



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

**Citation: 2013 TMOB 122**  
**Date of Decision: 2013-07-11**

**IN THE MATTER OF AN OPPOSITION  
by Ben Sherman Group Limited to  
application No. 1,414,670 for the trade-  
mark Sherman in the name of Michele  
Knautz**

[1] On October 15, 2008, Michele Knautz (the Applicant) filed an application to register the trade-mark Sherman (the Mark) based on proposed use in Canada in association with “jewellery”.

[2] The application was advertised in the *Trade-marks Journal* of August 5, 2009.

[3] Ben Sherman Group Limited (the Opponent) filed a statement of opposition on October 5, 2009. The Applicant filed and served a counter statement essentially denying the Opponent’s allegations.

[4] In support of its opposition, the Opponent filed the affidavit of Lee Stafford Gage, Company Secretary and Legal Counsel of the Opponent, with Exhibits LSG1 – LSG6; and the affidavit of Maureen Cho, office assistant of the Opponent’s trade-marks agent, with Exhibits A – G. The affiants were not cross-examined.

[5] The Applicant did not file any evidence in support of her application.

[6] Both parties filed written arguments; an oral hearing was not held. It should be noted that the Applicant’s written argument is essentially a reiteration of the counter statement along with the unsubstantiated submissions that: (a) the Opponent has not proven the allegations in its

statement of opposition and thus failed to meet its evidential burden; and (b) the Applicant has met her legal burden.

### Grounds of Opposition

[7] The Opponent pleaded grounds of opposition under sections 38(2)(b), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). As one of the grounds was stricken by an interlocutory ruling of the Registrar dated May 10, 2010, the remaining grounds of opposition can be summarized as follows:

- a) the Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's registered trade-marks BEN SHERMAN (Nos. TMA590,020 and TMA714,020) and BEN SHERMAN JEANSWEAR (No. TMA651,264);
- b) the Applicant is not entitled to registration of the Mark under section 16(3)(a) of the Act in view of confusion with the Opponent's trade-mark BEN SHERMAN, previously used in Canada in association with jewellery;
- c) the Applicant is not entitled to registration of the Mark under section 16(3)(c) of the Act in view of confusion with the Opponent's trade-names Ben Sherman Group and Ben Sherman Group Limited previously used in Canada in association with jewellery; and
- d) the Mark is not distinctive under section 2 of the Act in that it is not adapted to distinguish the wares of the Applicant from those of the Opponent.

### Onus on the Parties

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that her application complies with the requirements of the Act. However, there is 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 [see *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD) at 298].

### Analysis of the Grounds of Opposition

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

[10] In considering the evidence, I disregard any opinions of Mr. Gage that go to the questions of fact and law to be determined by the Registrar in this proceeding. Insofar as the evidence provided by Ms. Cho is concerned, I note that it essentially consists in printouts of select pages that she obtained from third party websites. Even though Ms. Cho is an employee of the Opponent's trade-marks agent, she provides no opinions that need to be excluded from consideration pursuant to *Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* (2005) 43 CPR (4th) 21 (FC); aff'd (2006), 53 CPR (4th) 286 (FCA) 133.

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

[11] The material date for considering this 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)].

[12] I have exercised the Registrar's discretion to check the register in order to confirm the existence of the three registrations alleged by the Opponent [see *Quaker Oats Co of Canada/Cie Quaker Oats du Canada v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. I confirm that these registrations, which are detailed in Schedule "A" to this decision, are extant.

[13] Since the Opponent has satisfied its initial evidential burden, the question becomes whether the Applicant has met her legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trade-marks.

[14] 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.

[15] 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 each has 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]

[16] In my opinion, comparing the Mark and the trade-mark BEN SHERMAN of registration No. TMA590,020 will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and the trade-mark BEN SHERMAN registered for use in association with clothing, beachwear, sportswear, headgear, footwear, and articles of leather, then it would not be likely between the Mark and the trade-marks BEN SHERMAN registered for use in association with eyewear and articles of luggage (No. TMA714,020), and BEN SHERMAN JEANSWEAR registered for use in association with clothing (No. TMA651,264).

[17] In *Masterpiece, supra*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion 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... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[18] Thus, I now turn to the assessment of the likelihood of confusion between the Mark and the Opponent's registered trade-mark BEN SHERMAN (No. TMA590,020) having regard to the surrounding circumstances of this case, starting with the degree of resemblance between the marks.

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

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

[20] The Opponent submits that the parties' trade-marks are nearly identical; it contends that since the first portion of its trade-mark, BEN, "is merely a short, common forename element", the second portion, SHERMAN, is "the more dominant, distinctive element".

