



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 268

**Date of Decision:** 2022-12-30

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Loft Ipco LLC

**Applicant:** Industria de Diseno Textil, S.A. (Inditex, S.A.),  
a Spanish company

**Application:** 1,647,990 for LFT

### **INTRODUCTION**

[1] Loft Ipco LLC (the Opponent) opposes application no. 1,647,990 (the Application) for registration of the trademark LFT (the Mark) filed by Industria de Diseno Textil, S.A. (Inditex, S.A.), a Spanish company (the Applicant).

[2] The opposition is based primarily on an allegation that the Mark—the Application for which covers a lengthy list of electronic, print, textile, jewellery, toiletry, and sport related goods—is not registrable because it is confusing with the Opponent’s trademark LOFT (the LOFT Trademark), registered for use in association with apparel, accessories, and retail services in the field of apparel, accessory, and toiletry products. This ground of opposition succeeds in part. For the reasons that follow, I find that the

Mark is confusing with the LOFT Trademark and thus not registrable in respect of the goods that are similar, related in nature, or meaningfully connected to the Opponent's goods and services.

[3] With respect to the remaining goods, I note that the opposition is also based on an allegation that the Applicant's claim to have used the Mark in Spain is false, which would invalidate use and registration in Spain as a basis for registration in Canada. I find the Opponent has met its evidential burden in this regard and, in the absence of any evidence from the Applicant, the opposition to use and registration in Spain as a registration basis succeeds. However, the Application is also based on a claim of proposed use in Canada, and the Application may proceed to registration for the remaining goods on that basis.

#### **THE RECORD**

[4] The Application was filed on October 16, 2013, on the dual bases of (i) the Mark's proposed use in Canada in association with the goods listed in Schedule A below (the Goods) and (ii) registration and use of the Mark in Spain in association with the same goods.

[5] The Application was advertised for opposition purposes on May 4, 2016, and opposed on October 3, 2017, when the Opponent's predecessor in title Annco, Inc. (Annco) filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The statement of opposition was subsequently amended, on May 21, 2021, to reflect the recent transfer in ownership of the LOFT Trademark, on which the opposition is based, from Annco to the Opponent. The Applicant filed a counter statement denying each of the grounds of opposition.

[6] The grounds of opposition allege that the Mark is not registrable under section 12(1)(d) of the Act and that the Application does not comply with the filing requirements set out in section 30(d) of the Act. Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition

will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[7] In support of its opposition, the Opponent filed the following evidence:

- A certified copy of registration no. TMA826,272 for the trademark LOFT (the Opponent's Registration).
- The affidavit of Annco's Assistant Secretary, Carole E. Klinger, which is dated July 9, 2018. Ms. Klinger is also the Vice President & Chief Counsel for Annco's ultimate parent company, Ascena Retail Group, Inc. (Ascena). Other related companies include AnnTaylor Retail, Inc., AnnTaylor, Inc., and ANN INC. (Annco and its related companies hereinafter collectively the "Ann Taylor Group"). In her affidavit, Ms. Klinger describes Annco's background history and business, as well as the Ann Taylor Group's use and promotion of the LOFT Trademark and related trademarks.
- The affidavit of Dane Penney, a trademark search specialist employed by the Opponent's agent, whose affidavit is dated July 13, 2018. Mr. Penney provides the results of various Internet searches he was asked to perform on July 9, 2018, regarding the parties' respective businesses. He also describes a LOFT store visit and online purchase he was asked to make on July 3, 2018, and provides documentation of the visit and his purchases.

[8] The evidence of an employee of a party's agent is generally only admissible to the extent that it relates to non-controversial and non-central matters [*Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2005 FC 1254, 43 CPR (4th) 21, *aff'd* 2006 FCA 133, 53 CPR (4th) 286]. I find that Mr. Penney's affidavit is admissible on this basis, since his evidence consists essentially of printouts and photographs documenting the website and store visits, with an objective description of the steps he took and no subjective observations or opinions. Although aspects of his evidence address central matters in the case, these aspects relate to the parties' own websites and stores, and the Applicant had the opportunity to challenge and refute this

evidence—including the opportunity to request cross-examination of Ms. Klinger, whose evidence addresses similar and overlapping matters.

[9] Statements made on a website are generally considered to be hearsay, but may be admissible for the truth of their contents if they satisfy the criteria of necessity and reliability [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD), re the principled exception to the rule against hearsay]. In this respect, to the extent that the Opponent lacks personal knowledge of the Applicant’s activities, I am prepared to admit the printouts from the Opponent’s website and corporate documents attached as exhibits to Mr. Penney’s affidavit. I consider this evidence to be reliable, since it originates from the Applicant, who also had the opportunity to refute it.

[10] Neither Ms. Klinger nor Mr. Penney was cross-examined and the Applicant filed no evidence of its own. Only the Opponent filed written representations, but both parties were represented at an oral hearing. I note that, two weeks before the hearing, the Opponent submitted an “aide-mémoire” table consisting of a series of proposed correlations between various groups of the parties’ respective goods and services, presented as straight lists of goods and services with no added commentary. At the hearing, I permitted the Opponent to refer to this table in the course of making its oral representations as to the basis on which overlaps, relationships, or connections might be found between the parties’ goods and services.

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

[11] In an opposition proceeding, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

**GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)**

[12] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act, because the Mark is confusing with the subject of the Opponent's Registration. More specifically, the Opponent pleads that use of the Mark in the same marketplace as where goods are sold and services are rendered in association with the LOFT Trademark is "very likely" to confuse the public, because the trademarks are almost identical in appearance and similar in sound and because the Opponent's goods and services commonly travel through the same channels of trade. The full list of the Opponent's registered goods and services (respectively the Opponent's Goods and the Opponent's Services) is reproduced below.

Opponent's Goods:

Clothing, namely, dresses, skirts, suits, jeans, sweaters, shirts, t-shirts, tank tops, bodysuits, jumpers, vests, gloves, sleep wear, robes, swimsuits, blouses, pants, shorts, jackets, coats, socks, hosiery, belts, scarves, underwear; headwear namely hats and caps and footwear namely shoes.

Opponent's Services:

On-line and in store retail store services in the fields of clothing, footwear, handbags, small leather accessories, toiletries, consumable bath products and cosmetic products.

[13] The material date for this ground of opposition is that of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent's initial burden is met if the registration relied upon is in good standing on this date and the Registrar has discretion to check the Register in this respect [per *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised this discretion, I confirm that the Opponent's Registration is in good standing.

[14] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the LOFT Trademark.

### ***The test for confusion***

[15] 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 system for trademark registrations [section 6(2) of the Act]. Thus, the test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source. Where it is likely to be assumed that the applicant's goods either come from the opponent or are approved, licensed, or sponsored by the opponent, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[16] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

### ***Section 6(5)(e): Degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them***

[17] The degree of resemblance between the trademarks at issue is often the factor likely to have the greatest effect on the confusion analysis and thus is an appropriate starting point [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27]. In assessing resemblance, each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression; it is not the proper approach to set the trademarks side by side and carefully examine them to tease out

similarities and differences. However, considering a trademark as a whole does not mean that a dominant component that would affect an average consumer's overall impression of the trademark should be ignored. The preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece* at para 64].

[18] I find the striking aspect of the LOFT Trademark to be that it is an English dictionary word generally referring to a room under the roof or to a building's upper room converted into an apartment (having also a dictionary meaning referring to a similar apartment in French). I find the striking aspect of the Mark to be that it is a string of three consonants. There is necessarily a fair degree of visual resemblance between the trademarks given their length and the arrangement of the letters. However, in the absence of any context informing how the Mark will be sounded, it is difficult to assess the degree of resemblance in sound and in ideas suggested.

[19] The Opponent submits that, despite the absence of the letter O from the Mark, it could be pronounced the same as the word LOFT. In this respect, the Opponent notes the absence of periods separating the letters or of any other indicators that the Mark is an acronym, and invites the Registrar to take judicial notice of the common practice among the public of dropping vowels from words when text messaging, for example, typing "text" as "TXT" or "thanks" as "THNX". In the Opponent's submission, the parties' trademarks should be considered to be the same phonetically and in ideas suggested, because there is no evidence as to how "LFT" would be sounded and it is more natural to mentally insert a vowel sound than to find that a word contains no vowels. The Opponent submits that the tendency to mentally fill in the vowel would be particularly strong for consumers of fashion goods somewhat in a hurry with an imperfect recollection of the LOFT Trademark.

[20] Conversely, the Applicant submits that the parties' trademarks differ in appearance in that the letters L, F, and T feature exclusively vertical and horizontal strokes, making the addition of a round O stand out. Furthermore, in the Applicant's submission, human experience suggests that the most plausible pronunciation of the

Mark would be to sound it as the separate letters of an acronym (ell-eff-tee), resulting in a very different sound from that of the word LOFT. The Applicant further submits that the Mark differs conceptually in that it suggests the idea of an acronym.

[21] In this respect, the Applicant seeks to draw an analogy with the decision in *Dairy Farmers of Canada v Cytosport, Inc*, 2012 TMOB 125, and *Dairy Farmers of Canada v Cytosport, Inc*, 2014 TMOB 148, where the Registrar found no evidence to suggest the average consumer would pronounce the trademark “MLK” as a word rather than an acronym or equate its meaning with the word “milk”. As noted by the Opponent, this determination was made in the context of assessing whether the trademark MLK was clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act. Nevertheless, I find the *Dairy Farmers* cases to be relevant, but only as support for the principle that the pronunciation and interpretation of a three-consonant trademark is a question to be decided on the evidence on a case-by-case basis.

[22] In the alternative, the Applicant submits that, according to human experience, the most plausible attempt to sound LFT as a word would be to insert a vowel sound resulting in a pronunciation closer to that of “lift” or “left”. I would note that this proposed pronunciation as made during the oral hearing also sounded close to pronunciations rhyming with “tuft” or “hoofed”.

[23] On balance, I find that the Mark tends to suggest the idea of an acronym even in the absence of any guiding punctuation and may accordingly be pronounced by sounding each of the letters individually. However, in the absence of evidence from the Applicant as to how it intends to use the Mark, I am not prepared to infer that pronunciation as a word is unlikely. Moreover, although I agree with the Applicant that, in the absence of any further context, “loft” would not necessarily be the most ready English pronunciation, I am not prepared to find that it would be unlikely for the average francophone consumer and/or for consumers having an imperfect recollection of the LOFT Trademark in association with similar or related goods or services.

[24] Furthermore, I find that there is a high degree of visual resemblance between the two trademarks. While they are not identical, when the trademarks are each considered



as a whole, they create a similar visual impression. In my view, as a matter of first impression and imperfect recollection, this resemblance in appearance is important enough to outweigh the potential differences in sound and ideas suggested.

