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

Citation: 2017 TMOB 89

Date of Decision: 2017-07-28

IN THE MATTER OF AN OPPOSITION

Elektra Printz Gorski

Opponent

and

Henrietta Colleen Prasad

Applicant

1,622,359 for Lettuce Turnip the Beet

Application

INTRODUCTION

[1] Elektra Printz Gorski (the Opponent) is an independent designer of clothing and accessories featuring the LETTUCE TURNIP THE BEET trade-mark. Ms. Gorski is based in the United States and since 2011, she has sold shirts featuring this trade-mark through the e-commerce website Etsy.

[2] In 2013, Henrietta Colleen Prasad (the Applicant) filed an application to register the trade-mark Lettuce Turnip the Beet in association with a variety of goods and services including clothing, clothing accessories and retail services. The Opponent opposed this application.

[3] For the reasons that follow, I find that the application should be refused as the Applicant has failed to show that she is the person entitled to register the trade-mark Lettuce Turnip the Beet pursuant to section 16(3) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

FILE HISTORY

[4] On April 15, 2013, the Applicant filed an application to register the trade-mark Lettuce Turnip the Beet (the Mark) based on her proposed use of the Mark in Canada in association with the following Goods and Services (as amended):

Goods:

(1) Clothing, namely, t-shirts, shirts, tank tops, sweatshirts, sweaters, jerseys, jumpers, pants, sweatpants, shorts, skirts, dresses, jackets, coats, vests, underwear, socks, warm-up suits, bodysuits, leotards, tights, leggings, leg warmers; headwear, namely, hats, caps, toques, visors, headbands, bandanas; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, mittens, gloves; sandals; souvenirs, namely, postcards, and photographs; novelty items, namely, magnets, keychains, pins, stickers, mugs, and glassware. Yoga mats, yoga mat carrying cases, yoga mat straps, yoga backpacks, yoga bricks (blocks); handbags, mesh bags, fanny packs, water bottle carriers, messenger bags, cosmetic bags, athletic gym bags, sport bags, beach bags, backpacks, tote bags; eye pillows; pull loops, tension bands, flying disks; reflective safety tape; pre-recorded CDs, videos and DVDs, all featuring topics relating to yoga instruction, yoga philosophy, exercise and healthy living; water bottles; blankets; cloth towels; hair ties, hair bands; posters; books and magazines featuring topics relating to yoga instruction, yoga philosophy, gardening, exercise and healthy living; key cuff holders; cell phone cases.

Services:

(1) Charitable fundraising services; Retail store services and on-line retail services featuring clothing, clothing accessories, yoga mats and yoga accessories, namely bricks, mats, blankets, straps, carrying cases, mat cleaning spray and bolsters, souvenirs, novelty items, handbags, sport bags, beach bags, eye pillows, pre-recorded CDs, videos and DVDs, water bottles, blankets, towels, hair ties, hair bands, posters, books and magazines, key cuff holders, cell phone cases.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 4, 2015.

[6] On May 28, 2015, the Opponent opposed the application on the basis of the grounds summarized below:

- (a) The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because at the date of filing the application, namely April 15, 2013, the Mark was confusing with the Opponent's trade-mark LETTUCE TURNIP THE BEET previously used in Canada.
- (b) The Mark is not distinctive under section 2 of the Act because it does not actually distinguish, nor is it adapted to distinguish, the Goods and Services from the Opponent's goods and services, in view of the Opponent's prior and significant use and advertisement of the Opponent's trade-mark LETTUCE TURNIP THE BEET in Canada.
- (c) The application does not conform to the requirements of section 30(i) of the Act, because contrary to the statement contained in the application, the Applicant could not have been satisfied when she filed the application that she was entitled to use the Mark in Canada with the Goods and Services.
- (d) The application does not conform to the requirements of section 30(e) of the Act because the Applicant did not intend to use the Mark in Canada with any or all of the Goods and Services.

[7] The Applicant filed and served a counter statement.

[8] The Opponent filed her own affidavit as her evidence. No cross-examination was requested. The Applicant did not file evidence. Both parties submitted a written argument and attended a hearing.

MATERIAL DATES AND ONUS

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
 - sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3) of the Act];
- and

- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

[10] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). 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 an applicant.

OBJECTIONS TO THE OPPONENT'S EVIDENCE

[12] At the hearing and in its written submissions, the Applicant raised several issues with the Opponent's evidence. For the reasons below, I have not had regard to the following evidence:

- (a) The evidence that Ms. Gorski owns trade-mark applications and registrations for LETTUCE TURNIP THE BEET in the United States and other jurisdictions (paras 4-5; Exhibits B-C) is not relevant to the grounds of opposition pleaded.
- (b) The evidence that Ms. Gorski gives on "information and belief" about the Applicant's intention and access to her products is not relevant as it is speculative (paras 11-14). Further, Ms. Gorski's opinion on the likelihood of confusion, deception and goodwill has not been given any weight.
- (c) Ms. Gorski's statements regarding her customers or her sister wearing LETTUCE TURNIP THE BEET clothing to music festivals and receiving

many compliments (para 11) have not been afforded any weight. The affiant's statements are hearsay and lack specificity.

