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

Citation: 2019 TMOB 5

Date of Decision: 2019-01-18

IN THE MATTER OF AN OPPOSITION

Aktieselskabet af 21. november 2001

Opponent

and

DOSAIL CANADA CORP.

Applicant

1,699,692 for VELAMODA

Application

THE RECORD

[1] On October 27, 2014 DOSAIL CANADA CORP. (the Applicant) filed the application bearing serial No. 1,699,692 to register the trade-mark VELAMODA (the Mark). This application has been amended since then and now covers a long list of clothing, accessories and massage equipment (the Goods) and the services of wholesale, retail stores, mail order service, online sale of the Goods, custom printing of some of the Goods, special custom design of the Goods, business management; operation of the business for the manufacturing of the Goods and the franchise services for the retail selling of the Goods (the Services) which are detailed in Annex A to this decision.

[2] The application is based on use of the Mark in Canada since September, 2014. No specific date of the month is mentioned in the application. Therefore, the date of first use of the

Mark is presumed to be the last day of the month namely, September 30, 2014 [see *Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388(TMOB)].

[3] The application was published on October 26, 2016 in the *Trade-marks Journal* for the purposes of opposition.

[4] On December 22, 2016 Aktieselskabet af 21. november 2001 (the Opponent) filed a statement of opposition which was forwarded to the Applicant by the Registrar on January 17, 2017. The grounds of opposition pleaded are based on sections 12(1)(d) (registrability); 16(1)(a) (entitlement); 30(b) and (i) (compliance); and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[5] The Applicant filed a counter statement on March 13, 2017.

[6] The Opponent filed, as its evidence, the affidavits of Malene Gulstad Heslop sworn on July 5, 2017, Dane Penney sworn on July 11, 2017 and Amy Dam sworn on July 10, 2017.

[7] The Applicant filed, as its evidence, the affidavits of Fei Dong sworn on October 5, 2017 and Juan Li, sworn on the same date.

[8] None of the deponents were cross-examined.

[9] Both parties filed written arguments and a hearing was not requested.

[10] For the reasons that follow, I allow in part the application.

PRELIMINARY REMARKS

[11] In reaching my decision I have considered all the relevant evidence in the file. However, I shall only refer to those portions of the evidence which are directly on point to the issues discussed in the body of my decision.

ONUS

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential

burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

GROUND OF OPPOSITION BASED ON SECTION 30(I)

[13] It has often been ruled that section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the goods and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[14] The Opponent has not filed any evidence of that nature in the record. Therefore it has not met its initial evidential burden.

[15] Consequently, this ground of opposition is dismissed.

GROUND OF OPPOSITION BASED ON SECTION 30(B) OF THE ACT

[16] The material date with respect to this ground of opposition is the filing date of the application (October 27, 2014) [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

The Opponent's initial burden

[17] In *1772887 Ontario Ltd v Vancouver Free Press Publishing Corp* 2015 TMOB 120, my colleague Lisa Reynolds described the Opponent's burden under section 30(b) in those terms:

23 While the legal burden is upon the applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M. Opp. Bd.), at 329 ; and *John Labatt Ltd. v. Molson Cos.* (1990), 30 C.P.R. (3d) 293 (Fed. T.D.)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the initial evidentiary burden on the Opponent with respect to this ground is relatively light [see *Tune Masters*

v. Mr. P's Mastertune Ignition Services Ltd. (1986), 10 C.P.R. (3d) 84 (T.M. Opp. Bd.)]. Furthermore, the Opponent may rely upon both its own evidence and that of the Applicant in order to meet its initial evidential burden [*Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (Fed. T.D.), at 230].

24 In cases where an opponent has relied upon the applicant's evidence in order to meet its evidential burden for a section 30(b) ground of opposition, it has been held that in order to do so, the opponent must show that the applicant's evidence is "clearly inconsistent" with the claims set forth in its application [see, *Ivy Lea Shirt Co. v. Muskoka Fine Watercraft & Supply Co.* (1999), 2 C.P.R. (4th) 562 (T.M. Opp. Bd.), at 565 -6 , affirmed 2001 FCT 252 (Fed. T.D.) (CanLII), (2001), 11 C.P.R. (4th) 489 (Fed. T.D.)]. However, I note that in a more recent decision in the Federal Court, Justice Rennie pointed out that this "clearly inconsistent" approach leads to a somewhat opaque evidential burden, as the burden is described simultaneously as being a "light" burden while also demanding, in the case of an opponent who relies on the applicant's evidence, that the evidence be "clearly inconsistent" with the applicant's claims, shifting the burden higher [*Bacardi & Co. v. Corporativo de Marcas GJB, S.A. de C.V.*, 2014 FC 323 (F.C.) at paragraphs 30-38 (CanLII)].