[25] Overall, I find that the resemblance factor slightly favours the Opponent.

***Section 6(5)(a): Inherent distinctiveness of the trademarks and extent to which they have become known***

[26] Trademarks comprising rare, arbitrary, or invented words are generally considered to be more inherently distinctive than trademarks consisting of everyday dictionary words or words of a descriptive or suggestive character, and the extent of protection will vary accordingly [see *Joseph E Seagram & Sons Ltd v Canada (Registrar of Trade Marks)* (1990), 33 CPR (3d) 454 (FCTD); and *YM Inc v Jacques Vert Group Ltd*, 2014 FC 1242]. Inherently distinctive trademarks “strike the imagination and become more firmly rooted in the consumer’s memory” and, as such, are generally given a greater degree of protection [see *G M Pfaff Aktiengesellschaft v Creative Appliance Corp Ltd* (1988), 22 CPR (3d) 340 (FCTD) at para 7].

[27] Although LOFT is an ordinary dictionary word, I find the LOFT Trademark to be inherently distinctive, since it has no readily apparent meaning in relation to the Opponent’s Goods or the Opponent’s Services. Although it might arguably lend a slight laudatory connotation to the extent that it evokes ideas of height, similar to the derivative words “lofty” or “aloft”, I do not consider the LOFT Trademark to suggest the quality of the associated goods or services as a matter of immediate impression.

[28] I am aware that the word LOFT also has dictionary meanings in connection with apparel in that it can refer to the resiliency of a fabric or to the thickness of insulating material in a garment such as a coat [see *Concise Canadian Oxford Dictionary* (2005); see also *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65, regarding the Registrar taking judicial notice of dictionary definitions]. However, the parties did not cite these particular meanings, and there is no evidence to suggest that they would come to consumers’ minds as a matter of immediate impression, even in a clothing context.

[29] I find that the Mark's level of inherent distinctiveness is lower. In this respect, I note that trademarks consisting mainly of one or more letters of the alphabet are generally considered to possess a low degree of inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. The Mark as applied for has no design features that might increase its inherent distinctiveness.

[30] With respect to the Applicant's submission that the combination "LFT" is meaningless or might suggest the idea of the word "left", I am not prepared to speculate on whether or how "LFT" might be interpreted as a dictionary word. Neither party furnished evidence to suggest that any particular meaning, such as "left", would come to the mind of an average consumer of the Goods more readily than any other meaning, such as "loft" or "lift" (both words suggesting the idea of height) or "a lefty" (when the three letters are sounded individually with emphasis on the F).

[31] I note that one of the decisions cited (on a different point) in the Applicant's written argument is *LFT Group Brands Ltd v Industria De Diseno Textil, SA (Inditex, SA)*, 2019 TMOB 141, in which the Registrar rejected a third party's opposition against the Application. The decision in *LFT Group Brands* makes reference to evidence filed in that case linking the Applicant to a website for the brand "Lefties" where clothing items are displayed bearing the trademark "LFT". However, no such evidence has been furnished in the present case. I note references to the companies Lefties Espana, S.A. and Lefties Logistica, S.A. in the Opponent's 2014 annual report [at pages 206 and 235] and the brand "lefties" in a list of brands in the document "The List by Inditex. III Edition", apparently published in or around 2015 (both documents located on the Applicant's website and discussed in more detail under the second ground of opposition). However, there is no evidence tying any of these companies or brands to the trademark "LFT". Moreover, the two documents in question appear to be from well before the material date. I am not prepared to infer from these isolated references to the name or brand "Lefties" that consumers would likely associate the Mark with the words "left" or "a lefty" as a matter of immediate impression upon encountering the Mark in the marketplace.

[32] A trademark's distinctiveness can be enhanced through use and promotion. Only the Opponent filed evidence in this respect, which consists of the affidavit of Ms. Klinger, supplemented by portions of the affidavit of Mr. Penney.

[33] Ms. Klinger explains that, at the time of her affidavit, the Opponent's predecessor Annco was the owner of the trademarks LOFT and ANN TAYLOR LOFT, as well as the logo reproduced below (ANN TAYLOR LOFT Logo), consisting of the words ANN TAYLOR in fine print above the word LOFT [paras 3–4]:



[34] Annco licensed the above-noted three trademarks to its affiliated operating companies, including Ann Taylor, Inc., for use on and in connection with women's apparel and fashion accessories sold in the Ann Taylor Group's retail stores bearing the trade name LOFT and on the commercial website at *www.loft.com*, a domain name registered by Annco (the LOFT Website) [Klinger para 4 and Penney Exhibit A]. Ann Taylor, Inc. in turn licensed ANN Canada, Inc. to use the trademarks at the LOFT stores operating in Canada [Klinger para 7].

[35] Ms. Klinger further explains that Annco first owned and licensed the trademark ANN TAYLOR—used in the United States since 1954—in association with a clothing and fashion accessories line targeting professional women [paras 5–10]. In 1995, a new line was created under the trademark ANN TAYLOR LOFT, featuring styles for consumers “who typically work in a relaxed professional environment” [para 11]. In 2010, the branding was updated to remove the reference to ANN TAYLOR and simply use the trademark LOFT, including a logo consisting of only the LOFT element from the ANN TAYLOR LOFT Logo [para 14]. It appears that the brand was introduced in Canada after this update, such that only the LOFT Trademark has been used and promoted in Canada. In this respect, I am satisfied that any use of the new LOFT logo—being the word LOFT in a simple font—constitutes use of the LOFT Trademark.

[36] Between November 2012 and August 2014, the Ann Taylor Group opened nine LOFT stores in Canada, located in Ontario, Alberta, and British Columbia—sales of LOFT-branded goods in these stores have generated in excess of US\$80 million in total revenue, being in excess of US\$15 million each year since 2014 [Klinger paras 16–17; Penney paras 4, 5, Exhibits C, D]. The LOFT Trademark is displayed on the storefront, hangers, clothing items (printed directly thereon), clothing labels, hangtags, jewellery backing cards, and receipts; it is also featured on tissue paper wrapping stickers as part of the hashtag #LOVELOFT and on shopping bags as part of a “WANT FIND LOFT” logo [Penney para 6, Exhibit E].

[37] On February 6, 2013, the Ann Taylor Group began offering international shipping, including to Canada, of purchases made on the LOFT Website [Klinger paras 13, 21, 22]. Since then, the LOFT Website has received over 7 million visits from consumers with Internet Service Providers in Canada and shipments of LOFT-branded goods ordered from Canada to Canadian addresses have generated over US\$4 million in revenues [paras 18–19, see also representative shipping confirmations dated from 2015 to 2018 at Exhibit A]. The LOFT trademark is displayed on the website (i) in the header, (ii) in a pop-up for customers selecting Canada as the shipping destination to display prices in Canadian dollars, and (iii) at the time orders are placed; it is also displayed on confirmation e-mails and on the packaging and labelling for the purchased goods [Klinger paras 20–22; Penney para 3, Exhibit B].

[38] Since November 2012, the Ann Taylor Group has spent over US\$1 million advertising the LOFT Trademark in Canada, including through the LOFT Website, through social media, in newspapers and magazines, and by e-mail, with over 50,000 Canadians subscribing to receive promotional e-mails since 2014 [Klinger paras 23–24]. Reproduced in Ms. Klinger’s affidavit are screenshots from the LOFT-branded Facebook, Twitter, Pinterest, and Instagram social media accounts [paras 26–29]. The number of Canadian visitors to these accounts is not provided; however, the Opponent argued at the hearing that it may be inferred from the level of traffic to the LOFT Website and its targeting of Canadians that at least a portion of the visits would be from Canada.

[39] Ms. Klinger also provides a December 19, 2001, *Globe & Mail* article in which a Michigan outlet mall was featured as a favourite destination for Canadian shoppers, with “Ann Taylor Loft” being one of its stores [para 25]. I am prepared to take judicial notice that there is general circulation of the *Globe & Mail* newspaper in Canada [with respect to taking judicial notice of newspapers’ circulation, see *Milliken & Co. v Keystone Industries* (1970) Ltd (1986), 12 CPR (3d) 166 (TMOB); and *Northern Telecom Ltd v Nortel Communications Inc* (1987), 15 CPR (3d) 540 (TMOB)]. In the Opponent’s submission, this article’s specific mention of Ann Taylor Loft being present is an indication of the brand’s reputation and interest to Canadian readers, as early as 2001.

[40] Finally, I note that Mr. Penney’s affidavit also introduces a copy of an advertisement from the June 23, 2012 edition of the *Toronto Star* newspaper provided to him by a lawyer at his firm, who advised she had located it on June 19, 2018 by searching a newspaper archive database accessed through the Toronto Public Library’s website; however, this database was offline when he attempted to replicate the search on July 9, 2018 [para 13; Exhibit L]. This advertisement for “Premium Outlets” shopping centres in the United States lists “Loft Outlet” among its stores. Mr. Penney does not mention any other attempts to find the article himself and I am therefore not satisfied that this hearsay evidence meets the criterion of necessity. However, even if I were to admit this evidence, it would not affect the outcome my analysis. Although I would have been prepared to take judicial notice of the *Toronto Star’s* circulation, I would not have found that the small reference to “Loft Outlets” in this advertisement demonstrates or contributes meaningfully to the LOFT Trademark’s reputation in Canada.

[41] Considering the totality of the evidence, it would appear that the LOFT Trademark has become known to some extent in Canada. However, Ms. Klinger does not specify whether it has become known through use and promotion by Annco specifically; all of her references to use and promotion are to activity by the Ann Taylor Group, which includes other companies. Ms. Klinger notes that, under U.S. law, use of the LOFT Trademark by the licensees has at all times enured to the benefit of its owner, namely Annco [para 8]. However, she does not address whether such use would also meet the requirements of section 50 of the Act, so as to enure to the registered owner’s

benefit under Canadian law. In particular, there is neither evidence that Annco has control of the character or quality of the goods or services in accordance with section 50(1) nor evidence of public notice that the use is licensed by Annco in accordance with section 50(2). Moreover, there is no evidence that U.S. law requires any such control or notice for licensed trademark use to enure to the owner's benefit.

[42] It is well established that corporate structure or a corporate relationship alone is insufficient to meet the requirements of section 50 of the Act [*Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2020 FCA 120]. An inference that the requisite control exists *may* be drawn where an individual is a director or an officer of both the registered owner and the licensee [*Petro-Canada v 2946661 Canada Inc* (1999), 83 CPR (3d) 129 (FCTD); *Lindy v Canada (Registrar of Trade Marks)* 1999 CarswellNat 652 (FCA)]. However, although Ms. Klinger mentions also being Vice President of Annco's parent company Ascena, she does not attest to having any role within ANN Canada, Inc. or within any of the licensed operating companies in the Ann Taylor Group.

