



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 094

Date of Decision: 2023-05-31

IN THE MATTER OF AN OPPOSITION

Opponent: Elevenate AB

Applicant: Elleaime SAS

Application: 1,903,059 for E11EME

INTRODUCTION

[1] Elleaime SAS (the Applicant) has applied to register the trademark E11EME (the Mark) for use in association with various cosmetic, apparel, and fashion accessory goods and related retail and wholesale store services.

[2] Elevenate AB (the Opponent) opposes application no. 1,903,059 for the Mark (the Application), based primarily on an allegation that the Mark is confusing with the Opponent's trademark E11 and its two design marks reproduced below, used in association with clothing and headgear and their online retail sale:



(E11 Design Mark)



state of elevenate

(Elevenate Logo)

[3] The first design mark (the E11 Design Mark) consists of the trademark E11 in stylized lettering (the E11 Design); the second design mark (the Elevenate Logo) consists of the E11 Design above the words “state of elevenate” in small, simple lettering.

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] The Application was filed on June 7, 2018, based on proposed use in Canada in association with the following goods and services (categorized by Nice Class):

<u>Class</u>	<u>Goods</u>
3	Perfumery; cosmetics; cosmetic creams; make-up; Eau de Cologne; leather preserving polishes; shoe wax.
9	Spectacles; spectacle cases; sunglasses.
14	Jewellery; precious stones; timepieces and chronometric instruments namely, chronometers, watches, clocks; jewellery cases; watches; key rings.
18	Leather and imitations of leather; suitcases; wallets; purses (coin purses); handbags; backpacks; travel bags; key cases (leather goods).
25	Clothing namely, leather jackets, belts, gloves, scarves, underwears, tee-shirts, pullovers, sweatshirts, short-sleeve shirts, shirts, suits, trench coat, jackets, trousers, coats, pyjamas, skirts, pants, dresses, overcoats; footwear namely, slippers, half-boots, boots, beach shoes, sandals; headgear namely, berets; shoes; scarves; hats.

<u>Class</u>	<u>Services</u>
35	Retail and wholesale store services, and online retail and wholesale store services featuring cosmetics, sunglasses, jewelry, handbags, clothing, footwear and headwear.

[6] The Application was advertised for opposition on June 23, 2021, and opposed on December 21, 2021, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). An amended statement of opposition was filed on July 8, 2022, to add reliance on the Elevenate Logo. The Applicant filed a counter statement that it intends to respond to the opposition.

[7] The grounds of opposition allege that the Applicant is not entitled to registration under section 16(1)(a) of the Act and that the Mark is not distinctive within the meaning of section 2 of the Act. In accordance with section 69.1 of the Act, since the Application was advertised after the Act was amended on June 17, 2019, the grounds of opposition will be assessed based on the Act as amended.

[8] In support of its opposition, the Opponent filed the July 6, 2022 affidavit of its co-founder and Chief of brand operations, Jimmy Odén, who describes the Opponent's business and its use and promotion of the Opponent's trademarks. The Applicant did not cross-examine Mr. Odén and did not file any evidence of its own in support of the Application. Only the Opponent filed written representations; no oral hearing was held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[9] 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)].

ENTITLEMENT UNDER SECTION 16(1)(A) OF THE ACT

[10] The Opponent pleads that the Applicant is not entitled to registration having regard to section 16(1)(a) of the Act because, at the filing date of the Application or any earlier date of first use of the Mark in Canada, the Mark was confusing with the Opponent's trademarks E11, E11 Design Mark, and Elevenate Logo (collectively the Opponent's Trademarks), which had been used or made known in Canada since at least as early as September 30, 2015 in association with the goods "clothing, headgear" in Class 25 and the services "online retail sales of clothing and headgear" in Class 35.

[11] There being no evidence of use of the Mark prior to filing, the material date to assess entitlement in this case is the filing date of the Application, namely June 7, 2018.

