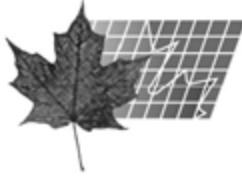


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 151

Date of Decision: 2018-11-29

IN THE MATTER OF AN OPPOSITION

Brooks Sports, Inc.

Opponent

and

Anta (China) Co., Ltd.

Applicant

**1,715,568 for MISCELLANEOUS
DESIGN**

Application

OVERVIEW

[1] Anta (China) Co., Ltd. (the Applicant) has applied to register the trade-mark set out below (the Mark) in association with the following goods:





Goods:



(1) purses; satchels; backpacks; wallets; handbags; bags, namely, travel bags, athletic bags, paper bags, polyethylene bags; envelopes; plastic bags for packaging; cases, namely, vanity cases sold empty, key cases; valises; suitcases; slings for carrying infants; umbrellas; walking sticks; clothing, namely, athletic clothing, beachwear, business attire, casual clothing, tee-shirts, tights, pajamas, petticoats, sweat-absorbent underwear, beachwear, raincoat, headbands against sweating; singlets; vests, namely, clothing suit vests, fishing vests; undergarments; underpants; children's garments, namely, dresses, bonnets, layettes; sports clothing, namely, cyclists' jerseys; caps, bathing caps; swimsuits; exercise clothing, namely, gymnastics clothing, clothing for wear in judo practices, wrestling clothing; football shoes; ski equipment, namely, ski boots; footwear, namely, athletic shoes, casual shoes, children's shoes; boots, namely, mountaineering boots, hiking boots, horse-riding boots, ladies' boots, rain boots; athletic footwear, namely, gymnastic shoes, basketball shoes, running shoes, walking boots; caps as clothing; muffs, namely, ear muffs; hosiery; gloves, namely, bicycle gloves, boxing gloves, goalkeepers' gloves, golf gloves; shawls; neckwear, namely, neckerchiefs, neckties; girdles, namely, sports equipment girdles and foundation girdles; tables for indoor football; toys, namely, flying discs; puzzles; chess game sets; golf equipment, namely, golf balls, golf clubs, golf wear, golf shoes, golf bags; racket or racquet strings; table tennis playing equipment; balls, namely, basketballs, footballs, volleyballs, tennis balls, table tennis balls, badminton balls, rugby balls, baseballs; badminton game sets; exercise equipment, namely, barbells, dumbbells, treadmills; archery equipment, namely, arrows, bows, sights, targets; boards, namely, surfboards; fencing equipment, namely, chest protectors, gauntlets, masks, sabres, swords, fencing vests; mountaineering equipment, namely, binding straps, boots, carabiners, pitons; skateboards; boxing equipment, namely, mouth guards, punching bags, punching gloves, boxing shoes; dart game sets; whistles; pools, namely, swimming pools; protective body equipment, namely, eye shields, face shields, elbow and knee pads, leg guards; cuffs; skates; fishing equipment, namely, hooks, lines, lures, reels and rods

[2] The application for the Mark is based on the Applicant's proposed use. There is no evidence that use of the Mark has commenced in Canada.

[3] Brooks Sports, Inc. (the Opponent) alleges that the Mark is confusing with its trade-

marks including a single flare chevron design such as  and  for use in association with footwear and sports and casual clothing. The Opponent's evidence shows that its sales of goods in Canada in association with trade-marks including a single flare chevron design totaled over \$40 million USD in the five years between 2011-2016.

[4] Given the extent of use of the Opponent's trade-marks, the lack of evidence of use of the

Mark, the similarities between the Opponent's trade-marks  and  and the Mark, as well as the overlap in the nature of the goods and channels of trade, I find that the Applicant has failed to prove that there is no reasonable likelihood of confusion. As such, the Opponent succeeds with respect to three of its grounds of opposition for the reasons that follow.

BACKGROUND






[5] On February 17, 2015, the Applicant filed an application to register the Mark based on its proposed use of the Mark in association with the Goods.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated January 20, 2016.

[7] On June 20, 2016, the Opponent opposed the application on the basis of the grounds of opposition summarized below:

- (a) The application does not comply with the requirements of section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the application does not contain a statement in ordinary commercial terms of the specific goods in association with which the Mark will be used.
- (b) The application does not comply with the requirements of sections 30(b) and 30(e) of the Act in that the application was filed on the basis of proposed use but the Mark was used with the Goods prior to the filing date of the application.
- (c) The application does not comply with the requirements of section 30(g) of the Act as the application does not contain the address of the Applicant's principal office or place of business in Canada or abroad.
- (d) The application does not comply with the requirements of section 30(i) of the Act as the Applicant cannot be satisfied that it is entitled to use the Mark in Canada with the Goods, in light of the prior use in Canada of the Opponent's Chevron Design Trade-marks (defined below).