[43] I do not find it particularly probative that the domain name for the LOFT Website is registered by Annco, since the owner of an Internet address does not necessarily operate the website located there or control the character or quality of the goods or services provided through that website. Similarly, I do not find it particularly probative that the LOFT goods originate in and are shipped from the United States or that the presentation of the stores and trademarks is consistent between the two countries, with Canadian stores being a natural expansion of the U.S. business. In this respect, Ms. Klinger's evidence is that international shipping is offered by the Ann Taylor Group, which includes companies other than Annco. Furthermore, as noted above, the evidence is insufficient for an inference that Annco controls the character or quality of the goods or services originating in the United States. It is equally possible that Annco is, for example, merely a holding company, with other entities in the Group controlling the character and quality of the goods and related retail services.

[44] The Opponent notes that the Applicant has not cross-examined Ms. Klinger or requested undertakings to provide supporting documentation. However, the difficulty is not in accepting Ms. Klinger's statements at face value but rather in the insufficiency of her evidence, and of the evidence of record as a whole, to meet the requirements of section 50 of the Act. The Applicant is under no obligation to assist the Opponent by identifying gaps in its case and requesting specific evidence that could help fill them.

[45] In view of the foregoing, even if the evidence shows that the LOFT Trademark has become known in Canada, I am unable to find that it has become known through use and promotion enuring to the benefit of the Opponent or a predecessor in title. I note that this conclusion is based strictly on the evidence before me and is not a finding with respect to the validity or enforceability of the Opponent's Registration. I would also note that, in any event, my conclusion below with respect to the likelihood of confusion would not have substantively changed had I found the section 6(5)(a) factor—which involves a combination of the inherent and acquired distinctiveness of the parties' trademarks—to more significantly favour the Opponent.

[46] On balance, I find that the overall consideration of the section 6(5)(a) factor does not weigh strongly in favour of either party, only slightly favouring the Opponent given my findings on inherent distinctiveness.

***Section 6(5)(b): Length of time the trademarks have been in use***

[47] The Application is based on proposed use and there is no evidence that use of the Mark has commenced since the Application was filed. Although it appears the LOFT Trademark has been used for some time in Canada, the evidence fails to establish that any such use has enured to the benefit of the Opponent or its predecessor in title. Under the circumstances, this factor favours neither party.

***Sections 6(5)(c) & (d): Nature of the parties' goods, services, businesses, and trades***

[48] When considering the nature of the goods, services, and trades under a registrability ground of opposition, it is the statements of goods and services in the

applicant's application and in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[49] The Opponent's Registration covers goods in the nature of apparel and accessories and retail services in the field of apparel, accessories, and toiletries, including consumable bath products and cosmetics. LOFT brand apparel and accessories offered through LOFT physical and online retail stores over the years have included pants, jeans, dresses, jackets and outerwear, swimwear, blouses, sweaters, professional attire, skirts, sweatshirts, shirts, tops, shorts, jumpsuits, rompers, blazers, sleepwear, maternity wear, eyewear, jewellery, watches, cosmetics, scarves, shoes, socks, tights, kimonos, ponchos, bags, belts, sunglasses, readers, umbrellas, and hats [Klinger paras 12, 22, Exhibit A; Penney paras 3, 6, Exhibits B, E-1–E-4].

[50] As for the Application, it covers a long list of Goods, including many that the Opponent submits overlap with or are related to its own goods and services. The Opponent further submits that neither the Application nor the Opponent's Registration imposes any restrictions on channels of trade and that the Opponent, under its own registration, would be entitled to sell the Goods online.

[51] Conversely, the Applicant submits that the Application covers generally different goods when the statement of goods is considered as a whole. In the Applicant's further submission, any overlap is superseded by a lack of resemblance between the trademarks, which the Applicant submits is the overriding factor in the present case.

[52] At the hearing, the Opponent proposed seven categories of overlap between the parties' respective goods and services. I will address each of these categories in turn. In considering the nature of the Goods and the probable channels of trade, I will bear in



mind the limited evidence available with respect to the Applicant's business, which consists of Mr. Penney's printouts from the Applicant's website. This evidence shows that the Applicant describes itself on its corporate website as "one of the world's largest fashion retailers", being "globally focussed on the key elements of fashion production— design, manufacture, distribution and retail", with "an integrated model of physical and online stores" [paras 7–8, Exhibits F–G]. The Opponent's description in its 2014 Annual Report, which was obtained through this website, supports the conclusion that the Opponent is a large and sophisticated retailer involved not only in the sale of apparel, fashion accessories, and household textile products, but also in their design, manufacture, and distribution through a network of owned and franchised stores.

[53] For the Goods that are similar or related in nature to the Opponent's Goods and Services, or where there is a meaningful connection to the Opponent's Goods and Services, the sections 6(5)(c) and (d) factors will favour the Opponent. For the remaining Goods, these factors will favour the Applicant.

#### Goods overlapping with the Opponent's Goods

[54] First, the Opponent submits that some of the Goods are the same as the Opponent's Goods, citing "footwear" and "shoes" as an example. Its written argument also cites "clothing, hats, bags ... gloves, raincoats" as an example of such Goods or of closely related Goods [at para 59].

[55] However, when the statement of goods is read as a whole, I find that the foregoing terms appear primarily in the context of descriptions of textiles. Although the punctuation creates some ambiguities, on a fair reading, I find that the goods in Class 24 are to be interpreted as the types of textiles and textile goods that this class is intended to cover, rather than finished clothing, headwear, footwear, or accessory apparel of the type intended for Class 25 (like hats and gloves) or leather and artificial leather goods intended for Class 18 (like handbags).

[56] On this basis, I decline to find any direct overlap between the Opponent's Goods and the following Goods in Class 24:

- sleeping bags (sheeting),
- lining fabric for shoes, fabric for footwear,
- gummed cloth for gum boots, gummy rain jacket, gummy umbrella, gummy shirts, gummy pants,
- knitted fabric for the manufacturing of clothing, household furnishings, home and commercial interiors and wall hangings;
- adhesive fabric for application by heat namely for footwear; clothing, hats, bags, sleeping bags, gloves, raincoats, carpets, curtains, sofas, tents and slip covers for cars.

[57] Additional terms identified by the Opponent appear in descriptions of protective and sporting equipment. Although the Opponent's Registration does not specifically exclude the sale of such specialized apparel, accessories, or bags, I find it unlikely given Ms. Klinger's evidence to the effect that the Opponent is in the fashion business, with the LOFT Trademark being used for a relaxed professional line. I reach the same conclusion in respect of Goods that are in the nature of toys or theatrical costumes. Accordingly, I also decline to find any direct overlap between the Opponent's Goods and Goods such as the following:

- shoes for protection against accidents, irradiation and fire, bullet-proof waistcoats, life jackets, clothing for protection against fire, gloves for divers, protective gloves against cutting injuries and against chemical exposure, diving suits, ... clothing for protection against accidents, irradiation and fire; protective suits for aviators; ... divers' weight belts; ... reflective safety vests, reflective safety bands to be worn on the body for running, walking and training; ... divers' masks, swimming belts and water wings; (Class 9)
- bibs of paper; (Class 16)
- gymnastic shoes; ... gloves for baseball, boxing, fencing, and golf; ... weight lifting belts, weight lifting gloves, (Class 28)
- golf bags, with or without wheels; ... bags especially designed for skis and surfboards; ... skating boots with skates attached; ... punching bags; (Class 28)

- theatrical and toy masks; ... novelty hats; ... dolls' clothes; (Class 28).

#### Goods sold in the Opponent's stores

[58] The Opponent further submits that some of the Goods may be sold in the stores it operates in the course of providing the Opponent's Services.

[59] I agree that the Opponent's Services are broad enough to encompass most of the Goods in Class 3, being cleaning and cosmetic preparations. I would exclude only the following Goods, which do not appear to be toiletry, bath, or cosmetic products (for humans): "essential oils ... for the manufacture of perfume; ... shoe polish, and wax; ... sachets for perfuming linen; ... incense; scented wood; ... potpourris fragrances; ... leather bleaching preparations, namely gels, wax, milks and creams; ... cleaning chalk; shampoos for pets; cosmetics for animals; ... javelle water; dry-cleaning preparations, namely solvents;".

[60] I find that the Opponent's Services are also broad enough to encompass the following Goods from other classes:

- bathroom scales, ... hand held mirrors, (Class 9)
- tissues of paper for removing make-up, ... handkerchiefs of paper; ... face towels of paper; ...towels of paper; ... toilet paper; (Class 16)
- bath linen, tissues of textile for removing make-up, ... handkerchiefs of textile, ... towels of textile, ... face towels of textile, (Class 24)
- hair colouring caps; (Class 26).

[61] I am thus satisfied that there is a meaningful connection between the Goods identified above and the Opponent's Services, and also a potential for overlap in the channels of trade, since such Goods could be sold in the Opponent's stores or similar stores.

### Goods applied to the Opponent's Goods

[62] The Opponent submits that certain Goods may be *applied to* the Opponent's Goods and are thus related goods. For example, the Applicant's "hat ornaments" may be applied to the Opponent's "hats". I find the following Goods fall into this category:

- shoe polish, and wax; (Class 3)
- watch batteries; ... electric camera, cell phones and watch batteries; solar watch and calculators batteries; (Class 9)
- ornamental pins; tie pins; ... badges of precious metal; shoe ornaments of precious metal; hat ornaments of precious metal; cuff links; ... shoe, hats and hair ornaments (jewellery); ... tie clips; (Class 14)
- shoe and hat ornaments (not of precious metal); ... brooches (clothing accessories); ... ornamental novelty badges (buttons); ... feathers used as decorative ornaments for clothing, hats and footwear; ... heat adhesive patches for decoration of textile articles (haberdashery); (Class 26)
- brassards; ... shoe laces; ... expanding bands for holding sleeves; (Class 26).

[63] I find that there is a meaningful connection between the foregoing Goods and the Opponent's Goods in that consumers may assume that the Goods are manufactured licensed, or approved by the Opponent for use with its own goods. Indeed, it is well accepted that the likelihood of confusion may be heightened where the goods in issue are of such a nature that they often are used together [*Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2021 FC 782; *Empresa Cubana Del Tabaco v Tequila Cuervo SA Dec V*, 2013 FC 1010, aff'd 2015 FCA 15]. Moreover, I find there to be a potential for overlap in the channels of trade to the extent that the Opponent's Goods may be sold in proximity to optional accessories.

