 42(2), this application should be deemed to have been abandoned for the purposes of s. 38(7.2) of the Act. As the Opponent did not raise this procedural issue in a timely manner, I shall disregard it at this stage.

The Applicant's agent, by letter undated but transmitted to the Registrar on November 28, 2005, approximately a week prior to the oral hearing, requested leave to file the affidavit of Mr. Patrick Forte, a representative of the Applicant. The Applicant does not specify under which rule it filed such request, but I shall treat it as an application to file additional evidence under rule 44.

Mr. Forte simply states in his affidavit that he is one of the Applicant's directors; that the documents sealed in an envelope by the Applicant's agent on June 13, 2003, were to serve as the Applicant's evidence in this matter, did originate from the Applicant's office and that they were prepared by the Applicant's employees.

The practice notice entitled "Procedure before the Trade-marks Opposition Board" published on June 19, 1996 states that the Registrar must consider, when assessing the merit of an application to file additional evidence, all the surrounding circumstances including:

- i) the stage the opposition proceeding has reached;
- ii) why the evidence was not filed earlier;
- iii) the importance of the evidence;
- iv) the prejudice which will be suffered by the other party.

Moreover the said practice notice stipulates that once the written arguments have been requested, as in this case, such application will only be considered if it is specifically agreed that the affiant will be made available for cross-examination at the request of the other party. At the oral hearing, I informed the parties that my ruling on this application would form part of my decision in this opposition.

The Applicant argued in support of its application that the Forte affidavit is filed in the event that the Voyatzis affidavit would be ruled unacceptable. The Applicant failed to address, in its application, any of the above circumstances and did not advise the Opponent that the affiant would be available for cross-examination. The Applicant's agent tried to cure such last deficiency by stating during the verbal representations that the affiant would be available for cross-examination.

Despite such last minute undertaking, I refuse the Applicant's request to file the affidavit of Mr. Forte because the Voyatzis affidavit has not been excluded from the record. A distinction must be made between

its admissibility and the relevancy of its content. Moreover, there is no explanation as to why this affidavit was not filed at least after the receipt of the Opponent written submissions, why its content is important to the Applicant's case and why the Opponent would not suffer undue prejudice if such application is granted.

In the event that I am wrong in the exercise of my discretion, the affidavit of Mr. Forte would be of little assistance to the Applicant as it does not provide any facts or any explanations of the documents in the envelope "filed" in the record, except to state that they originate from the Applicant, nor does it address any of the issues raised by the Opponent in its statement of opposition and/or through the evidence it filed. It will become obvious from the reasons of my decision in this opposition that the content of Mr. Forte's affidavit would have no or minimal impact on it.

The question remains however as to the admissibility of the documents enclosed in an envelope for which we have no information whatsoever. During the oral hearing the Applicant's agent tried to explain the meaning of such documents. However the *Trade-marks Regulations (1996)* are quite clear: the evidence must be in the form of an affidavit or statutory declaration. We have in the record no affidavit that would explain the meaning and purpose of the documents "filed" by the Applicant. Certainly, the Applicant's agent cannot testify on behalf of his client. As such, I rule that the documents filed by the Applicant constitute inadmissible evidence.

III Discussion of the legal issues

The legal onus is upon the Applicant to show that its application complies with the provisions of s. 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant then has to prove 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.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

I shall analyze the first ground of opposition (non-compliance to the provisions of s. 30 of the Act) as of the filing date of the application. [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]. The

Opponent is arguing that the Applicant is not the owner of the Mark being a distributor of the Wares bearing the Mark. A distributor is precluded from registering the trade-mark of the manufacturer of the goods it distributes. [See *Lin Trading Co. Ltd. v. CBM Kabushiki Kaisha Ltd.* (1987), 14 C.P.R. (3d) 32] It appears from the two letters described above that the true owner of the Mark would be D.B. Thomas & Son Ltd. and any use of the Mark by the Applicant would be to the benefit of D.B. Thomas & Son Ltd. [See *McCabe v. Yamamoto* (1989), 23 C.P.R. (3d) 498 (F.C.T.D.) and *Bio Agri Mix Ltd. v. Canadian Bio Systems Inc.* (2002), 20 C.P.R. (4th) 372] Therefore, the Opponent pleads that the Applicant has failed to comply with the requirements of s. 30 of the Act as it could not have stated in its application that it used the Mark in Canada as of February 1997, as claimed in its application.

