

**IN THE MATTER OF AN OPPOSITION by BOUTIQUE
TRISTAN & ISEUT INC. to application No. 789,122 for the
trade-mark JOE AMERICA filed by JOE AMERICA LIMITED
LIABILITY COMPANY**

On August 2, 1995, the applicant, JOE AMERICA LIMITED LIABILITY COMPANY, filed an application to register the trade-mark JOE AMERICA based on proposed use of the trade-mark in Canada in association with the following wares:

“Clothing and clothing accessories, namely: swimwear, beach coverups, robes, pants, shorts, sweaters, turtlenecks, anoraks, coats, jackets, vests, dresses, skirts, blouses, dungarees, rainwear, namely: rain coats and rain hats, foul weather gear, shirts, jeans, overalls, sleepwear, lingerie, sweatshirts, sweat suits, warm-up suits, T-shirts, tops, underclothes, gloves, mittens, leotards, tank tops, halter tops, jumpsuits, jogging suits, stockings, anklets, knee high stockings, pantyhose, tights, thermal socks, socks, sweatsocks, leg warmers, neckwear, namely: mufflers, sashes, scarves, shawls, and neckties, belts, wrist bands; headgear, namely: bandannas, headbands, berets, ear muffs, hats, caps, rain hats, visors, scarves and bathing caps; housewares, namely: bakeware, basins, baskets (not of metal), mugs, cutting boards, bottle openers, barwear, bowls, boxes, brooms, brushes, toothbrushes (electric and non-electric), buckets, shower caddies, pet cages, can openers (electric and non-electric), candles holders, canister sets, garbage cans, trash containers, carpet sweepers, casseroles, molds, cleaning cloths, coasters, cups, coffee grinders, coffee pots (electric and non-electric), coffee servers made of non-precious metal, confectioners' molds, all purpose portable household containers, cookies cutters, cork screws, cosmetic wipes, cotton balls, ironing boards, ironing board covers, decanters, knives, forks, spoons, serving spoons, dispensers for liquid soap, drain stoppers, drinking glasses, drying racks, dust pans, furniture dusters, egg beaters, figurines of non-precious materials, fireplace brushes, flour sifters, flower pots, fly swatters, frying pans, funnels, garden hoses and nozzles, gloves, graters, griddles, grills, hair brushes and combs; hose nozzles, portable ice chests, ice cube molds, insulated containers, juicers (electric and non-electric), kettles (electric and non-electric), kitchen ladles, kitchen knives, knife blocks, electric carving knives, lawn sprinklers, lazy susans, pot lids, lint removers (electric and non-electric), litter boxes, lunch boxes, metal wool for cleaning, mixing spoons, mops, mouse traps, napkins rings of non-precious materials, oil, oil cans, gas cans, paper plates and cups, paper towels, perfumes atomizers sold empty, pet feeding dishes, pie servers, rolling pins, pitchers, plastic cups and plates, platters made of non-precious materials, powder puffs, pre-moistened towelettes for cleaning, clothes drying racks, spice racks, towel racks, dish racks, cleaning rags, salt and pepper shakers, saucepans, serving spoons, shirt stretchers, sweater stretchers, shoe horns, shoe trees, soap holders, spatulas, squeegees, streamer baskets, drawer and closet organizers, stove burner covers, strainers, syringes, toilet brushes, toilet paper holders, towel bars and holders, tubs, vacuum bottles, vases, hot water bottles, whisks, wine racks, laundry bags, clothesline, disposable container liners, cord, drop cloths, garment bags, and twine; radios, clocks, jewelry, watches, luggage, backpacks, and belts.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 11, 1996 and the opponent, BOUTIQUE TRISTAN & ISEUT INC., filed a statement of opposition on February 11, 1997, a copy of which was forwarded to the applicant on February 19, 1997. The applicant served and filed a counter statement in response to the statement of opposition

on March 7, 1997. The opponent filed as its evidence the affidavit of Gilles R. Fortin while the applicant elected not to submit any evidence. Both parties submitted a written argument and both were represented at an oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