### Goods that are of the same type as or a natural extension of the Opponent's Goods

[64] The Opponent submits that certain Goods are of the same type as the Opponent's Goods or represent a natural extension thereof. For example, the Opponent submits that "eyeglasses" would be perceived as a natural extension of a line of clothing, handbags, and small leather accessories. Indeed, the evidence shows that

umbrellas, eyeglasses, sunglasses, and sunglass cases are already being sold in the Opponent's stores [Klinger para 21; Penney Exhibit E-1].

[65] I find that most of the Goods in Class 14, being jewellery and other wearable ornamentation (including key rings and fobs) and cases therefor, are related to the Opponent's Goods in this manner. I would exclude only the following Goods, which do not appear to be ones you would wear (without further processing): "precious stones; ... chronometers, clocks; ... works of art of precious metal; ... coins; ... clock cases; ... alarm clocks; diamonds; ... cases for watches [presentation]".

[66] I find that the following eyewear and accessory Goods are similarly related to the Opponent's Goods and/or to goods covered by the Opponent's Services (such as handbags and small leather accessories):

- anti-glare glasses, eyeglasses (pince-nez), optical lenses, eyeglass chains (pince-nez chains), ... eyeglass cords (pince-nez cords), ... spectacles (optics), spectacle glasses, spectacle cases, frames for glasses, sunglasses, ... pince-nez chains; pince-nez cords; ... anti-glare visors (anti-glare shades); (Class 9)
- hair bands; ... wreaths of artificial flowers; ... bodkins; barrettes (hair slides); ... hair ornaments; false hair; hair nets; ... plaited hair; wigs; ... tresses of hair; toupees; (Class 26)
- artificial garlands; (Class 26).

[67] Given the nature of the goods at issue and in the absence of evidence to the contrary, I am prepared to infer that there is at least a potential for overlap in the channels of trade between the foregoing Goods and the Opponent's Goods.

#### Goods likely to be sold in the same types of stores as the Opponent's Goods

[68] The Opponent submits that certain Goods, while not the subject of the Opponent's Goods or Services, are likely to be sold in the same types of stores. Examples include gymnastic, sporting, and decorative articles that are not apparel as well as cleaning products that are not toiletries.

[69] With respect to gymnastic and sporting articles, although the Opponent's Registration does not specifically exclude clothing, headwear, and footwear for gymnastics and sports, I find the Opponent's actual business is unlikely to include such specialized items, given Ms. Klinger's evidence with respect to the Opponent being in the fashion business and the LOFT clothing line being for a relaxed professional environment. Accordingly, in the absence of evidence to the contrary, I am not prepared to find a potential for overlap between the gymnastic and sporting Goods (including items such as prize ribbons and textile competitors' numbers) and the Opponent's Goods and Services. I reach the same conclusion in respect of the theatrical and toy Goods as well as other miscellaneous Goods, such as "reins for guiding children".

[70] Furthermore, in the absence of evidence that toiletry products are sold in the same types of stores (or in the same sections of department stores) as household fragrance products, I am not prepared to find a potential for overlap in respect of Goods such as "incense; scented wood; ... potpourris fragrances;".

[71] Similarly, in the absence of evidence that fashion apparel is sold in the same types of stores (or in the same sections of department stores) as decorative accessories for the home or other household products, I am not prepared to find a potential for overlap in respect of the home furnishing Goods and other household and decorative Goods, with the following exception. The Goods "sachets for perfuming linen" (Class 3) and the Goods "hat boxes of cardboard" and "drawer liners of paper, perfumed or not" (Class 16) are related to wearing apparel in that they are used in its storage and I am not prepared to exclude a potential for overlap in the channels of trade when it comes to these particular Goods. Furthermore, I find the relationship between these Goods and the Opponent's Goods and Services sufficient to give rise to an assumption that the Goods are manufactured, licensed, or approved by the Opponent for use when storing its apparel items, and potentially also when storing toiletries such as bath linens. The Applicant has furnished no evidence to the contrary.

### Goods used in the manufacture of the Opponent's Goods

[72] The Opponent submits that certain Goods are used in the manufacture of the Opponent's Goods; for example, "patterns for dressmaking" might be used in the creation of clothing like that of the Opponent. In my view, the same might be said of "embroidery designs (patterns)" or "traced cloths for embroidery". I accept the argument that consumers may perceive a connection between the clothing sold by a fashion retailer and dressmaking patterns or embroidery patterns for similar clothing. Furthermore, I find the connection sufficiently meaningful for consumers to assume that such patterns are manufactured, licensed, sponsored, or approved by the retailer for use in creating fashion looks.

[73] Conversely, I find that the tools which are not tied to a ready-made design—such as leather bleaching preparations or tailor's chalk—are not related to the Opponent's Goods in the same way and I am not prepared to find that they would lead to a similar assumption.

[74] In addition, the Opponent submits that other Goods, such as textiles and trimmings, are used in the manufacture of the Opponent's Goods in a manner similar to parts and fitting. The Opponent submits that textile trademarks may also be displayed in association with finished apparel, citing NYLON and GORE-TEX as examples. Although the Opponent did not furnish any evidence with respect to such practices or the circumstances in which they would occur, I am prepared to accept the possibility that consumers might perceive a connection between the clothing sold by a fashion retailer and the character or quality of fashion fabrics and trimmings branded with the same trademark. Again, I find the connection may be sufficient for an assumption that the fashion retailer is the source of the material or has approved or licensed its design.

[75] With respect to the nature of the trade, in the absence of evidence, I am not prepared to infer that the Opponent's Goods would necessarily be sold in proximity to or through the same channels as patterns, fabrics, or other dressmaking tools. However, I find that there may be overlap in clientele to the extent that the Opponent's customers may seek to reproduce similar fashion looks at home.

### Goods used in the provision of the Opponent's retail services

[76] Finally, the Opponent submits that certain Goods are of a type that may be used in the provision of the Opponent's Services, for example, "electronic price and identification tags for goods". I find that a number of the electronic and stationery Goods might be used in the provision of retail services, ranging from cash registers and bar code readers to catalogues to packaging boxes, and also including more general office supplies.

[77] In the absence of evidence or jurisprudence to the contrary, I am not prepared to infer that consumers are likely to assume that articles *used* by retailers in the course of providing their retail services are also *sold* by the retailers or are manufactured for sale, licensed, or sponsored by the retailers. Nor am I prepared to infer that there would be any overlap in channels of trade between such Goods and those of a fashion retailer like the Opponent. While the LOFT Trademark may be displayed on promotional, packaging, or labelling materials in the course of promoting, packaging, or labelling the *Opponent's* Goods, I am not prepared to find that the average consumer might assume from such displays that the Opponent is also a source of stationery and office supplies sold as such to the general public.

### ***Conclusion with respect to the registrability ground of opposition***

[78] In an opposition proceeding, the onus is not on the opponent to show that confusion is likely but rather on the applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. In the present case, analysis of all the surrounding circumstances leads me to conclude that the Applicant has failed to meet its legal onus with respect to the various Goods that are similar to, related to, or meaningfully connected to the Opponent's Goods and Services. The full list of these Goods may be found below, in the first paragraph of the Disposition section of my decision.

[79] In respect of these Goods, I find that, at best for the Applicant, the probabilities are evenly balanced between a finding of confusion and no confusion. I reach this conclusion based primarily on my findings that there is an important degree of



resemblance between the Mark and the inherently distinctive LOFT Trademark, particularly in appearance, and that there is also a significant nexus between the parties' respective goods, services, businesses, and trades. In my view, a causal consumer having only an imperfect recollection of the LOFT Trademark may well, as a matter of first impression, upon seeing the Mark, assume that the associated Goods are from the same source as the LOFT-branded goods or, alternatively, are licensed, sponsored, or approved by that source. In the absence of evidence regarding the pronunciation of the Mark, I am not prepared to find that the phonetic and conceptual differences are sufficient to tip the balance in the Applicant's favour. In the end, I find that the Applicant has failed to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion in respect of these Goods.

[80] As the Applicant has not met its legal onus, the ground of opposition based on registrability of the Mark under section 12(1)(d) of the Act is successful in respect of the above-noted Goods.

[81] By contrast, owing to the difference in nature of the remaining Goods, and/or the lack of apparent overlap in the channels of trade, I am satisfied that the Applicant has met its legal onus to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of confusion between the LOFT Trademark and the Mark used in association with the remaining Goods. The full list of these remaining Goods may be found below, in the second paragraph of the Disposition.

### ***Compliance with section 30(d)***

[82] The Opponent pleads that the Application does not comply with section 30(d) of the Act in that, as of the Application's filing date, namely October 16, 2013, the Applicant had not used the Mark in association with the Goods, in Spain or at all, and the Application fraudulently claims otherwise.

[83] The initial burden on an opponent is lighter respecting the issue of non-compliance with section 30(d) of the Act because the relevant facts are more readily available to the applicant [see *John Labatt, supra*; and *Ivy Lea Shirt Co v Muskoka Fine*

*Watercraft & Supply Co*, 2001 FCT 252]. As explained by the Federal Court, “To adduce evidence of non-use of a mark by a competitor is problematic in two ways: first, because it requires [the opponent] to prove that something did not occur (an inherently difficult exercise), and second, because such evidence is far more likely to be in the possession of the applicant, not the party opposing the mark” [*Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at para 29; see also *Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 at para 10 (TMOB)].

[84] Although the foregoing comments were made in the context of a ground of opposition based on section 30(b) of the Act, they are equally applicable to a ground based on section 30(d). To the extent that an applicant has easier access to the facts, the initial burden on an opponent regarding a section 30(d) ground of opposition is less onerous and the amount of evidence required to discharge it may be very slight [*105272 Canada Inc v Grands Moulins de Paris, Société Anonyme* (1990), 31 CPR (3d) 79 (TMOB); citing *Canadian Council of Professional Engineers v 407736 Ontario Corp* (1987), 15 CPR (3d) 551 (TMOB)]. Multiple diverse considerations inform the assessment of the evidence, such as its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, and whether it has been tested on cross-examination and, if so, how it fared [*Bacardi* at para 37].

[85] In the present case, the Opponent relies on the results of Internet searches performed by Mr. Penney on July 9, 2018, and in particular on the following:

- a. Printouts of the “About Us” section of the website located at *www.inditex.com* (Inditex Website), which domain name is registered by the Applicant [para 8, Exhibit G; with registration details from *whois.domaintools.com* at para 7, Exhibit F]. These webpages identify and describe each of the Applicant’s “eight distinct brands”. Neither any of the brands nor any of the product lines identified within the brands are named “LFT”. The Opponent also draws attention to the Applicant’s description as a “fashion retailer” while submitting that many of the items in the long list of Goods in the Application—ranging from “architect’s models” to “protective welding helmet”—would “as a matter of common sense,

not be sold by fashion retailers”. In the Opponent’s submission, this incongruity is evidence of the Applicant “overclaiming” by listing Goods with which the Mark had not yet been used [written representations at para 80(e)].

