



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

Citation: 2018 TMOB 91

Date of Decision: 2018-08-08

IN THE MATTER OF AN OPPOSITION

Söfft Shoe Company, LLC

Opponent

and

M.J. Soffe, LLC

Applicant

1,684,981 for SOFFE

Application

INTRODUCTION

[1] Söfft Shoe Company, LLC (the Opponent) opposes registration of the trade-mark SOFFE (the Mark) that is the subject of application No. 1,684,981 by M.J. Soffe, LLC (the Applicant).

[2] The application is based upon proposed use of the Mark in Canada in association with the following goods:

Footwear, namely athletic footwear, running shoes, exercise footwear and casual shoes (sometimes hereinafter collectively referred to as the Goods).

[3] The opposition was brought under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), and raises grounds of opposition based upon sections 2 (non-distinctiveness); 12 (non-registrability); 16 (non-entitlement); and 30 (non-conformity) of the Act.

[4] For the reasons that follow below, the opposition ought to be rejected.

THE RECORD

[5] The application was filed on July 14, 2014 and advertised for opposition purposes in the *Trade-marks Journal* on April 1, 2015.

[6] The statement of opposition was filed on August 25, 2015. The grounds of opposition are as follows:

- i. The application does not conform to section 30(e) of the Act because, at the date of filing of the application, the Applicant was already using the Mark in association with each of the Goods.
- ii. The application does not conform to sections 30(e) and (h) of the Act because, the trade-mark proposed to be used is not the Mark covered by the opposed application but another, different from the one referred to in the opposed application, namely SOFFE with the design depicted in Canadian trade-mark application No. 1,684,982.
- iii. Alternatively or cumulatively, the application does not conform to section 30(e) of the Act because, the Applicant, by itself or through a licensee, or by itself and through a licensee, never intended to use the Mark in Canada in association with each of the Goods, be it the way the Mark is presented in the opposed application or for the Goods referred to in the opposed application, the Applicant never having, at the relevant time, the specific intention to use the Mark with each of the Goods.
- iv. The application does not conform to section 30(i) of the Act because, the statement that the Applicant is satisfied as to its entitlement to the use of the Mark in Canada is false in view of the content of the present opposition, including the knowledge of the Applicant of the rights of the Opponent as herein alleged and of the unlawfulness of said use, if any:
 - such use would be, was and is unlawful in that such use is encroaching upon the proprietary rights, as alleged herein, of the Opponent;
 - such use would be, was and is unlawful in that such use is likely to have the effect of depreciating the value of the goodwill attached to the registered trade-mark(s) alleged by the Opponent, contrary to section 22 of the Act;

- such use would be, was and is unlawful in that such use would direct public attention to Applicant's goods or business in such a way as to cause confusion in Canada between these goods or business and those of the Opponent, contrary to paragraph 7(b) of the Act.
- v. The Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the following registered trade-marks of the Opponent that are registered in association with "footwear, namely shoes, boots and sandals":
 - SÖFFT, registration No. TMA712,217
 - SÖFFT Design (reproduced below), registration No. TMA869,910

The image shows the word "Söfft" in a large, black, serif font. The letters are bold and have a classic, slightly ornate appearance. The 'S' is particularly large and prominent. The 'ö' has two dots above it. The 'ff' is written as a single unit with a thick vertical stroke and a thin horizontal stroke for the second 'f'.

- vi. The Applicant is not the person entitled to registration of the Mark under section 16(3) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent's trade-mark SÖFFT, whether in word or design form (or encompassing this term) that had been previously used in Canada or made known in Canada for footwear.
- vii. The Applicant is not the person entitled to registration of the Mark under section 16(3) of the Act because, as the date of filing of the application, the Mark was confusing with a trade-name that had been previously used in Canada by the Opponent, namely SÖFFT (or encompassing this term) for footwear.
- viii. The Mark is not distinctive within the meaning of section 2 of the Act, because:
 - the Mark does not actually distinguish the Goods in association with which the Mark is used or proposed to be used by the Applicant from the goods of the Opponent, nor is it adapted to distinguish them;
 - the Mark is used outside the scope of the licensed use provided for by section 50 of the Act, including Delta Apparel, Inc.

[7] The Applicant filed and served a counter statement on November 10, 2015 denying each of the grounds of opposition set out in the statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of its president and CEO, James E. Issler, sworn on March 8, 2016 (the Issler affidavit) and certified copies of trade-mark registration Nos. TMA712,217 and TMA869,910 referred to above.

