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

Citation: 2018 TMOB 6

Date of Decision: 2018-01-19

IN THE MATTER OF AN OPPOSITION

**Arcadia Group Brands Limited and
Top Shop / Top Man Limited**

Opponent

and

Isaac Bennet Sales Agencies Inc.

Applicant

1,479,597 for MOTO JEANS

Application

INTRODUCTION

[1] Arcadia Group Brands Limited and Top Shop / Top Man Limited (collectively referred to as the Opponent) oppose registration of the trade-mark MOTO JEANS (the Mark) that is the subject of application No. 1,479,597 that was filed by International Clothiers Inc. The application was assigned from International Clothiers Inc. to INC Group Inc. on February 2, 2016, and to Isaac Bennet Sales Agencies Inc. on July 30, 2016. I shall refer to International Clothiers Inc., INC Group Inc. and Isaac Bennet Sale Agencies Inc. interchangeably as the Applicant.

[2] Filed on May 4, 2010, the application is based on (1) use of the Mark in Canada in association with “jeans” since at least as early as June 1, 2004 and (2) proposed use of the Mark in Canada in association with the following:

Clothing and apparel, namely shirts, embroidered shirts, tee shirts, shorts, sport shirts, sweatshirts, sweatpants, socks, vests, belts, undergarments, underpants, undershirts, bathrobes, underwear, swimsuits, beach cover-ups, warm-up suits, jackets, jerseys, tank tops, sweaters, pants, vests, suits, sport coats, coats, head bands, overcoats, rain coats, top coats, jackets, parkas, ties, bow ties, vests, scarves, bandannas, pajamas, night shirts, suspenders, gloves; headwear, namely, hats, baseball caps, embroidered caps, and knitted hats; footwear namely, shoes, slippers, boots, sandals, and sneakers; body suits, jumpsuits; clothing for women and young adults, namely, brassieres, bustiers, camisoles, chemises, corselettes, corsets, dressing gowns, dusters, garter belts, girdles, housecoats, lingerie, negligees, night gowns, night shirts, pajamas, peignoirs, robes, teddies, panties, blouses, dresses, skirts, tops, scarves, sarongs, halter tops, hosiery, jumpers, shawls, stoles, scarves, shrugs, boleros, and wraps.

[3] The Opponent alleges that (i) the application does not conform to sections 30(b), 30(e) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not the person entitled to the registration of the Mark under sections 16(1)(a) and 16(3)(a) of the Act, and (iii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I refuse the application.

THE RECORD

[5] The Opponent filed its statement of opposition on August 29, 2012. The Applicant filed and served its counter statement on January 7, 2013 denying all of the grounds of opposition. The Opponent subsequently requested leave to amend its statement of opposition twice, on February 19, 2013 and on July 3, 2013, both requests were granted by the Registrar on April 22, 2013 and on October 24, 2013 respectively.

[6] In support of its opposition, the Opponent filed two affidavits of Matthew Boyd, a summer law student employed by the Opponent’s trade-mark agent; two affidavits of Jane Buckingham, a searcher employed by the Opponent’s trade-mark agent; an affidavit and a supplementary affidavit of Paul Gould, International Director of Arcadia Group Limited.

Mr. Boyd and Mr. Gould were both cross-examined on their affidavits; the transcripts of their cross-examinations have been made of record.

[7] In support of its application, the Applicant filed the affidavit of Paul Brener, Vice-President, Finance and Administration of International Clothiers Inc. Mr. Brener was not cross-examined on his affidavit.

[8] The Opponent further filed the affidavit of James Haggerty, a searcher employed by the Opponent's trade-mark agent, as its reply evidence. Mr. Haggerty was not cross-examined on his affidavit.

[9] Both parties filed a written argument and were represented at a hearing which took place concurrently with that for a related opposition proceeding (application No. 1,538,031 for the trade-mark MOTO) on November 30, 2017. A separate decision will issue for the related proceeding.

PRELIMINARY MATTERS

[10] At the outset of the decision, I wish to address the Applicant's objection to the Opponent's evidence in chief. In this regard, the Opponent's initial deadline to comply with section 41 of the *Trade-marks Regulations* (the Regulations) was May 7, 2013. On April 19, 2013, the Opponent requested a one-month extension of time pursuant to section 47 of the Act, or until June 7, 2013, to file its evidence in chief. In accordance with the Trade-marks Opposition Board's practice notice entitled *Practice in Trademark Opposition Proceedings*, the Opponent obtained the Applicant's consent to its request. The Registrar granted the Opponent's request on April 29, 2013.

[11] On June 7, 2013, the Opponent filed and served the first affidavit of Matthew Boyd and requested an additional two-week extension of time, or until June 21, 2013, to complete its evidence in chief pursuant to section 47 of the Act. The Opponent had once again obtained the Applicant's consent. The Registrar granted the Opponent's request on June 13, 2013. However, the notice in which the Registrar confirmed the Opponent's extension of time request inadvertently indicated that an extension of time was granted until September 7, 2013. Neither party alerted the Registrar to the error.

[12] On June 21, 2013, the Opponent filed and served a copy of the affidavit of Paul Gould and the first affidavit of Jane Buckingham, and indicated that they will rely on the Registrar's notice of extension of time granted until September 7, 2013 to file additional evidence as its evidence in chief under section 41 of the Regulations.

[13] Two weeks later, on July 3, 2013, the Opponent completed its evidence in chief by filing and serving the original sworn affidavit of Paul Gould, a copy of a supplemental affidavit of Paul Gould, a second affidavit of Jane Buckingham, and a second affidavit of Matt Boyd. The original sworn supplemental affidavit of Paul Gould was filed and served two days later, on July 5, 2013. On September 5, 2013, the Applicant requested the Registrar to issue an order for the cross-examination of Mr. Boyd, Mr. Gould and Ms. Buckingham on their respective affidavits, and an extension of time for the filing of its own evidence under section 41 of the Regulations. The cross-examination orders were issued, along with an extension of time for the filing of the Applicant's evidence, on October 29, 2013.

[14] On December 20, 2013, the Applicant wrote in and objected to evidence that was filed by the Opponent after June 21, 2013, the date to which it consented. The Registrar informed the parties that the matter would be dealt with at the final decision stage.

[15] In its written argument and at the hearing, the Applicant submits that it consented to an extension of time until June 21, 2013 only so as to afford the Opponent's principal affiant, Paul Gould, the opportunity to swear his affidavit, not so that the Opponent could gather, prepare and file additional evidence. As such, the Applicant submits that those affidavits filed and served after June 21, 2013 should be disregarded entirely.

[16] In response, the Opponent submitted during the hearing that the evidence should not be disregarded as section 47 of the Act is discretionary, allowing the Registrar to grant extensions of time fixed by the Act or the Regulations if the Registrar is satisfied that such extension is justified. The Opponent also submitted that it would be inappropriate to reject its evidence considering that the Applicant did not suffer any prejudice since the Applicant did not have to file its evidence in chief pursuant to section 42 of the Regulations until October 25, 2014, which was subsequently extended until November 24, 2014. Finally, the Opponent argued that it is

important that the opposition be considered on its merit, including all the evidence that the Opponent could file on appeal if rejected in any case.

[17] At the hearing, I asked the Applicant whether it was challenging the extension of time that was granted by the Registrar until September 7, 2013 pursuant to section 47 of the Act, to which the Applicant responded that it wasn't but that it objected to the evidence that was filed by the Opponent after the date to which it consented, namely June 21, 2013.

