



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2023 TMOB 032

**Date of Decision:** 2023-02-21

## IN THE MATTER OF TWO OPPOSITIONS

**Opponent:** Western Glove Works

**Applicant:** Silver Icing Inc.

**Applications:** 1845898 for SILVER ICING; and  
1845968 for Silver Icing & Logo

### INTRODUCTION

[1] Western Glove Works (the Opponent) opposes registration of the trademarks SILVER ICING (the Mark) and Silver Icing & Logo (the Design Mark) (collectively, the Silver Icing Trademarks), which are the subjects of application Nos. 1845898 and 1845968, respectively, filed by Silver Icing Inc. (the Applicant). The Design Mark is shown below:

SILVER  ICING

[2] The Silver Icing Trademarks are applied for in association with the following goods and services:

## *Goods*

(1) Jewelry; braids, namely bracelets that are braided, the foregoing excluding denim

(2) Handbags, wallets, and tote bags, the foregoing excluding denim

(3) Blanket wraps, the foregoing excluding denim

(4) Women's clothing, namely, tunics, toques, coats, shirts, t-shirts, pants, casual pants, leggings, sweaters, hoodies, jumpsuits, jackets, blazers, tank-tops, dresses, shorts, socks, bras, belts, caps, hats and scarves, the foregoing excluding jeans and denim; shoes; braids, namely, headbands and waist belts that are braided, the foregoing excluding jeans and denim

(5) Children's clothing, the foregoing excluding jeans and denim; men's clothing, namely, toques, coats, shirts, t-shirts, pants, casual pants, sweaters, hoodies, jackets, blazers, shorts, socks, belts, caps, hats and scarves, the foregoing excluding jeans and denim

## *Services*

(1) Online sale of women's clothing, shoes, tee shirts and accessories, namely, jewelry, scarves, handbags, socks, wallets, water bottles, travel mugs, baseball caps, tote bags, blanket wraps and braids; operation of a website for online sale of women's clothing, shoes, tee shirts and accessories, namely, jewelry, scarves, handbags, socks, wallets, water bottles, travel mugs, baseball caps, tote bags, blanket wraps and braids; online sale of women's clothing, shoes, tee shirts and accessories, namely, jewelry, scarves, handbags, socks, wallets, water bottles, travel mugs, baseball caps, tote bags, blanket wraps and braids, the foregoing excluding jeans and denim; operation of a website for online sale of women's clothing, shoes, tee shirts and accessories, namely, jewelry, scarves, handbags, socks, wallets, water bottles, travel mugs, baseball caps, tote bags, blanket wraps and braids, the foregoing excluding jeans and denim

(2) Online sale of men's and children's clothing; operation of a website for online sale of men's and children's clothing; online sale of men's and children's clothing excluding jeans and denim; operation of a website for online sale of men's and children's clothing excluding jeans and denim

[3] The oppositions are primarily based on an allegation that the Silver Icing Trademarks are confusing with the Opponent's trademark SILVER, previously registered and used in Canada in association with similar goods. I note that the pleadings, evidence and representations are essentially the same across both proceedings. As I have determined that my analysis and disposition of the oppositions

does not substantially differ based on the records before me, this decision addresses both oppositions.

### **THE RECORD**

[4] The applications were filed on July 5, 2017. The Silver Icing Trademarks were applied for on the basis of use in Canada since at least as early as September 2011 on goods (1) to (4) and on services (1), and on the basis of proposed use in Canada on goods (5) and services (2).

[5] The applications were advertised for opposition purposes on February 20, 2019. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On July 22, 2019, the Opponent opposed the applications by filing statements of opposition under section 38 of the Act. Pursuant to amended statements of opposition made of record on August 2, 2019, the grounds of opposition are based on non-registrability under section 12(1)(d) of the Act; non-entitlement under section 16 of the Act; non-distinctiveness under section 2 of the Act; and non-conformance with section 30(i) of the Act.

[7] The Applicant filed counter statements denying the grounds of opposition.

[8] In support of its oppositions, the Opponent filed the affidavit of Sheila Dyck, sworn February 3, 2020 (Dyck Affidavit).