[21] In my view, the two components of the Opponent's mark namely, BEN and SHERMAN, are both fairly equally dominant. Nonetheless, to the extent that the Mark is solely "Sherman", I find that there is a fair degree of resemblance between the two marks in appearance and sound.

[22] In terms of ideas suggested, I find that the mark BEN SHERMAN suggests the name of an individual, which is consistent with Exhibit LSG1 of the Gage Affidavit that provides a short history of the brand since the early 1960s and refers to the departure of Ben Sherman, the company's founder, in the 1970s. As for the Mark, I find it could be perceived by the average consumer as either a given name or surname. Thus both trade-marks suggest individuals.

[23] Accordingly, I find that the overall consideration of the section 6(5)(e) factor favours the Opponent.

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

[24] The section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[25] As I am of the view that the Mark may be seen a given name or surname, I find that it has little inherent distinctiveness, if any (see by analogy the comment of Mr. Justice Binnie in *Mattel, Inc, supra*, para. 3, to the effect that the name Barbie, a common contraction of Barbara, does not have as such an inherent distinctive character). Further, there is no evidence to conclude that the Mark has acquired distinctiveness in Canada through promotion or use.

[26] Since I am of the view that BEN SHERMAN may be perceived as a name, I find that the Opponent's mark also has little inherent distinctiveness, if any. Further, despite the Opponent's submissions that its trade-mark BEN SHERMAN is famous and well-known throughout the world, including Canada, based on the following review of the Gage affidavit, I cannot make such a finding, nor can I conclude that the mark has achieved strong secondary meaning in Canada through extensive marketing and distribution.

[27] Mr. Gage explains that the Opponent is a manufacturer and retailer of consumer goods in the United Kingdom. Its predecessor in title began selling shirts under the BEN SHERMAN brand in the UK in the late 1950s/early 1960s; products expanded to include a full range of merchandising, including jewellery, watches, eyewear and footwear since then. The Opponent, incorporated in 1993, has annual turnovers ranging from 11.7 to 56.8 million pounds sterling between 1994 and 2009. However, Mr. Gage does not indicate when shirts or any other products associated with the mark BEN SHERMAN were first sold in Canada.

[28] The Opponent's evidence deals with sales and promotion in different parts of the world. In addition to being rather succinct, the evidence concerning sales and promotion in Canada is introduced together with evidence concerning the United States. It includes the following:

- the Opponent distributes its own products in Canada;
- the Opponent has approximately 1,924 wholesale clothing customers and 456 wholesale footwear customers in the United States and Canada, with sales turnover of more than US\$44 million for the year ended on May 31, 2006; and
- there has been extensive promotion of the Opponent's products in the United States and in Canada, including ads in numerous publications, with annual promotional and advertising expenditures of US\$3 million in 2004 and of approximately US\$2.6 million in 2005 and 2006 annually for the two countries combined.

[29] Appended as Exhibit LSG3 to the Gage affidavit are "examples of promotional material dating back many years". Upon review of Exhibit LSG3, I note that it appears to consist of copies of advertising campaigns since 1997 showing various pieces of clothing, footwear, and fashion accessory items bearing the trade-mark BEN SHERMAN. However, I find it can fairly

be concluded that materials showing pricing information in sterling pounds with contact information in Europe do not relate to Canadian advertising campaigns.

[30] Mr. Gage states that advertisements and promotions have appeared in many publications and specifically identifies some of them, including *Esquire*, *People* and *Vogue*. I can take judicial notice that there is some circulation of these particular magazines in Canada [see *Conde Nast Publications Inc v Gozlan Brothers Ltd* (1980), 49 CPR (2d) 250 at 251 (FCTD), *Milliken & Co v Keystone Industries (1970) Ltd* (1986), 12 CPR (3d) 166 (TMOB), and *Timberland Co v Wrangler Apparel Corp* (2004), 38 CPR (4th) 178 (TMOB)]. That being said, I am at most prepared to infer that the Opponent started advertising the BEN SHERMAN products in magazines circulating in Canada only in 2004 because this is the earliest year for which Canadian promotional and advertising expenditures have been provided by the Opponent.

[31] The general and summary nature of the Opponent's evidence concerning sales, advertising and promotion of its products in Canada does not allow me to assess with any precision the extent to which the mark BEN SHERMAN has become known in Canada. Nevertheless, even though the Opponent did not provide a breakdown of its sales figures by product lines or country, it remains that the Opponent provided sales figures extending to Canada. Furthermore, even though the extent of the Opponent's advertising expenditures for Canada is unclear, there is indication that Canadians have been exposed to some of the Opponent's advertising featuring products in association with the trade-mark BEN SHERMAN.