- (d) With respect to Ms. Gorski's evidence of a customer writing her about the website *www.lettuceturnipthebeet.ca* and someone else selling shirts with LETTUCE TURNIP THE BEET in Vancouver, hearsay issues aside, I do not give this evidence any weight. As stated in *WIC TV Amalco Inc et al v ITV Technologies, Inc* (2005), 38 CPR (4th) 481 (FCA) at 501:

... While it is true that the Court can draw an adverse inference from the absence of evidence of actual confusion in certain cases (see *Dion Neckwear Ltd v Christian Dior, S.A.*, [2002] 3 FC 405, 2002 FCA 29 (CanLII), 20 CPR (4th) 155, 216 DLR (4th) 451 (CA)), it does not follow that a single instance of confusion is conclusive.

[13] I do not, however, find that the impugned content in Ms. Gorski's evidence is so improper that it lessens the weight to be given to the remainder of her evidence as requested by the Applicant who relies on *LMU v RLU* 2004 BCSC 95 at paras 40-41 where the British Columbia Superior Court states:

Despite judicial warnings about these matters, deponents often include inadmissible personal opinions and scandalous comments about the character or actions of another person and derogatory statements about their behaviour. Sopinka, supra, pages 604-616, paragraphs 12.1 to 12.24 set out the limits the law places on the admissibility of opinion evidence coming from lay persons. In *Creber v. Franklin* (August 26, 1993), Vancouver Registry DO83222 at pp. 8-9, [1993] B.C.D. Civ. 1549-03 (S.C.), Spencer J. commented that affidavit deponents should state facts only. They should not add their descriptive opinions of the facts. Affidavits should not be "larded with adjectives" expressing opinions about the conduct of others. "Self-serving protestations of surprise, shock, disgust or other emotions claimed" by deponents are not helpful, even if they rarely might be admissible.

These kinds of inadmissible gratuitous comments affect the weight given to the rest of the admissible affidavit material....

GROUND OF OPPOSITION

Section 16(3)(a) Ground of Opposition

[14] This ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act in view of confusion with the

Opponent's trade-mark LETTUCE TURNIP THE BEET alleged to have been previously used in Canada by the Opponent in association with:

Paper for wrapping and packaging; tote bags; wearable garments and clothing, namely, shirts

Retail and on-line retail store services featuring paper for wrapping and packaging, tote bags, wearable garments and clothing, namely, shirts

[15] In order to meet her evidential burden, the Opponent must show that she had used the trade-mark LETTUCE TURNIP THE BEET in Canada prior to April 15, 2013 [section 16(3)(a) of the Act]. Further, the Opponent must show that she had not abandoned her trade-mark at the date of advertisement of the application for the Mark, namely February 4, 2015 [section 16(5) of the Act].

[16] The Opponent's evidence set out below is sufficient to meet her burden:

- The Opponent's products are available through the e-commerce website Etsy which is accessible to Canadians (para 7; Exhibit E).
- The Opponent attaches what she calls representative invoices of goods sold to those located in Canada. These invoices feature photographs of t-shirts, tank tops and bags featuring the LETTUCE TURNIP THE BEET trade-mark along with a brief description, price, quantity, charge for shipping and the "shipped to" address. There are five invoices which match this description and show that the items were shipped prior to the filing date of the application (Exhibit G).

[17] The Applicant correctly notes in her written submissions that the invoices show sales totalling about \$200 (Applicant's Written Argument, para 22). She submits that the Opponent does not meet her evidential burden for the following reasons:

- The invoices are not admissible for the truth of their contents. At para 23 of her Written Argument, the Applicant submits:

... Either Ms. Gorski had to depose that she has personal knowledge of the details of each sale and the details contained in the invoices are correct, or she had to depose that the invoices are documents maintained in the ordinary course of her

business ... If the invoices were generated by another business they are inadmissible. (See *Re: AF 2000*, para 14).

Even though these business records may not satisfy the requirements of the business records hearsay exception, I am satisfied that the invoices are admissible as it was necessary for Ms. Gorski to file them to assist her in meeting her evidential burden and that they are reliable. Ms. Gorski provides in paras 1-2 of her affidavit that she is a sole proprietor and oversees all retail and online sales activities and that unless stated otherwise the contents of her affidavit are based on her knowledge or information in her files which she has access to in the ordinary course of her business.

- There is no evidence that the products shipped displayed the Mark or that they were actually received (Applicant's Written Submissions, para 24).
- To establish use, the Opponent must establish that she sold her products and services in Canada in the normal course of trade. Further, the level of use must at least exceed a *de minimis* threshold (Applicant's Written Submissions, para 28).

Evidence of Use Meets the Opponent's Burden

[18] If an opponent's evidence of use meets the requirements of section 4 and occurs at the material time, an opponent will have met its burden under this ground of opposition even if there is just one single sale or event [see, *7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150]. There is no requirement that the level of use meet a *de minimis* standard so long as the sales relied upon are in the normal course of trade [*JC Penney Co Inc v Gaberdine Clothing Co Inc*, 2001 FCT 1333 at paras 143-144].