[9] In support of its applications, the Applicant filed the following affidavits:

- Affidavit of Hayley Michelle Gregg, sworn May 15, 2020 (Gregg Affidavit); and
- Affidavit of Lisa Michelle Moore, sworn May 15, 2020 (Moore Affidavit).

[10] The Applicant's request for leave to submit additional evidence in the form of a second affidavit from Ms. Moore was refused.


[11] None of the affiants were cross-examined. Both parties submitted written representations and were represented at an oral hearing.


**OVERVIEW OF THE OPPONENT'S EVIDENCE**

[12] The Opponent is the owner of the following registrations for the word mark SILVER (the Silver Trademark):

<b>Trademark</b>	<b>Registration</b>	<b>Goods</b>
SILVER	TMA483254 1997-09-29	(1) Clothing namely jackets and vest. (2) Clothing namely shirts and T-shirts.
SILVER	TMA500131 1998-10-29	(1) Clothing namely pants, trousers, jeans and shorts. (2) Clothing namely jackets and vests. (3) Clothing namely shirts and T-shirts.

[13] The Opponent is also the owner of the following registrations for SILVER JEANS-formative trademarks (the Silver Jeans Trademarks):

<b>Trademark</b>	<b>Registration</b>	<b>Goods</b>
SILVER JEANS	TMA574810 2003-01-30	(1) Apparel, namely pants, trousers, jeans, shorts, jackets, vests, shirts, sweatshirts, T-shirts, caps, hats; swimwear.
	TMA775179 2010-08-20	(1) Apparel namely men's, women's, and children's pants and jeans. (2) Shorts and jackets. (3) T-shirts and swimwear. (4) Sweatshirts. (5) Coats and shirts. (6) Vests, belts and bags.

	TMA840202 2013-01-15	(1) Pants, jeans, trousers, slacks, shorts, capri's, shirts, jackets, blouses, vests, t-shirts, sweaters, sweatshirts. (2) Sleeves for laptops; cellphone cases; sunglasses. (3) Jewelry. (4) Handbags and backpacks; bags, namely bum bags, belt bags and hip bags, messenger bags, sports bags, tote bags, waist bags, toiletry cases sold empty, make-up bags; shoulder bags, satchels, wallets; luggage; weekend bags. (5) Children's clothing, children's shirts, children's footwear; hats and caps, headbands, mittens, gloves, scarves; men's shirts, woven shirts, woven tops, knit tops, outerwear jackets, swimwear, Bermuda shorts, jogging pants; women's blouses, women's shirts, women's sportswear, hooded tops, knitted sweaters, sweat tops, tank tops, camisoles, dresses, skirts, tunics, jumpsuits; knitted underwear, ladies underwear, long underwear, men's underwear, women's underwear, woven underwear, thermal underwear, loungewear, sleepwear; hosiery, leg warmers.
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[14] Collectively, I will refer to these trademarks as the Opponent's Trademarks.

*Dyck Affidavit*

[15] Ms. Dyck is the Chief Financial Officer of the Opponent [para 1]. She attests that the Opponent and its predecessors have used the Silver Trademark in association with men's and women's jeans since at least as early as 1980 [para 6] and that the Opponent has used the Silver Jeans Trademarks in association with men's and women's jeans and clothing since 1988. The Dyck Affidavit evidences the following:

- The history of the Opponent and its use of the Opponent's Trademarks [paras 4 to 9, Exhibits A to C];
- Sales in Canada, including total annual sales in association with the Opponent's Trademarks; the number of third-party retail outlets through which the

Opponent's goods were sold, such as Bootlegger, Hudson's Bay and Mark's Work Warehouse; and evidence of online sales through the Opponent's website and third-party websites [paras 10 to 12, Exhibit D]; and

- Advertising and promotion of the Opponent's Trademarks in Canada, including advertisement in third-party magazines and websites [paras 13 to 19, Exhibits E to H].