- (e) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with a registered trade-mark, namely the Opponent's Chevron Design Trade-marks set out below and the family of trade-marks formed by these trade-marks:

<p>TMA290,452</p> 	<p>Athletic shoes.</p>
<p>TMA577,600</p> 	<p>Clothing, namely shoes, boots, slippers, socks, sports clothing, leisure clothing, casual clothing, shirts, pants, jackets, hats, caps, bandanas, shorts, tights, hosiery, jogging suits, gloves, sweat pants, sweat suits, sweat shirts, warm up suits, head bands, T-shirts, skirts, leggings, unitards, wind resistant jackets, belts, insoles, vests, waterproof jackets, waterproof pants, waterproof vests, sweaters, track suits, tank tops, turtle necks, trousers, jerseys, visors, wrist bands.</p>
<p>TMA646,624</p> 	<p>Athletic bags, gym bags, fanny packs, backpacks and water holsters.</p>
<p>TMA338,782</p> 	<p>Shoes.</p>
<p>TMA620,170</p> 	<p>Athletic footwear, namely, shoes and socks.</p>
<p>TMA839,329</p>	<p>Athletic bags, gym bags, fanny packs, backpacks, water holsters, athletic footwear.</p>

- (f) The Applicant is not the person entitled to register the Mark in view of section 16(3)(a) of the Act since the Mark was confusing with the Opponent's Chevron Design Trade-marks and the family of trade-marks formed by the these trade-marks.
- (g) The Applicant is not the person entitled to register the Mark in view of section 16(3)(b) of the Act since the Mark was confusing with the Opponent's application Nos. 1,663,431; 1,663,429; and 1,663,430 and the family of marks formed by the Opponent's applications.
- (h) The Mark is not distinctive of the Goods of the Applicant since it does not distinguish the Goods in association with which it is proposed to be used from the goods of the Opponent.

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

[9] The Opponent filed as its evidence the affidavit of Dan Sheridan. No evidence was filed by the Applicant. The Opponent alone filed a written argument and no hearing was requested.

EVIDENTIAL BURDEN AND LEGAL ONUS

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

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



opponent (for those allegations for which the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

GROUND OF OPPOSITION

[12] I will now consider the grounds of opposition beginning with the section 12(1)(d) ground of opposition.

Section 12(1)(d) Ground of Opposition

[13] The material date for a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].



[14] The Opponent has pleaded that the Mark is not registrable because it is confusing with registration Nos. TMA290,452; TMA577,600; TMA646,624; TMA338,782; TMA620,170; and TMA839,329 set out in paragraph 7(e) of this decision. I have exercised my discretion and have checked the Register to confirm that these registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent's registered trade-marks. I consider that the Opponent's best case scenario rests in registration Nos. TMA577,600 and TMA646,624 for the trade-mark  and No. TMA620,170 for the trade-mark  and will concentrate my analysis on these registrations. If the Opponent is not successful based on these trade-marks, then it will not be successful based on any of its other registrations.



