

**IN THE MATTER OF AN OPPOSITION
by Premiere Vision Inc. to application No.
617,985 for the trade-mark EZ'S BY
HAGGAR filed by Hagggar Clothing Co.**

On October 27, 1988, the applicant, Hagggar Clothing Co., filed an application to register the trade-mark EZ'S BY HAGGAR for "men's and boys' clothing namely, slacks, coats, vests and suits." The application is based on use and registration (No. 1,525,819) in the United States. The applicant claimed priority based on its corresponding United States application and thus the effective filing date of the present application is May 16, 1988. The application was advertised for opposition purposes on August 23, 1995.

The opponent, Premiere Vision Inc., filed a statement of opposition on October 23, 1995, a copy of which was forwarded to the applicant on November 22, 1995. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant was, or should have been, aware of the opponent's previously used trade-mark E.Z. SPIRIT. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the trade-mark E.Z. SPIRIT registered under No. 385,340 for the following wares:

ladies' and men's, boys', girls' and children's sportswear, namely, pants, slacks, shorts, skirts, sweaters, t-shirts, blouses, shirts, jackets and tops.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(2)(a) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with the trade-mark E.Z. SPIRIT previously used in Canada by the opponent in association with the wares noted above. The fourth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's mark used for similar wares.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its Executive Vice President, Sales and Marketing, Emmanuel Perra. As its evidence, the applicant submitted an affidavit of its Senior Vice President, Treasurer,

Robert Qualls, and a trade-mark agent, Gladys Tibbo Witt. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground, it fails to raise a proper ground of opposition pursuant to Section 30(i) of the Act. The opponent alleged that the applicant was aware of the opponent's mark but failed to allege that the applicant was aware that its mark was confusing with the opponent's mark. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive although neither mark is inherently strong since the component EZ'S or E.Z. is suggestive of clothing with an easy or relaxed style or fit: see the unreported opposition decision in Haggar Clothing Company v. Premiere Vision Inc. (S.N. 729,026; December 18, 1998). In his affidavit, Mr. Perra states that the opponent has effected sales of E.Z. SPIRIT clothing throughout Canada for the period 1991-1996 in excess of \$9.6 million. Thus, the opponent's mark has become known to some extent in this country.

In his affidavit, Mr. Qualls states that his company has effected sales of clothing throughout Canada in association with the trade-marks EZ'S BY HAGGAR, HAGGAREZ'S and EZ'S for the period 1991-1995 totalling in excess of \$13.2 million. Thus, the applied for trade-mark has also become known to some extent in Canada.

Given that the opponent has failed to evidence use of its registered mark prior to 1991, the length of time the marks have been in use is not a material circumstance in the present case. As for the wares and trades of the parties, the wares of the parties are similar, the

applicant's wares comprising men's and boys' clothing and the opponent's wares consisting of wares for men, ladies, boys, girls and children. Both parties sell their wares principally through retail department stores. In fact, there is an overlap between the actual trades since both parties sell through EATONS and SEARS department stores across Canada.

As for Section 6(5)(e) of the Act, there is some degree of visual and phonetic resemblance between the marks at issue since they both commence with the letters "EZ." There is little resemblance between the marks in the ideas suggested. The applicant's mark suggests a product called EZ'S produced by an entity called Haggar whereas the opponent's mark is equivalent to the phrase "easy spirit."

The opponent's agent submitted that the words BY HAGGAR in the applicant's trade-mark suggest that EZ'S is a preexisting third party mark that has been appropriated by the Haggar Clothing Co. On the contrary, it is much more likely that consumers would view the words BY HAGGAR as underscoring the weak nature of the component EZ'S which is suggestive of clothing with an easy or relaxed style or fit.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence provided by the Witt affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

At the oral hearing, there was some discussion about the admissibility of the state of the register evidence in view of the decision in GSW Inc. v. Sta-Rite Industries Inc. (1999), 83 C.P.R.(3d) 281 (F.C.T.D.) wherein Mr. Justice Campbell held that a CD-ROM search of purported Trade-marks Office records was inadmissible as being hearsay evidence. In the present case, Ms. Witt also conducted a CD-ROM search. However, unlike in the GSW case, Ms. Witt provided evidence as to the source of the CD-ROM and as to its reliability as a

reasonably accurate reflection of the Trade-marks Office records. Thus, I have given the Witt search results full weight in this proceeding.

The Witt affidavit evidences more than two dozen trade-marks which include the component EZ, EASY or the like and are registered for clothing. Given that number of registered trade-marks, I am able to infer that a number of them are in active commercial use in Canada. Thus, I am able to conclude that consumers are used, to some extent, to seeing clothing trade-marks which include the component EZ, EASY or the like and would therefore be more likely to differentiate such marks based on their other components.

As a further additional surrounding circumstance, I have considered the fact that the two marks at issue have been used fairly extensively in the same area of trade for a number of years with no incidents of actual confusion having been evidenced by the opponent. In fact, both parties sell their goods through the EATON'S and SEARS department store chains and the Witt affidavit establishes that some 25 Canadian cities have outlets for both of those chains. Thus, it would appear that the wares of the parties have been sold in close proximity across Canada and yet no evidence of incidents of mistake or actual confusion has been provided. Although the absence of such evidence is not determinative of the issue of confusion, it is of particular significance in the present case given the widespread overlap in the actual channels of trade of the parties.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of (1) the fact that there is not a high degree of resemblance between the marks at issue, (2) the common use of clothing trade-marks incorporating the component EZ, EASY or the like and (3) the absence of evidence of incidents of mistake or actual confusion notwithstanding the fairly extensive contemporaneous use of the two marks, I find that the applicant has satisfied the onus on it to show that its applied for mark EZ'S BY HAGGAR is not confusing with the opponent's registered mark E.Z. SPIRIT. The second ground is therefore unsuccessful.

As for the third ground of opposition, there was an initial burden on the opponent to evidence use of its trade-mark prior to the applicant's filing date (i.e. - May 16, 1988).

Although the Perra affidavit evidences use of the opponent's mark from 1991 on, Mr. Perra did not provide evidence of any use of his company's mark prior to that date. Thus, the opponent has failed to meet its evidential burden and the third ground is also unsuccessful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - October 23, 1995): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

The fourth ground essentially turns on the issue of confusion between the marks of the parties as of the filing of the opposition. My conclusions respecting the second ground of opposition are, for the most part, also applicable to the fourth ground. Thus, I find that the marks were not confusing as of the material time. The fourth ground is therefore also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 2nd DAY OF FEBRUARY, 2000.

David J. Martin,
Member,
Trade Marks Opposition Board.