## **OVERVIEW OF THE APPLICANT'S EVIDENCE**

### *Gregg Affidavit*

[16] Ms. Gregg is the Chief Financial Officer of the Applicant [para 1]. She attests that the Applicant has been operating as an online clothing retailer since February 2011 [para 7] and that the Applicant has done business under the trade name SILVER ICING since September 2011 [para 11]. Ms. Dyck attests that, since September 2011, the Applicant has been using the Silver Icing Trademarks in association with "among other goods and services, online sale of women's clothing, shoes, tee shirts, and accessories" [paras 14 and 16]. The Gregg Affidavit evidences the following:

- The corporate history of the Applicant [paras 5 to 11];
- The Applicant's principal website, *silvericing.com*, including approximate number of unique visits since 2012 [paras 12, 13, 22 to 24, Exhibit C];
- The quantity and value of goods sold and services provided by the Applicant since 2012 in association with the Silver Icing Trademarks and the Applicant's Business [para 20];
- The Applicant's social media presence through Facebook, Instagram and Twitter accounts since 2011 [paras 26 to 30, Exhibits G to I]; and
- The Applicant's "public exposure", including third-party articles featuring the Applicant and the Applicant's business, and examples of awards the Applicant has received "in recognition of its achievements" [paras 31 to 45, Exhibits J to Y].

[17] The Dyck Affidavit also evidences the Applicant's registration No. TMA1032773 for the trademark Silver Icing Logo, shown below [para 19, Exhibit F].



#### *Moore Affidavit*

[18] Ms. Moore is a paralegal employed by the Applicant's agent of record [para 1]. In May 2020, Ms. Moore was instructed to conduct searches of CIPO's online trademark database. The Moore Affidavit includes printouts of the following:

- Exhibit A: search results for active trademarks including the term "Silver" in association with "clothing" goods;
- Exhibits B to M: printouts of SILVER-formative trademark applications and registrations reflected in the Exhibit A search results;
- Exhibit N: search results for active trademarks including the term "Silver" in association with "jeans" or "denim"; and
- Exhibits O to BB: printouts of SILVER-formative trademark applications and registrations reflected in the Exhibit N search results.

#### **EVIDENTIAL BURDEN AND LEGAL ONUS**

[19] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the 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.

[20] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the applications do not contravene the

provisions of the Act as alleged in the statements of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

[21] For clarity, I will first address the grounds of opposition against the application for the Mark, and then address the opposition against the Design Mark separately below.

**SECTION 12(1)(D) GROUND – CONFUSION WITH THE OPPONENT’S SILVER TRADEMARK**

[22] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that the Mark is not registrable within the meaning of section 12(1)(d) of the Act in that it is, and at all material times has been, confusing with the Opponent’s Trademarks.

[23] For purposes of this ground, I consider it appropriate to first focus on the Opponent’s registrations for the word mark SILVER and, in particular, registration No. TMA500131, as the registered goods encompass those of the earlier registration. In my view, this registration represents the Opponent’s strongest case for confusion in these proceedings.

[24] As the Opponent’s registration is extant on the register, the Opponent meets its initial burden under this ground.

[25] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent’s Silver Trademark. The material date with respect to assessing confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)].

*Test to determine confusion*

[26] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that 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.

[27] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for goods and services at a time when they have no more than an imperfect recollection of the Opponent’s Silver Trademark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[28] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[29] The criteria or factors in section 6(5) of the Act 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 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the degree of resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 64].

#### *Inherent Distinctiveness and Extent Known*

[30] In its written representations, the Opponent submits that both parties’ trademarks are inherently distinctive, as they have no particular connection to or association with the relevant goods and services [para 40]. With respect to the Opponent’s Trademarks, the Opponent emphasizes that its trademarks have been used and promoted in Canada in association with clothing since at least as early as 1980, with cumulative sales

revenue of over \$500 million and advertising expenditures over \$10 million [paras 41 and 42].

