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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 160

Date of Decision: 2022-08-18

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Kabooki A/S

Opponent

and

Les Importations N & N inc.

Applicant

1,821,448 for Buki

Application

INTRODUCTION

[1] Kabooki A/S (the Opponent) opposes the registration of the Buki trademark (the Mark)(reproduced below) in application no. 1,821,448 filed by Les Importations N & N inc. (the Applicant).

The Buki trademark logo is displayed in a large, bold, black font. It consists of a stylized lowercase letter 'b' on the left, which is composed of several geometric shapes. To the right of the 'b' is the word 'buki' in a lowercase, sans-serif font. The 'b' and 'u' are connected, and the 'i' has a dot.

[2] The application is based on the proposed use of the Mark in association with the following goods and services:

[TRANSLATION]

Goods: Children's clothing.

Services: Sale, namely, of children's clothing. Distribution, namely, of children's clothing. Design, namely, of children's clothing.

[3] The opposition is primarily based on an allegation of confusion between the Applicant's Mark and the Opponent's KABOOKI trademark, which is registered in association with similar goods.

[4] For the reasons that follow, I find that the application ought to be rejected.

RECORD

[5] The application for the Mark was filed on February 6, 2017, and advertised for opposition purposes in the *Trademarks Journal* on February 27, 2019.

[6] A statement of opposition was filed on April 29, 2019, under section 38 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act). It should be noted at this stage that, since the Act was amended on June 17, 2019, all references to this decision refer to the Act as amended, with the exception of references to grounds of opposition (see section 70 of the Act, which specifies that section 38(2) of the Act as it read applies to applications announced before that date).

[7] The grounds for opposition argued by the Opponent allege that the application does not conform to the requirements of section 30(e) of the Act; that the Mark is not registrable pursuant to section 12(1)(d) of the Act; and that the Mark is not distinctive pursuant to section 2 of the Act.

[8] The Applicant filed a counter statement denying each of the grounds of opposition pleaded by the Opponent and making arguments essentially related to the absence of likelihood of confusion between the marks at issue. An excerpt of the Opponent's website was also attached to the Applicant's counter statement as Annex CD-A. Since this excerpt was not properly entered

into evidence, I confirm that Annex CD-A of the Applicant's counter statement is not part of the record.

[9] Both parties filed evidence. In support of its opposition, the Opponent produced a certified copy of its registration for the KABOOKI trademark (TMA976,873) and an affidavit from Eric Chamberland dated November 5, 2019, and accompanied by exhibits A to J related thereto. In support of its application, the Applicant filed a solemn declaration by Louis Ruelland dated March 18, 2020, and accompanied by exhibits RA to RF related thereto. None of the affiants were cross-examined.

[10] Neither party filed written representations and only the Applicant was present at the hearing that was held.

EVIDENTIARY BURDEN

[11] It is initially up to the Opponent to establish the merits of its opposition. Its grounds of opposition must be properly pleaded and the Opponent must meet the initial evidentiary burden by submitting sufficient evidence from which we could reasonably conclude the existence of the facts on which it supports each of them. Once that initial evidentiary burden has been met, it is up to Applicant to establish, on a balance of probabilities, that no grounds of opposition prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd.*, (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS

Grounds based on section 12(1)(d) – non-registrability of the Mark

[12] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act, as it is confusing with the Opponent's KABOOKI mark registered under no. TMA976,783 in association with the following goods:

Clothing for children namely jackets, coats, snow suits, snow wear, rain wear; T-shirts, tops, sweatshirts, cardigans, dresses, tunics; pants, jeans, leggings, shorts; skirts; nightwear, underwear; scarves, gloves, mittens, neckwarmers, socks, belts, tights;

footwear for children namely shoes, boots, sandals, slippers; headgear for children namely hats and caps.

[13] Since registration no. TMA976,873 alleged by the Opponent in support of this ground of opposition is still active in the *Trademarks Journal*, the Opponent has met its initial evidentiary burden.

[14] The Applicant must now therefore demonstrate, on a balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's registered mark, KABOOKI.

Test for confusion

[15] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[16] Therefore, section 6(2) of the Act does not deal with confusion between the marks themselves but with the likelihood that the goods or services from one source will be perceived to come from another source.