The Opponent's initial burden

[12] To meet its initial burden under this ground, the Opponent must evidence that its trademark was used or made known prior to the material date [section 16(1) of the Act] and also that it had not been abandoned when the Application was advertised [section 16(3) of the Act]. However, I note at the outset that the Opponent has not met its initial burden in respect of making known, since it has not met the requirements set out in section 5 of the Act. In particular, although Mr. Odén mentions sales in Sweden and elsewhere, he does not provide any specific evidence of trademark use in another country prior to the material date.

The E11 Design Mark and the Elevenate Logo

[13] The E11 Design Mark consists of the characters E11 in a stylized lettering made up of individual strokes shaped somewhat like skis: the E consists of a stacked arrangement of two horizontal “skis” pointing inwards with a horizontal bar between them and the 11 consists of two vertical “skis” pointing left. The Elevenate Logo consists of the E11 Design above the phrase “state of elevenate” in considerably smaller, simple, rounded lettering.

[14] I am satisfied that the Opponent has shown use of both the E11 Design Mark and the Elevenate Logo prior to the material date, as described below in my analysis of the likelihood of confusion. Furthermore, I am satisfied from Mr. Odén’s evidence of advertising featuring these trademarks, and of invoices for the advertised goods, that neither the E11 Design Mark nor the Elevenate Logo had been abandoned when the Application was advertised on June 23, 2021. Accordingly, I am satisfied that the Opponent has met its initial burden in respect of these two trademarks.

The E11 word mark

[15] The Opponent has not drawn my attention to any portion of the evidence showing use or display of E11 as a word mark. Rather, it appears from the evidence

that the brand is only presented as the E11 Design. I appreciate that a word mark may generally be used in any stylized form. However, in the present case, the stylization is such that I am not satisfied this design, on its own, would necessarily be perceived as the letter E followed by the number 11. The second half of the design can also be interpreted as two lower case Ls, as a tall lower case N (disjointed like the E that precedes it), as simply two hooked strokes, or—especially in the context of the Opponent’s goods and services—as a pair of skis. Although I have followed the statement of opposition in characterizing the design as a stylized “E11”, the Opponent has not drawn my attention to any instances in the evidence where the design is actually named or written out as such.

[16] Applying the principles from *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), and in the absence of any evidence regarding consumer perceptions, a question arises as to whether replacing the number “11” with more ambiguous characters preserves the dominant features of the pleaded E11 word mark. Mr. Odén asserts that both the E11 Design Mark and the Elevenate Logo “put the emphasis on a stylised depiction of the ‘E11’ trademark as the dominant feature” [para 8]; however, he has not been qualified as an expert in trademarks or consumer perceptions and is not independent of the parties. Thus, his opinions on this question of fact have been disregarded.

[17] In any event, the Opponent meeting its initial burden in respect of the E11 word mark would not change the outcome of this proceeding, and therefore I do not consider it necessary to decide the issue. Since the non-entitlement ground is based on the Opponent’s actual use of its trademark, the manner and context of such use is important. Consequently, even if I were to characterize the E11 Design Mark as also constituting the word mark “E11”, its consistent stylization would still be factored into the analysis, as an additional surrounding circumstance. In my view, the special graphic form in which “E11” is always presented in the evidence is a key distinctive feature that would affect how the trademark has become known to consumers. It would also mitigate the degree of resemblance that results when considering only the textual element of the

evidenced trademark. In the end, I would reach the same conclusion for the non-entitlement ground based on the E11 word mark as I do for the ground based on the E11 Design Mark.

Variations of the Elevenate Logo

[18] The Opponent's evidence includes (i) a variation of the Elevenate Logo wherein "state of" and "elevenate" are written as stacked lines to the right of the E11 Design (the Horizontal Logo) and (ii) a composite trademark wherein "elevenate" is written to the right of and with approximately the same height as the E11 Design (the Condensed Logo), as reproduced below (the apparent curvature in the images is from the surfaces on which each trademark is printed and is not a feature of the trademarks themselves):



(Horizontal Logo)



(Condensed Logo)

[19] For the purposes of assessing the extent to which the Elevenate Logo has been used and become known, I find that the Horizontal Logo constitutes an acceptable deviation. The dominant features of the Elevenate Logo have been preserved, despite their slight rearrangement, such that the pleaded trademark has not lost its identity and remains recognizable [per the principles in *CII Honeywell Bull, supra*, and *Promafil, supra*]. Accordingly, I find that the Elevenate Logo can acquire distinctiveness through use and promotion of the Horizontal Logo variation.