[18] The Opponent, in its written argument, is relying entirely on the Applicant's evidence to support this ground of opposition. In fact the Heslop, Penney and Dam affidavits do not contain any allegation that would support directly or indirectly this ground of opposition. Given that the Opponent's evidence has not raised any serious issues with respect to the claimed date of first use alleged by the Applicant in its application, the Applicant was under no obligation to address this matter in its evidence. Nevertheless, because it chose to do so, if the Applicant's evidence on this subject is "clearly inconsistent" with its claimed date of first use alleged in its application, then the Opponent will have met its initial burden. Consequently, the burden would then shift on the Applicant to prove that it has used the Mark in Canada in association with each of the Goods and Services since the claimed date of first use namely, September 30, 2014.

[19] Under these circumstances, I will summarize in detail the relevant portion of the Applicant's evidence on which the Opponent is relying to support its contention, put forward in its written argument, that the Applicant never used the Mark since at least as early as September 2014, as alleged in its application.

The Applicant's relevant portion of its evidence

[20] The Opponent primarily relies on paragraph 2 of Mr. Dong's affidavit, the "owner" of the Applicant, as he describes himself. It reads:

2. **On March 17, 2014**, I registered business at the name of **8821298 CANADA CORP.** **In July 2014**, **8821208 CANADA CORP.** started its marketing under the brand name “VELAMODA”
In the early part of Sept., 2014, **8821208 CANADA CORP.** placed the first order with its producer & the brand name showed on labels and tags is: [VELAMODA & Design].
On Sept 28, 2014 the producer shipped the goods to **8821208 CANADA CORP.**
On Oct. 08, 2014, “**8821208 CANADA CORP.**” was amended to “**DOSAIL CANADA CORP.**”
On Oct. 27, 2014, **DOSAIL CANADA CORP.** filed the application for trademark **VELAMODA**

Attached hereto and marked as **Exhibit “A”** are printouts of **Certificate of Incorporation** of 8821208 CANADA CORP., **Certificate of Amendment to DOSAIL CANADA CORP.**, **BILL OF LADING of Shipment** on Sept. 28, 2014. (Emphasis in the affidavit itself).

[21] As for Mr. Li’s affidavit, he declares that he is the owner of YORKCO INC., which is in the business of wholesale and retail of “accessories”. Mr. Li does not explain the meaning of that word in the context of his affidavit.

[22] Mr. Li affirms that in January 2015, at the Spring Toronto Gift Show, the Applicant had “a booth to display some of their products-bags, scarves”. He then states: “I knew this company from that show and learned from them that it was a new company and its business established in 2014 in CANADA. I agreed with this company to show and sell some of their products in my showroom...”. He then annexed, as Exhibit A to his affidavit, two photographs, taken in September 2017, of a handbag, its label and tag on which appears the Mark.

Analysis of this evidence

[23] At the outset, I wish to point out that the ground of opposition based on section 30(b) of the Act makes reference to both the Goods and the Services. However, in its written argument, the Opponent focuses on the Goods. In any event, I will determine if this ground of opposition is successful in so far as the Goods are concerned, and then with respect to the Services.

The Goods

[24] The Opponent asserts that the mere statement that the Applicant placed the first order with its producer in the early part of September 2014 and the assertion that the producer shipped,

to the Applicant, the goods on September 28, 2014 are not sufficient to prove that the Mark has been used in Canada since the claimed date of first use, within the meaning of section 4(1) of the Act.

[25] In addition, the Opponent argues that Mr. Dong failed to mention whether this first order was the result of an order from a customer who would ultimately receive the products ordered. Also, Mr. Dong failed to mention whether the goods ordered were ever received by or transferred to a customer since the claimed date of first use. Citing the Registrar's decision in *383783 Ontario Ltd v Ram Golf Corp* (1989), 24 CPR (3d) 99 (TMOB), the Opponent submits there should be no inference the orders placed by the Applicant with a foreign manufacturer were in fact, received by the Applicant and subsequently sold to customers in Canada at the relevant date.

[26] As for the bill of lading annexed to Mr. Dong's affidavit, the Opponent notes that it describes the goods as "wallet", "hand bags" and "scarf". They were still in China on September 28, 2014 since the goods were "laden" or loaded onto the vessel that same day. Consequently, it would be highly improbable those goods arrived in Canada and were subsequently sold to customers in Canada during or "before the end of September 2014". Moreover, bills of lading are not considered documents establishing an association between a trade-mark and goods at the time of transfer of property or possession as required by section 4(1) of the Act [see *Bedessee Imports Ltd v Demerara Distillers Ltd*, 2014 TMOB 101].