[31] As noted by the Applicant in its representations, however, the Opponent's evidence (as well as the Opponent's written representations) largely conflates the extent to which the Opponent's Silver Trademark has become known with that of its Silver Jeans Trademarks. For example, the evidenced annual sales figures do not differentiate between the individual trademarks relied upon by the Opponent, and the representative images showing the manner in which the Silver Trademark appeared on the Opponent's clothing at Exhibit A are not otherwise correlated with specific sales figures or sales volumes. The majority of the images at Exhibit A show examples of display of one of the Silver Jeans Trademarks or variations thereof, rather than SILVER in isolation. Furthermore, of the tags and labels shown, most are shown in isolation and not clearly associated with any particular good, and I am only able to identify some of the tags and labels as appearing on jeans. With respect to the Exhibit C catalogue excerpts, the evidence relates to the Silver Jeans Trademarks, and the Silver Jeans Co. trademark design in particular. Given the overall impression, and as reflected in the degree of resemblance analyses below, I do not consider display of the Silver Jeans Trademarks to constitute display of the registered SILVER word mark alone.

[32] As such, while I accept that the Opponent's Silver Trademark has become known in Canada, it is not clear to what extent.

[33] Furthermore, the Applicant submits that the Opponent's Silver Trademark lacks inherent distinctiveness. In this respect, although not evidenced, it notes that SILVER is a common dictionary word with various definitions. In relation to the relevant goods, the Applicant notes in its written representations that the catalogues at Exhibit C to the Dyck Affidavit include reference to a "metallic finish" and show that some of the Opponent's goods include a strip of silver or are "silver-ish" in colour [paras 111 and 112]. In any event, the Applicant emphasizes that SILVER potentially has many meanings, including that of a surname in addition to that of colour or the metal [paras 75 to 81], such that the Silver Trademark lacks distinctiveness.

[34] I agree with the Applicant that the Mark has a greater degree of inherent distinctiveness, given the additional element ICING, which is modified by SILVER as an adjective [per Applicant's written representations at paras 90 to 93].

[35] With respect to the extent to which the Mark has become known, however, as argued by the Opponent, the Applicant's evidence suffers from similar issues regarding a lack of clarity as to the extent to which the Mark has become known in association with the specific applied-for goods and services. First, as noted by the Opponent in its written representations, it is not clear from the Applicant's evidence as a whole whether the Applicant uses the Mark in association with *any* of the applied-for goods [para 43]. For example, there is no evidence of display of the Applicant's Silver Icing Trademarks on tags or labels affixed to any of the applied-for goods. Furthermore, at the hearing, the Opponent noted that the website printouts at Exhibit C to the Gregg Affidavit show that one of the pulldown menu options is titled "BRANDS", suggesting that the Applicant does not exclusively sell SILVER ICING-branded goods, if at all.

[36] Indeed, while Ms. Gregg identifies the Applicant as an online clothing retailer, she provides approximate quantity and value of "goods sold and services provided by the Applicant in association with the Silver Icing [Trademarks] *and the Applicant's Business*" since 2012 [para 20, emphasis added]. The conflation of these numbers with "the Applicant's Business" is especially problematic given that Ms. Gregg states that the Applicant has been using the Mark since 2011 in association with "*among other goods and services*, online sale of women's clothing, shoes, tee shirts, and accessories" [para 14, emphasis added]. The Opponent submits that the Gregg Affidavit mostly evidences the "public exposure" of the Applicant's Chief Executive Officer and its business generally, rather than with respect to any of the applied-for goods and services [Opponent's written representations at para 20]. Indeed, aside from the aforementioned identification of the Applicant as an online clothing retailer, Ms. Gregg permits the exhibits to her affidavit to largely speak for themselves. However, such exhibits either do not clearly identify the Applicant's goods and services at issue, or they lead to the reasonable inference that the Applicant's business is at least in part other than that of

an online clothing retailer. For example, the printout from the Applicant's website at Exhibit C to the Dyck Affidavit includes the following excerpt:

Silver Icing is different. We are a fashion lifestyle brand dedicated to empowering women. It's through our expansive online community that we connect entrepreneurs with an unparalleled level of real time support. By creating innovative tools and through the development of a social selling platform, our community is able to effectively crowd-source, providing real and knowledgeable reviews such as fit advice, immediately delivering an intimate and reliable customer experience.

[37] Potentially reflecting this statement, at the hearing, the Applicant indicated that the parties' businesses differ in that the Applicant's business is at least in part actually more akin to that of personal shopping or curating/stylist services.