[17] In determining whether trademarks cause 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 trademarks and the extent to which they have become known; (b) the length of time the trademarks 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 trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and each of these factors can be assigned a different weight depending on the context [*Mattel, Inc. v 3894207 Canada Inc.*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al.*, 2006 SCC 23; and *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27].

Degree of resemblance between the marks

[18] The degree of resemblance between marks is often likely to have the greatest effect on the confusion analysis [*Masterpiece*, above, para 49].

[19] As part of this analysis, however, trademarks should not be dissected to their constituent elements but should be considered as a whole, without disregarding the dominant components that would have an impact on consumers' overall impression. In addition, while the first part of a trademark may, for the purposes of distinctiveness, be the most important in some cases, the preferred approach when examining the degree of resemblance is to first consider whether any of the elements or aspects of the trademark is particularly striking or unique [*Masterpiece*, at para 64].

[20] Here, the Opponent's mark KABOOKI is composed of a single invented word.

[21] With respect to the Mark, it is composed of an invented word and a drawing. In this regard, the Applicant maintains that the striking element of the Mark, as well as the one that makes a significant difference between it and the Opponent's trademark, is its drawn element, which it describes as the "logo", namely the round element (the "dot") that appears to the left of the word "buki". According to the Applicant, this logo is an element that a consumer, at first impression, would notice, but not necessarily pay attention to what makes it up (i.e., the lines that are incorporated into it and what they may or may not represent). The Applicant adds that the syllable "KA" and the two letters "OO" that are part of the word KABOOKI significantly contribute to the visual and phonetic differences between the marks in this case. The Applicant also submits that the parties' marks suggest different ideas, since the word "buki" in the Mark is invented, while the Opponent's trademark may be seen as a reference to the dictionary word "kabuki", which refers to a genre of Japanese theatre.

[22] I cannot support the argument that the logo, as described by the Applicant, would be the striking or dominant aspect of the Mark. It is clear to me that the logo does not contain "random" dashes or lines, but is instead made up of the letter "k" represented on a dark background inside a dot and would likely be perceived as such. In this respect, I also note that there is a set of shapes and contrasts in the Mark: the shape of the letter "k" (white on a black background) incorporated into this logo is almost identical to the one (this time black on a white background) found in the word "buki" and the shape of the dot is identical to the rounding of the letter "b" that makes up

the word “buki”. In short, since it is essentially the letter “k” positioned on a dark background, I do not consider the logo’s aspect in the Mark to be either particularly striking or dominant in relation to the “buki” element.

[23] That said, it seems difficult in the circumstances to identify with certainty how the Mark would be perceived. For example, it seems to me that visually and phonetically, a consumer could perceive both “k buki” and “buki” as what stands out. The fact that, on a few occasions in its evidence, both the Applicant and its distributor use “BUKI” or “Buki” to refer to the Mark (for example, in descriptions such as [TRANSLATION] “BUKI order” or “ Buki Delivery” that appear on some invoices in Exhibit RD), supports, at least to some extent, the second hypothesis. As mentioned above, however, the Applicant maintains a contrary position, namely that it would instead be the logo that would be seen as what stands out from the Mark.

[24] In any event, if a consumer saw “k buki” as the striking aspect of the Mark, I find that this would result in a very high degree of resemblance between the marks in this case, particularly in terms of phonetics and suggested ideas, given that each of the words “k buki” and “kabooki” may be understood as a reference or allusion to the word “kabuki” and to the concepts of play, song and dance that this term may evoke, particularly in a context of children’s clothing.

[25] On the other hand, if a consumer perceives “buki” as the striking aspect of the Mark, then the degree of resemblance would be mitigated. However, even in such a case, the pronunciation and ideas suggested by the marks are not very different, since I am not satisfied that the letter “k” found in the dot in the Mark could not nevertheless be seen, pronounced or understood upon first impression to contribute to the meaning of the Mark (namely as a nod to the word “kabuki”) when considered as a whole.

[26] I therefore find that the overall assessment of the factor set out in section 6(5)(e) of the Act favours the Opponent.

Inherent distinctiveness of the marks and the extent to which they have become known

[27] The marks in this case are similar in their inherent distinctiveness. As discussed above, both are composed of invented words that may (possibly) be seen as a reference to the word “kabuki”. The graphic element consisting of a dot in which the letter “k” is found and the

stylized lettering that is part of the Mark do not, in my view, significantly increase its inherent distinctiveness when the Mark is considered as a whole.