[27] As for the Li affidavit, the Opponent argues that the earliest referenced date is 2015.

[28] I have to determine if the evidence filed by the Applicant, or lack thereof, puts into issue the claimed date of first use of September 30, 2014 in association with the Goods.

[29] I conclude in favour of the Opponent. Mr. Dong specifically mentioned that the bill of lading corresponds to the first order, with a producer located in China. It bears a date of September 28, 2014. In the absence of any other documents that would establish a transfer of property of any of the Goods from the Applicant to a customer in Canada as of September 30, 2014, the evidence described above appears to be clearly inconsistent with the claimed date of first use of the Mark in Canada in association with any of the Goods.

[30] Consequently, the Applicant had the burden to prove that it used the Mark in Canada, within the meaning of section 4(1) of the Act, in association with the Goods at least as early as September 30, 2014. It failed to do so.

[31] Consequently, this ground of opposition is maintained, in so far as the Goods are concerned.

The Services

[32] Without elaborating on the use of the Mark in association with the Services as of the claimed date of first use, or lack thereof, the Opponent simply concludes after its argumentation detailed above, that the Applicant failed to show use of the Mark since the claimed date of first use in association with any of the Applicant's Goods and Services. I already disposed of the matter with respect to the Goods. I shall now discuss this ground of opposition in so far as the Services are concerned.

[33] Other than the allegation of Mr. Dong in paragraph 2 of his affidavit, reproduced above, that the Applicant started its "marketing" in July 2014, we have no additional information on the Applicant's business activities related to the Services that would represent clear inconsistencies with the claimed date of first use of the Mark in association with them.

[34] Consequently, the Opponent has not met its initial burden and consequently, the ground of opposition based on section 30(b) of the Act is dismissed in so far as the Services are concerned.

GROUND OF OPPOSITION BASED ON THE LIKELIHOOD OF CONFUSION

[35] The grounds of opposition based on sections 12(1)(d), 16(1) and 2 (distinctiveness) turn on the issue of likelihood of confusion of the Mark with the Opponent's trade-mark VERO MODA.

The material dates

[36] The relevant date to assess each of those grounds of opposition varies from one ground to another and they are:

- For section 12(1)(d): the date of the Registrar’s decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)];
- For section 16(1)(a) of the Act: the claimed date of first use of the Mark (September 30, 2014) [see section 16(1) of the Act];
- For section 2 (distinctiveness): the filing date of the statement of opposition (December 22, 2016) [see *Bojangles’ International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[37] The difference in the relevant dates for each of those grounds of opposition will not have an impact on the final outcome of my analysis of the likelihood of confusion between the parties’ marks.

[38] I shall review the evidence in the context of the ground of opposition based on section 12(1)(d) of the Act. If I conclude in favour of the Opponent under this ground of opposition, I would conclude in its favour under the other grounds of opposition mentioned above.

Ground of opposition based on section 12(1)(d)

The Opponent’s initial burden

[39] Ms. Heslop is the Head of the Legal Department for the Opponent. She filed as Exhibit A to her affidavit, a copy of a certified copy of registration TMA734569 for the trade-mark VERO MODA, owned by the Opponent. The registration covers the following goods and services:

(1) Clothing, namely shirts, sweaters, sweatshirts, vests, pants; skirts, jackets made of leather and imitation of leather.

(2) Shopping bags and key holders (leather). (The Opponent’s goods)

(1) The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods through retail stores, wholesale outlets or the Internet, namely, boxes of leather, envelopes of leather for packaging, trunks, valises, traveling bags, traveling sets, garment bags for travel, vanity-cases, rucksacks, bags, handbags, beach bags, shopping bags, shoulder bags, school bags, suit cases, canvas traveling sack, luggage, attaché-cases, leather cases, briefcases, pouches, pocket wallets, purses, key-holders, leather card holders, umbrellas, parasols, canes, walking-stick seats, clothing, footwear, headgear. (The Opponent’s services)

[40] I checked the register and this registration is extant. Consequently, the Opponent has met its initial burden with respect to its ground of opposition based on section 12(1)(d) of the Act.

The test for confusion

[41] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* [2006] 1 SCR 824, (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* [2006] 1 SCR 772, (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* [2011] 2 SCR 387, (2011), 96 CPR (4th) 361 (SCC)].

[42] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-mark, who sees the Applicant's Goods and Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

Degree of resemblance

[43] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. One must consider the degree of resemblance from the perspective of appearance, sound and in the ideas suggested by them. Moreover, the Supreme Court stated that 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. It is not the proper approach to set the marks side by side and to critically analyze them to find similarities and differences.