[38] For purposes of this factor, the foregoing means it is not clear to what extent the Silver Icing Trademarks have become known in association with the applied-for goods and services. In this respect, it is not clear to what extent the "revenue" generated in association with the "Applicant's business" or the unique visitors to the Applicant's website relate to the applied-for goods and services, rather than other services offered by the Applicant, and likely in relation to third-party branded goods.

[39] Overall, the extent to which each of the parties' trademarks have become known in Canada in association with the relevant goods and services is, at best, unclear. If I were to accept that display of the Silver Jeans Trademarks constituted use of the word mark SILVER, this factor would favour the Opponent. However, in view of the evidentiary issues regarding use and extent known, given the greater inherent distinctiveness of the Mark, this factor favours the Applicant, albeit not to a significant extent.

#### *Length of Use*

[40] While the extent to which the Opponent's Silver Trademark has become known is unclear, at a minimum, I accept that the Dyck Affidavit evidences its use since 1980 in association with jeans [para 6].

[41] Similarly, while the extent to which the Mark has become known in association with each of the applied-for goods and services is unclear, I accept the sworn statement in the Gregg Affidavit as evidencing use of the Mark since 2011, at least in association with the online sale of women's clothing, shoes, tee shirts, and accessories [para 16].

[42] In view of the foregoing, this factor favours the Opponent.

*Nature of the goods, services, or business / Nature of the trade*

[43] When considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements of goods and/or services in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[44] At the hearing, the Applicant submitted that its services are marketed online in the nature of "curating an outfit by a stylist", rather than in the nature of the Opponent's predominantly retail setting. However, the Opponent notes that there is no limitation in the application with respect to the potential channels of trade of the Applicant's goods and, in any event, the Opponent also sells its goods online through its own website and various third-party retailers. To the extent that the Applicant's curation or stylist services differ from the Opponent, such services are not the subject of the application. In any event, such services are nonetheless related to the sale of clothing and accessories.

[45] In its representations, the Applicant notes that the Opponent does not provide a breakdown of sales with respect to any non-jeans goods. Although otherwise problematic, I do not consider this to be determinative under this factor because the nature of both parties' goods remains that of clothing and the applied-for services relate to the sale of a wide variety of clothing. As a whole, I accept that the evidence shows that the Opponent's business is not limited to jeans and denim, and the Opponent's registration includes clothing goods other than jeans.

[46] I further agree with the Opponent that, with respect to the applied-for non-clothing goods and related online sales services, it is relevant that there is overlap in the

nature of the parties' businesses and potential overlap in the parties' channels of trade as clothing retailers. Similarly, I do not consider the exclusionary statements "excluding denim" or "excluding jeans and denim" to overcome the overlap in the nature of the parties' goods and businesses. The average consumer would not be aware of these caveats in the application.

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

*Degree of Resemblance*

[48] In its written representations, the Applicant submits that the parties' trademarks have a low degree of resemblance, emphasizing that the Opponent's Silver Trademark has a low degree of inherent distinctiveness, whereas the word ICING is the striking and unique element of the Mark [paras 65 to 83].

[49] However, I agree with the Opponent that, at a minimum, there is a significant degree of resemblance between the parties' trademarks in appearance and when sounded, given that the first portion of the Mark is identical to the entirety of the Opponent's Silver Trademark.

[50] Furthermore, while "silver" may have many meanings, it functions as an adjective modifying "icing" in the Mark. As such, the idea suggested by the parties' trademarks at least potentially results in some resemblance to the extent that the idea suggested by the Opponent's trademark is also that of the colour, rather than one of the other asserted meanings.

[51] In view of the foregoing, this factor favours the Opponent.

*Additional Surrounding Circumstance – No Evidence of Actual Confusion*

[52] In its representations, although not evidenced *per se*, the Applicant submitted that the parties have co-existed in the Canadian marketplace for over 10 years without confusion.

[53] However, to the extent the Gregg Affidavit does not necessarily or clearly evidence use of the Mark in association with the applied-for goods and services, I do not consider the absence of evidence of confusion significant in this case.