- b. The results of a search for the word “LFT” using the internal search functionality of the Inditex Website [Exhibit H]. All but one of the documents located are expressly dated after the material date, with the remaining, undated document also appearing (for reasons discussed below) to have been published after the material date.
- c. A printout of the “Inditex Annual Report 2014” located in the aforementioned search, which is the closest reference to the material date (another document dated 2014 appears to be a Spanish version) [Exhibit I]. This report describes the Opponent as the parent company in “a global fashion group ... which engages mainly in the retail sale of fashion goods, principally clothing, footwear, accessories and textile products for home”, whose “principal activity ... consists of the distribution of fashion items, mainly clothing, footwear, accessories and household textile products”, and which “carries out its activity through various commercial formats”—notably the Mark is not listed as one of the commercial formats or brands [see pages 193 and 237]. Furthermore, the results of a search for the word “LFT” within the annual report located only two references, both to the company “LFT RUS Ltd”, with an indication that this entity is among those incorporated by the group and consolidated for the first time “during the year” [at pages 220 and 235]. Since the fiscal year is defined as February 1, 2014 to January 31, 2015 [see page 132], it appears LFT RUS Ltd did not exist until after material date.
- d. Printouts from the aforementioned search’s one undated result, a document titled “The List by Inditex. III Edition”, including six introductory pages and three pages containing the term “LFT” [Exhibit J]. According to the introductory pages, the document’s purpose is to provide a list of chemical products that comply with the Opponent’s manufacturing standards. The three occurrences of “LFT” are in what

appear to be chemical product names—NOVOLAC LFT, SERA WHITE P-LFT, and LAMEPON LFT—with no suggestion of any connection to the Applicant. Moreover, according to the 2014 Annual Report, the first two such “Lists” were issued in 2013 and 2014 respectively, with a commitment for updates at least once per year [see page 74]. Therefore, although the exhibited third edition is undated, it would appear to have been published in or around 2015.

- e. A printout of an archived version of the webpage at *www.inditex.com/en* as captured by the Internet Archive Wayback Machine at *www.archive.org* on October 15, 2013 [Exhibit K]. The aforesaid eight brands are listed in the footer; LFT is not mentioned as a brand or otherwise. In this respect, I note that Wayback Machine evidence has been found to be admissible, generally reliable, and sufficient to raise a doubt concerning the correctness of a claimed date of first use under a section 30 ground of opposition [see *Candrug Health Solutions Inc v Thorkeelson* (2007), 60 CPR (4th) 35 (FC) at para 21, rev’d on other grounds 2008 FCA 100; and *Royal Canadian Golf Assn v ORCGA* (2009), 72 CPR (4th) 59 (TMOB)].

[86] The Opponent submits that this evidence is sufficient to meet its light evidential burden. First, a company’s annual report is the public facing statement of that company’s activity during the year and should, as a matter of common sense, be treated as reliable. Second, the annual report relied upon in this particular case groups the financial statements of the Applicant and its subsidiaries, lists the Applicant’s “Retail Formats” and Groups Brands”, and indicates that it “presents all the issues that have an economic, social and environmental impact relevant to Inditex” [pages 4, 184, 17–25, 110–11, my emphasis]. Third, Mr. Penney obtained the document from the Applicant’s own website and the document has not been challenged through either cross-examination or independent evidence.

[87] With respect to the timing of the evidence, the Opponent seeks to draw an analogy with the situation in *Les Marques Metro / Metro Brands SENC v 1161396 Ontario Inc*, 2017 FC 806. In that case, data from third-party sales databases and the

applicant's own product catalogues was introduced into evidence by the opponent and not challenged through cross-examination; the Federal Court found it to be relevant and sufficiently probative of whether the applicant's mark had been used as claimed in the application, even though the available particulars were from after the material date [at paras 22–27, 33, 65–66].

[88] The Applicant, for its part, submits that Mr. Penney's evidence fails to meet even a light evidential burden, because there is no inherent contradiction between use of the Mark and its absence from the annual report. In the Applicant's submission, while the annual report is voluminous, it focusses on the Applicant's products and need not necessarily reference each and every trademark in the Applicant's portfolio, including ones that are less important or used only by licensees. The Applicant submits that the Opponent has demonstrated an absence of *evidence* rather than an absence of *use*.

[89] The Applicant's arguments notwithstanding, I am satisfied that the Opponent has met its initial burden. An opponent's evidence need not be "clearly inconsistent" with the claims set forth in the application, if the opponent is relying on its own evidence rather than on evidence filed by the applicant [*Bacardi, supra* at para 33]. In my view, while not necessarily conclusive, the Mark's absence from what appears to be a comprehensive annual report issued by the Applicant only slightly after the material date—taken together with the other evidence described above—calls into question whether the Applicant had in fact used or even licensed the Mark at the material date. The level of doubt raised is sufficient to shift the burden to the Applicant to establish compliance with the Act.

[90] As the Applicant did not file or point to any evidence in this respect, the section 30(d) ground of opposition is successful and the claim of use and registration in Spain is refused.

[91] I note, however, that the success of this ground does not result in the refusal of the Application, which was filed on the dual bases of (i) use and registration abroad and (ii) proposed use in Canada. The Application proceeds based on proposed use subject to the outcome of the first ground of opposition, as reflected in the disposition below.

## **DISPOSITION**

[92] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act only in respect of the following Goods:

- 3 Skin soaps, body soaps, perfumery, namely, perfumes, scented water, toilet water, Cologne water, perfume extracts, perfume water; [essential oils] for personal use, [...]; cosmetics; hair lotions; shoe polish, and wax; depilatory wax; hair shampoo; cosmetic kits; depilatory preparations; make-up removing lotions, gels, milks and waters; deodorants for personal use; lip-sticks; pencils for cosmetic uses, namely eye, eyelashes, eye brows and lips pencils; hair spray and nail polish; lacquer removers; tissues impregnated with cosmetic lotions for skin care; after shave lotions; skin care lotions; make-up; skin care pomades; sachets for perfuming linen; nail care preparations; hair bleaching decolourants for cosmetic purposes; extracts of flowers (perfumes); [...] decorative patterns for cosmetic purposes, namely ephemeral decorative tattoos; false eyelashes and nails; pumice stone; [...] cosmetic preparations for slimming purposes, namely lotions, gels, creams, milks; cosmetic preparations for baths, namely foam, pearls, salts and milk; hair waving preparations; non-medicated toiletries, namely mouth washes, mouth rinse, dental floss, dentifrice; skin care oils for toilet purposes; sun-tanning preparations, namely sunscreen preparation, sun-tanning lotions, milks and sprays; skin care talcum powder for toilet use; adhesives for cosmetic purposes; skin care greases; abrasive boards for use on fingernails; emery paper for use on fingernails; skin care abrasive granules; shaving preparations, namely lotions, soaps, balms, and foam; cotton sticks for cosmetic purposes; skin care beauty masks; moustache wax; [...] dental bleaching gels; hair colorants; cosmetics for eyebrows; [...] cosmetic skin care creams; cakes of soap; soap for preventing foot perspiration; cleansing milk for toilet purposes; [...] cosmetics for eyelashes; make-up powder; adhesives for affixing false hair; cosmetic hair dyes.
- 9 [Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments, namely] anti-glare glasses, eyeglasses (pince-nez), optical lenses, eyeglass chains (pince-nez chains), [...] eyeglass cords (pince-nez cords), [...] spectacles (optics), spectacle glasses, spectacle cases, frames for glasses, sunglasses, [...] watch batteries; [...] [weight measuring instruments, namely] bathroom scales, [...] [mirrors (optics), namely] hand held mirrors, [...] pince-nez chains; pince-nez cords; [...] electric camera, cell phones and watch batteries; solar watch and calculators batteries; [...] anti-glare visors (anti-glare shades); [...].
- 14 Precious metals and their alloys and goods in precious metals or coated therewith, namely rings, necklaces, chains, earrings, bracelets and key rings; jewellery [...]; [horological and chronometric instruments, namely] watches, [...] ornamental pins; tie pins; [...] key rings (trinkets or fobs); medals; [...] badges of precious metal; shoe ornaments of precious metal; hat ornaments of precious metal; cuff links; watch chains; [...] jewellery cases; shoe, hats and hair ornaments (jewellery); jewellery of yellow amber; pins (jewellery); jewel amulets; rings (jewellery); ornaments of jet;

bracelets (jewellery); chains (jewellery); boxes of precious metal; necklaces (jewellery); tie clips; watch glasses; chronographs (watches); [...] pendants; trinkets (jewellery), namely, key rings, key fobs and watch fobs; [...] ivory jewellery; locket (jewellery); pearls (jewellery); straps for wristwatches; diadems.

- 16 [...] patterns for dressmaking; tissues of paper for removing make-up; [...] handkerchiefs of paper; [...] face towels of paper; hat boxes of cardboard; [...] towels of paper; [...] toilet paper; [...] embroidery designs (patterns); [...] drawer liners of paper, perfumed or not [...].
- 24 [Textiles and textile goods, namely] [...] bath linen, tissues of textile for removing make-up, [...] lining fabric for clothes, [...] handkerchiefs of textile, [...] towels of textile, [...] traced cloths for embroidery, face towels of textile, [...] cotton fabrics, haircloth (sackcloth), brocades, lining fabric for shoes, fabric for footwear, [...] trellis (hemp cloth), zephyr (cloth), cheviots (cloth), [...] crepe fabric, crepon, [...] damask, elastic woven material, [...] gummed cloth for gum boots, gummy rain jacket, gummy umbrella, gummy shirts, gummy pants, esparto fabric, chenille fabric, felt, flannel (fabric), [...] gauze fabric, fabric for making team jersey, woolen cloth, woolen fabric, lingerie fabric, linen fabrics, [...] marabouts (cloth), [...]; imitation animal skin fabrics, [knitted fabric for the manufacturing of] clothing [...]; ramie fabric, rayon fabric, silk (cloth), taffeta (cloth), [...] [adhesive fabric for application by heat namely for] footwear; clothing, hats, bags, [...] gloves, raincoats, [...]; traced cloths for embroidery, velvet, tulle.
- 26 Fabric laces and embroidery, ribbons and textile braids; buttons for clothing, hooks and eyes, [...]; shoe and hat ornaments (not of precious metal); haberdashery, except thread; hair bands; brassards; [...] brooches (clothing accessories); [...] belt clasps; shoe laces; wreaths of artificial flowers; ornamental novelty badges (buttons); [...] belt, bag, clothing and shoe buckles; shoulder pads for clothing; hair pins; badges for wear not of precious metal; orsedew (trimmings for clothing); bodkins; barrettes (hair slides); passementerie; feathers used as decorative ornaments for clothing, hats and footwear; topknots (pompoms); zip fasteners; [...] heat adhesive patches for decoration of textile articles (haberdashery); [...] snap fasteners; [...] whalebones for corsets; [...] decorative cords for rimming, textile cords for clothing fastening and decorating; tassels (haberdashery); expanding bands for holding sleeves; hair ornaments; false hair; hair nets; shoe eyelets; chenille (passementerie); frills (lacework); [...] fastenings for clothing, namely zippers; hook and pile fastening tapes; elastic ribbons; [...] cords for clothing; collar supports; false hems; [...] fringes; [...] hair colouring caps; artificial garlands; [...] trimmings for clothing, namely tinsels; plaited hair; wigs; silver embroidery; edgings for clothing; rosettes (haberdashery); suspender ends [fasteners]; skirt flounces; tresses of hair; toupees; shoe hooks.