[18] It was an unfortunate clerical error in the Registrar's notice that led to the Opponent to complete its evidence beyond the date to which Opponent requested and the Applicant has consented. While I am sympathetic to the Applicant's predicament, I am not satisfied that the remainder of the Opponent's evidence filed after June 21, 2013, all of which was filed within the extension of time granted by the Registrar, should be disregarded under these circumstances. The Applicant has not explained what prejudice this additional 2-week delay has occasioned to its case. As noted by the Opponent, the Applicant was able to cross-examine the Opponent on its evidence and obtained additional time to prepare its evidence in return.

[19] I would add if the Opponent had requested a retroactive extension of time and paid the fee, I would have been prepared to grant the Opponent a retroactive extension of time under section 47(2) of the Act for the filing and service of the remainder of its evidence after June 21, 2013 in view of the confusion occasioned by the Registrar's notice. Section 47 of the Act provides the Registrar with an unfettered discretion to grant an extension of time, including a retroactive extension of time, under the Act when the Registrar deems it appropriate to do so. In particular, section 47(2) of the Act provides the Registrar with discretion to grant retroactive extensions of time in cases where the Registrar is satisfied that a party's failure to meet its deadline or request an extension of time for so doing was not reasonably avoidable. The Federal Court has stated that the reasonableness of avoidability should be determined through the eyes of the party making the request, not from some other perspective [see *Wordex Incorporated v Wordex et al* (1984), 82 CPR (2d) 276 (FCTD)]. Given the particular circumstances of this case, I would have been satisfied that the Opponent's failure to meet the prescribed deadline was not reasonably avoidable.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[20] The Opponent has the initial evidential burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark complies with the Act remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS

[21] I will now consider each of the grounds of opposition, though not necessarily in the order in which they appear in the statement of opposition.

Was the Mark Distinctive of the Applicant Within the Meaning of Section 2 of the Act?

[22] In its statement of opposition, the Opponent alleges that the Mark is not distinctive of the Applicant because as of the filing date of the statement of opposition, the Mark was confusing with the Opponent's trade-mark MOTO, which was made known in Canada since well prior to the claimed date of first use, and that the Mark does not actually distinguish the goods of the Applicant from those of the Opponent's MOTO brand nor is it adapted to do so, in light of the protectable reputation and goodwill of the Opponent's trade-mark MOTO in Canada in association with clothing, which has become known sufficiently in Canada to negate the distinctiveness of the Mark.

[23] As noted in both parties' written arguments, the material date for assessing distinctiveness is generally accepted as being the date of filing of the opposition, which is August 29, 2012 in this case [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]. There is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once the burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others. [See *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 298; *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB); *Imperial Tobacco Canada*

Limited v Philip Morris Products SA, 2013 TMOB 175 (TMOB) para 24, aff'd 2014 FC 1237 para 15-16 and 68; *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 para 55].

[24] As pointed out by the Applicant in its written argument and at the hearing, the Opponent's non-distinctiveness ground is not based on use of the trade-mark MOTO by other traders in the Canadian marketplace. Thus I will limit my discussion of this ground of opposition to evidence related to the Opponent's own trade-mark MOTO and that of the Mark [see *Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC)].

Opponent's Initial Evidential Burden

[25] An opponent meets its initial evidential burden with respect to a non-distinctiveness ground if it shows that as of the filing of the statement of opposition its trade-mark had become known sufficiently in Canada to negate the distinctiveness of the applied-for mark. Moreover, it is not necessary for an opponent to show that its trade-mark is well known or that it has been made known solely by the means set out in section 5 of the Act. Evidence of knowledge or reputation spread by word of mouth, as well as evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles, as opposed to advertising *per se*, are also to be taken into consideration [see *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[26] In this regard, the Opponent relies on Mr. Gould's affidavit.

The Gould Affidavit

[27] In his affidavit, Mr. Gould states that the Opponent, Arcadia Group Brands Limited, is a subsidiary of Arcadia Group, a privately held company that is one of the UK's leading multiple retailers of fashion clothing, shoes, make-up and accessories. According to Mr. Gould, Arcadia Group Brands Limited is the registered owner of trade-mark registrations of the Opponent's trade-marks TOPSHOP and MOTO. Following a corporate restructure in December 2012, Arcadia Group Brands Limited sold its worldwide TOPSHOP and MOTO brands and businesses

to Top Shop / Top Man Limited. I will collectively refer to the Opponent and its predecessors-in-title as TOPSHOP.

[28] Mr. Gould explains the relationship between the TOPSHOP and the MOTO brands as follows. Launched in 1964, the TOP SHOP brand, which later became TOPSHOP, provides up to the minute affordable style to fashion-conscious shoppers and industry insiders. According to Mr. Gould, TOPSHOP has become “a major style authority, and stands today as one of the most famous high street brands in the fashion industry”. At the time that his affidavit was sworn July 1, 2013, Mr. Gould states that TOPSHOP has over 470 retail stores across 37 countries, including Canada, all of which carry MOTO clothing and merchandise. The Opponent’s TOPSHOP/TOPMAN flagship store located in London’s Oxford Circus is, according to Mr. Gould, the largest fashion store in the world at approximately 70,000 square feet in size, 2,230 of which is devoted to the MOTO brand. Mr. Gould further states that the flagship store is a shopping destination for travelers around the world, including Canadians.

[29] According to Mr. Gould, TOPSHOP began designing, promoting and selling a line of jeans and casual wear under the MOTO brand in 1993/1994. Mr. Gould states that TOPSHOP’s MOTO brand has enjoyed great commercial success from its inception with the sale of 5,000 pairs of MOTO jeans daily on a global basis. By way of example, Mr. Gould states that the sales of TOPSHOP’s MOTO jeans and denim clothing in UK alone have exceeded 758 million GBP for the period between March 2001 and July 2013. Attached as Exhibit “A1” to Mr. Gould’s affidavit are excerpts of UK newspaper articles dated between 1994 and 2002 that mention MOTO clothing for men and women. Attached as Exhibit “B” are sample clothing labels bearing the trade-mark MOTO, said to be representative of the Opponent’s use of the trade-mark MOTO since its launch in 1993/1994, as well as in 2009, 2010 and 2011. Labels with MOTO, or M-O-T-O, can be seen on jeans, including one with TOPSHOP shown in a smaller size on a separate line above MOTO in a different font.

[30] In terms of the MOTO brand’s connection to Canada, Mr. Gould states the Canadians have been shopping at TOPSHOP stores for decades. In this regard, Mr. Gould provides a chart that sets out Canadian VAT refunds from TOPSHOP stores in UK from 2001 to 2010, totalling over 1.8 million GBP. I note that there is no information as to the extent to which those figures

cover the sales of MOTO brand clothing in particular. On more than one occasions during his cross-examination, Mr. Gould explained that for the Opponent, “Top Shop is synonymous with MOTO” [see for example answer to Q146 of Mr. Gould’s cross-examination]. Even so, the non-distinctiveness ground of opposition is based on an allegation of confusion with the Opponent’s trade-mark MOTO, not TOPSHOP. As such, it is necessary to distinguish between evidence of use and reputation associated with the two brands.