[44] Mr. Dong affirms that “vela” is an Italian word that means “sailing” and “moda”, also an Italian word, means “fashion”. He has not filed extracts of an Italian-English dictionary to support such allegation. However, the Applicant, in its application, does refer to the English meaning of these Italian words. For the purpose of this discussion, I am prepared to accept these translations as the true meaning in English of the components of the Mark.

[45] As for the Opponent’s trade-mark VERO MODA, Mr. Dong affirms that “vero” is an Italian word that means “true” in English. In fact, in its application for the registration of its mark, the Opponent did mention that both components of its mark are Italian words where “vero” translates to "true" and “moda” translates to "fashion".

[46] Mr. Dong states that the font used by the Applicant for the Mark is “distinct and completely different” from the Opponent’s trade-mark VERO MODA and as such cannot cause confusion with the Opponent’s trade-mark.

[47] Therefore, the Applicant submits the marks in issue are different in appearance, sound and ideas suggested as the first components of the marks have completely different meanings and spelling. Moreover, the font used by the Applicant serves to distinguish the Mark from the Opponent’s trade-mark VERO MODA.

[48] In so far as the meaning of the Italian words “vela” and “vero” which are the dominant portions of the marks in issue, I have no evidence that the average Canadian, French speaking, English speaking or bilingual, would know the meaning of those two words. I acknowledge that, for a French speaking or bilingual Canadian, the word “moda” may be associated with the French word “mode”, or “fashion” in English, because of its similarity in appearance and sound, but with the evidence in the record, I cannot conclude that the average Canadian would differentiate the marks in their totality by their meaning in French or English.

[49] As for the font used by the Applicant for the Mark, the application is for the registration of a word mark and as such the Applicant, if its application is allowed, would be at liberty to use any font for its Mark, including block letters. Therefore, the argument of using a different font, is of no assistance to the Applicant.

[50] I agree with the Opponent that in the context of imperfect recollection, the marks do share some similarities in appearance and sound. They have the same first two letters (VE) and the last four letters (MODA). They have the same number of syllables. In all, I am of the opinion that the parties' marks share more important features than they have differences.

[51] This factor favours the Opponent. Consequently, I have to analyze the other relevant factors to determine if they favour the Applicant in such a way, that globally they would outweigh the resemblance of the marks and therefore would negate the risk of confusion between the parties' marks.

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

[52] Both marks have the same degree of inherent distinctiveness, given their similarities. However, the degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada.

[53] I have already discussed the evidence of "use" of the Mark, or lack thereof. Even if I were to conclude that there has been use or promotion of the Mark in Canada since July 2014, which is not the case, I do not have any information on the extent of the marketing activities. Therefore, I would still not be able to determine the extent to which the Mark has become known in Canada.

[54] I do not need to summarize at length the content of the Opponent's evidence on its use of its trade-mark VERO MODA in Canada. Suffice to say that through the Heslop, Penney and Dam affidavits the Opponent has proven that:

- The Opponent is a global clothing company that markets and sells an extensive line of clothing, accessories and related fashion products in over 40 markets across the world, including Canada (paragraph 3 of the Heslop affidavit);
- The Opponent obtain the registration for the trade-mark VERO MODA on February 17, 2009 and is based on use in Canada since at least as early as February 28, 2005 for the Opponent's goods and March 1, 2011 for the Opponent's services (Exhibit A to the Heslop affidavit);
- The Opponent's trade-mark VERO MODA appears directly on product labels and hang tags affixed to clothing and accessories which are sold through major departmental stores, clothing boutiques and online ecommerce stores (paragraph 7 and Exhibit C to the Heslop affidavit);

- The Opponent’s trade-mark VERO MODA has been appearing directly on interior and exterior store signage of VERO MODA-branded retail clothing boutiques and designated areas of department stores such as the Hudson’s Bay (paragraphs 8 and 9 and Exhibits D and E to the Heslop affidavit);
- The Opponent’s goods are sold in association with the trade-mark VERO MODA online through Canadian ecommerce stores such as <bestsellerclothing.ca>, <thebay.com>, <simons.ca>, <shop.ca>, and <amazon.ca> (paragraph 10 and Exhibit G to the Heslop affidavit);
- In Canada, the total number of the Opponent’s goods sold bearing the VERO MODA trade-mark have exceeded 480,000 units annually from 2012 to 2016 (paragraph 13 of the Heslop affidavit);
- From January 2011 to July 2013, the Opponent has spent \$75,000 to promote the Opponent’s goods and services in association with the trade-mark VERO MODA (see paragraph 14 and exhibit H to the Heslop affidavit for a sampling of Canadian magazine and newspaper articles that feature or make reference to the Opponent’s trade-mark VERO MODA, which include *National Post*, *the Gazette*, *Toronto Star*, *Flare* and *Chatelaine*);
- At the wholesale level, the Opponent advertises its goods bearing the trade-mark VERO MODA by distributing “brand Books”, a sample of which is annexed to the Heslop affidavit as Exhibit K (paragraph 17 of the Heslop affidavit);
- The Opponent’s trade-mark VERO MODA is also advertised through websites and social media such as Facebook, Instagram and Twitter (see paragraphs 18, 19 and 20 and Exhibits L, M and N of the Heslop affidavit).