[93] Pursuant to the authority delegated to me under section 63(3) of the Act and in accordance with section 38(12) of the Act, I reject the opposition with respect to the remaining Goods:

- 3 [...] essential oils [...] for the manufacture of perfume; [...] incense; scented wood; [...] potpourris fragrances; [...] leather bleaching preparations, namely gels, wax, milks and creams; [...] cleaning chalk; shampoos for pets; cosmetics for animals; [...] javelle water; dry-cleaning preparations, namely solvents [...].
- 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments, namely [...] contact lenses, [...] measuring rules, [...] lens cases, containers for contact lenses, shoes for protection against accidents, irradiation and fire, bullet-proof waistcoats, life jackets, clothing for protection against fire, gloves for divers, protective gloves against cutting injuries and against chemical exposure, diving suits, magnetically encoded credit, debit and phone cards, magnetic identity cards; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely electricity meters, voltmeters, electric batteries chargers, electric transformers, voltage regulators, flashlights, battery powered wall lights and Christmas lights, camera batteries, cellular phone batteries [...]; apparatus for recording, transmission or reproduction of sound or images, namely receivers, integrated amplifiers, tuners, control amplifiers, power amplifiers, compact disc players, headphones, televisions, video cassette recorders, video disc players, camera, video cameras, movie cameras; blank magnetic data carriers, namely computer disks, audio cassettes, tapes and cards, USB flash drives, blank sound recording discs; blank compact discs, compact discs featuring music, films, documentaries, and animated cartoons; blank DVDs, DVDs featuring music, films, documentaries, and animated cartoons; mechanisms for coin-operated apparatus; cash registers, calculators, data processing equipment, namely computers; fire extinguishers; computer peripheral devices, namely screens, printers, scanners, speakers, web cameras, mouse; clothing for protection against accidents, irradiation and fire; protective suits for aviators; electronic agendas; telephone apparatus, namely telephones, cellular phones; weight measuring instruments, namely [...] food scales; directional compasses; adding machines; protective welding helmets; protective helmets for sports; telescopes; chronographs (time recording apparatus); measuring spoons; pedometers; blank compact discs (read-only memory), compact discs (read-only memory) featuring films, documentaries, and animated cartoons; mirrors (optics), namely [...] convex security mirrors, bicycle and motorcycle rear view mirrors, decorative furniture mirrors; binoculars; temperature indicators, namely thermometers; [...] computer game programs; cassette players; bar code readers; signal lanterns; magnifying glasses (optics); dictating machines; mechanisms for coin-operated dispensing machines; divers' weight belts; [...] recorded computer programs for use in database management, for use as a spread sheet, for word processing; electronic pocket translators; transistors (electronics); intercommunication apparatus, namely walkie-talkie; blank video cassettes, video cassettes featuring music, films, documentaries, and animated cartoons; portable radio-telephones; downloadable electronic publications, namely newsletters, books, calendars, magazines; egg timers (sandglasses); acoustic (sound) alarms, namely burglar alarms, personal security alarms; anti-theft warning apparatus, namely, vehicle alarms; fire alarms; mouse pads; loudspeakers; aerials, namely car, cell phones, parabolic, radio and television antennas; [...] telephone receivers; music headphones; telephone answering machines; false coin detectors; teeth protectors; machines for counting and sorting money; apparatus for measuring the thickness of animal skins; electronic price and identification tags for goods; goggles for sports,



namely ski, bicycle, motorcycle and swimming goggles; fridge magnets; light-emitting electronic pointers; enlarging apparatus (photography), namely photographic zooms; thermionic valves; juke boxes, musical; life-saving rafts; magnetic tape recorders; head cleaning tapes (recording); blank magnetic tapes; demagnetizing apparatus for magnetic tapes, namely magnetic tape erasers; barometers; ticket dispensers; heat regulating apparatus, namely thermostats; cinematographic cameras; camcorders; video game cartridges; magnetic encoders; measuring glassware; revolution counters; photographic slides; slide projectors; dynamometers; reflecting discs for wear, for the prevention of traffic accidents, namely reflective tapes, reflective safety vests, reflective safety bands to be worn on the body for running, walking and training; hemline markers; dosimeters; covers for electric outlets; flash-bulbs (photography); photocopiers (photographic, electrostatic, thermic); speaking tubes, namely megaphones; computer memory devices, namely microphones, microprocessors, modems; breathing apparatus for divers, namely compressed-air tanks for underwater swimming, oxygen cylinders for underwater swimming diving snorkels, divers' masks, swimming belts and water wings; photographic lenses; ozonisers; projection screens; electric switches; dog whistles; push buttons for bells; radios; audio-receivers and video-receivers; wrist rests for use with computers; lever scales (steelyards); record players; data processing software for word processing; video telephones; computer carrying cases for **[sic]** portable computers; cases adapted for mobile phones; personal stereos.

- 14 [...] precious stones; horological and chronometric instruments, namely [...] chronometers, clocks; [...] works of art of precious metal; [...] coins; [...] clock cases; [...] alarm clocks; diamonds; [...] cases for watches [presentation]; [...].
- 16 Paper; cardboard; goods made from paper and cardboard, namely decorative boxes, packaging boxes, grocery bags; printed matter, namely calendars, almanacs, posters, lithographs, greeting cards, note cards, blank cards; bookbinding material, namely bookbinding adhesive, loose-leaf binders, cloth for bookbinding, cords for bookbinding; photographs; stationery, namely wrapping paper for books, adhesive tape dispensers, envelopes, diaries, scrapbooks, address books; adhesives for stationery or household purposes; artists' materials, namely paint brushes, oil paint, pigments, oil pastels, pastels, palettes for painters, canvas for painting; typewriters; office requisites (except furniture), namely rulers, rubber-bands; instructional and teaching material (except apparatus), namely printed forms and printed guides for conducting classes, seminars, workshops in the field of design and fashion; plastic materials for packaging; printers' type; printing blocks; engravings; [...] stencil cases; labels, not of textile; table linen of paper; napkins of paper; [...] pen cases; holders for chequebooks; writing cases sets comprising pens, envelopes and writing paper; inking sheets for document reproducing machines; bags (envelopes, pouches) of paper or plastics, for packaging; tailors' chalk; [...] tracing cloth and paper; [...] picture, souvenir, and stamp albums; label printing machines; loose-leaf binders; writing instruments, namely ball-point pens, pencils for writing, pens, markers, blotting paper, blotting pads; transfers (decalcomanias); folders for papers; catalogues; drawing sets comprising oil paint, watercolor, pastels, pencils, and a palette for painter; newspapers; periodicals; magazines (periodicals); books; wrapping paper; [...] paperweights; mats for beer glasses; bookmarkers; bookends; inks; inkwells; bibs of paper; drawing materials, namely drawing sheets, crayons, felt-tip pens, charcoals; graphic prints; school supplies (stationery), namely tapes, pencil

sharpeners, rulers, erasers, pen boxes, homework notebooks, exercise books; writing slates; comic books; trays for sorting and counting money; [...] garbage bags of paper or of plastics; geographical maps; terrestrial globes; moisteners (office requisites); plastics for modeling; stencils (stationery); placards of paper or cardboard; steel letters and steel pens; watercolours (paintings); adhesive tapes and bands for stationery or household purposes; stickers (stationery); cigar bands; files (office requisites); modeling clay; arithmetical tables; [...] architects' models; atlases; flags of paper; tickets; calendar and memo pads; ball-point pens; bags for microwave cooking; writing board erasers; rubber erasers; bottles wrappers and envelopes of cardboard or paper; painters' easels; song books; charcoal pencils; writing paper; advertisement boards of paper or cardboard; booklets; ink sticks; modeling wax, not for dental purposes; sealing wax; thumbtacks; paper ribbons and bows; inking ribbons for computer printers; typewriter inking ribbons; clipboards; cabinets for stationery (office requisites); compasses for drawing; paper clasps; paper cutters; writing or drawing books; paintings (pictures) framed or unframed; finger-stalls (office requisites); bookbinding laminating machines (office equipment); gummed cloth for stationery purposes; inking pads; square rulers; paper seals; filter paper; book covers; photograph stands; elastic bands for offices; stapling presses (office requisites); paper-clips; paper sheets (stationery); pencil sharpeners; pencil holders; luminous paper; silver paper; waxed paper; modeling paste; office perforators; house painters' rollers; postcards; rosaries; blotters.