- a) The applied for trade-mark is not registrable in view of paragraphs 38(2)(b) and 12(1)(d) of the *Trade-marks Act* in that the trade-mark JOE AMERICA is confusing with the opponent's registered trade-mark AMERICA, registration No. 348,902;
- b) The applicant is not the person entitled to registration of the trade-mark JOE AMERICA in view of the provisions of paragraphs 38(2)(c), 16(3)(a) and 16(3)(b) of the *Trade-marks Act* in that, as of the filing date of the present application, the applicant's trade-mark JOE AMERICA was confusing with the opponent's registered trade-mark AMERICA and with the opponent's pending trade-mark application for the mark TRISTAN AMERICA which had been previously used in Canada;
- c) The applied for trade-mark is not registrable in view of paragraph 38(2)(d) of the *Trade-marks Act* in that the applicant's trade-mark was not distinctive nor was it adapted to distinguish the applicant's wares in association with which it intended to use its trade-mark from those of other owners including the opponent which has used the trade-marks AMERICA and TRISTAN AMERICA in association with its services.

In addition to the above grounds, the opponent asserted in its statement of opposition that, as of the filing date of the present application, as well as at the date of advertisement of the present application, it was using the trade-marks AMERICA and TRISTAN AMERICA to a significant extent in association with all the wares and the services described in its statement of opposition. In this regard, the opponent asserts that its trade-mark AMERICA has been used and registered under registration No. 348,902 in association with the following wares:

“Vêtements et accessoires vestimentaires pour hommes, nommément: chemises, chandails, pantalons, vestons, manteaux et cravates”.

and in association with the following services:

“Exploitation de boutiques au détail, spécialisées dans la vente de vêtements et d'accessoires vestimentaires pour hommes.”

Further, the opponent asserts that its trade-mark TRISTAN AMERICA is the subject of pending application No. 750,342 and has been used in association with the following services:

“Exploitation de boutiques au détail, spécialisées dans la vente de vêtements et d'accessoires vestimentaires pour dames et pour hommes.”

In assessing whether there would be a reasonable likelihood of confusion between the applicant's trade-mark JOE AMERICA and the opponent's registered trade-mark AMERICA, registration No. 348,902, in relation to the paragraph 12(1)(d) ground, the Registrar must have regard to all the surrounding circumstances including those specifically enumerated in Subsection 6(5) of the *Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date in relation to the paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], the opponent's registered trade-mark AMERICA possesses little inherent distinctiveness in view of its geographic significance. Further, the applicant's trade-mark JOE AMERICA possesses some measure of inherent distinctiveness when considered in its entirety even though the word JOE has a given name significance and the word AMERICA has a geographic significance and therefore neither of these elements add much inherent distinctiveness to the applicant's mark.

As for the extent to which the trade-marks at issue have become known [para.6(5)(a)] and the length of time the marks have been in use [para.6(5)(b)], no evidence has been furnished by the applicant and its trade-mark JOE AMERICA must be considered as not having become known to any extent in Canada. On the other hand, the Fortin affidavit establishes that the opponent was operating 25 retail outlets selling men's clothing and accessories in association with the trade-mark AMERICA in the province of Quebec as of November of 1994, as well as an additional ten such retail outlets in the province of Ontario as of that date. Further, Mr. Fortin, President of the opponent, sets forth the annual sales of clothing and accessories through the opponent's retail stores from 1981 to 1997, the total exceeding \$180,000,000. As a result, the extent to which the trade-marks at issue have become known and the length of time the marks have been in use both clearly favour the opponent.

With respect to the nature of the wares and services associated with the trade-marks at issue [para.6(5)(c)] and the nature of the trade of the parties [para.6(5)(d)], it is the applicant's statement of wares and the statements of wares and services covered in the opponent's registration which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in an application or registration [see, in this regard, *McDonald's Corporation v. Coffee Hut Stores Ltd.*, 68 C.P.R.(3d) 168, at p.169 (F.C.A.)]. In the present opposition, there is no ambiguity as to the wares and services covered in the present application and the opponent's registration.

With the exception of "belts", the applicant's wares identified under the general category of "housewares" bear no similarity to the wares or services covered in registration No. 348,902 and would not travel through the same channels of trade. On the other hand, the shirts, sweaters, pants, vests, coats and ties covered in registration No. 348,902 overlap the applicant's pants, shorts, sweaters, turtlenecks, anoraks, coats, jackets, vests, T-shirts, sweatshirts, sweat suits, warm-up suits, thermal socks, socks, sweatsocks, rainwear, namely: rain coats and rain hats, foul weather gear, shirts, tops, jeans, overalls, robes, neckties, jogging suits, tank tops, dungarees, neckwear, namely: mufflers, sashes, scarves, belts, wrist bands; headgear, namely: bandannas, headbands, berets, ear muffs, hats, caps, rain hats, visors, scarves, swimwear, gloves and mittens. Further, I would expect that the channels of trade associated with these wares would or could be the same. As for the applicant's beach coverups, dresses, skirts, blouses, sleepwear, lingerie, underclothes, leotards, halter tops, jumpsuits, stockings, anklets, knee high stockings, pantyhose, tights, leg warmers and shawls, these wares are intended primarily for women and they differ specifically from the wares and services covered in the opponent's registration. However, since boutiques specializing in the sale of clothing and accessories for men and women could be selling the wares of both parties, there