[55] The Penney and Dam affidavits support the Opponent’s contention that the trade-mark VERO MODA has been appearing on in-store signs within the Hudson’s Bay department store (see pictures filed as Exhibit A to the Penney affidavit) and on exterior and interior signs of VERO MODA-branded retail stores (See Exhibit A to the Dam affidavit).

[56] In all, I conclude that the Opponent’s trade-mark VERO MODA is known in Canada to some extent in association with the Opponent’s goods and services.

[57] Consequently, this factor favours the Opponent.

Length of time the trade-marks have been in use

[58] From the evidence described above, this factor also favours the Opponent even if I consider, for the purpose of this analysis, that the Mark has been used in Canada since July 2014, which is not the case.

Nature of the goods, services and nature of the trade

[59] For the purpose of assessing paragraphs 6(5)(c) and (d) of the Act, it is the Applicant's Goods and Services and the goods and services listed in the Opponent's registration that govern [see *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. As for the channels of trade, those statements must be read with a view to determine 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 [see *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 Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[60] As indicated earlier, the Goods include clothing and accessories as well as massage equipment while the Services include wholesale, retail stores, mail order service, online sale of the Goods, custom printing of some of the Goods, special custom design of the Goods, business management; operation of the business for the manufacturing of the Goods and the franchise services for the retail selling of the Goods.

[61] The Opponent's registration TMA734569 for the trade-mark VERO MODA covers clothing and accessories and the services of operating retail stores, wholesale outlets or offering for sale on the Internet clothing and accessories.

[62] Ms. Heslop describes the Opponent as a family-owned global company selling clothing, accessories and related fashion products under various brands, including the trade-mark VERO MODA. She explains that the Opponent operates approximately 2,700 branded chain stores worldwide, including Canada, and its products are sold in approximately 15,000 multi-brand and department stores, and online through various Canadian ecommerce retailers enumerated above.

[63] As reported earlier, Mr. Dong describes the Applicant as a wholesaler of fashionable products including, bags, scarves and hats.

[64] I conclude from this evidence that the parties' goods and services overlap save and except for:

Clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

Wholesale, retail stores, mail order service, online sale of: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

Special custom design for: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

Business management; operation of the business of manufacturing of: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

Franchise services for the retail store selling: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers.

(Collectively hereinafter referred to as “the Applicant’s non-overlapping Goods and Services”)

[65] Consequently, this factor also favours the Opponent, except for the Applicant’s non-overlapping Goods and Services.

Conclusion

[66] All the relevant factors favour the Opponent, except for the Applicant’s non-overlapping Goods and Services. The Applicant has not discharged its burden to prove, on a balance of probability, that a consumer, with an imperfect recollection of the Opponent’s trade-mark VERO

MODA, who sees the Applicant's Goods and/or Services (except for the Applicant's non-overlapping Goods and Services) in association with the Mark, would not think that they emanate from the Opponent or sponsored, or approved by the Opponent.

[67] I also conclude that the nature of the Applicant's non-overlapping Goods and Services is sufficient to rule in favour of the Applicant for those goods and services.

[68] I therefore maintain in part the ground of opposition based on section 12(1)(d) of the Act. It is dismissed for the Applicant's non-overlapping Goods and Services.

[69] Since the difference in the relevant dates would have no positive effect in favour of the Applicant in my analysis of the relevant criteria under the grounds of opposition based on section 16(1) and 2 (distinctiveness) of the Act, I also maintain in part those other two grounds of opposition.