- 24 Textiles and textile goods, namely bed and table covers, [...] labels (cloth), [...] wall hangings of textile, [...] curtains of textile or plastic, kitchen linen, [...] travelling rugs (lap robes), net curtains, curtain holders of textile material, banners and flags (not of paper), eiderdowns (down coverlets), loose covers for furniture, covers for cushions, mattress covers, pillowcases, mosquito nets, glass cloths, billiard cloth, table cloths (not of paper), [...] sleeping bags (sheeting), [...] coverlets (bedspreads), bed blankets, [...] mattress slips [other than incontinence], shower curtains of textile or plastic, [...] bedspreads, [...] oilcloth (for use as table cloths), [...] fitted toilet lid covers (fabric), [...] place mats of textile, printers' blankets of textile, [...] upholstery fabrics, furnishing fabrics namely velvet, suede, cotton; [...] knitted fabric for the manufacturing of [...] household furnishings, home and commercial interiors and wall hangings; cheese cloth, [...] fibreglass fabrics for textile use, adhesive fabric for application by heat namely for [...] sleeping bags, [...] carpets, curtains, sofas, tents and slip covers for cars [...].
- 26 [...] pins and needles; artificial flowers; pin cushions; [...] reins for guiding children; [...] sewing boxes; [...] sewing thimbles; needle cases; [...] competitors' numbers to be sewn or stuck for marking linen; [...] rug hooks; [...] ostrich feathers; [...] prize ribbons; [...] trouser clips for cyclists; [...] tapes for curtain headings; [...] festoons (embroidery); [...] artificial fruits; [...] darning lasts [...].
- 28 Games and playthings, namely skittles, role playing games, pinball games, table tennis games, video games, paddle ball games, parlour games, action target games, arcade games, card games, party games, table top games, word games; gymnastic and sporting articles, namely gymnastic mats and parallel bars, gymnastic training stools, rhythmic gymnastic hoops, gymnastic shoes; decorations for Christmas trees; fishing tackle; rods for fishing; theatrical and toy masks; dolls'

houses; climbers' harness; novelties for parties, namely garlands, confetti, serpentine, flags, balloons, novelty hats, practical jokes; dances party favours in the nature of noisemakers and small toys; gloves for baseball, boxing, fencing, and golf; puppets; body-building and body-training apparatus, namely, weight lifting benches and bench accessories, chest expanders, exercise treadmills, exercise tables, exercise bars, exercise benches, stationary exercise bicycles, exercise doorway gym bars, manually operated exercise equipment, namely bicycles, weights, exercise pulleys, exercise equipment for lateral movement in a skating motion, exercise equipment, namely, stair-stepping machines, exercise machines, powered treadmills for running, rowing machines, weight lifting machines, exercising pulleys and manually operated jogging machines, exercise platforms, exercise trampolines, exercise weight cuffs, exercise weights, manual leg exercisers, weight lifting belts, weight lifting gloves, exercise weights, leg weights, ankle and wrist weights for exercise; Christmas trees of synthetic material; bladders of balls for football, rugby, soccer; elbow and knee guards (sports articles); kites; rattles; kaleidoscopes; rocking horses; toy building blocks; amusement machines, automatic and coin-operated; playing cards; teddy bears; dolls; dolls' clothes; air pistols [toys]; chess games; flippers for swimming; ring games; Christmas tree stands; archery implements, namely archery bow sights, finger tabs, quivers, sights, stabilizers, target stands and targets; balls for games; dolls' feeding bottles; building blocks [toys]; body boards; stationary exercise bicycles; golf bags, with or without wheels; dolls' beds; marbles for games; butterfly nets; swings; confetti; cups for dice; checkers [games]; checkerboards; darts; discuses for sports; flying discs [toys]; dominoes; counters for games; skis; bags especially designed for skis and surfboards; tables for indoor table football (baby foot); horseshoe games; hockey sticks; soap bubbles [toys]; board games; toys for domestic pets; scale model vehicles; skateboards; mobiles [toys]; paintballs [ammunition for paintball guns] [sports apparatus]; artificial snow for Christmas trees; golf clubs; billiard tables; skating boots with skates attached; in-line roller skates; ice skates; roller skates; scooters [toys]; plush toys; spinning tops [toys]; piñatas; swimming pools [play articles]; punching bags; jigsaw puzzles; conjuring apparatus namely, magicians' sets; ping-pong, tennis, and badminton rackets; surf boards; chessboards; sling shots [sports articles]; slides [playthings]; spring boards [sports articles]; sleighs [sports articles]; toy vehicles; radio-controlled toy vehicles; shuttlecocks.

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Oksana Osadchuk  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

### ***Applicant's Goods (Nice class & Statement)***

- 3 Skin soaps, body soaps, perfumery, namely, perfumes, scented water, toilet water, Cologne water, perfume extracts, perfume water; essential oils for personal use, for the manufacture of perfume; cosmetics; hair lotions; shoe polish, and wax; depilatory wax; hair shampoo; cosmetic kits; depilatory preparations; make-up removing lotions, gels, milks and waters; deodorants for personal use; lip-sticks; pencils for cosmetic uses, namely eye, eyelashes, eye brows and lips pencils; hair spray and nail polish; lacquer removers; tissues impregnated with cosmetic lotions for skin care; after shave lotions; skin care lotions; make-up; skin care pomades; sachets for perfuming linen; nail care preparations; hair bleaching decolourants for cosmetic purposes; extracts of flowers (perfumes); incense; scented wood; decorative patterns for cosmetic purposes, namely ephemeral decorative tattoos; false eyelashes and nails; pumice stone; potpourris fragrances; cosmetic preparations for slimming purposes, namely lotions, gels, creams, milks; cosmetic preparations for baths, namely foam, pearls, salts and milk; hair waving preparations; non-medicated toiletries, namely mouth washes, mouth rinse, dental floss, dentifrice; skin care oils for toilet purposes; sun-tanning preparations, namely sunscreen preparation, sun-tanning lotions, milks and sprays; skin care talcum powder for toilet use; adhesives for cosmetic purposes; skin care greases; abrasive boards for use on fingernails; emery paper for use on fingernails; skin care abrasive granules; shaving preparations, namely lotions, soaps, balms, and foam; cotton sticks for cosmetic purposes; skin care beauty masks; moustache wax; leather bleaching preparations, namely gels, wax, milks and creams; dental bleaching gels; hair colorants; cosmetics for eyebrows; cleaning chalk; shampoos for pets; cosmetics for animals; cosmetic skin care creams; cakes of soap; soap for preventing foot perspiration; cleansing milk for toilet purposes; javelle water; dry-cleaning preparations, namely solvents; cosmetics for eyelashes; make-up powder; adhesives for affixing false hair; cosmetic hair dyes.
  
- 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments, namely anti-glare glasses, eyeglasses (pince-nez), optical lenses, eyeglass chains (pince-nez chains), contact lenses, eyeglass cords (pince-nez cords), measuring rules, spectacles (optics), spectacle glasses, spectacle cases, frames for glasses, sunglasses, lens cases, containers for contact lenses, shoes for protection against accidents, irradiation and fire, bullet-proof waistcoats, life jackets, clothing for protection against fire, gloves for divers, protective gloves against cutting injuries and against chemical exposure, diving suits, magnetically encoded credit, debit and phone cards, magnetic identity cards; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely electricity meters, voltmeters, electric batteries chargers, electric transformers, voltage regulators, flashlights, battery powered wall lights and Christmas lights, camera batteries, cellular phone batteries, watch batteries; apparatus for recording, transmission or reproduction of sound or images, namely receivers, integrated amplifiers, tuners, control amplifiers, power amplifiers, compact disc players, headphones, televisions, video cassette recorders, video disc players, camera, video cameras, movie cameras; blank magnetic data carriers, namely computer disks, audio cassettes, tapes and cards, USB flash drives, blank sound

recording discs; blank compact discs, compact discs featuring music, films, documentaries, and animated cartoons; blank DVDs, DVDs featuring music, films, documentaries, and animated cartoons; mechanisms for coin-operated apparatus; cash registers, calculators, data processing equipment, namely computers; fire extinguishers; computer peripheral devices, namely screens, printers, scanners, speakers, web cameras, mouse; clothing for protection against accidents, irradiation and fire; protective suits for aviators; electronic agendas; telephone apparatus, namely telephones, cellular phones; weight measuring instruments, namely bathroom scales, food scales; directional compasses; adding machines; protective welding helmets; protective helmets for sports; telescopes; chronographs (time recording apparatus); measuring spoons; pedometers; blank compact discs (read-only memory), compact discs (read-only memory) featuring films, documentaries, and animated cartoons; mirrors (optics), namely hand held mirrors, convex security mirrors, bicycle and motorcycle rear view mirrors, decorative furniture mirrors; binoculars; temperature indicators, namely thermometers; pince-nez chains; pince-nez cords; computer game programs; cassette players; bar code readers; signal lanterns; magnifying glasses (optics); dictating machines; mechanisms for coin-operated dispensing machines; divers' weight belts; electric camera, cell phones and watch batteries; solar watch and calculators batteries; recorded computer programs for use in database management, for use as a spread sheet, for word processing; electronic pocket translators; transistors (electronics); intercommunication apparatus, namely walkie-talkie; blank video cassettes, video cassettes featuring music, films, documentaries, and animated cartoons; portable radio-telephones; downloadable electronic publications, namely newsletters, books, calendars, magazines; egg timers (sandglasses); acoustic (sound) alarms, namely burglar alarms, personal security alarms; anti-theft warning apparatus, namely, vehicle alarms; fire alarms; mouse pads; loudspeakers; aerials, namely car, cell phones, parabolic, radio and television antennas; anti-glare visors (anti-glare shades); telephone receivers; music headphones; telephone answering machines; false coin detectors; teeth protectors; machines for counting and sorting money; apparatus for measuring the thickness of animal skins; electronic price and identification tags for goods; goggles for sports, namely ski, bicycle, motorcycle and swimming goggles; fridge magnets; light-emitting electronic pointers; enlarging apparatus (photography), namely photographic zooms; thermionic valves; juke boxes, musical; life-saving rafts; magnetic tape recorders; head cleaning tapes (recording); blank magnetic tapes; demagnetizing apparatus for magnetic tapes, namely magnetic tape erasers; barometers; ticket dispensers; heat regulating apparatus, namely thermostats; cinematographic cameras; camcorders; video game cartridges; magnetic encoders; measuring glassware; revolution counters; photographic slides; slide projectors; dynamometers; reflecting discs for wear, for the prevention of traffic accidents, namely reflective tapes, reflective safety vests, reflective safety bands to be worn on the body for running, walking and training; hemline markers; dosimeters; covers for electric outlets; flash-bulbs (photography); photocopiers (photographic, electrostatic, thermic); speaking tubes, namely megaphones; computer memory devices, namely microphones, microprocessors, modems; breathing apparatus for divers, namely compressed-air tanks for underwater swimming, oxygen cylinders for underwater swimming diving snorkels, divers' masks, swimming belts and water wings; photographic lenses; ozonisers; projection screens; electric switches; dog whistles; push buttons for bells; radios; audio-receivers and video-receivers; wrist rests for use with computers; lever scales (steelyards); record players; data processing software for word processing;

video telephones; computer carrying cases for portable computers; cases adapted for mobile phones; personal stereos.