[32] In the end, since there is no evidence of promotion and use of the Mark in Canada, it can only be concluded that the Opponent's mark BEN SHERMAN has become known in Canada to a larger extent than the Mark. Accordingly, the section 6(5)(a) factor lends support to the Opponent's case.

*Section 6(5)(b) – the length of time the trade-marks have been in use*

[33] As I previously mentioned, Mr. Gage does not indicate when shirts or any other products associated with the mark BEN SHERMAN were first sold in Canada. However, I note that the earliest date of first use claimed in registration No. TMA590,020 is “at least as early as 1995” for “clothing namely, shirts”.

[34] The Gage affidavit does not suffice to establish continuous use of the mark BEN SHERMAN in Canada since at least as early as 1995. However, it remains that the application for the Mark is based upon proposed use in Canada and there is no evidence that the Mark has been used to date.

[35] Accordingly, the section 6(5)(b) factor lends support to the Opponent's case, although not as significantly as argued by the Opponent.

*Sections 6(5)(c) and (d) – the nature of the wares and the nature of the trade*

[36] When considering sections 6(5)(c) and (d) of the Act, it is the statements of wares as defined in the application for the Mark and in the Opponent's registration No. TMA590,020 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)].

[37] The statement of wares of the Opponent's registration includes men's, women's and boy's clothing, beachwear, sportswear, headgear, footwear, and articles of leather. In terms of its channel of trade, the Gage affidavit provides that the Opponent distributes its own products to numerous wholesale clothing and footwear customers in Canada and in the United States, who in turn sell the BEN SHERMAN products in thousands of retail outlets in the two countries. Mr. Gage also states that the Opponent's products are featured in around 30 million mail order catalogues every year, although it is unclear the extent to which the mail orders cover its Canadian operations, if any.

[38] By comparison, the Mark is associated with jewellery; no evidence of the Applicant's channels of trade was provided.

[39] The Opponent submits that both parties' wares fall within the same general class of "fashion", which includes clothing and accessories, such as jewellery. It also submits that there is a close connection between the two types of wares in that clothing and jewellery are designed to be used together.



[40] The wares associated with the Mark are intrinsically different from those covered by the Opponent's registration. However, it is not necessary that the parties operate in the same general field or industry or that the respective wares be of the same type for there to be a likelihood of confusion. Section 6(2) of the Act states that confusion may result whether or not the wares are of the same general class. Moreover, the Opponent's contention as to a connection between clothing and jewellery is not without merit. As stated by my colleague Member Robitaille in *Emilio Pucci International BV v El Corte Ingles, SA*, 2011 TMOB 32 at paragraph 57: "An argument can be made that [...jewellery...] may to some extent be considered as 'clothing' or 'fashion' accessories. Jewellery, costume jewellery and watches in particular are decorative items that supplement and complement clothes."

[41] Furthermore, the Opponent relies on the Cho affidavit as evidence demonstrating that various Canadian retailers sell clothing in conjunction with fashion accessories, including jewellery.

[42] Ms. Cho files as Exhibits A to G to her affidavit printouts of select pages from third party websites that she accessed on June 7, 2010, namely: *holtrenfrew.com*; *harryrosen.com*; *mexx.ca*; *guess.ca*; *lacoste.com/can*; *canadaroots.com*; and *clubmonaco.com*. The printouts show photos of clothing items and fashion accessories such as necklaces, rings, cuffs, chains, and watches sold by the same retailers; there is also information on the location of the retailers' stores in Canada.

[43] While excerpts of third party websites are generally considered hearsay and cannot be relied upon as evidence of the truth of their contents, I am satisfied that some weight may be placed on the Cho Affidavit as showing an overlap in the channels of trade for jewellery and clothing items. Consequently, in the absence of evidence from the Applicant, for the purposes of assessing confusion I conclude that there is potential for overlap between the parties' channels of trade.

[44] Accordingly, the overall consideration of the sections 6(5)(c) and (d) factors lends support to the Opponent's case.

*Conclusion on the likelihood of confusion*

[45] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the application for the Mark complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[46] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances of this case, I am not satisfied that the Applicant has discharged her legal onus of establishing that there is no reasonable likelihood of confusion between the Mark and the trade-mark BEN SHERMAN of registration No TMA590,020.

[47] As I accept the section 12(1)(d) ground of opposition based upon registration No. TMA590,020, I am not considering the ground of opposition based on registration No. TMA714,020 for BEN SHERMAN and registration No. TMA651,264 for BEN SHERMAN JEANSWEAR.