When non-compliance to s. 30 is raised, the Opponent's initial burden is light. It met such evidentiary burden by filing a copy of the file history of this application that contains a copy of the two aforesaid letters. The burden of proof thus shifts on the Applicant, who must prove on a balance of probabilities, that at the filing date of the application, it was the true owner of the Mark in Canada and has used it since at least the date of alleged first use.

The Applicant is taking the position that the application complies with the provisions of s. 30 as any use of the Mark since February 1997 has inured to the benefit of the Applicant. To support its contention, it argues that it was the entity having direct control over the character and quality of the wares associated with the Mark, as it is solely responsible for determining the character and quality of the goods, to the complete exclusion of D.B. Thomas & Son Ltd. There is however no proof in the record of such allegation.

The Applicant states in its written argument: "Furthermore, at the time of the transfer of the property in the wares to clients of the Applicant, the wares themselves are labelled with the DEKKER trade-mark, which labels were created and are affixed by the Applicant". Not only there is no evidence to prove such statement, but also the trade-mark in issue is DEKKER WOMEN and Design and not DEKKER. The Applicant goes on to state that a search has revealed that D.B. Thomas & Son Ltd does not have any registered rights in connection with the Mark, whether in Canada, the United States or the United Kingdom. Without commenting on the relevancy of this statement, again those facts were not introduced as evidence in the file.

There is no admissible evidence in the record that the Applicant could rely on to meet its burden of proof with respect to this ground of opposition. Under the circumstances I have no alternative but to maintain ground of opposition 1) i) described above.

As for ground of opposition 1) iii), s.30 (i) of the Act only requires that the Applicant states that it is satisfied that it is entitled to use the mark in Canada. Such statement is included in the application. There is neither an allegation in the statement of opposition nor any evidence in the file that the Applicant attempted to appropriate the Mark to the detriment of a third party. It may have been filed in good faith in a misdirected attempt to protect the rights of a third party, D.B. Thomas & Son Ltd in this case. There is no allegation and proof that the Applicant acted in bad faith. As drafted, this ground of opposition must fail. [See *Sapodilla Co. Ltd. v. Bristol Myer Co.* (1974), 15 C.P.R. (2d) 152]

The second ground of opposition is based on s. 16(1) of the Act. The material time for considering such ground of opposition is the date of first use claimed in the application (February 1997) [See Section 16 of the Act] Entitlement of the Mark must be assessed in the context of an allegation of confusion with a trade-mark or a trade-name previously used in Canada by any other person. There is no such allegation in the statement of opposition. In any event, there is no admissible evidence in the file of prior use of the Mark within the meaning of s. 4 of the Act by any third party. Therefore, this ground of opposition is also dismissed.

The third ground of opposition raises the issue of distinctiveness of the Mark. The material date for assessing the issue of distinctiveness is generally accepted to be the filing date of the statement of opposition (March 11, 2003). [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.), *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A) and *Metro-Goldwyn-Meyer Inc v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th)317 (F.C.T.D.) at 324]

The evidence filed by the Opponent, as discussed above under ground of opposition 1)i), is sufficient to meet its initial onus. The burden thus shifts on the Applicant who must prove, on a balance of probabilities, that the Mark distinguishes, or is apt to distinguish, the Applicant's Wares from the wares or

services of others. The Opponent is arguing that the Mark cannot be distinctive of the Applicant as it is not the owner of the Mark but a simple distributor of the Wares bearing the Mark. The Applicant failed to file any evidence that would enable me to conclude that the Mark is distinctive of the Applicant within the meaning of s. 2 of the Act and would serve to distinguish the Applicant's Wares from the wares of others. I therefore maintain the third ground of opposition.

Having already ruled in favour of the Opponent under two separate grounds of opposition, it is not necessary for me to adjudicate on ground 1) ii) of the statement of opposition.

IV Conclusion

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application for the registration of the Mark in association with the Wares, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN BOUCHERVILLE, QUEBEC, THIS 14th DAY OF DECEMBER 2005.

Jean Carrière,
Member,
Trade-marks Opposition Board