- 14 Precious metals and their alloys and goods in precious metals or coated therewith, namely rings, necklaces, chains, earrings, bracelets and key rings; jewellery, precious stones; horological and chronometric instruments, namely watches, chronometers, clocks; ornamental pins; tie pins; works of art of precious metal; key rings (trinkets or fobs); medals; coins; badges of precious metal; shoe ornaments of precious metal; hat ornaments of precious metal; cuff links; watch chains; clock cases; jewellery cases; shoe, hats and hair ornaments (jewellery); jewellery of yellow amber; pins (jewellery); jewel amulets; rings (jewellery); ornaments of jet; bracelets (jewellery); chains (jewellery); boxes of precious metal; necklaces (jewellery); tie clips; watch glasses; chronographs (watches); alarm clocks; diamonds; pendants; trinkets (jewellery), namely, key rings, key fobs and watch fobs; cases for watches [presentation]; ivory jewellery; locket (jewellery); pearls (jewellery); straps for wristwatches; diadems.
- 16 Paper; cardboard; goods made from paper and cardboard, namely decorative boxes, packaging boxes, grocery bags; printed matter, namely calendars, almanacs, posters, lithographs, greeting cards, note cards, blank cards; bookbinding material, namely bookbinding adhesive, loose-leaf binders, cloth for bookbinding, cords for bookbinding; photographs; stationery, namely wrapping paper for books, adhesive tape dispensers, envelopes, diaries, scrapbooks, address books; adhesives for stationery or household purposes; artists' materials, namely paint brushes, oil paint, pigments, oil pastels, pastels, palettes for painters, canvas for painting; typewriters; office requisites (except furniture), namely rulers, rubber-bands; instructional and teaching material (except apparatus), namely printed forms and printed guides for conducting classes, seminars, workshops in the field of design and fashion; plastic materials for packaging; printers' type; printing blocks; engravings; patterns for dressmaking; tissues of paper for removing make-up; stencil cases; labels, not of textile; table linen of paper; napkins of paper; handkerchiefs of paper; pen cases; holders for chequebooks; writing cases sets comprising pens, envelopes and writing paper; inking sheets for document reproducing machines; bags (envelopes, pouches) of paper or plastics, for packaging; tailors' chalk; face towels of paper; hat boxes of cardboard; tracing cloth and paper; towels of paper; picture, souvenir, and stamp albums; label printing machines; loose-leaf binders; writing instruments, namely ball-point pens, pencils for writing, pens, markers, blotting paper, blotting pads; transfers (decalcomanias); folders for papers; catalogues; drawing sets comprising oil paint, watercolor, pastels, pencils, and a palette for painter; newspapers; periodicals; magazines (periodicals); books; wrapping paper; toilet paper; paperweights; mats for beer glasses; bookmarkers; bookends; inks; inkwells; bibs of paper; drawing materials, namely drawing sheets, crayons, felt-tip pens, charcoals; graphic prints; school supplies (stationery), namely tapes, pencil sharpeners, rulers, erasers, pen boxes, homework notebooks, exercise books; writing slates; comic books; trays for sorting and counting money; embroidery designs (patterns); garbage bags of paper or of plastics; geographical maps; terrestrial globes; moisteners (office requisites); plastics for modeling; stencils (stationery); placards of paper or cardboard; steel letters and steel pens; watercolours (paintings); adhesive tapes and bands for stationery or household purposes; stickers (stationery); cigar bands; files (office requisites); modeling clay; arithmetical tables; drawer liners of paper, perfumed or

not; architects' models; atlases; flags of paper; tickets; calendar and memo pads; ball-point pens; bags for microwave cooking; writing board erasers; rubber erasers; bottles wrappers and envelopes of cardboard or paper; painters' easels; song books; charcoal pencils; writing paper; advertisement boards of paper or cardboard; booklets; ink sticks; modeling wax, not for dental purposes; sealing wax; thumbtacks; paper ribbons and bows; inking ribbons for computer printers; typewriter inking ribbons; clipboards; cabinets for stationery (office requisites); compasses for drawing; paper clasps; paper cutters; writing or drawing books; paintings (pictures) framed or unframed; finger-stalls (office requisites); bookbinding laminating machines (office equipment); gummed cloth for stationery purposes; inking pads; square rulers; paper seals; filter paper; book covers; photograph stands; elastic bands for offices; stapling presses (office requisites); paper-clips; paper sheets (stationery); pencil sharpeners; pencil holders; luminous paper; silver paper; waxed paper; modeling paste; office perforators; house painters' rollers; postcards; rosaries; blotters.

- 24 Textiles and textile goods, namely bed and table covers, bath linen, tissues of textile for removing make-up, labels (cloth), lining fabric for clothes, wall hangings of textile, handkerchiefs of textile, curtains of textile or plastic, kitchen linen, towels of textile, travelling rugs (lap robes), net curtains, curtain holders of textile material, banners and flags (not of paper), eiderdowns (down coverlets), loose covers for furniture, covers for cushions, mattress covers, pillowcases, mosquito nets, glass cloths, billiard cloth, table cloths (not of paper), traced cloths for embroidery, face towels of textile, sleeping bags (sheeting), cotton fabrics, haircloth (sackcloth), brocades, lining fabric for shoes, fabric for footwear, coverlets (bedspreads), bed blankets, trellis (hemp cloth), zephyr (cloth), cheviots (cloth), mattress slips [other than incontinence], shower curtains of textile or plastic, crepe fabric, crepon, bedspreads, damask, elastic woven material, oilcloth (for use as table cloths), gummed cloth for gum boots, gummy rain jacket, gummy umbrella, gummy shirts, gummy pants, esparto fabric, chenille fabric, felt, flannel (fabric), fitted toilet lid covers (fabric), gauze fabric, fabric for making team jersey, woolen cloth, woolen fabric, lingerie fabric, linen fabrics, place mats of textile, printers' blankets of textile, marabouts (cloth), upholstery fabrics, furnishing fabrics namely velvet, suede, cotton; imitation animal skin fabrics, knitted fabric for the manufacturing of clothing, household furnishings, home and commercial interiors and wall hangings; cheese cloth, ramie fabric, rayon fabric, silk (cloth), taffeta (cloth), fibreglass fabrics for textile use, adhesive fabric for application by heat namely for footwear; clothing, hats, bags, sleeping bags, gloves, raincoats, carpets, curtains, sofas, tents and slip covers for cars; traced cloths for embroidery, velvet, tulle.
- 26 Fabric laces and embroidery, ribbons and textile braids; buttons for clothing, hooks and eyes, pins and needles; artificial flowers; pin cushions; shoe and hat ornaments (not of precious metal); haberdashery, except thread; hair bands; brassards; reins for guiding children; brooches (clothing accessories); sewing boxes; belt clasps; shoe laces; wreaths of artificial flowers; ornamental novelty badges (buttons); sewing thimbles; needle cases; belt, bag, clothing and shoe buckles; shoulder pads for clothing; hair pins; badges for wear not of precious metal; orsedew (trimmings for clothing); bodkins; barrettes (hair slides); passementerie; feathers used as decorative ornaments for clothing, hats and footwear; topknots (pompoms); zip fasteners; competitors' numbers to be sewn or stuck for marking linen; heat adhesive patches for decoration of textile articles (haberdashery); rug hooks; snap fasteners; ostrich feathers; whalebones for corsets; prize ribbons; decorative cords for rimming, textile

cords for clothing fastening and decorating; tassels (haberdashery); expanding bands for holding sleeves; hair ornaments; false hair; hair nets; shoe eyelets; chenille (passementerie); frills (lacework); trouser clips for cyclists; fastenings for clothing, namely zippers; hook and pile fastening tapes; elastic ribbons; tapes for curtain headings; cords for clothing; collar supports; false hems; festoons (embroidery); fringes; artificial fruits; hair colouring caps; artificial garlands; darning lasts; trimmings for clothing, namely tinsels; plaited hair; wigs; silver embroidery; edgings for clothing; rosettes (haberdashery); suspender ends [fasteners]; skirt flounces; tresses of hair; toupees; shoe hooks.

- 28 Games and playthings, namely skittles, role playing games, pinball games, table tennis games, video games, paddle ball games, parlour games, action target games, arcade games, card games, party games, table top games, word games; gymnastic and sporting articles, namely gymnastic mats and parallel bars, gymnastic training stools, rhythmic gymnastic hoops, gymnastic shoes; decorations for Christmas trees; fishing tackle; rods for fishing; theatrical and toy masks; dolls' houses; climbers' harness; novelties for parties, namely garlands, confetti, serpentine, flags, balloons, novelty hats, practical jokes; dances party favours in the nature of noisemakers and small toys; gloves for baseball, boxing, fencing, and golf; puppets; body-building and body-training apparatus, namely, weight lifting benches and bench accessories, chest expanders, exercise treadmills, exercise tables, exercise bars, exercise benches, stationary exercise bicycles, exercise doorway gym bars, manually operated exercise equipment, namely bicycles, weights, exercise pulleys, exercise equipment for lateral movement in a skating motion, exercise equipment, namely, stair-stepping machines, exercise machines, powered treadmills for running, rowing machines, weight lifting machines, exercising pulleys and manually operated jogging machines, exercise platforms, exercise trampolines, exercise weight cuffs, exercise weights, manual leg exercisers, weight lifting belts, weight lifting gloves, exercise weights, leg weights, ankle and wrist weights for exercise; Christmas trees of synthetic material; bladders of balls for football, rugby, soccer; elbow and knee guards (sports articles); kites; rattles; kaleidoscopes; rocking horses; toy building blocks; amusement machines, automatic and coin-operated; playing cards; teddy bears; dolls; dolls' clothes; air pistols [toys]; chess games; flippers for swimming; ring games; Christmas tree stands; archery implements, namely archery bow sights, finger tabs, quivers, sights, stabilizers, target stands and targets; balls for games; dolls' feeding bottles; building blocks [toys]; body boards; stationary exercise bicycles; golf bags, with or without wheels; dolls' beds; marbles for games; butterfly nets; swings; confetti; cups for dice; checkers [games]; checkerboards; darts; discuses for sports; flying discs [toys]; dominoes; counters for games; skis; bags especially designed for skis and surfboards; tables for indoor table football (baby foot); horseshoe games; hockey sticks; soap bubbles [toys]; board games; toys for domestic pets; scale model vehicles; skateboards; mobiles [toys]; paintballs [ammunition for paintball guns] [sports apparatus]; artificial snow for Christmas trees; golf clubs; billiard tables; skating boots with skates attached; in-line roller skates; ice skates; roller skates; scooters [toys]; plush toys; spinning tops [toys]; piñatas; swimming pools [play articles]; punching bags; jigsaw puzzles; conjuring apparatus namely, magicians' sets; ping-pong, tennis, and badminton rackets; surf boards; chessboards; sling shots [sports articles]; slides [playthings]; spring boards [sports articles]; sleighs [sports articles]; toy vehicles; radio-controlled toy vehicles; shuttlecocks.



# Appearances and Agents of Record

**HEARING DATE:** 2022-11-10

## **APPEARANCES**

**For the Opponent:** Tamara Winegust

**For the Applicant:** Barry Gamache

## **AGENTS OF RECORD**

**For the Opponent:** Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

**For the Applicant:** ROBIC