Test to Determine Confusion

[15] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether

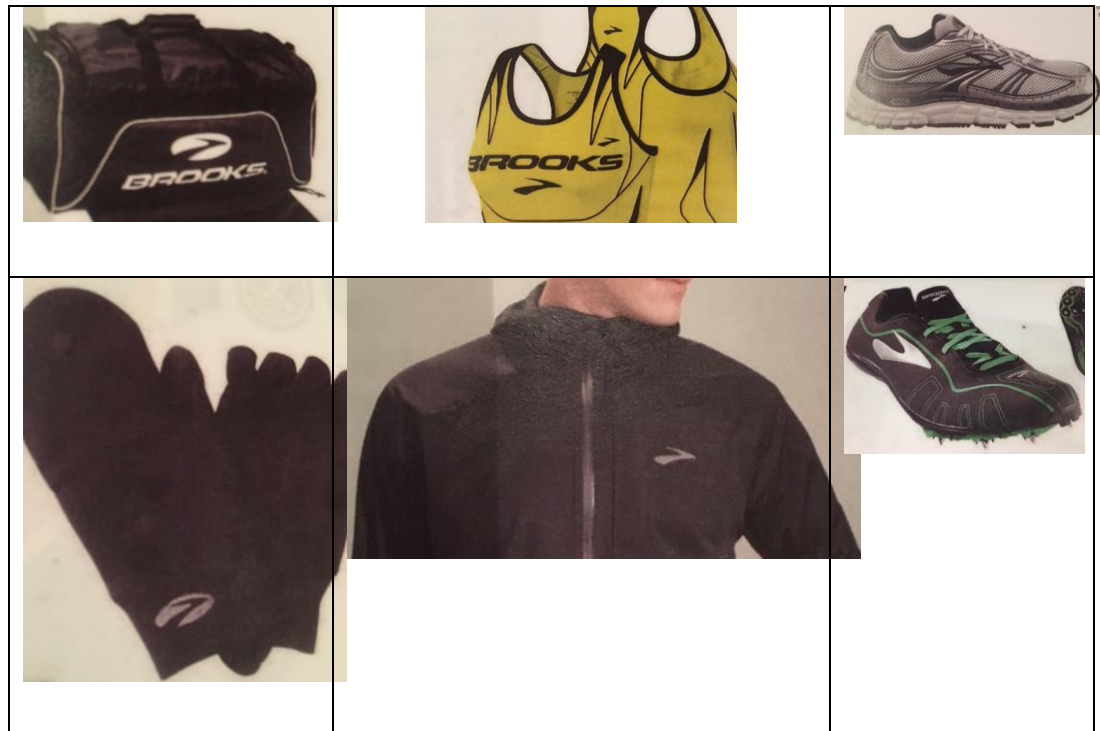
or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.


Summary of the Opponent's Evidence With Respect to Its Single Flare Chevron Design

[16] The Opponent filed the affidavit of Dan Sheridan, its Executive Vice President – General Manager Global Sales of the Opponent (para 1). Mr. Sheridan has been employed by the Opponent since 1998 (para 2). The Opponent's evidence summarized below leads to the conclusion that its trade-marks  and  are well known in Canada.

- The Opponent was originally founded in 1914 and throughout its history has produced and sold athletic shoes and apparel (para 5). The Opponent's products have been sold in Canada since at least as early as 1977 (para 6).
- The Opponent distinguishes its products through consistent use of a diagonal chevron mark with a single, under-sized flare (para 8).
- All sales of the Opponent's products in Canada are made in association with at least one of its chevron trade-marks (para 17).
- The Opponent provides photos of its design trade-marks  and  on running shoes, socks, jackets, tank tops, pants, sports bras, and hats sold in Canada as included in its 2009-2017 catalogues (Exhibits A, B, H). Representative examples are set out below. I find that any deviations in the registered designs do not alter the trade-marks identity. First, the colour scheme of

the examples provided is immaterial, as it is well established that registration of a trade-mark in black and white covers use of that mark in any combination of colours [*Brouillette & Associés v Constellation Brands U.S. Operations, Inc.*, 2016 TMOB 159 at para 19]. Second, I do not discount uses of these trade-marks that appear in conjunction with the trade-mark BROOKS, because there is nothing to prevent two trade-marks being used at the same time in association with the same goods [*A.W. Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); *Canadian Council of Professional Engineers v Ardex Inc* (2001), 13 CPR (4th) 554 (TMOB)].



- The Opponent's evidence also includes photographs of point-of-sale material including its trade-mark  on wall signs, wall banners, light boxes, clothing bars, foot forms, and stools (Exhibits A, H) including those set out below:



- In Canada, sales of Brooks footwear products from 2011 to 2016 were in excess of 735,000 units having a value of over \$35 million USD with yearly sales between 65-150,000 units and \$2.5-9.5 million (para 19). In Canada, sales of Brooks apparel from 2011 to 2016 were in excess of 615,000 units having a value of over \$9 million USD with yearly sales between 55-130,000 units and \$0.7-1.5 million (para 20).
- Brooks distributes its goods throughout Canada in national retailers such as Mountain Equipment Co-Op, Winners, Sport Chek, and Running Room (para 15), as well as through its website *www.brooksrunning.com* (para 16, Exhibit F).
- Between 2008-2016, there were between 25-130,000 unique visits per year to the Opponent's website from Canada (para 28).

Analysis of the Section 6(5) Factors

Inherent Distinctiveness

[17] Both the Mark and the Opponent's registered trade-marks examined herein possess some inherent distinctiveness as they are all artistic shapes with no apparent connection between the designs and the parties' respective goods. That being said, the parties' trade-marks are not inherently strong as they are decorative and comprise simple geometric designs [*Levi Strauss & Co v Vivant Holdings Ltd* (2003), 34 CPR (4th) 53 (TMOB)].