[28] With respect to the extent to which the specific trademarks have become known, the evidence from the parties must be reviewed.

Evidence from the Opponent – Eric Chamberland’s affidavit

[29] Mr. Chamberland is Vice-President – Sports & Fitness at ACI Brands Inc. (ACI), a multi-division supplier focused on all retail sales channels in Canada and the United States [paras 1 and 2].

[30] Mr. Chamberland states that the Opponent designs, produces, markets, sells and distributes clothing for children under the LEGO Wear mark, under licence from “LEGO” [para 5].

[31] Mr. Chamberland states that the Opponent holds the KABOOKI trademark and is authorized to use “the LEGO Trademarks” for “the Products” marketed and sold in Canada by the Opponent [para 6]. I note that Mr. Chamberland does not define exactly what he means by that term. That said, in view of the context and considering the affidavit as a whole, it is possible to believe that the designation “Products” refers generally to clothing for children that is sold in association with the KABOOKI trademark. I will therefore use the expression “Products” as found in Mr. Chamberland’s affidavit and as understood to be a general reference to children’s clothing.

[32] Mr. Chamberland states that ACI is an authorized distributor of the Opponent in Canada that holds the rights needed to market and sell the Opponent’s Products on the Canadian market, as well as the rights to use the KABOOKI trademark and the LEGO trademarks in Canada. More specifically, it states that the Opponent sells the Products to ACI, which in turn sells them to Canadian retailers, such as Sporting Life, Sports Experts and SAIL [paras 7 and 9].

[33] Mr. Chamberland states that the Opponent controls the characteristics and quality of the Products sold in association with the KABOOKI mark at all times by supervising the manufacturing process and by performing quality control. He also states that the Opponent

monitors and controls the use made of the KABOOKI mark in Canada by ACI and he gives some examples of how this is done [para 10].

[34] Mr. Chamberland states that the KABOOKI trademark has been used in Canada in association with the Products since “early” 2019 [para 8]. More specifically, Mr. Chamberland states that ACI placed an order for the Products in January 2019, which was delivered to ACI in June 2019 [para 12, Exhibit B]. He also states that ACI ordered samples of the Opponent’s Products in March 2019 [para 11, Exhibit A]. For illustrative purposes, below is the footer of the page that appears on the invoice and order confirmation pages found in exhibits A and B.

Footer:

The logo for KABOOKI, featuring the word "KABOOKI" in a stylized, bold, sans-serif font. The letters are black and have a slightly irregular, hand-drawn appearance. The "K" and "I" are particularly prominent.

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[35] It should be noted at this stage that in most of the exhibited examples of use of the KABOOKI trademark, it appears in the same stylized form as the one illustrated in the previous paragraph. I am satisfied that the use of this stylized form is valid for the use of the KABOOKI word mark, which in my view preserves its identity and overall remains recognizable in the context of its use [according to *Registrar of Trade Marks v. Compagnie Internationale pour l'informatique CII Honeywell Bull*, (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v. Prodesign* (1984), 2 CPR (3d) 535 (TMOB)]. I will add that if I am mistaken on this point, it would not change the final outcome of my analysis for this ground of opposition based on the word mark registered by the Opponent.

[36] Mr. Chamberland states that in 2019, the purchase of the Opponent’s Products by ACI exceeded US\$230,000 and he provided a breakdown of the number of units bought by type of Products [para 13]. Although it is extensive, I note that the listing of the Products thus sold is limited to the following items only: jackets, snow suits, cardigans, ski pants, gloves, mittens, neckwarmers and hats.

[37] Mr. Chamberland also provided photographs of some of the clothing that is said to be representative of what was sold to ACI in 2019. These photographs show “KABOOKI hangtags”, labels that, according to Mr. Chamberland’s statements, are attached to the Opponent’s Products when they are sent to Canadian retailers, as well as when these goods are sold by retailers to consumers [paras 13 to 20, exhibits C to H]. In reviewing the labels, I note that they bear the Mark, as well as substantially similar markings as those reproduced in paragraph 34 above and found on the invoice and order confirmation in exhibits A and B. I also note that some labels display prices in a number of foreign currencies and not in Canadian dollars. However, this does not necessarily appear fatal in light of the invoices produced by Mr. Chamberland attesting to the sale of Products in Canada. Moreover, this would not likely prevent a Canadian retailer from also affixing its own price labels on the resold Products.