[9] In support of its application, the Applicant filed the affidavit of Dori Ludwig Walton, a law clerk employed at the law firm representing the Applicant in this proceeding, sworn October 28, 2016 (the Walton affidavit) and certified copies of the following registered trade-marks of the Applicant that are registered in association with “clothing namely jackets, jerseys, tee shirts, polo shirts, tank tops, shorts, sweat pants, sweat shirts and sweat suits”:

- SOFFE, registration No. TMA958,492
- SOFFE Design (reproduced below), registration No. TMA673,517



This registration includes the following colour claim:

Colour is claimed as a feature of the trade-mark. The colours red and blue are claimed as a feature of the trade-mark. The mark consists of the word SOFFE in large red capital letters with two blue underlines above and two blue underlines below the word SOFFE.

[10] None of the affiants were cross-examined on their affidavits.

[11] Only the Applicant filed written arguments, but both parties were represented at an oral hearing.

ONUS AND RELEVANT DATES

[12] The Opponent has the initial evidentiary 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 is registrable remains on the Applicant, on a balance of probabilities [*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)].

[13] The relevant dates that apply to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act: the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- Sections 38(2)(b)/12(1)(d) of the Act: the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) of the Act: the filing date of the application [see section 16(3) of the Act]; and
- Sections 38(2)(d)/2 of the Act: the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

ANALYSIS

Grounds of opposition summarily dismissed

Sections 30(e) and (h) grounds of opposition

[14] All of the sections 30(e) and (h) grounds of opposition are dismissed for the Opponent's failure to meet its evidentiary burden. The Opponent did not file any evidence in support of these grounds of opposition, nor did it make any submissions in this regard.

Second prong of the section 2 ground of opposition

[15] The second prong of the non-distinctiveness ground of opposition alleges that the Mark is used outside the scope of the licensed use provided for by section 50 of the Act, including Delta Apparel, Inc. This ground is dismissed for the Opponent's failure to meet its evidentiary burden. The Opponent did not file any evidence in support of this ground of opposition, nor did it make any submissions in this regard.

Analysis of the remaining grounds of opposition

[16] The sections 12(1)(d) (non-registrability); 16(3) (non-entitlement); and 38(2)(d) (non-distinctiveness under section 2 of the Act) grounds of opposition turn on the issue of the likelihood of confusion between the Mark and the Opponent's SÖFFT trade-mark (whether in word or design form) or trade-name. As I consider the section 12(1)(d) ground of opposition to present the Opponent's strongest case and as in the circumstances of this case, it does not make any difference which material date is selected, I will assess the likelihood of confusion in the context of that ground. A determination of the issue of confusion under that ground will effectively decide the outcome of the sections 16(3) and 38(2)(d) grounds of opposition.

Section 12(1)(d) ground of opposition

[17] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-marks SÖFFT and SÖFFT Design identified above.

[18] I have exercised the Registrar's discretion to confirm that these two registrations are in good standing as of today's date.

[19] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and one or both of the Opponent's registered trade-marks.

The test for confusion

[20] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the 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.

[21] Thus, this section does not concern the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[22] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[23] The Applicant submits that the Mark is inherently distinctive as it consists of a coined word, which has no inherent connection to the Goods, or any other source. The Applicant submits that by contrast, the Opponent's trade-mark SÖFFT (word and design versions) is a weak mark because as demonstrated by the Walton affidavit (discussed below), there are numerous third party registrations which co-exist on the register which include the element "soft" and are registered for use in association with footwear or shoes. I partly disagree with the Applicant's approach.

[24] The fact that there may be other "soft" trade-marks standing on the register of trade-marks does not come into play when assessing the inherent distinctiveness of each of the parties' mark *per se*. However, state of the register evidence may constitute a relevant circumstance to be considered as an additional circumstance under the test for confusion. I will return to that point later.

[25] That being said, I agree with the Opponent that both parties' marks possess a certain degree of inherent distinctiveness. As a coined word having no readily apparent meaning in relation to the Opponent's footwear, the Opponent's registered SÖFFT trade-mark (word and design versions) is not weaker than the Mark.

[26] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[27] There is no evidence that the Applicant's proposed use Mark has been used or become known in Canada. In comparison, the Opponent's evidence filed through the Issler affidavit speaks to the issue of the Opponent's use of its SÖFFT trade-mark (word and design versions). According to Mr. Issler:

- The Opponent carries on business as a manufacturer and distributor of footwear since 1927 [para 5 of the affidavit].
- Since at least as early as June 2004, the Opponent adopted the trade-mark SÖFFT, whether in word or design format, for the sale of its footwear [para 6 of the affidavit].
- The Canadian sales for the Opponent's SÖFFT footwear in Canada for the years 2010-2016 amounted to \$1,118,361.93 USD (41,557 pairs). A breakdown per year is provided [para 8].