[31] In terms of sales in Canada, Mr. Gould states that TOPSHOP and TOPSHOP MOTO clothing had been sold in Canada through select Holt Renfrew stores, and two other retailers in Toronto and Montreal since “at least as early as 2007”. Mr. Gould did not specify the extent to which the Opponent’s MOTO brand clothing was sold in Canada through these retailers. Mr. Gould further states that TOPSHOP and TOPSHOP MOTO clothing were also available to Canadians travelling abroad, including in the United States since 2001. In this regard, Mr. Gould did not provide any information with respect to the MOTO brand specifically. Attached as Exhibit “F” are emails representative of those received from Canadians making inquiries related to TOPSHOP and TOPSHOP clothing, dating back as early as May 2002. I note that the representative emails do not contain any reference to the Opponent’s trade-mark MOTO.

[32] In terms of its online presence, the Opponent began offering its TOPSHOP branded clothing and merchandise for sale in the United States through its website located at *www.topshop.co.uk* in 1998, and at *www.topshop.com* as of 2006. Mr. Gould specifies that Canadians were able to buy TOPSHOP and MOTO branded clothing through the TOPSHOP website as of 2010. Printouts of the website as shown at that time are attached as Exhibit “E”, I note one reference to “Moto Denim” in the printouts.

[33] Mr. Gould also provides the annual number of “hits” to the TOPSHOP website between 2007 and 2013 from Canada, UK, and other countries. With respect to Canada, the number of “hits” went from 81,200 in 2007 to over 3 million in 2012. Moreover, over 17,400 Canadians are said to have signed up to receive the latest TOPSHOP news as of June 2013. I note that Mr. Gould did not indicate the extent to which the MOTO brand is referenced on the TOPSHOP website since 2007 or in the news sent to subscribers.

[34] In terms of sales from the website, Mr. Gould states that there were 100,000 GBP worth of sales of MOTO branded clothing to Canada between March 2010 and July 2013.

[35] In March 2011, Hudson Bay Company secured the rights to become the licensee of TOPSHOP in Canada and the flagship TOPSHOP store was launched in July 2011 in Toronto. Mr. Gould states that similar “store-within-a-store” concepts have opened in Montreal, Calgary and Vancouver since that time, “with anticipated expansions into other major Canadian cities planned over 2013-14”. By March 2014, Mr. Gould states that 10 full-sized TOPSHOP retail stores, including those within The Bay locations, will be in operation in Canada. Since the launch of TOPSHOP through The Bay in July 2011, Mr. Gould states that sales of TOPSHOP MOTO jeans and denim alone in Canada have topped 2.7 million GBP.

[36] In terms of promotion, Mr. Gould states that the Opponent’s TOPSHOP and MOTO brand have been promoted for decades to Canadians in a number of ways. Notably, Mr. Gould points to the Opponent’s flagship store in London which devotes retail space to its MOTO branded clothing. The flagship store is said to be referenced in popular travel guides as a “must-shop” destination in London. Attached as Exhibit “G” are excerpts of various travel guides, said to be available to Canadians through bookstores and libraries. I note that the excerpts make no mention of the Opponent’s trade-mark MOTO, and there is no information regarding the circulation of these travel guides in Canada.

[37] Since the launch of the Opponent’s flagship TOPSHOP store in New York City in 2009, Mr. Gould states that it has also been featured as an important US shopping destination in magazines. Attached as Exhibit “H” are excerpts of the 2009 and 2010 editions of *Time Out: New York*, said to have been available for purchase on newsstands in Canada, and printouts from the magazine’s website showcasing the flagship store and the TOPSHOP website. I note that neither the magazine excerpts nor the printouts make reference to the Opponent’s trade-mark MOTO.

[38] Similarly, attached as Exhibit “I” are excerpts from a number of fashion and lifestyle magazines between 2006 and 2011 circulated in Canada, said to be representative of the depiction of TOPSHOP in such publications. Mr. Gould further adds that many of these publications have corresponding websites with similar content. Attached as Exhibit “J” are

excerpts from various newspapers referencing TOPSHOP's collaboration with Kate Moss. I note that none of the magazine excerpts or articles contains any reference to the Opponent's trade-mark MOTO.

[39] According to Mr. Gould, social media has played an increasingly significant role in the marketing of TOPSHOP and its MOTO brand since 2009. Attached as Exhibit "K" are representative printouts of promotional materials and posts featuring the TOPSHOP brand on the Opponent's Facebook page, which has received over 3.4 million "likes" as of June 2013, 27,000 of which are said to be Canadians. Mr. Gould explains that these posts include hyperlinks to the TOPSHOP website where consumers, including Canadians, may purchase the displayed items.

[40] I note several references to the Opponent's trade-mark MOTO on the TOPSHOP Facebook page, including the description "MOTO bleach skinny jeans" next to a photo of jeans in a December 2009 post, that of a pair of "MOTO strawberry printed skinny jeans" in a April 2010 post, that of "MOTO Grunge Flag Skinny Jeans" in a February 2011 post, and that of "MOTO Denim Stripe High Waisted Hotpants" in an April 2011 post. Screenshots of TOPSHOP's website with various MOTO branded clothing are also included with prices shown in GBP, but with the "Shipping to Canada" option.

[41] Attached as Exhibit "L" are representative printouts of TOPSHOP's "@Topshop" and "@Topshop_Canada" Twitter accounts depicting posts of TOPSHOP and MOTO goods from 2014, linking followers to TOPSHOP's website where consumers, including Canadians, may purchase the displayed items. Mr. Gould states that TOPSHOP Twitter account has 14,000 followers in Canada and that the online traffic from TOPSHOP's Twitter account to TOPSHOP's website from Canada is approximately 250 visits per week. I note that there are references and photos of the Opponent's MOTO branded clothing from tweets from the Opponent in 2011, with tweets from other users mentioning the Opponent's MOTO brand in 2011 as well. There is no information regarding the location of the authors of these tweets. Screenshots of TOPSHOP's website with various MOTO branded clothing are included with prices shown in GBP, but with the "Shipping to Canada" option. A screenshot of Hudson's Bay's website for a pair of "TOPSHOP MOTO Joni Super High Waist Short Length" is attached.

Finally, a photo of a model wearing a pair of pants identified as “MOTO stripe leigh jeans” in a tweet dated “6 Jun” from the “Topshop_Canada” account is also attached.

[42] Attached as Exhibit “M” are representative printouts of TOPSHOP’s Tumblr page which is said to also feature the Opponent’s MOTO denim. I note that while there are many photos on the TOPSHOP Tumblr page, there is no mention of the trade-mark MOTO but only of TOPSHOP. It appears however that descriptions underneath certain photos contain hyperlinks to the Opponent’s website. According to Mr. Gould, the TOPSHOP Tumblr page receives an average of 305 hits per week from Canada.

[43] Attached as Exhibit “N” are representative printouts of TOPSHOP’s Pinterest account depicting posts of TOPSHOP and its MOTO apparel. Mr. Gould states that the TOPSHOP Pinterest account has 31,000 followers and “it is estimated that 100 of those followers are from Canada”. I note numerous references to MOTO branded clothing.

[44] Mr. Gould states that TOPSHOP has also been making podcasts available online, featuring its runway shows, interviews with designers and models, and the latest styles available at the TOPSHOP stores. The TOPSHOP YouTube channel is said to receive an average of 1,600 views per week from Canadians, with 429 views dating back to November 2007 and over 11,000 views in 2010/2011. There is however no information regarding the extent to which the Opponent’s trade-mark MOTO is referenced in these podcasts.