*Additional Surrounding Circumstance – State of the Register*

[54] The Moore Affidavit includes reference to third-party trademarks, registered in Canada in association with “jeans” or other clothing goods and incorporating the element SILVER. These registrations include TMA376634 for SILVER BELL, TMA390524 for SILVER TAB, TMA458781 for SILVER LAKE, TMA483255 for SILVER’S CLUB, TMA565729 for SilverLining, TMA648190 for SILVER SENSE & Design, TMA703886 for SILVERTIP, TMA754642 for silver diablo, TMA775148 for SILVERMAX, TMA1048489 for SILVERCLEAN, TMA1043163 for SILVER SPIDER, and TMA1053518 for SILVERFLINT.

[55] In its written representations, the Applicant argues that the Moore Affidavit identifies at least 11 and upwards of 15 relevant third-party registrations [paras 179 to 188]. In particular, it highlights that the third-party registrations for SILVER BELL and SILVER TAB (both in association with “jeans” and other clothing goods) predate the Opponent’s SILVER registrations [paras 190 to 192]. As such, the Applicant submits that it is reasonable for the Registrar to infer that consumers of clothing in Canada would be accustomed to seeing trademarks in the marketplace with SILVER as the first element, and be able to distinguish among them [para 184].

[56] However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)].

[57] Although the Applicant submits that the “threshold” has been met in this case and that even fewer relevant registrations have been considered sufficient in other cases, as

noted by the Opponent, the Federal Court has cautioned that the number of similar trademarks necessary to establish that an element has been commonly adopted and used in association with the relevant goods or services depends on the facts of a given case. In this respect, in *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539, the Federal Court noted the difficulty with state of the register evidence as follows:

...a search of the Trade-marks Office Register is not the best way to establish the state of the marketplace or the actual use of a mark. The fact that a mark appears on the register does not show that it is currently in use, was in use as of the relevant material dates, is used in relation to wares or services similar to those of the parties, or the extent of any such use... [at para 40].

[58] In its written representations, the Opponent submits that there is an insufficient number of third-party registrations to make any meaningful inferences regarding the state of the marketplace in this case [para 62]. The Opponent questions the relevance of the cited registrations, arguing that, at best, there are 10 registered trademarks that include the term SILVER in association with “clothing” or “jeans or denim” [para 66]. At the hearing, in addition to arguing nuances regarding differences in the degree of resemblance with some of these third-party trademarks, the Opponent noted that two of the cited registrations had subsequently been expunged (SILVER BELL and SILVER SENSE & Design).

[59] In this case, I consider the number of registrations to be, at best, borderline. In my view, at least some of the “relevant” registrations are susceptible to being dismissed or distinguished from the subject trademarks to some degree. As such, I am not prepared to make any significant inferences regarding the state of the marketplace favourable to the Applicant in this case, echoing the Federal Court’s caution in *Hawke* that a search of the trademarks register is not the “best way” to establish the state of the marketplace.

[60] Related to the foregoing, in its written representations, the Applicant notes that the third-party registrations for SILVER SPIDER and SILVER CLEAN include exclusionary statements in the statement of goods such as “all of the foregoing not



including jeans or other denim products” similar to the exclusionary text in the subject applications [para 195]. As such, the Applicant submits that it is reasonable to infer that the Opponent is satisfied with the co-existence of its Silver Trademark with third-party trademarks having a trademark format of the word “silver” followed by another distinctive term, both on the Canadian trademarks register and in the Canadian marketplace [para 198].

[61] However, absent evidence of use of such third-party trademarks in the marketplace, I do not consider such exclusionary statements relevant. Again, the average consumer would not be aware of such exclusionary statements and I do not consider it appropriate to make a negative inference against the Opponent for the mere existence of these third-party trademark registrations, notwithstanding that the Opponent has opposed these and other trademark applications in the past.

[62] Indeed, overall, at best for the Applicant, I agree with the Opponent that the state of the register evidence should not be given much weight, given the small number of relevant SILVER-formative trademark registrations.

[63] Accordingly, this factor favours neither party.