[20] However, I find that the dominant features of the Elevenate Logo have not been preserved in the Condensed Logo, where the phrase "state of" is missing. With this omission, the trademark no longer suggests a particular quality, mode, or condition of being, and no longer creates the impression that the coined word "elevenate" might refer to a particular state of mind or state of being.

[21] I would also note that I do not consider display of the Condensed Logo to constitute display of the pleaded E11 Design Mark *per se*. In applying the principles set out in *CII Honeywell Bull, supra*, and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), I find that the E11 Design, despite being in a different style of

lettering, does not stand out sufficiently from the Condensed Logo as a whole to have its own distinct identity or to be recognized as a separate trademark. In my view, the immediate impression is still that of a single string of characters rather than a composite trademark.

[22] Since the Condensed Logo has not been pleaded as a separate trademark, likelihood of confusion between the Mark and the Condensed Logo cannot be considered as a ground of opposition [per *Imperial Developments Ltd v Imperial Oil* (1984), 79 CPR (2d) 12 (FCTD)]. However, use and promotion of the Condensed Logo may still be considered as a surrounding circumstance in assessing the likelihood of confusion between the Mark and the Elevenate Logo or between the Mark and the E11 Design Mark [see *H-D Michigan Inc v MPH Group Inc*, 2006 FC 538].

Likelihood of confusion with the Elevenate Logo

[23] Having found that the Opponent has met its initial burden in respect of both the Elevenate Logo and the E11 Design Mark, I will begin by considering the likelihood of confusion with the Elevenate Logo.

[24] I will discuss the likelihood of confusion with the E11 Design Mark in the following section. As noted above, to the extent that the Opponent may also have met its initial burden in respect of the E11 word mark, my conclusion with respect to the likelihood of confusion with that trademark would be the same as for the E11 Design Mark.

The test for confusion

[25] Two trademarks will be considered confusing 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 in the same class of the Nice Classification system for trademark registration [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 or services 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)].

[26] 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, including in appearance or sound or in the ideas suggested by them

[27] 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]. The question must be considered from the perspectives of the average anglophone consumer, the average francophone consumer, and the average bilingual consumer, since a trademark cannot be registered if there is a likelihood of confusion from any one of these perspectives [see *Pierre Fabre Medicament v SmithKline Beecham Corporation*, 2001 FCA 13]. Each trademark must be considered as a whole and assessed for its effect on the average consumer as a matter of first impression [*Masterpiece, supra*].

[28] It is not the proper approach to set the trademarks side by side and carefully examine them to tease out similarities and differences [*Veuve Clicquot, supra*]. However, it is still possible to focus on particular features of each trademark that may have a determinative influence on the public's perception of it [per *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)]. In this respect, the first portion of a trademark is generally considered to be important for the

purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, 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].

[29] I find that both the large E11 Design element and the phrase “state of elevenate” are striking and unique features of the Elevenate Logo. Simple combinations of letters and numbers are generally considered to be weak elements in themselves [see *GSW Ltd v Great West Steel Industries Ltd et al* (1975), 22 CPR (2d) 154 (FCTD); and *Noxzema Chemical Co of Canada Ltd v Estee Lauder Cosmetics Ltd* (1975), 23 CPR (2d) 214 (TMOB)]. However, within the Elevenate Logo, the E11 Design element attracts attention by virtue of its size and design concept.

[30] I find the Mark to be striking and unique in its entirety. In this case, I find that the combination “E11EME” is more than a simple string of letters and numbers and instead creates the impression of a coined word wherein certain letters are rendered as numerals for added interest.