Analysis

[45] There are many deficiencies in Mr. Gould’s affidavit. There is a general lack of specificity regarding the extent to which the Opponent’s trade-mark MOTO has been used and promoted separate and apart from that of the trade-mark TOPSHOP. The same observation applies to the lack of specificity with respect to evidence pertaining to the extent of the MOTO brand’s reputation in Canada as opposed to elsewhere. There is also a general lack of data in support of some of the rather bald statements made by Mr. Gould surrounding the notoriety of the Opponent’s trade-mark MOTO in association with clothing, which would have been useful in determining the magnitude of its “commercial success” separate from that of the trade-mark TOPSHOP. I will also note that there are limited annual breakdowns of figures in the affidavit,

making it difficult to determine the extent to which the Opponent's mark had become known at a particular time in the past, in Canada and elsewhere.

[46] In its written argument and at the hearing, the Applicant submits that Mr. Gould's affidavit is largely inadmissible hearsay evidence as "Mr. Gould admitted that most of the statements in his affidavit were based solely upon documents provided to him by unidentified persons".

[47] In his affidavit, Mr. Gould states that he has been with Arcadia Group for over fifteen years and that over this time, he has been promoted to various roles including Head of International and Head of Regional Business Development. Mr. Gould further states that in his capacity as International Director, he is responsible for the global development of Arcadia's brand, including the TOPSHOP and MOTO brands, which means to find new markets and to run existing markets for fashion brands that are owned by Arcadia Group [see answer to Q27 of Mr. Gould's cross-examination]. Mr. Gould specifies that he has access to the books, records and documents of Arcadia Group.

[48] During his cross-examination, Mr. Gould explained that within Arcadia Group, there are multiple divisions including the international division, and each of the brands operates as divisions as well. While financial and sales functions sit within each of the brands, the information is also reported up to group functions, including the finance and the international divisions. Mr. Gould stated that some of the sales records in his affidavit were produced by the finance group while some of the statistics and sales figures were provided as part of internal reports produced by the finance team within Top Shop/Top Man Limited, the entity that directly runs TOPSHOP and its MOTO brand on a day to day basis [see answers to Q23 to 54, Q109 to 114, Q121 to 133, Q148 to 152 of Mr. Gould's cross-examination].

[49] Likewise, Mr. Gould explained during his cross-examination that the advertising and promotional information of TOPSHOP and MOTO brands, including their online presence and online sales, are derived from company records, as well as from reports and emails provided by the digital team [see answers to Q74 to 76, Q190 to 224, Q242 to 247, Q253 to 263 of Mr. Gould's cross-examination].

[50] In his affidavit, Mr. Gould states that the facts and matters set out in his affidavit are either known to him personally and/or based on business and corporate records maintained by the Opponent to which he has access by virtue of his employment, kept in the normal course of business.

[51] In its written argument, the Applicant points to the lack of documentary evidence that would corroborate the sales and promotional figures and information provided by Mr. Gould in his affidavit. As per my discussion of the Applicant's own evidence below, neither party provided any sample sales reports or sample sales receipts in support of their statements of sales to consumers on a retail level. Even so, that is not problematic as there is no one particular kind of evidence which must be provided in these proceedings.

[52] Based on a fair reading of Mr. Gould's affidavit together with the transcript of his cross-examination, I am satisfied that the sales and marketing information related to the TOPSHOP and MOTO brands are based on records and reports that were prepared and kept in the ordinary course of the business by the Opponent. I see no reason to question the reliability of the sales and marketing information set forth in Mr. Gould's affidavit.

[53] Having reviewed Mr. Gould's affidavit in its entirety, I am satisfied that the Opponent has provided sufficient evidence to support a finding that the Opponent's trade-mark MOTO had become known sufficiently to negate the distinctiveness of Mark at August 29, 2012. In particular, I am mindful of the sale of TOPSHOP MOTO clothing in select Holt Renfrew stores and two other retailers in Toronto and Montreal since "at least as early as 2007", consistently increasing number of visits from Canada to TOPSHOP's website since 2007 combined with 100,000 GBP of online sales of MOTO brand clothing to Canada from the website between 2010 and 2013, TOPSHOP's established presence in Canada following its collaboration with Hudson Bay Company as of July 2011 followed by additional stores in other Canadian cities, sales of 2.7 million GBP of TOPSHOP MOTO jeans and denim through that channel between July 2011 and July 2013, and TOPSHOP's general social media presence which promotes its MOTO brand clothing to followers from Canada and elsewhere. I also had some regard, though to a much lesser extent, to Mr. Gould's more general statements along with supporting documentary evidence regarding TOPSHOP's longstanding business and reputation in the clothing and

fashion industry in Canada and elsewhere, to which the MOTO brand appears to be an integral part based on Mr. Gould's testimony.

Applicant's Legal Onus

[54] Since the Opponent has satisfied its initial evidential burden, the legal onus is on the Applicant to establish, on a balance of probabilities, that the Mark was distinctive as of the material date. In other words, the Applicant would have to show that as of August 29, 2012, as a matter of first impression, from the point of view of the everyday consumer of the applied for goods, there was no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark MOTO such that the Mark would be perceived as a source identifier for its applied for clothing in Canada in light of the Opponent's presence in the market.

[55] In this regard, the Applicant provides evidence of use and promotion of the Mark in Mr. Brener's affidavit.

The Brener Affidavit

[56] In his affidavit, Mr. Brener states that the Applicant has extensively used, promoted and advertised various trade-marks in Canada in association with clothing that include the term MOTO "since at least as early as 1997", including the trade-marks MOTO, MOTO JEANS, MOTO SPORT and MOTO GEAR (collectively referred to in his affidavit as the "MOTO brand"). Attached as Exhibits "A" and "B" are particulars of the Applicant's Canadian trade-mark registrations for MOTO SPORT (TMA502,767) registered on October 23, 1998 and MOTO GEAR (TMA731,143) registered on December 17, 2008.

[57] Mr. Brener states that the MOTO brand is an important brand of the Applicant and that the latter has enforced its rights in this regard. Attached as Exhibit "C" is a copy of a settlement agreement the Applicant has reached with a third party who agreed to cease the use of a trade-mark that includes the term "MOTO". Attached as Exhibit "D" is a copy of a cease and desist letter dated September 13, 2011 sent to the Opponent.

[58] Mr. Brener provides three volumes of documentary evidence which include sample purchase order worksheets from the Applicant to manufacturers, sample invoices from

manufacturers and vendors to the Applicant, sample artwork and photographs of labels, hangtags and clothing, as well as sample print advertisements, all of the Applicant's MOTO brand clothing, dated between 1997 and 2014, said to be sold at retail in Canada through its own stores.

[59] In particular, attached as Exhibit "E" is a copy of an affidavit that Mr. Brener had filed in connection with another opposition proceeding in which the Applicant was involved in 2009 and as Exhibit "F" a copy of an affidavit that he had filed in connection with the appeal of that opposition proceeding in 2012. Mr. Brener states that he has reviewed both affidavits and confirms that their contents remain accurate. I will refer to these affidavits as Mr. Brener's 2009 affidavit and 2012 affidavit.

[60] Mr. Brener's 2009 affidavit provides information with respect to the use and promotion of the Applicant's MOTO brand between 1997 and 2009. In particular, attached as Exhibit "C" are sample purchase worksheets and related invoices for the purchase of MOTO-branded clothing by the Applicant dated between 1997 and 2008 which in turn was sold at retail in Canada through the Applicant's own retail stores.