could be a potential overlap in the channels of trade associated with these wares and with the opponent's wares and services.

With respect to the degree of resemblance between the trade-marks at issue [para.6(5)(e)], the applicant's trade-mark JOE AMERICA and the opponent's registered trade-mark AMERICA are similar in appearance and in sounding and, to the extent that both marks suggest an association with America, the marks suggest similar ideas.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the opponent's evidence establishes that it has used the trade-mark TRISTAN AMERICA in association with the operation of men's and women's retail clothing stores. In paragraph 38 of his affidavit, Mr. Fortin sets out the annual retail sales figures in Canada of clothing and accessories sold through the TRISTAN AMERICA boutiques from 1994 to 1997, the total of such sales exceeding \$66,000,000. Thus, the opponent has used a mark comprising a given name in combination with the word AMERICA as applied to the operation of boutiques selling clothing and accessories which could be used by both women and men.

Having regard to the foregoing and, in particular, to the fact that the trade-marks at issue are similar in appearance, sounding and in the ideas suggested and are applied to clothing which could travel through the same channels of trade, and bearing in mind that the opponent has made relatively extensive use of its registered trade-mark AMERICA in Canada and has also used the trade-mark TRISTAN AMERICA in association with the operation of boutiques selling clothing and accessories for women and men, I find that the applicant has failed to meet the legal burden on it in respect of the issue of confusion between its trade-mark JOE AMERICA as applied to all the clothing and clothing accessories covered in the present application and the opponent's registered trade-mark AMERICA. On the other hand, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark JOE AMERICA as applied to its housewares excluding belts and the opponent's registered trade-mark AMERICA, bearing in mind the differences between the applicant's housewares and the opponent's wares and services and the different channels of trade associated with these wares and services.

The second ground is based on paragraphs 16(3)(a) and (b) of the *Act*, the opponent relying on its prior use of its trade-marks AMERICA and TRISTAN AMERICA and on its previously filed application for registration of the trade-mark TRISTAN AMERICA in challenging the applicant's entitlement to registration of the trade-mark JOE AMERICA. The Fortin affidavit establishes the opponent's prior use of its trade-marks AMERICA and TRISTAN AMERICA, as well as its non-abandonment of these marks as of the date of advertisement of the present application. Furthermore, application No. 750,342 for the trade-mark TRISTAN AMERICA was filed prior to the filing date of the present application and was pending as of the date of advertisement of the present application. The opponent has therefore met the initial burden on it under subsections 16(5) and 17(1) in relation to the 16(3)(a) ground and under subsection 16(4) in relation to the 16(3)(b) ground. Thus, both grounds turn on the issue of confusion between the applicant's trade-mark JOE AMERICA and the opponent's previously used trade-marks AMERICA and TRISTAN AMERICA and its previously filed application for the latter mark. In both instances, the legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the filing date of the present application.

With respect to the likelihood of confusion between the applicant's trade-mark JOE AMERICA and the opponent's trade-mark AMERICA, my previous comments concerning the surrounding circumstances in assessing the issue of confusion in relation to the first ground continue to apply. I find therefore that the applicant has not met the legal burden on it of showing that there would be no reasonable likelihood of confusion between its trade-mark JOE AMERICA as applied to its clothing and clothing accessories and the opponent's previously used trade-mark AMERICA as applied to clothing and accessories as of the filing date of the present application. As a result, this aspect of the second ground is successful. I also find that the applicant has failed to meet the legal burden on it of showing that there would be no reasonable likelihood of confusion between its trade-mark JOE AMERICA as applied to its clothing and accessories and the opponent's trade-mark TRISTAN AMERICA in that the applicant's clothing and accessories are related to the services associated with the trade-mark TRISTAN AMERICA and trade-marks JOE AMERICA and TRISTAN AMERICA bear some similarity in appearance and are similar in the ideas suggested as both marks include a given name followed by the word AMERICA. On the other hand, there would

be no reasonable likelihood of confusion between the applicant's trade-mark JOE AMERICA as applied to its "housewares" and the opponent's trade-mark TRISTAN AMERICA as applied to the operation of retail stores selling men's and women's clothing and accessories, bearing in mind the differences between the applicant's "housewares" and the opponent's operation of clothing boutiques and the nature of the trade associated with these wares and services.