*Conclusion – Confusion with the Opponent’s Silver Trademark*

[64] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the likelihood of confusion between the parties’ trademarks. At best for the Applicant, I consider the likelihood of confusion as to the source of the parties’ goods and services to be evenly balanced. I reach this conclusion due to the resemblance between the trademarks, especially in view of the overlap in the nature of the parties’ goods, and the potential overlap in the nature of the parties’ services, businesses and trades and notwithstanding the relatively low inherent distinctiveness of the Opponent’s Silver Trademark.

[65] Similarly, with respect to the Opponent’s registration No. TMA483254 for SILVER, I find that the Applicant has not met its legal burden with respect to the likelihood of confusion between the parties’ trademarks, notwithstanding that

registration is with respect to a narrower range of clothing goods. The analysis with respect to the degree of resemblance and the nature of the goods, services, businesses and trade remain essentially the same.

[66] Accordingly, as it relates to the Opponent's Silver Trademark registrations, the section 12(1)(d) ground of opposition is successful.

**SECTION 12(1)(D) GROUND – CONFUSION WITH THE OPPONENT'S SILVER JEANS TRADEMARKS**

[67] With respect to the Opponent's registrations for its Silver Jeans Trademarks, as the registrations are extant on the register, the Opponent meets its initial burden under this ground.

[68] However, in assessing the surrounding circumstances, I find that the balance of probabilities shifts in favour of the Applicant with respect to these trademarks. Notwithstanding that the Opponent's evidence of extent known is greater with respect to its Silver Jeans Trademarks, the degree of resemblance significantly differs.

[69] In this respect, I consider the degree of resemblance between the Mark and the Opponent's word mark SILVER JEANS to be significantly different in appearance, when sounded and, most importantly, in ideas suggested given the additional JEANS element. The idea suggested by SILVER JEANS and SILVER ICING is not the same, notwithstanding the shared first element.

[70] Similarly, with respect to registration No. TMA775179, the degree of resemblance is further reduced, given the additional JEANS element as well as the prominent stylized S, neither of which are present in the Mark.

[71] With respect to registration No. TMA840202, this degree of resemblance is also further reduced as the Opponent's trademark as a whole specifically suggests the idea of a jeans company.

[72] As such, notwithstanding the common SILVER element, I find that the Opponent's Silver Jeans Trademarks sufficiently differ from the Mark in appearance, in sound, and in idea suggested.

[73] Accordingly, having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the Mark and the Silver Jeans Trademarks. I reach this conclusion due to the low degree of resemblance between the parties' trademarks, and notwithstanding the evidence of extent known of the Opponent's Silver Jeans Trademarks and the overlap in the nature of the parties' goods.

[74] In view of the foregoing, as it relates to the Opponent's Silver Jeans Trademarks, the section 12(1)(d) ground of opposition is rejected.

#### **SECTION 16 GROUNDS – NON-ENTITLEMENT TO REGISTRATION**

[75] Pursuant to section 38(2)(c) of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark in view of sections 16(1)(a) and 16(1)(c) of the Act with respect to the use-based goods and services because, as of the claimed date of first use, and at all other material times, the Mark is and was confusingly similar to the Opponent's Trademarks and Silver Jeans Co. trade name which had been previously used in Canada by the Opponent and were not abandoned at the date of advertisement of the application, or at any time.

[76] The Opponent also pleads that that the Applicant is not the person entitled to registration of the Mark in view of sections 16(3)(a) and 16(3)(c) of the Act with respect to the proposed use-based goods and services because, as of the filing date, and at all other material times, the Mark is and was confusingly similar to the Opponent's Trademarks and Silver Jeans Co. trade name which had been previously used in Canada by the Opponent and were not abandoned at the date of advertisement of the application.

[77] In view of the statements regarding use of the Opponent's Trademarks as set out in the Dyck Affidavit, I am satisfied that the Opponent has met its initial burden under

these grounds, at least with respect to jeans and men's and women's clothing [para 6]. Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and each of the Opponent's Trademarks as of the applicable material dates.

[78] However, notwithstanding the earlier material dates, I find that the analysis above with respect to the 12(1)(d) ground(s) does not differ significantly under these grounds.