[38] Mr. Chamberland states that ACI received orders for the Opponent’s Products from SAIL, Sporting Life and Sports Experts, and he attached copies of invoices dated 2019, said to be representative of the ones issued by ACI for the sale of these Products [para 21, Exhibit I]. I note that there is a clear correlation between the various goods initially ordered by ACI and those ultimately billed to Ontario and Quebec retailers (for example, see the names and codes of goods, including certain colours and sizes in Exhibit B and those appearing in Exhibit D).

[39] In terms of advertising, Mr. Chamberland states that ACI participated in an exhibition at Sports Experts to present the Opponent’s Products. Mr. Chamberland also states that ACI promotes the Opponent’s Products through online and print catalogs. He provides a link to access an online catalogue, as well as a copy of the last page (the back) of a paper catalogue of goods, said to be representative of the last page of the catalogues provided to Canadian retailers [paras 22 to 24]. I note that if the Opponent wanted the content of an online catalogue to be considered as evidence, Mr. Chamberland would have had to provide a copy of it and attach it as an exhibit to his affidavit. I also note that no details were provided regarding the exhibition, consulting online catalogues or the circulation of the paper catalogues in question.

Evidence from the Applicant – solemn declaration from Louis Ruelland

[40] Mr. Ruelland is the General Manager of the Applicant, a company specializing in the design, manufacture and sale of children’s clothing for more than 20 years [paras 1 and 3].

[41] Mr. Ruelland states that since 2018, the Applicant has designed and produced a collection of snowsuits for children in association with the Mark and he attached as Exhibit RA a document that details the contents of this collection [para 7]. Although one of the two attached pages is incomplete, I note that these pages depict snowsuits for boys and girls from ages 2 to 8 (“Snowsuit (coat+pants)”) and that both display the Mark.

[42] Mr. Ruelland states that the Applicant subsequently designed and produced collections of snowsuits for children in association with the Mark for 2019 and 2020, and he attached as Exhibit RB documents that detail the contents of these collections [para 8]. In particular, I note that there are sheets describing the technical details of the children’s clothing associated with the Mark.

[43] Mr. Ruelland states that during the same period and since as early as December 18, 2017, the Applicant sold and distributed its collection of snowsuits in association with the Mark in Canada and he attached as Exhibit RC two orders from J. M. Clément Ltée (Clément) [para 9]. Mr. Ruelland also states that Clément subsequently placed orders for the clothing collection associated with the Mark in 2018 and 2019, and he attached as Exhibit RD a few invoices for this purpose [para 10]. I note that the orders received by the Applicant on December 18, 2017, and illustrated in Exhibit RC relating to its Winter 2018 collection, seem to anticipate the possibility of cancellation and announce a delivery in September 2018. At least some of these orders also seem to have been delivered and billed only in fall 2018, as appears in Exhibit RD (for example, see order no. 222104 partially transposed onto invoices nos. 71306 and 71879 dated September 28 and October 23, 2018, respectively).

[44] Mr. Ruelland states that Clément is a major retail firm in the province of Quebec that operates 29 stores in Canada [para 11]. However, no details are provided as to the location of the stores in question in the country.

[45] Lastly, Mr. Ruelland states that in addition to selling the clothing from the Applicant’s collection associated with the Mark in its stores, Clément also sells the same collection through its online shop on the *clement.ca* site and he attached as Exhibit RF excerpts of this website that appear to have been printed on March 16, 2020 [para 12]. It is difficult to see whether the snowsuits shown in these excerpts actually display the Mark. However, I note that the Mark

appears in a few places on the pages of this website. That said, no statistics were provided regarding the website's traffic.

Conclusion on the extent to which the parties' marks have become known

[46] At the hearing, the Applicant raised some deficiencies in Mr. Chamberland's evidence, including the inaccuracy surrounding the term "Products", labels said to be "problematic" (mainly due to how the Mark appears there and prices that are not in Canadian dollars), as well as a lack of details and clarity surrounding the advertising efforts made.