DISPOSITION

[70] Given that the Opponent has been successful with its ground of opposition based on section 30(b) of the Act for all of the Goods only, and in part for the grounds of opposition based on sections 12(1)(d), 16(1) and 2 and pursuant to the authority delegated to me under section 63(3) of the Act, the net result is that I reject in part the opposition in so far as the following services are concerned:

Wholesale, retail stores, mail order service, online sale of: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

special custom design for: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

business management; operation of the business of manufacturing of: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their

parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers;

franchise services for the retail store selling: clocks, chronometers, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers; travel clocks and their parts and fittings; walking sticks, carpets, picnic rugs; massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers.

and I refuse the application for all of the Goods and the remainder of the Services pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

ANNEX A

Goods: (1)handbags, tote bags, satchels, shoulder bags, clutch bags, clutch purses, evening bags, bags for campers, beach bags, carry-all bags, rucksacks, backpacks, suitcases, briefcases, trunk for travel, luggage, travel kits, overnight cases, portfolio, cases and holders for portable computers and mobile telephones, school bags, purses, pouches, toiletry bags, wrist bags, tie cases , attache cases, billfolds, cases and bags for keys, cosmetic bags and pouches(sold empty),change purses, passport holders, card holders, messenger bags, knap sacks, suit bags, duffle bags, drawstring bags, wallets, travel wallets, eyeglass cases, cases for personal organizers, cooler bags, picnic bags and baskets (2)Footwear, namely shoes, boots, top boots, wellington boots, slippers, sandals, espadrilles, sneakers, sports footwear, flip-flops, socks, stocking, hosiery, booties, moccasins (3)Clothing, namely shirts, shirt blouses, T-shirts, tank top,crop top,tube top,jean top,halter top,turtleneck, skirts, aloha shirts, jackets, blouses, polo shirts, blousons, dresses, pullovers, knitweares, pants, sweat pants, breeches, slacks, trousers, knickers, culottes, suit-coat, jogging suits, jumpers, jumpsuits, jeans, pedal pusher, shorts, gym shorts, legging, vests, vested suits, sweaters, sweatshirts, coats ,overcoats, trench coats, fur coats and jackets, suit coats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, suits, sport coats, sport shirts, tennis and golf dresses, warm-up suits, snowsuits, cloaks, raincoats, parkas, blazers, cardigans, boleros, anoraks, jerseys, hosiery, pantsuits, corsets, bodices, bodysuits, swimwear, bathing suits, beachwear, sleepwear, nightgowns, nightshirts, pajamas, slips, loungewear , pinafores, suspenders, chemisettes, camisoles, chemises, undershirts, underpants, undershorts, robes, rainwear, ponchos, lingerie, formal clothes, overalls, aprons, bibs, bras, panties and pantyhose (4)Headgear, namely hats, caps, baseball caps, sun visors, flat caps, berets, parasol, umbrellas (5)scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties, bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves, bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, standard size textile fabric (6)watches, clocks, chronometers, alarm watches, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers,software timers, programmable timers,watch cases, watch chains, wrist watches, pocket watches, watch straps, travel clocks, and their parts and fittings, men's and women's belts, buckles for belts,gloves, mitten, walking sticks, carpets, picnic rugs (7)massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers. (The Goods)

Services: (1) (1)Wholesale, retail stores, mail order service, online sale of 1. handbags, tote bags, satchels, shoulder bags, clutch bags, clutch purses, evening bags, bags for campers, beach bags, rucksacks, backpacks, suitcases, briefcases, trunk for travel, luggage, carry-on luggage, travel kits, overnight cases, portfolio, cases and holders for portable computers and mobile telephones, school bags, purses, pouches, toiletry bags, wrist bags, tie cases , attache cases, billfolds, cases and bags for keys, cosmetic bags and pouches(sold empty),change purses, passport holders, card holders, messenger bags, knap sacks, suit bags, duffle bags, drawstring bags, wallets, travel wallets, eyeglass cases, cases for personal organizers, cooler bags, picnic bags and baskets 2.Footwear, namely shoes, boots, top boots, wellington boots, slippers, sandals, espadrilles, sneakers, sports