[79] As such, with respect to the Opponent's Silver Trademark, having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for goods and services. At best for the Applicant, I find that the balance of probabilities regarding the likelihood of confusion as to the source of the parties' goods and services to be evenly balanced. I reach this conclusion due to the resemblance between the Mark and the Silver Trademark, especially in view of the overlap in the nature of the parties' goods and the potential overlap in the parties' services, businesses and trades.

[80] Accordingly, as they relate to the Opponent's Silver Trademark, the grounds based on section 16 of the Act are successful.

[81] As above, though, with respect to the Silver Jeans Trademarks and the Opponent's Silver Jeans Co. trade name, I find that the degree of resemblance factor sufficiently shifts the confusion analysis in the Applicant's favour.

[82] Accordingly, as they relate to the Opponent's Silver Jeans Trademarks and trade name, the grounds based on section 16 of the Act are rejected.

## **SECTION 2 GROUND – NON-DISTINCTIVENESS**

[83] Pursuant to section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act because it does not distinguish, and is not adapted to distinguish, the Applicant's applied-for goods and services from the goods and services associated with the Opponent's Trademarks and Silver Jeans

Co. trade name. In this respect, the Opponent pleads that the Mark is likely to be confused with the Opponent's Trademarks and trade name.

[84] Although the preamble to the pleaded grounds in the statement of opposition (at paragraphs 4 and 5) include reference to the Opponent having "built up highly valuable goodwill" in the Opponent's Trademarks and that such trademarks have become "well-known", in my view, it is not clear that this ground is sufficiently pleaded, as confusion with an opponent's trademarks or trade name alone does not support an allegation of non-distinctiveness.

[85] In this respect, and in any event, where an opponent relies on its own trademark (or trade name) in support of a non-distinctiveness ground, to meet its initial evidentiary burden, the test is not merely one of whether the opponent's trademark was used, but rather the trademark "must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient" [*Bojangles International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 34; see also *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10 at para 4]. In this case, at a minimum, I am not satisfied that the Opponent has evidenced sufficient reputation in its trademarks or trade name and, in particular, there is no evidence of *negation* of the distinctiveness of the applied-for Mark.

[86] Accordingly, the non-distinctiveness ground of opposition is rejected.

### **SECTION 30(I) GROUND – NON-CONFORMANCE**

[87] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform with section 30(i) of the Act because the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the applied-for services in view of the Opponent's Trademarks and Silver Jeans Co. trade name which had been previously used in Canada and of which the Applicant should have been aware in view of the prior registration and long term, widespread use of the Opponent's Trademarks and Silver Jeans Co. trade name by the Opponent.

[88] It is well established that this sort of pleading is not viable under section 38(2)(a) of the Act.

[89] Accordingly, the ground of opposition based on section 30(i) of the Act is rejected.

### **OPPOSITION AGAINST THE DESIGN MARK**

[90] As noted above, the pleaded grounds and evidence of record are essentially the same in the proceeding against the application for the Design Mark. As such, aside from the presence of the Silver Icing Logo design element in the Design Mark, I do not consider the analyses with respect to each of the grounds of opposition to significantly differ from the analyses above.

[91] With respect to the confusion grounds, the design element increases the inherent distinctiveness of the Design Mark, but does not significantly impact the degree of resemblance between the parties' trademarks in appearance, and has no effect on sound and idea suggested, given the common SILVER element. Indeed, the placement of the design element serves to separate the word elements in the Design Mark, increasing the prominence of the first SILVER element. Otherwise, the aforementioned evidentiary issues and analysis with respect to the other surrounding circumstances apply equally here.

[92] Accordingly, to the extent the grounds based on sections 12(1)(d) and 16 of the Act are based on confusion with the Opponent's Silver Trademark, they are successful.

[93] However, for the same reasons as above, the remaining grounds (including the confusion grounds as they relate to the Opponent's Silver Jeans Trademarks) are rejected.

**DISPOSITION**

[94] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications pursuant to section 38(12) of the Act.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2022-10-25

## **APPEARANCES**

**For the Opponent:** Eric Macramalla

**For the Applicant:** Pablo Tseng

## **AGENTS OF RECORD**

**For the Opponent:** Gowling WLG (Canada) LLP

**For the Applicant:** McMillan LLP