[61] Attached as Exhibit "D" to Mr. Brener's 2009 affidavit are photographs of sample MOTO-branded clothing said to have been sold in Canada by the Applicant, including those with the Mark on different photos of jeans. Attached as Exhibit "E" to Mr. Brener's 2009 affidavit are sample labels and hangtags used by the Applicant in association with the sale of its MOTO-branded clothing sold in Canada from 2003 and on, including different variations of the Mark. Finally, attached as Exhibit "F" to Mr. Brener's 2009 affidavit are sample print advertisements of the Applicant's MOTO-branded clothing in the Toronto Star and Toronto Sun newspapers. The Mark can be seen in the ads in association with shirts and jeans. While a few copies are dated 2008, the remaining ones are either undated or the hand-written inscriptions are not legible.

[62] In his 2012 affidavit, Mr. Brener provides additional sample purchase worksheets and related invoices dated 2010 and 2011, along with additional photographs of sample MOTO-branded clothing said to be sold in Canada bearing the Mark, with or without additional written materials, as Exhibits "A" and "B". In particular, worksheets with "Date Ordered" of July 11, 2011 and July 15, 2011 for "Knitted 100% Polyester Fleece" include references to the "Label" as "MOTO JEANS"; the related invoice dated September 26, 2011 for these two orders;

as well as a photo of a pair of jeans bearing the label “MOTO JEANS” with that of a hangtag for “MOTO JEANS” are attached. Mr. Brener also provides the annual retail sales figures of the Applicant’s MOTO-branded clothing through its retail stores in Canada between 2006 and 2011, totalling over \$36 million. Mr. Brener did not provide a breakdown for each specific MOTO brand such as those associated with the Mark.

[63] Similar sample purchase order worksheets and related invoices dated 2010 to 2014 for the purchase of MOTO-branded clothing by the Applicant which in turn is sold at retail in Canada through its various retail stores, similar photographs of additional sample MOTO-branded clothing, and similar sample labels used in association with MOTO-branded clothing used by the Applicant between 2010 and 2014, are attached as Exhibits “H”, “I”, “J” and “K” to Mr. Brener’s main affidavit. All the worksheets and invoices in Exhibit “H” are for clothing items with a “MOTO” label only. Attached as Exhibit “I” are worksheets and related invoices dated 2011 to 2014 with references to “MOTO JEANS” labels, artwork of “Fall 2011”, “Spring 2013”, “Fall 2013”, “Spring 2014” and “Fall 2014” “MOTO JEANS” hangtags, labels and price tickets for jeans, as well as photos of jeans with the Mark on the labels and hangtags.

[64] Mr. Brener states that the Applicant operates in excess of 200 stores and that MOTO-branded clothing is sold at the majority of these stores. In addition to the retail sales figures for the Applicant’s MOTO-branded clothing through its retail stores set out in his 2012 affidavit, Mr. Brener provides the Applicant’s updated 2012 retail sales figures, as well as those for 2013 and 2014, totalling over \$49 million between 2006 and 2014. Mr. Brener did not provide a breakdown for each specific MOTO brand such as those associated with the Mark. In this regard, Mr. Brener states that the sales figures represents only a portion of total sales because the Applicant does not track retail sales by brand, but only as part of its purchase order worksheets.

Test for Confusion

[65] 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.

[66] 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 *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, *supra*; 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].

[67] I will now turn to the assessment of the section 6(5) factors.

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

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

[69] I assess both parties' trade-marks to have the same degree of inherent distinctiveness in view of the term "MOTO". In this regard, I am of the view that the second component of the Mark, "JEANS", does not contribute to the inherent distinctiveness of the Mark given its descriptive/suggestive nature.

[70] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. As per the review of Mr. Gould and Mr. Brener's affidavits, I assess the Mark to have become known to a greater extent than that of the Opponent's trade-mark MOTO in Canada. In doing so, I am mindful of some of the shortcomings of the Opponent's evidence discussed earlier, the relatively later arrival of the TOPSHOP stores in Canada together with its smaller Canadian sales figures thus far, as well as evidence of use of the Mark by the Applicant for a longer period of time in Canada with substantial sales of the Applicant's various MOTO-brand clothing, which includes to some extent that of the Mark. As

such, I am satisfied that the Applicant has shown use and promotion of the Mark prior to that of the Opponent's in association with clothing, including jeans, in Canada.

[71] In view of the foregoing, the section 6(5)(a) factor favours the Applicant.

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

[72] The application is based on use of the Mark in Canada in association with "jeans" since at least as early as June 1, 2004 and proposed use of the Mark in association with other clothing and apparel items. As per the review of Mr. Brener's affidavit, the Applicant has provided evidence of use of various trade-marks in Canada in association with clothing that include the term "MOTO" "since at least as early as 1997" and thereafter, with evidence of use of different variations of the Mark, with or without additional written materials, on hangtags and labels of jeans from 2004, and other types of clothing thereafter.

[73] In the case of the Opponent's trade-mark MOTO, Mr. Gould states that there were sales of the Opponent's MOTO brand clothing in select Holt Renfrew stores and two other retailers in Toronto and Montreal since "at least as early as 2007".

[74] In view of the foregoing, the section 6(5)(b) factor favours the Applicant.

Sections 6(5)(c) and (d) - the nature of the goods, trade and business

[75] Sections 6(5)(c) and (d) factors involve the nature of the goods, trade and business.

[76] As per the statement of opposition and Mr. Gould's affidavit, the Opponent's trade-mark MOTO is used in association with clothing, including jeans, denim clothing and casual wear. Similarly, the Mark is applied for use in association with jeans and proposed use in association with other types of clothing and apparel, including shirts, pants, coats, headwear, footwear, clothing for women and young adults.

[77] There is clear overlap between the parties' goods as both are in the clothing and fashion industry. Although the subject application does not contain any restriction on the Applicant's channels of trade, I note that there is also clear evidence of overlap between the parties' channels of trade as both operate retail clothing stores.

[78] Accordingly, these two factors favour the Opponent.

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

[79] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. While 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, it is nevertheless possible to focus on particular features that may have a determinative influence on the public's perception [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)]. The preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[80] I am of the view that the relatively more striking element of the Mark is the term MOTO, which is the entirety of the Opponent's trade-mark. Both convey the idea of motor or motion [see *Merriam-Webster Dictionary*]. The second component of the Mark, JEANS, is descriptive/suggestive of the applied for goods.

[81] When the parties' trade-marks are viewed in their entirety, I find that there is a significant degree of resemblance in sound, appearance and in ideas suggested. Accordingly, the 6(5)(e) factor favours the Opponent.

[82] Accordingly, this factor favours the Opponent.

Conclusion in the likelihood of confusion

[83] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], the Supreme Court of Canada indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. Specifically, the Court noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion

analysis; the other factors become significant only once the trade-marks are found to be identical or very similar.

[84] 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, including that there is strong resemblance between the parties' trade-marks, that there is clear overlap between the parties' goods, and that there is real and potential for overlap in the channels of trade, I am not satisfied that the Applicant has discharged its burden to prove that, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark MOTO as of August 29, 2012.

[85] In this regard, while the evidence shows that the Mark has been used for a longer period of time in Canada in association with the Applicant's jeans and other clothing items and that the Applicant's overall MOTO-branded clothing has also become known to a greater extent in Canada through use and promotion, there are nevertheless two different entities selling and proposing to sell the same goods in association with highly similar trade-marks through the same channels of trade in Canada at the material date, such that the Mark can no longer function as a single source identifier. Use of both trade-marks in the same area would be likely to lead to the inference that the goods associated with the two trade-marks are manufactured, sold, leased, hired or performed by the same person.