footwear, flip-flops, socks, stocking, hosiery, booties, moccasins 3. Clothing, namely shirts, shirt blouses, T-shirts, tank top, crop top, tube top, jean top, halter top, turtleneck, skirts, aloha shirts, jackets, blouses, polo shirts, blousons, dresses, pullovers, knitwears, pants, sweat pants, breeches, slacks, trousers, knickers, culottes, suit-coat, jogging suits, jumpers, jumpsuits, jeans, pedal pusher, shorts, gym shorts, legging, vests, vested suits, sweaters, sweatshirts, coats, overcoats, trench coats, fur coats and jackets, suit coats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, suits, sport coats, sport shirts, tennis and golf dresses, warm-up suits, snowsuits, cloaks, raincoats, parkas, blazers, cardigans, boleros, anoraks, jerseys, hosiery, pantsuits, corsets, bodices, bodysuits, swimwear, bathing suits, beachwear, sleepwear, nightgowns, nightshirts, pajamas, slippers, loungewear, pinafores, suspenders, chemisettes, camisoles, chemises, undershirts, underpants, undershorts, robes, rainwear, ponchos, lingerie, formal clothes, overalls, aprons, bibs, bras, panties and pantyhose 4. Headgear, namely hats, caps, baseball caps, sun visors, flat caps, berets, parasol, umbrellas 5. Scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties, bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves, bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, standard size textile fabric 6. watches, clocks, chronometers, alarm watches, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers, watch cases, watch chains, wrist watches, pocket watches, watch straps, travel clocks, and their parts and fittings, men's and women's belts, buckles for belts, gloves, mitten, walking sticks, carpets, picnic rugs 7. massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers (2) Custom printing of footwear, bags, clothing, headgear, scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties, bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves, bed sheets, pillow covers, bed covers, table cloths, napkins, towels, standard size textile fabric (3) Special custom design for :

1. handbags, tote bags, satchels, shoulder bags, clutch bags, clutch purses, evening bags, bags for campers, beach bags, carry-all bags, rucksacks, backpacks, suitcases, briefcases, trunk for travel, luggage, travel kits, overnight cases, portfolio, cases and holders for portable computers and mobile telephones, school bags, purses, pouches, toiletry bags, wrist bags, tie cases, attache cases, billfolds, cases and bags for keys, cosmetic bags and pouches (sold empty), change purses, passport holders, card holders, messenger bags, knap sacks, suit bags, duffle bags, drawstring bags, wallets, travel wallets, eyeglass cases, cases for personal organizers, cooler bags, picnic bags and baskets 2. Footwear, namely shoes, boots, top boots, wellington boots, slippers, sandals, espadrilles, sneakers, sports footwear, flip-flops, socks, stocking, hosiery, booties, moccasins 3. Clothing, namely shirts, shirt blouses, T-shirts, tank top, crop top, tube top, jean top, halter top, turtleneck, skirts, aloha shirts, jackets, blouses, polo shirts, blousons, dresses, pullovers, knitwears, pants, sweat pants, breeches, slacks, trousers, knickers, culottes, suit-coat, jogging suits, jumpers, jumpsuits, jeans, pedal pusher, shorts, gym shorts, legging, vests, vested suits, sweaters, sweatshirts, coats, overcoats, trench coats, fur coats and jackets, suit coats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, suits, sport coats, sport shirts, tennis and golf dresses, warm-up suits, snowsuits, cloaks, raincoats, parkas, blazers, cardigans, boleros, anoraks, jerseys, hosiery, pantsuits, corsets, bodices,

bodysuits, swimwear, bathing suits, beachwear, sleepwear, nightgowns, nightshirts, pajamas, slippers, loungewear, pinafores, suspenders, chemisettes, camisoles, chemises, undershirts, underpants, undershorts, robes, rainwear, ponchos, lingerie, formal clothes, overalls, aprons, bibs, bras, panties and pantyhose 4. Headgear, namely hats, caps, baseball caps, sun visors, flat caps, berets, parasol, umbrellas 5. scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties, bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves, bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, standard size textile fabric 6. watches, clocks, chronometers, alarm watches, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers, watch cases, watch chains, wrist watches, pocket watches, watch straps, travel clocks, and their parts and fittings, men's and women's belts, buckles for belts, gloves, mitten, walking sticks, carpets, picnic rugs 7. massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers (4) Business management; operation of the business for the manufacturing of 1. handbags, tote bags, satchels, shoulder bags, clutch bags, clutch purses, evening bags, bags for campers, beach bags, carry-all bags, rucksacks, backpacks, suitcases, briefcases, trunk for travel, luggage, travel kits, overnight cases, portfolio, cases and holders for portable computers and mobile telephones, school bags, purses, pouches, toiletry bags, wrist bags, tie cases, attache cases, billfolds, cases and bags for keys, cosmetic bags and pouches (sold empty), change purses, passport holders, card holders, messenger bags, knap sacks, suit bags, duffle bags, drawstring bags, wallets, travel wallets, eyeglass cases, cases for personal organizers, cooler bags, picnic bags and baskets 2. Footwear, namely shoes, boots, top boots, wellington boots, slippers, sandals, espadrilles, sneakers, sports footwear, flip-flops, socks, stocking, hosiery, booties, moccasins 3. Clothing, namely shirts, shirt blouses, T-shirts, tank top, crop top, tube top, jean top, halter top, turtleneck, skirts, aloha shirts, jackets, blouses, polo shirts, blousons, dresses, pullovers, knitweaves, pants, sweat pants, breeches, slacks, trousers, knickers, culottes, suit-coat, jogging suits, jumpers, jumpsuits, jeans, pedal pusher, shorts, gym shorts, legging, vests, vested suits, sweaters, sweatshirts, coats, overcoats, trench coats, fur coats and jackets, suit coats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, suits, sport coats, sport shirts, tennis and golf dresses, warm-up suits, snowsuits, cloaks, raincoats, parkas, blazers, cardigans, boleros, anoraks, jerseys, hosiery, pantsuits, corsets, bodices, bodysuits, swimwear, bathing suits, beachwear, sleepwear, nightgowns, nightshirts, pajamas, slippers, loungewear, pinafores, suspenders, chemisettes, camisoles, chemises, undershirts, underpants, undershorts, robes, rainwear, ponchos, lingerie, formal clothes, overalls, aprons, bibs, bras, panties and pantyhose 4. Headgear, namely hats, caps, baseball caps, sun visors, flat caps, berets, parasol, umbrellas 5. scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties, bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves, bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, standard size textile fabric 6. watches, clocks, chronometers, alarm watches, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers, watch cases, watch chains, wrist watches, pocket watches, watch straps, travel clocks, and their parts and fittings, men's and women's belts, buckles for belts, gloves,