[47] In my view, the evidence of each of the parties summarized above has its share of deficiencies. For example, the Applicant's evidence does not report any advertising or promotional expenses and does not give any details on how the Mark is promoted. In addition, in terms of sales, no figures have been provided by Mr. Ruellant—the Applicant's evidence simply shows eight invoices attached as Exhibit RD to Mr. Ruellant's statement, totalling approximately \$115,000 in sales to the same retailer, Clément. With respect to the Opponent's evidence, although Mr. Chamberland states that the purchase of the Opponent's Products by ACI exceeded US\$230,000 and he details the number of units sold by type of Product, the fact remains that the Opponent's evidence only establishes the sale in Canada of some of the clothing items covered by the Opponent's registration. Furthermore, ACI's sales to Canadian retailers seem to be limited to Quebec and Ontario to an indeterminate extent. Lastly, in terms of advertising and promotion, Mr. Chamberland did not provide any expenses or details regarding the referenced exhibition, the content of or access to online promotional catalogues or the circulation of paper promotional catalogues.

[48] In the end, notwithstanding these deficiencies and the representations made during the hearing, I am prepared to accept, considering Mr. Chamberland's affidavit as a whole, that the Opponent's trademark has been used since 2019 in association with certain children's clothing (jackets, snowsuits, cardigans, ski pants, gloves, mittens, neckwarmers and hats). I am also prepared to accept that the Mark has been used since 2018 in association with similar goods (i.e., mainly snowsuits). That said, because of the inaccuracies mentioned above, I am at most prepared to conclude that the parties' marks have become minimally known in Canada.

[49] I therefore find that the factor set out in section 6(5)(a) of the Act, which encompasses both the inherent distinctiveness and the acquired distinctiveness of the trademarks, clearly does not favour either party.

Length of time in use

[50] The factor set out in section 6(5)(b) of the Act favours the Applicant, as it has demonstrated use of the Mark since 2018 as opposed to 2019 in the Opponent's case.

Nature of the goods, services or business

[51] The Applicant does not dispute that the parties' products are identical (both marks cover children's clothing) and that the factors set out in sections 6(5)(c) and (d) of the Act favour the Opponent. However, it argues that these factors are not determinative in this case and should not prevail over those regarding the degree of resemblance between the marks.

Conclusion on the likelihood of confusion

[52] As previously mentioned, the degree of resemblance between the trademarks is indeed one of the most important criteria in assessing the likelihood of confusion and becomes more important in cases where the goods are similar or the same.

[53] Since I find that, all things considered, the marks in this case are more similar than they are different, that the products are identical and that there is a potential overlap in the parties' marketing channels, I find that the Applicant has not discharged its burden of establishing, according to a balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's KABOOKI mark.

[54] Accordingly, this ground of opposition based on section 12(1)(d) of the Act is successful.

Remaining grounds summarily dismissed

Section 30(e) – non-conformity of the application

[55] The Opponent argued that the application does not conform to the requirements of section 30(e) of the Act because the Applicant had no intention of using the Mark in Canada.

[56] However, no evidence or observations were provided in support of this allegation. Accordingly, the ground of opposition based on section 30(e) of the Act is summarily dismissed.

Section 2 – The Mark’s non-distinctiveness

[57] The Opponent argued that the Mark is not distinctive and is not adapted to distinguish the Applicant’s goods and services from “those of the Opponent”. In this context, I understand that the Opponent refers here to the goods offered in association with its KABOOKI trademark.

[58] To discharge its evidentiary burden regarding this ground of opposition, the Opponent must demonstrate that its KABOOKI mark had become known sufficiently as of April 29, 2019, to negate the distinctiveness of the Mark. More specifically, the Opponent must demonstrate that its trademark was known in Canada at least to some extent, having acquired a “substantial, significant or sufficient” reputation or had otherwise become “well known in a specific area of Canada”. [see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles International LLC v. Bojangles Café Ltd.*, 2006 FC 657, at paras 25 to 34].

[59] As is evident from my discussion above of Mr. Chamberland’s affidavit, although I have concluded that the KABOOKI mark was used, the Opponent’s evidence contains deficiencies that prevent me from finding that this trademark had become known on the filing date of the statement of opposition to the point required by jurisprudence to affect the distinctiveness of the Mark.

[60] Consequently, the ground of opposition based on section 2 of the Act is also dismissed.

DISPOSITION

[61] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the application pursuant to section 38(12) of the Act.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Tony Santin

The English is WCAG compliant.

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2022-06-02

APPEARANCES

No appearance For the Opponent

Gabriel St-Laurent For the Applicant

AGENTS OF RECORD

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