[86] I would add that while I am mindful that the Applicant has sent a cease and desist letter to the Opponent in September 2011, the Applicant has not alleged or submitted that the Opponent should not be permitted to rely on the use of its trade-mark in Canada since that time on the basis that it was unlawful or that it was not *bona fide* use.

[87] Under these circumstances, I find that the Applicant has failed to establish, on a balance of probabilities, that the Mark was distinctive within the meaning of section 2 of the Act as of the material date. Accordingly, this ground of opposition is successful.

Does the Application Conform to the Requirements of Section 30(b) of the Act?

[88] In its statement of opposition, the Opponent alleges that contrary to section 30(b) of the Act, the Applicant has not used the Mark in Canada in association with “jeans” since the claimed date of first use, namely since “at least as early as June 1, 2004”.

[89] The material date for assessing a section 30(b) ground is the filing date of the application, namely May 4, 2010 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[90] The issue under section 30(b) is whether the Applicant had continuously used the Mark in the normal course of trade from the alleged date of first use to the material date [see *Immuno AG v Immuno Concepts, Inc* (1996) 69 CPR (3d) 374 (TMOB); *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262 and *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323].

[91] There is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application’s non-conformity to section 30(b) of the Act, bearing in mind that the facts regarding the Applicant’s first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas GJB*, supra]. The Court has noted that an opponent’s initial burden under section 30(b) can be met by reference not only to its own evidence but also that of the Applicant [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[92] In the present case, the Opponent is relying on the Mr. Boyd’s affidavit of June 7, 2013 and the Applicant’s own evidence to meet its initial evidential burden.

The Boyd Affidavit of June 7, 2013

[93] In his affidavit of June 7, 2013, Mr. Boyd provides printouts of his search results via the Wayback Machine at *archive.org* for earlier versions of the website located

www.internationalclothiers.com, purported to show the absence of any reference to “MOTO JEANS” at the claimed date of first use. According to Mr. Boyd’s search results, the first mention of “MOTO JEANS” that he was able to find on said website was dated September 2, 2011 (Exhibit “E”). There is also a screen shot of the website as it appeared on June 17, 2004 attached as Exhibit “D”, I note that the webpage shows various pieces of tops and jeans described as Men’s “JEANS & TEES By: Meccas & Paco”, with a copyright notice at the bottom of the screen “© 2002 International Clothiers INC.”

[94] Moreover, relying on Mr. Brener’s affidavit, the Opponent submits in its written argument that the Applicant’s evidence raises doubts as to whether the Mark has been used in association with “jeans” since June 1, 2004. In particular, the Opponent argues that Mr. Brener’s affidavit provides no evidence of use of the Mark since the claimed date of first use and that none of the work orders, hangtags, labels or advertisement attached to the Brener affidavit makes reference to the Mark “on or before June 1, 2004”. The Opponent adds that though the worksheets do make mention of the Mark, they do not evidence use as per section 4(1) of the Act as they do not evidence a transfer of possession, nor do they support the claimed date of first date “as the arrival date of the goods on these worksheets is in 2005”.

[95] As per my review of Mr. Brener’s affidavit, the 2009 affidavit provides information with respect to the use and promotion of the Applicant’s MOTO brand between 1997 and 2009. In particular, attached as Exhibit “C” are sample purchase worksheets and related invoices for the purchase of MOTO-branded clothing by the Applicant dated between 1997 and 2008 which in turn was sold at retail in Canada through the Applicant’s own retail stores. Purchase worksheet no. 46447 has October 13, 2004 as the “Date Ordered” for jeans described as “100% Cotton Denim” with label identified as “Moto Jeans”, with an indicated “expected arrival date” of “February 25, 2005”. Additional worksheets for jeans with “Moto Jeans” labels are included with similar order and expected arrival dates, and thereafter.

[96] Attached as Exhibit “D” to Mr. Brener’s 2009 affidavit are photographs of sample MOTO-branded clothing said to have been sold in Canada by the Applicant. Labels bearing the Mark, shown on a separate line underneath another trade-mark MOTO in a bigger font, can be seen prominently on different photos of jeans. Attached as Exhibit “E” to Mr. Brener’s 2009

affidavit are sample labels and hangtags used by the Applicant in association with the sale of its MOTO-branded clothing sold in Canada from 2003 and on. Different variations of the Mark, with or without additional written materials, are shown on hangtags and labels from those identified as “Fall 04”, “Spring 05” and “Fall 05”.

[97] In response, the Applicant submits that the Opponent did not adduce any evidence to support its allegation of non-compliance with section 30(b) of the Act. In particular, the Applicant argues that the Opponent had not proven any facts to dispute the Applicant having used the Mark in Canada in association with “jeans” since June 1, 2004 and that the Opponent’s evidence is insufficient to meet its initial evidential burden and cast doubt on the correctness of the Applicant’s claimed date of first use for the Mark. Notably, the Applicant contends that one cannot reasonably infer from the absence of reference of the Mark on selected screenshots of the Applicant’s website that it never used the Mark in Canada or that it did not use the Mark continuously as of the claimed date of first use.

[98] Having reviewed Mr. Boyd’s affidavit as well as Mr. Brener’s affidavit in its entirety, including the attached copies of Mr. Brener’s 2009 and 2012 affidavits, I am not satisfied that the Opponent has met its light initial evidential burden with respect to its section 30(b) ground. In particular, the Opponent failed to put into question the veracity of the claimed date of first use of the Mark in association with “jeans”.

[99] When the evidence mentioned above is viewed as a whole, I cannot conclude that there is inconsistency such that it casts doubt over the Applicant’s use of the Mark as of the claimed date of first use. Rather, the evidence appears to show hangtags bearing the Mark for jeans designed for sale in time for the Fall 2004 collection. While the Applicant’s evidence could have been more specific and fulsome by providing additional sales information of MOTO-branded clothing by the Applicant at the retail level in Canada from the claimed date of first use, and in particular those bearing the Mark specifically, in the absence of any evidence suggesting that the Applicant has not or could not have used the Mark in Canada as of the alleged date of first use in association with “jeans”, the Applicant is under no obligation to positively evidence such use.

[100] In the end, there is no requirement for the Applicant to substantiate its claimed date of first use with respect to its applied for goods until the Opponent has met its initial evidential

burden. In this case, the Opponent has not done so. Consequently, the section 30(b) ground is dismissed.

Does the Application Conform to the Requirements of Section 30(e) of the Act?

[101] In its statement of opposition, the Opponent alleges that contrary to section 30(e) of the Act, the Applicant does not have a *bona fide* intention to use the Mark in Canada in association with each of the general class of goods set out in the application under the proposed use claim.

[102] The material date for assessing a section 30(e) ground is the filing date of the application, namely May 4, 2010 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[103] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act. Thus the issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act. There is an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its claim of non-compliance with section 30(e) of the Act, whether by relying on its own evidence or that of the applicant [see *Molson Canada v Anheuser-Busch Inc* (2003), 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FC) at 334].

[104] While I accept that the facts regarding the Applicant's intention to use the Mark are particularly within the knowledge of the Applicant, there is nevertheless an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(e) of the Act. It is not until the Opponent has discharged its initial evidential burden that the Applicant is required to substantiate the claim that it intended to use the Mark in association with the applied for goods at the time of filing of the application.

[105] In its written argument and at the hearing, the Opponent submits that "it would be unusual for non-jeans related goods to be sold in association with the Mark, especially in light of the Applicant's numerous other MOTO brands". The Opponent once again states that work orders do not constitute evidence of use under section 4(1) of the Act.