[31] There is necessarily a point of resemblance between these two trademarks to the extent that they may both be perceived as beginning with “E11”. In this respect, I find that at least English-speaking consumers viewing the Opponent’s trademark as a whole would be guided by the word “elevenate” to perceive the number 11 in the visually ambiguous “E11” design element. However, when both parties’ trademarks are considered as a whole, I find there to be important visual differences. Most significantly, in the Elevenate Logo, the E11 Design stands out as a separate and dominant element, followed by a small phrase. By contrast, the Mark consists of a single, undivided alphanumeric sequence that merely begins with the characters “E”, “1” and “1”. The remainder of the sequence—“E”, “M”, “E”—does not resemble or appear to be derived from the phrase “state of elevenate”. Furthermore, to the extent that “E11EME” approximates “EMEME”, there is also a certain level of repetitive visual pattern and near symmetry to the Mark, which are effects absent from the Elevenate Logo.

[32] Regarding resemblance in sound, I likewise find that at least English-speaking consumers would be guided by the word “elevenate” to sound the E11 Design portion of the Opponent’s trademark as the English letter E followed by the number “eleven”. However, the trademark as a whole might also be pronounced *without* sounding the upper design element, if it is perceived as only an added decorative motif—for example, based on a stylized initial followed by a pair of skis. There is no evidence as to whether unilingual francophone consumers would tend to sound the E11 Design portion of the trademark as “*E onze*” (E eleven) or be guided towards other pronunciations, for example, as the beginning of the word “Elevenate” or as the French word “*En*” (in).

[33] As for the Mark, I do not find that it brings to mind any particular English word or phrase that might influence its pronunciation as a matter of immediate impression. French-speaking consumers could read the Mark as the French letter *E* followed by the ordinal “*onzième*” (eleventh), given that such a combination could be abbreviated as “*E 11^{ème}*” (even if the spelling “*E 11^e*” might be grammatically preferred). However, a French-speaking consumer tending to perceive numbers in the middle of a word as letters might instead sound the Mark as “*elle aime*” (she likes) or “*elle me...*” (to me she...). I note that the former pronunciation would be consistent with the Applicant’s name, Elleaime SAS; however, there is no evidence that this name would be known to consumers.

[34] In any event, regardless of the specific pronunciation or linguistic perspective, I find that the Mark as a whole, when sounded, would tend to be short, and would not include the important “state of elevenate” element from the Opponent’s trademark. Thus I find there to be little resemblance between the trademarks as a whole phonetically.

[35] As for ideas suggested, there is again a point of resemblance to the extent that both trademarks may convey the idea of the letter E followed by the number 11. However, the overall idea suggested by each trademark in its entirety is different.

[36] In this respect, I find that the Opponent’s trademark suggests a state of mind or a state of being that is somehow reflected in the coined word “elevenate”, which not only evokes the number eleven but is also vaguely reminiscent of words such as “elevate”,

“levitate”, or “*élevant*” (elevating). The concept of elevation has a laudatory connotation to the extent that it suggests higher quality or a superior state, and it is particularly apt in the context of the Opponent’s goods, which are predominantly skiwear and other apparel marketed for sports, leisure, and recreation in the mountains. Additionally, in the context of the Opponent’s skiwear and mountain resort wear, the shape of the strokes composing the E11 Design element suggests the idea of pairs of skis.

[37] By contrast, the Mark contains no additional element reinforcing the notion of the number eleven; nor does it suggest the idea of an elevated state or of skis. Instead, the Mark may suggest the idea of liking or being liked and of pronouns such as “*elle*” (she) and “me”. In the context of the Applicant’s goods, which include cosmetics, apparel, and fashion accessories, the pronoun “*elle*” would be particularly apt for women’s or girls’ fashion lines. Additionally, the phrase “*elle aime*” would tend to suggest, at least to French-speaking consumers, that the goods are ones a female purchaser will like. These ideas are absent from the Opponent’s trademark.

[38] Overall, when each trademark is considered as a whole, I find that the degree of resemblance between them is fairly low, regardless of whether the question is considered from the perspective of an anglophone, francophone, or bilingual consumer. Thus, this important factor favours the Applicant.