[28] In support, Mr. Issler attaches as Exhibit A-1 to his affidavit, random extracts from the Opponent's website at *www.softshoe.com* showing "representative footwear, as sold in Canada by [the Opponent] since at least as early as June 2004". Mr. Issler confirms that even though these extracts were taken in March 2016, they are representative of the kind of footwear, as well as of the marking of those with the SÖFFT trade-marks of the Opponent when sold in Canada [para 7 of the affidavit].

[29] In its written argument, the Applicant has commented on Mr. Issler's affidavit as follows:

It is important to note what Mr. Issler [*sic*] does not include in his affidavit, and for which there is no evidence. That includes:

- a) any evidence of use of the word mark SÖFFT. All the images which Mr. Issler states, at paragraph 7 of his affidavit, that depict use of the SÖFFT trade-marks in Canada on footwear, are use of the SÖFFT Design mark, not the word mark SÖFFT;
- b) the specific type of footwear sold (i.e. dress shoes v. athletic shoes);

- c) any information about sales and marketing efforts in Canada. For example, there is no evidence that any Canadian ever visit [*sic*] the Opponent's website; and
- d) any information regarding the channels of trade for the Opponent's goods.

[30] I partly disagree with the Applicant's approach.

[31] First, I am satisfied that use of the SÖFFT Design mark covered by registration No. TMA869,910 qualifies as use of the word mark SÖFFT, which constitutes the dominant element of the mark. The Opponent is not under a restriction to use its word mark in any particular format by virtue of the fact that the registration is for a word mark.

[32] Second, upon review of Exhibit A-1, I note that the Opponent's footwear is described in the Opponent's Fall/Winter 2015 Lookbook as comprising "modern boots", "chic booties", "wearable heel heights" and "comfortable flats" for women. Other excerpts also include photographs of women's sandals. In other words, Exhibit A-1 relates to women's footwear.

[33] Third, although Mr. Issler does not expressly describe the Opponent's channels of trade and marketing efforts in Canada, the Opponent's sales figures (and number of pairs) for the Opponent's SÖFFT footwear in Canada for the years 2010-2016 appear significant enough for me to conclude that the Opponent's SÖFFT trade-mark (word and design versions) has become known to some extent in Canada. The breakdown provided by Mr. Issler shows constant sales over time (on average about \$184,000 USD (about 6,875 pairs) per year). Moreover, the Applicant elected not to cross-examine Mr. Issler on his affidavit, and I therefore have no reason to discount Mr. Issler's evidence.

[34] In view of the foregoing, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent.

The length of time the trade-marks have been in use

[35] In view of my comments above, this factor also favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[36] When considering the nature of the goods and services and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registrations relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[37] I agree with the Opponent that the parties' goods clearly overlap. As indicated above, the Opponent's registrations cover "footwear, namely shoes, boots and sandals" whereas the Applicant's applied-for goods cover "footwear, namely athletic footwear, running shoes, exercise footwear and casual shoes". In this regard, I do not find convincing the Applicant's argument made at the hearing according to which the parties' respective footwear are completely different. The Opponent's footwear is not restricted to dress shoes. Moreover, some of the Opponent's footwear shown in Exhibit A-1 to the Issler affidavit could arguably be characterized as casual footwear.

[38] In the absence of evidence to the contrary, it is presumable that the parties' channels of trade would also overlap to some extent.

[39] In view of the foregoing, these factors also favour the Opponent.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[40] As noted by the Supreme Court in *Masterpiece*, *supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names

do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[41] Moreover, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. The trade-marks must be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark [*Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 369]. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [*Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [*Masterpiece, supra*, at para 64].

[42] In its written argument, the Applicant submits that:

39. The Opponent’s mark includes the highly unusual umlaut over the “o”. Given that this not [*sic*] punctuation used by either French or English speakers, the average Canadian would focus on the umlaut and, even in a hurry, would recognize its presence (or absence) as a defining feature of the Opponent’s mark. Hence, the absence of the umlaut in the [Mark] renders the marks different, especially considering the number of marks on the register which include “soft” for relevant goods.

40. [...] [The] design [of the SÖFFT Design mark] is very different that the [Mark].
[...]

