

**IN THE MATTER OF AN OPPOSITION by J2  
Fashion Inc. to application No. 1,262,197 for the  
trade-mark KIER + J2 & Design filed by Clio  
Apparel Inc.**

---

[1] On June 22, 2005, Clio Apparel Inc. (the Applicant) filed an application to register the trade-mark KIER + J2 & Design (the Mark) based upon:

1. use of the trade-mark in Canada in association with women's sweaters and tops since at least as early as June 2004;
2. use and registration of the trade-mark in the United States of America in association with clothing, namely, women's pants, blouses, sweaters, tops, dresses and skirts;
3. proposed use of the trade-mark in association with clothing, namely, women's pants, blouses, dresses and skirts.

[2] The Mark is shown below:

Kier + J<sup>2</sup>

[3] The application was advertised for opposition purposes in the Trade-marks Journal of March 7, 2007.

[4] On May 7, 2007, J2 Fashion Inc. (the Opponent) filed a statement of opposition. Grounds of opposition have been pleaded pursuant to s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[5] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed affidavits of Simon Cheung (the Opponent's Director) and Carrie A. Schulz (a trade-mark agent).

[7] The Applicant elected not to file any evidence and did not cross-examine the Opponent's affiants.

[8] Only the Opponent filed a written argument. An oral hearing was not requested.

### Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Likelihood of Confusion

[10] In its written argument, the Opponent submits that the central issue in these proceedings is whether there is a likelihood of confusion between the Opponent's trade-mark J2 and trade-name J2 Fashion Inc. and the applied-for Mark. This issue is central to each of the grounds of opposition pleaded under s. 38(2)(b), (c) and (d). The material date with respect to each of these grounds differs. The Opponent's case is strongest with respect to the s. 38(2)(b) ground of opposition, namely that the Mark is not registrable under s. 12(1)(d) in that it is confusing with the registered mark J2, because the material date with respect to that ground is today's date.

### *test for confusion*

[11] 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.

[12] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

[13] I will now assess each of the factors insofar as they relate to the s. 12(1)(d) ground of opposition. The Opponent has satisfied its initial burden under s. 12(1)(d) as its registration for J2, No. TMA656,371, is extant.

*s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known*

[14] Each of the marks is inherently distinctive since neither relates directly to the associated wares.

[15] A mark may acquire distinctiveness through use or promotion. There is no evidence of any use or promotion of the Applicant's Mark. On the other hand, the Opponent has evidenced use and promotion of its mark in Canada. In particular, between May 2003 and February 2008 revenue from the Opponent's J2 clothing exceeded \$236,000 and more than \$15,740 was spent advertising the J2 mark by means of radio, the Internet and newspaper advertisements.

*s. 6(5)(b) - the length of time each mark has been in use*

[16] According to Mr. Cheung, the Opponent began use of its mark at least as early as May 2003, which is earlier than the Applicant's claimed date of first use of June 2004.

*s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade*

[17] Both parties' marks are associated with clothing. The Opponent has registered J2 for men's, ladies' and youth's/junior's clothing apparel, namely, shirts, tops, blouses, pants, jeans, capris, skirts, shorts, skorts, dresses, sweaters, cardigans, jumpsuits, sweat suits, sarongs, wraps, vests, coats, jackets, blazers, ponchos, swim suits; underwear, namely, bras, bustiers, briefs,

panties, thongs, camisoles, undershirts, stockings, leggings, tights, pyjamas; footwear, namely shoes, socks, boots, sneakers, sandals, slippers, flip flops; accessories namely, hats, caps, fedoras, toques, visors, headbands, hairpins, scarves, legwarmers, backpacks, bags, purses, fanny packs, handbags, tote bags, wallets, umbrellas, towels, belts and gloves. The Opponent's evidence shows how J2 appears on tags attached to various types of clothing, as well as on clothing store windows and on bags in which the purchased wares are placed.

[18] As the parties' wares are similar, it is reasonable to assume that the nature of the parties' trades would also be similar.

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

[19] The marks resemble one another because the Applicant's Mark incorporates the Opponent's mark. There is no evidence that J2 is a descriptive or common formative in the clothing field; to the contrary, the evidence of Ms. Schulz indicates that as of February 4, 2008, the only mark on the Trade-marks Register that included both the letter J and the numeral 2 in the clothing field, other than the marks at issue here, is STUDIO J 24, which is owned by a third party.

[20] The first component of a mark is often considered more important for the purpose of distinction. [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)] Here the common feature is not the first component of the Applicant's Mark. The Applicant has prefaced the common component with "KIER +". KIER is a distinctive word, but the fact that the Applicant has chosen to insert a plus sign between KIER and J2 might be interpreted as indicating that there has been a merger or partnership between KIER and J2.

[21] I have not forgotten that the Applicant's Mark is a design mark and that some people might read the latter portion of the mark as "J squared". I will also mention that the Opponent sometimes uses a design version of J2 in which the 2 appears in smaller font superimposed over the bottom right-hand portion of the J.

[22] Overall, the marks only resemble each other to a small degree visually and aurally, with their resemblance being less with respect to the ideas suggested.

*conclusion re likelihood of confusion*

[23] Even though the resemblance between the marks is far from overwhelming, I have concluded that the Applicant has not met its legal burden to satisfy me that on a balance of probabilities confusion as to the source of the marked wares is not likely. I base my conclusion on the fact that each of the s. 6(5)(a) through (d) factors clearly favours the Opponent, the Applicant has filed neither evidence nor argument in support of its application, and the Applicant has included the Opponent's mark in its Mark in a way that suggests that there may have been a merger with the source of the J2 clothing. The s. 12(1)(d) ground therefore succeeds.

[24] If I were to assess each of the s. 6(5) factors as of the Applicant's claimed date of first use or as of the filing date of the application (as required by the grounds pleaded pursuant to s. 38(2)(c)), the main difference would be that there would be no specific evidence of the distinctiveness acquired by the Opponent's mark as of those material dates. Nevertheless, I would still conclude that the Applicant has not met its legal burden.

Disposition

[25] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the application pursuant to s. 38(8) of the Act, for the reasons set out above.

DATED AT TORONTO, ONTARIO, THIS 16<sup>th</sup> DAY OF OCTOBER 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board