[106] In response, the Applicant submits that it is clear that it complies with section 30(e) of the Act and that the Opponent has not adduced any evidence to indicate otherwise. In this regard, the Applicant argues that there is no evidence of record to suggest “a lack of intention” to use the Mark on the part of the Applicant, and that it is not required to prove its intention in the absence of evidence to the contrary as of the material date.

[107] I agree with the Applicant. Having reviewed Mr. Brener’s affidavit in its entirety, I am not satisfied that the Opponent has met its light initial evidential burden in putting in question the veracity of the statement made pursuant to section 30(e) of the Act by the Applicant in its application as of May 4, 2010. I have already addressed the Opponent’s argument with respect to evidence of work orders in the context of use under section 4(1) of the Act. More importantly, there is evidence that the Applicant did indeed use the Mark in association with other clothing items besides jeans, since the material date, such as with “Knitted 100% Polyester Fleece” in 2011. As such, the evidence corroborates the Applicant’s intention to use the Mark in association with non-denim clothing and apparel at the material date, despite the Opponent’s contention that “it would be unusual” to use the Mark in association with non-jeans items, an argument which in any case would not be sufficient to put into question the Applicant’s intention in this case.

[108] In view of the foregoing, I dismiss the section 30(e) ground of opposition.

Does the Application Conform to the Requirements of Section 30(i) of the Act?

[109] The Opponent alleges that contrary to section 30(i) of the Act, the application was filed in bad faith. In particular, the Opponent alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied for goods given the renown of the Opponent’s trade-mark MOTO in Canada since prior to the claimed date of first use; that the Applicant was likely well aware of the Opponent and its predecessor-in-title’s trade-mark MOTO prior to the claimed date of first use and filing date of the application; that the Applicant was likely well aware of the success of the Opponent’s trade-mark MOTO in association with clothing, including jeans, prior to the claimed date of first use and the filing date; and that the Applicant has for years engaged in a pattern of filing Canadian trade-mark applications to register marks which are identical or nearly identical to those of existing brands, and in particular to European and American clothing and retail brands.

[110] The material date for assessing a section 30(i) ground is the filing date of the application, namely May 4, 2010 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[111] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

Opponent's Initial Evidential Burden

[112] As in the case of a ground of opposition based on section 30(b) or 30(e) of the Act, to meet its initial evidential burden, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist (see *John Labatt Limited, supra*). The Opponent's burden is lighter with respect to the issue of non-compliance with section 30(i) because the facts regarding the Applicant's satisfaction as to its entitlement to use the trade-mark are particularly within the knowledge of the Applicant [see *Cerverceria Modelo SA de CV v Marcon* (2008) 70 CPR (4th) 355 (TMOB)].

[113] The fact that the Opponent has alleged confusion between the Mark and the prior use of its trade-mark outside of Canada, or of its prior making known in Canada, in association with the same or similar type of goods and services as those of the Applicant in Canada is not by itself sufficient to put into question section 30(i) of the Act. In any case, as discussed in the entitlement analysis below, I am not satisfied that the Opponent's trade-mark MOTO has been made known in Canada at the material date.

[114] Likewise, the fact that the Applicant might have been aware of the Opponent's use and registration of its trade-mark elsewhere is also not sufficient by itself to suggest bad faith and to put into question section 30(i) of the Act [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197]. In *Taverniti SARL v DGGM Bitton Holdings Inc* (1986), 8 CPR (3d)

400 (TMOB) at 404-405, Member Troicuk states the following with respect to a section 30(i) ground:

The opponent's third ground of opposition is that the applicant's application does not comply with section 30(i) in that the applicant could not have been satisfied that it was entitled to use the trade mark in Canada ... The opponent submitted that it could be inferred from the evidence that ... the applicant had knowledge of the opponent's trade marks and ... could not have been satisfied that it was the person entitled to registration. In support of this submission, the opponent relied upon the decision of the Exchequer Court in *Williamson Candy Co. v. W. J. Crothers Co.*, [1924] Ex. C.R. 183 (Can. Ex. Ct.), and, in particular, Maclean J.'s following statement at p. 191:

I think knowledge of foreign registration and user, of a mark applied to the same class of goods, as in this case, and particularly where the foreign user is in a contiguous country using the same language, and between which travel is so easy, and advertising matter so freely circulates, should in most cases be a bar to registration knowingly, of that mark here.

The *Williamson* case was, however, decided under the *Trade Mark and Design Act*, R.S.C. 1906, c. 71, s. 13 of which required an applicant to declare that the trade mark for which he sought registration was not in use to his knowledge by any other person than himself at the time of his adoption thereof. No such provision exists under the present *Trade-Marks Act*. In the present case, the opponent has not established prior use, prior making known, prior filing of an application or that its trade marks were known sufficiently in Canada to negate the distinctiveness of the applicant's trade mark and there is therefore no basis for concluding that the applicant could not have been satisfied that it was entitled to use its trade mark in Canada in association with the wares covered in its application. As a result, I also reject the opponent's third ground of opposition.

[115] The Opponent also alleges that the Applicant, "a sophisticated Canadian retailer", has for years engaged in a persistent pattern of filing Canadian applications to register marks for an array of pre-existing international brands, in particular European and American clothing, with no apparent link to the Applicant, and that the application for the Mark falls squarely within this pattern of predatory filing.

[116] In this regard, the Opponent points to Mr. Boyd's August 16, 2013 affidavit. Attached as Exhibit "A" are the particulars of 118 active Canadian trade-mark applications and registrations

by the Applicant, followed by 119 inactive ones also by the Applicant. Attached as Exhibits “B” to “EE” are the results of a search for the existence of third party brands for jeans, clothing, and retail stores, on the Internet, for which the Applicant has applied for identical or nearly identical registration in Canada accompanied by copies of search results from various trade-mark registries for these third party brands.

[117] Notably, Mr. Boyd’s August 16, 2013 affidavit made the following comparisons between the Applicant’s Canadian applications/registrations and those of third parties in Canada and abroad:

Applicant’s Applied For or Registered Mark	Third Party Registered Mark
<p style="text-align: center;">BOOM. BOOM. Application No. 1,096,083 – abandoned</p>	<p style="text-align: center;">BOOM BOOM JEANS by Blue Planet International, Inc. Canada – TMA779,266 United States – No. 3,589,710</p>
<p style="text-align: center;">PELLE JEANS Application No. 658,187– abandoned</p>	<p style="text-align: center;">PELLE PELLE by Pelle Pelle, Inc. Canada – TMA363,868</p>
<p style="text-align: center;">GARAGE U.S.A. TMA423,342 – expunged</p>	<p style="text-align: center;">GARAGE by Groupe Dynamite Inc. Canada – TMA678,226</p>
<p style="text-align: center;">RIVER ISLAND Application No. 1,351,950 – opposed</p>	<p style="text-align: center;">RIVER ISLAND by River Island Clothing Co. Limited Community Trade Mark – EU000135889</p>
<p style="text-align: center;">STVDIO LONDON Application No. 1,026,257 – abandoned</p>	<p style="text-align: center;">STVDIO BY JEFF BANKS by Jeffrey Tatham-Banks UK – UK00002121046</p>

<p>SoulCal Application No. 1,485,003 – allowed</p>	<p>SOUL CAL by Republic IP Limited Community Trade Mark – EU004105581</p>
<p>VROOM & DRESSMANN Registration No. TMA701,886 – registered</p>	<p>VROOM & DRESSMANN by V&D B.V. Benelux – 0593032</p>
<p>AKADEMIKS Application No. 1,076,282 – abandoned</p>	<p>AKADEMIKS by Kemistre 8 LLC Canada – TMA616,408 United States – No. 2,802,261</p>
<p>BEN SHERMAN SHIRT CO. Application No. 1,005,611 – abandoned</p>	<p>BEN SHERMAN by Ben Sherman Group Limited Canada – TMA590,020 Community Trade Mark – EU000217232</p>

[118] In view of the foregoing, I find that in this case, the Opponent has met its light evidential burden in putting the veracity of the Applicant’s satisfaction as to its entitlement to use the trade-mark in question by engaging in a pattern of seeking Canadian trade-mark registrations for an array of pre-existing international brands with no apparent link to the Applicant.