mitten, walking sticks, carpets, picnic rugs 7. massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers (5) Franchise services for retail store selling: 1. handbags, tote bags, satchels, shoulder bags, clutch bags, clutch purses, evening bags, bags for campers, beach bags, carry-all bags, rucksacks, backpacks, suitcases, briefcases, trunk for travel, luggage, travel kits, overnight cases, portfolio, cases and holders for portable computers and mobile telephones, school bags, purses, pouches, toiletry bags, wrist bags, tie cases, attache cases, billfolds, cases and bags for keys, cosmetic bags and pouches (sold empty), change purses, passport holders, card holders, messenger bags, knap sacks, suit bags, duffle bags, drawstring bags, wallets, travel wallets, eyeglass cases, cases for personal organizers, cooler bags, picnic bags and baskets 2. Footwear, namely shoes, boots, top boots, wellington boots, slippers, sandals, espadrilles, sneakers, sports footwear, flip-flops, socks, stocking, hosiery, booties, moccasins 3. Clothing, namely shirts, shirt blouses, T-shirts, tank top, crop top, tube top, jean top, halter top, turtleneck,, skirts, aloha shirts, jackets, blouses, polo shirts, blousons, dresses, pullovers, knitwears, pants, sweat pants, breeches, slacks, trousers, knickers, culottes, suit-coat, jogging suits, jumpers, jumpsuits, jeans, pedal pusher, shorts, gym shorts, legging, vests, vested suits, sweaters, sweatshirts, coats, overcoats, trench coats, fur coats and jackets, suit coats, outer coats and jackets, fur trimmed and shearling coats and jackets, furs, suits, sport coats, sport shirts, tennis and golf dresses, warm-up suits, snowsuits, cloaks, raincoats, parkas, blazers, cardigans, boleros, anoraks, jerseys, hosiery, pantsuits, corsets, bodices, bodysuits, swimwear, bathing suits, beachwear, sleepwear, nightgowns, nightshirts, pajamas, slips, loungewear, pinafores, suspenders, chemisettes, camisoles, chemises, undershirts, underpants, undershorts, robes, rainwear, ponchos, lingerie, formal clothes, overalls, aprons, bibs, bras, panties and pantyhose 4. Headgear, namely hats, caps, baseball caps, sun visors, flat caps, berets, parasol, umbrellas 5. scarves, foulards, kerchiefs, neckerchiefs, neckwear, neckties; bow ties, shawls, capes, stoles, wraps, serapes, pocket square, headbands, head scarves; bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, standard size textile fabric 6. watches, clocks, chronometers, alarm watches, digital clocks, waterproof clocks, electronic timers, mechanical timers, electromechanical timers, software timers, programmable timers, watch cases, watch chains, wrist watches, pocket watches, watch straps, travel clocks, and their parts and fittings, men's and women's belts, buckles for belts, gloves, mitten, walking sticks, carpets, picnic rugs 7. massage equipment, namely massage chairs, massage cushions, massage pillows, shoulder massagers, foot massagers, foot bath, massage belts, slimming belts, tapping massagers, air pressure massagers, portable massagers. (The Services)

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

No Hearing Held

AGENT OF RECORD

Bereskin & Parr LLP

FOR THE OPPONENT

No Agent Appointed

FOR THE APPLICANT