[19] In this case, a fair reading of Ms. Gorski's evidence, establishes use in the normal course of trade in association with t-shirts and tank tops and retail store services selling t-shirts and tank tops. Ms. Gorski has sold t-shirts and tank tops bearing the trade-mark LETTUCE TURNIP THE BEET on the Etsy website since 2011 (para 7, Exhibit E). Her on-line store on Etsy features the trade-mark LETTUCE TURNIP THE BEET prominently (para 7, Exhibit E). Ms. Gorski has provided five invoices dated prior to the material date showing that goods featuring the trade-mark LEETUCE TURNIP THE BEET were shipped to Canadian addresses (Exhibit

G). It is reasonable to infer that these t-shirts arrived in Canada and I do not consider Ms. Gorski's evidence to be ambiguous in this respect.

[20] As such, I am satisfied that the Opponent has met its evidential burden under this ground of opposition. I must now determine whether the Applicant has met her onus of proving no reasonable likelihood of confusion on a balance of probabilities.

[21] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[22] 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 goods, 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 SCC 22 , (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

[23] In the present case, I do not consider it necessary to engage in a lengthy confusion analysis. The parties' marks are almost identical with the only difference being the complete capitalization of the Opponent's trade-mark versus the Mark which is in mixed upper and lower case letters. The nature of the goods and services appears to be identical with respect to t-shirts and retail store services featuring clothing and appears to be related with many of the other applied-for goods and services such as clothing accessories, bags and retail services featuring clothing accessories. The trade-marks of each party have a high degree of inherent distinctiveness given the juxtaposition of the different vegetable names to create a catchy phrase. With respect to the extent known and length of time in use factors, I do not find that these factors favour either party. While the Applicant has not filed any evidence, the Opponent's evidence does not allow me to conclude that there has been use to any significant extent.

[24] Considering all of the surrounding circumstances as discussed above, I find that the Applicant has not satisfied her onus of establishing on a balance of probabilities that there is no reasonable likelihood of confusion as between the Mark and the Opponent's LETTUCE TURNIP THE BEET trade-mark. Accordingly, this ground of opposition is successful.

Section 2 Ground of Opposition

[25] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to have shown that her trade-mark LETTUCE TURNIP THE BEET has become known sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657]. To do so, the Opponent must establish that her trade-mark is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles, supra* at paras 33-34].

[26] The Opponent's evidence is insufficient to show that her trade-mark was sufficiently known as of the material date of May 28, 2015. Accordingly, the Opponent fails to meet her evidential burden.

[27] While Ms. Gorski provides that she has had sales revenue of over \$77,000 Cdn within Canada since 2011 (para 10), she does not breakdown the percentage of the sales attributable to goods with the trade-mark. I cannot presume the sales were for goods bearing the Opponent's trade-mark as this was not clearly stated and such an ambiguity must be resolved against the affiant. While Ms. Gorski does support her claim of sales in Canada with invoices and examples of sales, the invoices attached to her affidavit show around ten sales to those in Canada Canada (Exhibits G, I).

[28] Ms. Gorski's evidence is that her LETTUCE TURNIP THE BEET clothes have been worn by various celebrities, received media attention, are popular on social media and have been featured in the magazine *Pregnancy and Newborn* which Ms. Gorski says is distributed in Canada (para 9; Exhibit F). With respect to this evidence, there is no information which would allow me to find that a sufficient number of Canadians have been exposed to the Opponent's trade-mark LETTUCE TURNIP THE BEET such that the reputation of this trade-mark would have been impacted.

[29] Even if I had given weight to Ms. Gorski's evidence of a potential customer in the Vancouver area having contacted her or that various customers and her sister attended or were planning to attend music festivals in British Columbia wearing the Opponent's t-shirts with the LETTUCE TURNIP THE BEET trade-mark (para 11), this evidence does not assist me in reaching the conclusion that the trade-mark was sufficiently known to negate the distinctiveness of the Mark.

[30] Accordingly, the Opponent has failed to meet her evidential burden and this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[31] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd. v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances underlying the allegations in this pleading, the section 30(i) ground is dismissed.

Section 30(e) Ground of Opposition

[32] In her counter statement, the Applicant states the following:

In response to paragraph 9 and 10 of the Statement of Opposition, the Application does conform to the requirements of Section 38(2)(a) of the [the Act]. Particularly:

...

(b) The Applicant intended to use the [Mark] in Canada with some or all of the [Goods and Services] with which the Mark is associated.

[33] At the hearing, the Opponent submitted that this was sufficient to meet her burden under the section 30(e) ground of opposition [see *Société nationale Elf Aquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB)].

[34] The Applicant submitted in response that as this was not raised in the written argument, and she wasn't given notice that the Opponent was relying on this admission, it should not be sufficient to meet the Opponent's burden.

[35] A review of the Opponent's written argument shows that the Opponent does not mention the section 30(e) ground of opposition at all. In view of this, I decline to read the statement in the counter statement as an admission sufficient to meet the Opponent's burden. Had the Opponent raised this issue in its written argument, the Applicant would have had the opportunity to request leave to amend its counter statement.

DISPOSITION

[36] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2017-06-07

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