Applicant’s Legal Onus

[119] As the Opponent has met its initial evidential burden, I must now assess whether the Applicant has met its legal onus of proving that it was satisfied that it was entitled to use the Mark in Canada.

[120] In its written argument, the Applicant submits that the Opponent has not adduced any evidence of the Applicant’s bad faith. In this regard, the Applicant points to Mr. Brener’s affidavit in which the affiant states that “the adoption by [the Applicant] of the MOTO brand was entirely without knowledge of any use of “MOTO” by the Opponent in the United Kingdom or elsewhere.” As mentioned above, the Opponent did not cross-examine Mr. Brener on his affidavit. The Applicant also makes reference to answers provided by Mr. Gould during his

cross-examination. In particular, while Mr. Gould states in his affidavit that it would be highly unlikely that the Applicant was not aware of the Opponent's TOPSHOP and MOTO brands considering its worldwide success since the launch in 1993/1994, he has no personal knowledge in this regard [answers to Q273 and 274 of Mr. Gould's cross-examination].

[121] In addition, the Applicant refers to answers provided by Mr. Boyd during the cross-examination of his affidavit where he stated that he had no knowledge of how the Applicant came to choose any of the trade-marks mentioned in Mr. Boyd's affidavit, that he did not know whether the Applicant had a connection with any of the owners of these brands, and that he did not know what knowledge the Applicant had of these other trade-marks at the time of filing [answers throughout Mr. Boyd's cross-examination].

[122] Having reviewed the evidence put forth by the Opponent together with the extensive evidence of ongoing use of the Mark and of other MOTO brands by the Applicant for an extended period of time prior to the filing of the subject application, I am not satisfied that the Opponent has shown, in this particular case and with respect to this particular mark, that the statement made by the Applicant under section 30(i) of the Act that it is satisfied that it is entitled to use the trade-mark in Canada was untrue in that the application was filed in bad faith.

[123] At the hearing, the Opponent pointed to several cases where the application was found to be in non-compliance with section 30(i) of the Act by reason of bad faith including the Marcon case referenced above.

[124] In the Marcon case, there was evidence of prior use and registration of the identical mark for identical goods by the opponent in Canada, of the applicant's knowledge of the opponent's mark and of its prior use in Canada, of a pattern of applying for a series of third party arguably well-known registered marks in Canada for related goods with no or minimal commencement of use for any of them, and of a lack of professional experience and concrete business plans related to the applied for goods and services. These facts do not exist in the present case.

[125] Moreover, there are other surrounding circumstances here including the evidence of use of the Mark and that of other MOTO trade-marks in association with its applied for goods by the Applicant with significant sales figures in Canada for years prior to the filing of the application,

its prior registrations for related trade-marks MOTO SPORT (TMA502,767) and MOTO GEAR (TMA731,143) in Canada, the very limited presence of the Opponent's MOTO brand in Canada at the material date, and Mr. Brener's statement that the adoption of the Mark by the Applicant was entirely without knowledge of any use of "MOTO" by the Opponent in another country.

[126] As each case must be determined on its own facts [*Kraft Ltd v Registrar of Trade-marks* (1987), 1 CPR (3d) 457 (FCTD)], when the evidence is viewed in its entirety, I am not satisfied that, on a balance of probabilities, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada at the time of filing of the application. Consequently, the section 30(i) ground is dismissed.

Was the Applicant the Person Entitled to Registration of the Mark?

[127] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(1)(a) and 16(3)(a) of the Act, on the ground that it is confusing with the Opponent's trade-mark MOTO, which was previously made known in Canada since prior to the claimed date of first use and the filing date of the subject application.

[128] The material date for considering the section 16(1)(a) ground of opposition with respect to "jeans" is the claimed date of first use of the subject application, namely "since at least as early as June 1, 2004", and that for considering the section 16(3)(a) ground of opposition with respect to the remaining applied for clothing and apparel is the filing date of the subject application, namely May 4, 2010.

[129] The Opponent has the initial burden of proving that its trade-mark was made known in Canada prior to the material dates in question and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

Made Known in Canada

[130] Section 5 of the Act reads:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

(a) the goods are distributed in association with it in Canada, or

(b) the goods or services are advertised in association with it in

(i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or

(ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

[131] In *Williams Companies Inc et al v William Tel Ltd*, (2000) 4 CPR (4th) 253 (TMOB), the Registrar states:

In other words, the opponents are obliged, as a matter of law, to show that their marks had been “made known” and had become “well-known” by the specific means set out in section 5: see *Valle's Steak House v. Tessier* (1980), 49 C.P.R. (2d) 218 (F.C.T.D.) at pp. 224-5, and see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at p. 56. It follows that a mark which becomes well-known in Canada by means of word of mouth, or through newspaper or magazine articles (as opposed to advertising) is not a mark that has been “made known” in Canada within the meaning of section 5: see *Motel 6*, supra, at page 59, where this distinction is made.

[132] Having considered Mr. Gould’s affidavit, I am not satisfied that the Opponent has met its initial evidential burden of showing that its trade-mark MOTO has been made known in Canada as of June 1, 2004 or May 4, 2010 within the meaning of section 5 of the Act.

[133] In this regard, while there is some evidence of sale of TOPSHOP MOTO clothing in select Holt Renfrew stores and two other retailers in Toronto and Montreal since “at least as early as 2007”, the only evidence provided by Mr. Gould that pertains to advertising of the Opponent’s trade-mark MOTO in printed publications in Canada prior to either of these material dates are excerpts of UK newspaper articles dated between 1994 and 2002 discussing MOTO clothing for men and women attached as Exhibit “A1”. There is no evidence that any of these UK newspapers were circulated in Canada at that time.

[134] As for excerpts of various travel guides published in 2002, 2006, 2007 and 2008, said to be available to Canadians through bookstores and libraries attached as Exhibit “G”, there is no mention of the Opponent’s trade-mark MOTO in them nor are there any circulation numbers of

those books in Canada. Similarly, with respect to excerpts of the 2009 and 2010 editions of *Time Out: New York*, said to have been available for purchase on newsstands in Canada, there is no reference to the Opponent's trade-mark MOTO in the excerpts.

[135] There is also no evidence of advertising by radio broadcast ordinarily received in Canada.

[136] In its written argument, the Opponent also contends that since the application does not comply with section 30 of the Act, there can be no entitlement to this registration. As per my analysis regarding the section 30(b), 30(e) and 30(i) grounds, since I am not satisfied that the application does not conform to section 30 of the Act, it will not be necessary for me to address whether this would have been a proper pleading under the non-entitlement grounds of opposition, or whether this allegation forms part of the Opponent's statement of opposition.

[137] Consequently, the sections 16(1)(a) and 16(3)(a) grounds are dismissed.

DISPOSITION

[138] 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.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: November 30, 2017

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