Having concluded that the opponent's first two grounds of opposition are successful in relation to the clothing and accessories covered in the present application, I find that the final ground is also successful in relation to these wares. On the other hand, having also found that there would be no reasonable likelihood of confusion between the applicant's trade-mark JOE AMERICA as applied to its "housewares" excluding belts and the opponent's trade-marks AMERICA and TRISTAN AMERICA in the first and second grounds, I have likewise concluded that the third ground is also unsuccessful in relation to the "housewares" excluding belts.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the present application as applied to the following wares:

"Clothing and clothing accessories, namely: swimwear, beach coverups, robes, pants, shorts, sweaters, turtlenecks, anoraks, coats, jackets, vests, dresses, skirts, blouses, dungarees, rainwear, namely: rain coats and rain hats, foul weather gear, shirts, jeans, overalls, sleepwear, lingerie, sweatshirts, sweat suits, warm-up suits, T-shirts, tops, underclothes, gloves, mittens, leotards, tank tops, halter tops, jumpsuits, jogging suits, stockings, anklets, knee high stockings, pantyhose, tights, thermal socks, socks, sweatsocks, leg warmers, neckwear, namely: mufflers, sashes, scarves, shawls, and neckties, belts, wrist bands; headgear, namely: bandannas, headbands, berets, ear muffs, hats, caps, rain hats, visors, scarves and bathing caps;"

and otherwise reject the opponent's opposition to registration of the applicant's trade-mark JOE AMERICA as applied to the following wares:

"housewares, namely: bakeware, basins, baskets (not of metal), mugs, cutting boards, bottle openers, barwear, bowls, boxes, brooms, brushes, toothbrushes (electric and non-electric), buckets, shower caddies, pet cages, can openers (electric and non-electric), candles holders, canister sets, garbage cans, trash containers, carpet sweepers, casseroles, molds, cleaning cloths, coasters, cups, coffee grinders, coffee pots (electric and non-electric), coffee servers made of non-precious metal, confectioners' molds, all purpose portable household containers, cookies cutters, cork screws, cosmetic wipes, cotton balls, ironing boards, ironing board covers, decanters, knives, forks, spoons, serving spoons, dispensers for liquid soap, drain stoppers, drinking glasses, drying racks, dust pans, furniture dusters, egg beaters, figurines of non-precious materials, fireplace brushes, flour sifters, flower pots, fly swatters,

frying pans, funnels, garden hoses and nozzles, gloves, graters, griddles, grills, hair brushes and combs; hose nozzles, portable ice chests, ice cube molds, insulated containers, juicers (electric and non-electric), kettles (electric and non-electric), kitchen ladles, kitchen knives, knife blocks, electric carving knives, lawn sprinklers, lazy susans, pot lids, lint removers (electric and non-electric), litter boxes, lunch boxes, metal wool for cleaning, mixing spoons, mops, mouse traps, napkins rings of non-precious materials, oil, oil cans, gas cans, paper plates and cups, paper towels, perfumes atomizers sold empty, pet feeding dishes, pie servers, rolling pins, pitchers, plastic cups and plates, platters made of non-precious materials, powder puffs, pre-moistened towelettes for cleaning, clothes drying racks, spice racks, towel racks, dish racks, cleaning rags, salt and pepper shakers, saucepans, serving spoons, shirt stretchers, sweater stretchers, shoe horns, shoe trees, soap holders, spatulas, squeegees, streamer baskets, drawer and closet organizers, stove burner covers, strainers, syringes, toilet brushes, toilet paper holders, towel bars and holders, tubs, vacuum bottles, vases, hot water bottles, whisks, wine racks, laundry bags, clothesline, disposable container liners, cord, drop cloths, garment bags, and twine; radios, clocks, jewelry, watches, luggage, backpacks.”

In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC THIS 30th DAY OF NOVEMBER, 2000.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.