42. When sounded, consumers would refer for Opponent’s mark as the common English word “soft” (pronounce “saw-ff-t”). By contrast, consumers would likely refer to the [Mark] SOPH-EE (similar to the pronunciation of the name Sophie) or SOPH (similar to the pronunciation of the first element of “sofa”).

43. The idea suggested by the [Mark] is also much different than the idea suggested by the Opponent’s marks. As set out above, the Opponent’s mark conveys the idea of softness or, in the context of footwear, comfort. By contrast, the [Mark] connotes the name Sophie.

[43] At the hearing, the Opponent focussed its submissions on the visual and phonetic similarities between the parties’ marks. In reply to the Applicant’s afore-described submissions,

the Opponent submits that the substitution of the letter “T” for the letter “E” does not result in substantial differences between the marks.

[44] Visually speaking, the Opponent submits that contrary to the Applicant’s submission, the umlaut in the Opponent’s SÖFFT trade-mark (word and design versions) is not a dominant feature as it merely consists of a common punctuation mark in the French language (like in *Noël*, *Israël*, *naïf*, *paranoïaque*, *égoïste*, *coïncidence*, *Joëlle*, etc.). The Opponent submits that the average French-speaking or bilingual consumer is used to see that punctuation mark and would not pay attention to it.

[45] Phonetically speaking, the Opponent submits that the Applicant’s submission according to which consumers would likely refer to the Mark SOPH-EE (similar to the pronunciation of the name Sophie) is flawed. For the Mark to be pronounced that way, it would have to be spelled “SOFFIE” or “SOFFEE”. The Opponent submits that the parties’ marks would be pronounced the same, that is “SOFF”.

[46] In reply, the Applicant submitted at the hearing that although the umlaut is a common punctuation mark in the French-language, the examples given by the Opponent do not cover the situation where the umlaut is over the letter “o”. The Applicant submits that the average consumer would react to the umlaut over the letter “o” as a name of German consonance. The Applicant submits that the Opponent’s trade-mark SÖFFT is equivalent to the word “soft”, which is inherently weak in the context of the Opponent’s footwear as demonstrated by the Walton affidavit (discussed below).

[47] I find the truth is somewhere between the two parties’ views.

[48] Both parties’ trade-marks consist of single coined words.

[49] Considering first the ideas suggested by the marks, I do not find persuasive the Applicant’s submission that Canadian consumers would react to the Mark as evoking the name Sophie. Nothing in the Mark is reminiscent of the name Sophie. Rather, I find the Mark does not evoke any particular meaning for English and/or French-speaking consumers. However, I do agree with the Applicant that the Opponent’s trade-mark SÖFFT (whether in word or design form) is likely to be perceived as a foreign sounding name by reason of the unusual umlaut over

the letter “o”. Furthermore, while the Opponent’s trade-mark SÖFFT (whether in word or design form) does not have any clear meaning in relation to footwear, I do agree with the Applicant that the average consumer is likely to react to the Opponent’s mark by thinking of the common English word “soft” given their strong similarity.

[50] Visually speaking, I agree with the Applicant that the parties’ marks are different. The different spellings of the trade-marks (including the unusual umlaut over the letter “o” in the Opponent’s SÖFFT trade-mark (whether in word or design form) render them quite different in appearance.

[51] The only similarity between the parties’ marks is phonetically. Still, I disagree with the Opponent that the parties’ marks would be pronounced exactly the same. Rather, I find that consumers would refer to the Opponent’s trade-mark SÖFFT (whether in word or design form) as the common English word “soft” (pronounce “saw-ff-t”) and to the Mark as “SOF” (with a soft “o” – rhyming with “cough”).

[52] Overall, when all three aspects of resemblance are considered together, I find that the parties’ marks are quite different.

Additional surrounding circumstances

State of the register

[53] The Applicant has submitted through the Walton affidavit information about searches Ms. Walton conducted of the Canadian Trade-marks Office database of active applications and registrations for trade-marks that contain the word “soft” and include either “footwear” or “shoes” in the list of goods and services.

[54] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205

(FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[55] In the present case, the Applicant submits that the Walton affidavit demonstrates numerous co-existing registrations which begin with the element “soft” which are for use in association with footwear or shoes, including: SOFTMOC (Reg. TMA554,070); SOFTWAVES (Reg. TMA653,366); SOFTWAIR (Reg. TMA678,531); SOFT SYSTEM (Reg. TMA531,002); SOFT STAGS (Reg. TMA726,866); SOFT-TEX (Reg. TMA850,233); SOFT SHOES (Reg. TMA371,712).