Non-entitlement Under Section 16(3)(a) of the Act

[48] The pleaded ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark in view of confusion with the trade-mark BEN SHERMAN, previously used in Canada by the Opponent in association with jewellery.

[49] The material date for considering this ground of opposition is the filing date of the application for the Mark.

[50] The Opponent has the initial burden of proving that its trade-mark BEN SHERMAN had been used in Canada in association with jewellery before October 15, 2008 and had not been abandoned at the date of advertisement of the application, namely August 5, 2009 [see section 16(5) of the Act].

[51] The Opponent submits that Exhibit LSG5 to the Gage Affidavit provides evidence of use of the mark BEN SHERMAN in association with jewellery in Canada. The exhibit includes

printouts of listings from *Ebay.ca* for the sale of cufflinks, watches and bracelets described as Ben Sherman items, as well as excerpts from the Opponent's North American website *www.benshermanusa.com* purported to show cufflinks for sale under the BEN SHERMAN brand.

[52] The evidence from the third party's website *Ebay.ca* is of no assistance to the Opponent's case because the printouts are dated June 4, 2010, which is subsequent to the material date. Likewise, the excerpts from the Opponent's North American website are dated June 4, 2010 and therefore of no assistance to its case. Accordingly, I find it not necessary to discuss whether or not such evidence establishes use of the trade-mark BEN SHERMAN in Canada in association with jewellery under section 4(1) of the Act.

[53] Furthermore, as I previously indicated, the Opponent's evidence concerning Canadian sales is introduced together with evidence concerning the United States; the Opponent did not provide a breakdown of its sales figures by product lines or country. The ambiguity of the evidence must be resolved against the Opponent [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[54] In the end, I conclude that the Gage affidavit does not provide evidence establishing sales of any jewellery items associated with its trade-mark BEN SHERMAN in Canada prior to the material date.

[55] Accordingly, I dismiss the section 16(3)(a) ground of opposition for the Opponent's failure to meet its initial evidential burden.

#### Non-entitlement Under Section 16(3)(c) of the Act

[56] The material date for considering this ground of opposition is also the filing date of the application for the Mark.

[57] The Opponent has the initial burden of proving that its alleged trade-names Ben Sherman Group and Ben Sherman Group Limited have been used in Canada in association with jewelry, as pleaded, before October 15, 2008 and had not been abandoned at the date of advertisement of the application.

[58] The Opponent did not provide any evidence about the use of its trade-names in Canada. In fact, Mr. Gage does not reference the Opponent's trade-names; he essentially introduces evidence concerning the Opponent's trade-mark BEN SHERMAN.

[59] Accordingly, I dismiss the section 16(3)(c) ground of opposition for failure of the Opponent to satisfy its initial evidential burden.

Non-distinctiveness of the Mark

[60] As I have addressed three grounds of opposition and I have decided one of them in favour of the Opponent, I will not consider the ground of opposition based upon non-distinctiveness, especially since the Applicant has shown little interest in this proceeding.

Disposition

[61] Having accepted the section 12(1)(d) ground of opposition based on registration No. TMA590,020 for the trade-mark BEN SHERMAN, 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.

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

Schedule "A"

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
BEN SHERMAN	TMA590,020	(1) Clothing namely, shirts. (2) Men's and women's clothing, namely shirts, t-shirts, shorts, slacks, trousers, sweatshirts, pullovers, ties, jackets, overcoats, and scarves; footwear, namely dress shoes and sport shoes, headgear, namely hats and caps; articles of leather and imitation leather, namely belts, bags, rucksacks, wallets and key cases; card cases and parts and fittings for all the aforesaid goods, namely, buckles, buttons, ribbons and lace. (3) Men's and boys' clothing namely, shirts; beachwear, namely swimsuits, t-shirts, polo-shirts, shorts, sun hats and caps. (4) Men's and women's clothing, namely shirts, blouses, and shorts; beachwear, namely swimsuits, t-shirts, polo-shirts, shorts, sun hats and caps; men's and boy's clothing, namely ties; dressing gowns, jackets and pajamas; sailing wear, namely t-shirts, polo-shirts, shorts, pullovers, sweatshirts, windbreakers, trousers, jackets, coats, hats and caps. (5) Suits; jackets; trousers; jeans; chinos; shirts; T-shirts; blouses; sweatshirts; pullovers; ties; men's underwear; overcoats; sportswear namely, shorts, track suits and tops for use in sporting activities; shoes and caps.
BEN SHERMAN JEANSWEAR	TMA651,264	(1) Clothing, namely jackets and jeans.
BEN SHERMAN	TMA714,020	(1) Eyeglasses; sunglasses; cases for eyeglasses and sunglasses; articles of luggage; and travel bags.