Extent Known and Length of Time in Use

[18] I am satisfied from the evidence of Mr. Sheridan that the trade-marks  and




have been promoted and used extensively in Canada for a long period of time.


Consequently, I find it reasonable to conclude that each of these trade-marks is quite well known in Canada. As the Applicant has filed no evidence of use or reputation in Canada, this factor significantly favours the Opponent.

Nature of Goods and Trade



[19] Sections 6(5)(c) and (d) factors, which involve the nature of the goods, trade and business, also favour the Opponent to a large extent.

[20] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods as defined in each of the registrations relied upon by the Opponent and in the application for each of the Marks that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[21] The Opponent's trade-mark  is registered for a variety of sports clothing, leisure

clothing, footwear and bags and its trade-mark  is registered with shoes and socks. In

his affidavit, Mr. Sheridan provides evidence that the Opponent's footwear, apparel and

accessories bearing its trade-marks  and  are sold in stores across Canada and through the website www.brooksrunning.com. The Mark is applied for use in association with goods that can be generally described as casual and athletic footwear, bags and cases, clothing and accessories, headgear, and sport equipment. In the absence of evidence from the Applicant, I conclude that with the exception of pools, namely swimming pools and puzzles, there is direct overlap in the nature of the parties' goods. Further, the parties' clothing, accessories, footwear and sports equipment could all be sold by sports retailers. With respect to puzzles and swimming pools, bearing in mind the lack of evidence from the Applicant, I find that there is still

the potential for overlap in their channels of trade as puzzles and smaller swimming pools (ie for use by children) may be sold in the same stores that sell apparel and running shoes.

Degree of Resemblance

[22] As stated earlier, the degree of resemblance between the trade-marks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trade-mark [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, *supra* at para 20].



[23] In terms of appearance, I find the most striking or unique element of the Mark and the Opponent's trade-marks is the overall effect of the chevron design. I find that the trade-marks share an extremely high degree of visual resemblance as they are nearly identical chevrons in reverse orientation. In this case, neither trade-mark is susceptible of being sounded and neither trade-mark suggests any idea in particular [*Levi Strauss & Co v Benetton Group SpA* (1997) 77 CPR (3d) 233 (TMOB)].

Surrounding Circumstance: Family of Trade-marks

[24] In its statement of opposition, the Opponent alleges that it has a family of trade-marks with a chevron design. Where there is a family of trade-marks, there may be a greater likelihood that the public would consider a trade-mark that is similar to be another trade-mark in the family and consequently, assume that the product or service that is associated with that trade-mark is manufactured or performed by the same person. There is, however, no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), *aff'd* 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 at para 35 (TMOB)]. Given that there are no sales figures for the different versions of the Opponent's chevron design trade-marks, I do not find that the Opponent has provided sufficient evidence of a family of trade-marks such that I could find that there is an increased likelihood of confusion.



Conclusion

[25] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I find that the Applicant has failed to meet its legal onus of proving, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[26] Specifically, a casual consumer with an imperfect recollection of either of the trade-marks  and  who encounters the Goods in association with the Mark may think that said Goods are sold by, sold under license or are otherwise affiliated with the Opponent. As an aside, with the benefit of evidence or representations from the Applicant, I may have reached a different conclusion with respect to the goods described as “puzzles” and “pools, namely, swimming pools” and issued a split decision.

[27] In finding this ground of opposition successful, I have had regard to all of the surrounding circumstances including that: (i) only the Opponent’s trade-mark has a significant degree of acquired distinctiveness; (ii) there is an extremely high degree of resemblance between the Mark and the Opponent’s trade-marks; and (iii) there is no evidence that casual consumers are accustomed to seeing and having to distinguish between trade-marks with chevron designs in the parties’ fields of interest.

Sections 16(3) and 2 Grounds of Opposition

[28] The evidence of use of either the trade-marks  or  discussed with respect to the section 12(1)(d) ground of opposition is sufficient to meet the Opponent’s burden under these grounds of opposition. The Applicant’s position is no stronger as of the filing date or the statement of opposition filing date [see section 16 of the Act and *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, (2004), 34 CPR (4th) 317 at 324 for the material dates for these grounds of opposition]. As such, these grounds of opposition also succeed.

Remaining Grounds of Opposition

[29] As I have already found in favour of the Opponent under three grounds of opposition, I do not consider it necessary to address the remaining grounds.

DISPOSITION

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

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

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

No Hearing Held

Agents of Record

Clark Wilson LLP

For the Opponent

Smart & Biggar

For the Applicant