[56] In reply, the Opponent submitted at the hearing that the registration for SOFTMOC does not cover footwear *per se*. Still, I note that this registration covers “retail footwear store services” and “sale of footwear over the internet”. The Opponent further pointed out that among the tens of hits revealed by Ms. Walton searches, about 9 registrations are owned by the Opponent; about 6 other registrations do not cover footwear or shoes *per se* (but related goods/services); a few hits pertain to applications that have either been abandoned or not yet allowed for registration; and a few registrations do not include the element “soft” in the trade-mark. The Opponent further submitted that more importantly, all of the twenty-some remaining registrations revealed by Ms. Walton’s searches include the element “soft” *in combination* with other word or design elements. As a result, the Opponent submits that the state of the register evidence introduced through the Walton affidavit does not assist the Applicant’s case.

[57] While I agree with the Opponent that none of the twenty-some remaining registrations revealed by Ms. Walton’s searches may be as “close” to the Opponent’s SÖFFT trade-mark as the Mark, the fact remains that they do incorporate the element “soft” for a variety of footwear. In addition to the trade-mark registrations listed above, it is worth noting, among others, the following registrations which also begin with the element “soft” for use in association with footwear: SOFTSHELL & Design (Reg. TMA928,343); SOFT COMFORT (Reg. TMA694,608); SOFT STEP (Reg. TMA252,856); SOFT WALK (Reg. TMA627,350); SOFT STYLE (Reg. TMA789,562); SOFT FLEXIBLE BY HIGHLIGHTS (Reg. TMA492,268); SOFT TREADS BY LUC ANTHONY (Reg. TMA885,548); SOFT SURROUNDINGS (Reg. TMA878,814); SOFT-JOYS (Reg. TMA242,646). These registrations represent a number

significant enough for inferences about the state of the marketplace to be drawn. In other words, I am able to infer that at least some of those marks are in use and that consumers are accustomed to seeing such “soft” marks in the marketplace. They would therefore be more likely to differentiate such marks on the basis of their other components. This leads me to find in this case that a consumer would be more likely to pay attention to the suffix of the Mark and the umlaut and “FF” in the Opponent’s trade-marks and distinguish them on this basis.

[58] To sum up, I find this is a surrounding circumstance favouring the Applicant.

Existing Canadian registrations

[59] As a surrounding circumstance, the Applicant submits that it already owns Canadian registration Nos. TMA958,492 and TMA673,517 for the trade-mark SOFFE for use in association with “clothing namely jackets, jerseys, tee shirts, polo shirts, tank tops, shorts, sweat pants, sweat shirts and sweat suits” [as per the certified copies mentioned above].

[60] The Applicant submits that in *Patagonia, Inc v Chaussures André SA, Société Anonyme*, 1994 CanLII 10087 (TMOB), the Registrar concluded that clothing and footwear are related, specifically finding that:

[...] the nature of the parties' wares are essentially the same, except that the opponent does not sell footwear under its mark PATAGONIA. However, **footwear are related to clothing, and in the absence of evidence to the contrary, I conclude that clothing and footwear would travel through the same channels of trade**: see *Eber San Francisco v. Irmaos Pedro Ltda.* (1986), 9 C.P.R.(3d) 141 at 144 (TMOB); *Salamander AG v. Pacific Clothing Exchange* (1988), 19 C.P.R.(3d) 349 at 351 (TMOB). (**Emphasis added by the Applicant**)

[61] The Applicant also notes the decision of the Federal Court in *Hayabusa Fightwear Inc v Suzuki Motor Corporation*, 2014 FC 784 where the Court agreed with the Registrar that footwear is included in the definition of clothing.

[62] Using that logic, the Applicant submits that the co-existence of the Applicant’s registration for SOFFE and SOFFE Design for clothing, *including socks* with the Opponent’s SÖFFT trade-mark must, by necessity, mean that the Mark for use in association with the Goods can likewise co-exist. The Applicant submits that given the absence of evidence to the contrary

about channels of trade, and using the logic of the Registrar in *Patagonia, supra*, in essence the marks already co-exist.

[63] I find it is not necessary to consider this additional surrounding circumstance in order to find in favour of the Applicant.

Conclusion regarding the likelihood of confusion

[64] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar “need not be satisfied beyond doubt that confusion is unlikely. Should the ‘beyond doubt’ standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity.”

[65] Given my analysis above, I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent’s SÖFFT trade-mark (whether in word or design form) would be unlikely to conclude that the Applicant’s Goods originate from the same source or are otherwise related to or associated with the Opponent’s registered goods.

[66] I find that the differences existing between the parties’ marks are determinant in themselves and more than sufficient to outweigh the factors favouring the Opponent in this case. My finding is reinforced when the state of the register evidence is factored in.

[67] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Section 16(3) grounds of opposition

[68] In order to meet its evidentiary burden with respect to its section 16(3) grounds of opposition, the Opponent had to show that as of the date of filing of the Applicant’s application, its trade-mark or trade-name SÖFFT had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant’s application [section 16(5) of the Act].

[69] I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to its section 16(3) grounds of opposition.

[70] Indeed, even if I were to assume that the Opponent has met its evidentiary burden with respect to these grounds of opposition, the difference in relevant dates would not affect my analysis above under the section 12(1)(d) ground of opposition. In other words, I would still find that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark in association with the Goods and the Opponent's trade-mark or trade-name in association with the Opponent's footwear at the filing date of the Applicant's application.

[71] Accordingly, the non-entitlement grounds of opposition are also rejected.

First prong of the section 2 ground of opposition

[72] In order to meet its evidentiary burden with respect to the first prong of its non-distinctiveness ground of opposition, the Opponent had to show that as of the filing date of the opposition its trade-mark had a substantial, significant or sufficient reputation in Canada in association with its alleged footwear so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[73] I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to this ground of opposition.

[74] Indeed, even if I were to assume that the Opponent has met its evidentiary burden with respect to this ground of opposition, the difference in relevant dates would not affect my analysis above under the section 12(1)(d) ground of opposition. In other words, I would still find that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark in association with the Goods and the Opponent's trade-mark in association with the Opponent's footwear at the filing date of the opposition.

[75] Accordingly, the first prong of the non-distinctiveness ground of opposition is also rejected.

Section 30(i) ground of opposition

[76] The following comments made by Member de Paulsen in the decision *Intercast Europe S.r.l. v Next Retail Limited*, 2017 TMOB 12 are applicable to the present case:

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

[29] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied it is or was entitled to use the Mark in Canada in association with the Goods and Services given the Opponent's Registrations in Canada and sections 7, 20, and 22 of the Act. Even though it is far from certain that the combination of section 30(i) with any of sections 7(b), 20 and 22 of the Act constitutes a valid ground of opposition [see *Euromed Restaurant Limited v Trilogy Properties Corporation*, 2012 TMOB 19 at para 13 citing *Parmalat Canada Inc. v Sysco Corp.* (2008), 2008 FC 1104, 69 CPR (4th) 349 (FC) at paras. 38-42], the Opponent has not met its initial burden with respect to its allegation that the Applicant could not be satisfied it was entitled to use the Mark in view of these sections of the Act. Specifically:

a. The Opponent has failed to adduce any evidence in support of the elements required to show a violation of section 7(b) of the Act: (i) the existence of goodwill, (ii) deception of the public due to a misrepresentation and (iii) actual or potential damage to the offended party [see *Ciba-Geigy Canada Ltd. v Apotex Inc.*, 1992 CanLII 33 (SCC), [1992] 3 SCR 120 at para 33 cited by *Pharmacommunications Holdings Inc. v Avencia International Inc.*, 2008 FC 828 at para 41].

b. Section 20 requires a finding of confusion; however, I have found that the Mark is not confusing with one or both of the Opponent's Registrations.

c. The Opponent has failed to adduce any evidence of a depreciation of goodwill of one or both of the Opponent's Registrations as required to show a violation of section 22 of the Act [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, *supra* at paras 46 and 63 to 68].

[77] I find it is not necessary to determine if the section 30(i) ground of opposition, as pleaded, raises a valid ground of opposition.

[78] Indeed, even if I were to assume that the ground is valid and properly pleaded, I would still find that the Opponent has not met its evidentiary burden with respect to this ground of opposition since my finding made above concerning the absence of a likelihood of confusion remains applicable as of the filing date of the application. I further note that the Opponent did not make any submission about this ground of opposition.

[79] Accordingly, the section 30(i) ground of opposition is also rejected.

DISPOSITION

[80] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2018-06-18

APPEARANCES

Gabriel St-Laurent

FOR THE OPPONENT

Antonio Turco

FOR THE APPLICANT

AGENTS OF RECORD

Robic

FOR THE OPPONENT

Blake, Cassels & Graydon LLP

FOR THE APPLICANT