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

[39] I find the Opponent’s trademark to be inherently distinctive. The Elevenate Logo features the coined phrase “state of elevenate” and a design seemingly inspired by the coined word “elevenate”. Moreover, I find the design concept of forming letters and numerals with ski-shaped strokes to be an inherently distinctive one. Regarding the Mark, it consists of a coined word wherein two of the letters have been replaced with numerals. I find the substitution of numerals adds an element of interest; however, overall, I consider the combination of features in the Elevenate Logo to render it more inherently distinctive.

[40] I would also note that Mr. Odén's affidavit references an Examiner's Report issued in respect of the Opponent's application no. 1,989,609 to register the E11 Design Mark, wherein the Examiner cites not only the Application but also two third-parties' applications to register trademarks featuring the sequence "E11" for use in association with goods that include clothing and accessories [Exhibit JO-8]. However, the Examiner's Report on its own does not enable me to draw any meaningful inferences regarding the state of the marketplace or the distinctiveness of the trademarks at issue and is thus not a relevant consideration in this regard. The relevance of the Examiner's Report as an additional surrounding circumstance will be discussed below.

[41] A trademark's distinctiveness can be enhanced through use and promotion. Only the Opponent furnished evidence in this respect.

[42] In his affidavit, Mr. Odén explains that the Opponent is a Swedish company founded in 2010, specializing in the design, development, manufacture, and sale of casual clothing, outdoor clothing, sports clothing, sports articles, and related accessories (the Elevenate Goods) [paras 1, 5]. The clothing lines include jackets, vests, tops (such as shirts, tee-shirts, short-sleeve shirts, sweatshirts, and pullovers), pants, and shorts; the accessories are in the nature of belts and headwear [para 6]. Mr. Odén provides no further explanation regarding "sports articles"; however, the only item in evidence that appears to be uniquely specialized for a specific sport is a thin buckled strap identified in the Opponent's catalogs as an "Elevenate Ski Strap".

[43] I note that the Opponent has not pleaded use of its trademarks in association with "sports articles" or "accessories" *per se*; however, since the neckwear, belts, and ski straps in evidence appear to be in the nature of apparel, or at least articles to be worn, I am prepared to consider them as fitting within the general definition of "clothing" for the purposes of this proceeding. I note that this characterization does not affect my overall conclusion, since I would otherwise have considered use and promotion of the Elevenate Logo in association with items such as ski straps and canvass belts to be an additional surrounding circumstance that favours the Opponent. In my view, the Elevenate Logo as pleaded would benefit from any reputation acquired in respect of

such closely related goods [for similar conclusions, see *e.g. Mondo Foods Co Ltd v Saverio Coppola*, 2011 TMOB 228; and *Canadian Broadcasting Corporation/Société Radio-Canada v Big Mountain Coffee House and Roasters Ltd*, 2014 TMOB 240].

[44] Mr. Odén states that, since the launch of the company, the Opponent has consistently sold the Elevenate Goods in association with the Opponent's Trademarks, starting in Sweden and then extending sales to Europe, Asia, and North America [paras 7, 9]. Since at least as early as in 2015, the Opponent has continuously advertised and sold the goods in Canada through third-party distributors and resellers, both in physical stores and online [para 10]. Prior to September 2019, the Opponent's sales were made both through distributors—which then sell the goods to resellers operating clothing stores for resale to consumers—and directly to the clothing stores themselves [para 16].

[45] Mr. Odén confirms that the Opponent systematically affixes the trademarks directly to the goods themselves and also consistently displays these trademarks on the goods' tags, as can be seen on the Opponent's website at *elevenate.com* and in its catalogs circulated to distributors in Canada between 2016 and 2021 [paras 11–13, 20]. He attaches the following supporting documents as exhibits to his affidavit: a fall/winter catalog for each of 2016 and 2019 and a spring/summer catalog for each of 2020 and 2021 [Exhibit JO-1]; printouts made in 2022 from the Opponent's website [Exhibits JO-1, JO-3]; printouts of archived versions of the Opponent's webpages as captured by the Internet Archive Wayback Machine at *www.archive.org* in 2015, 2016, 2017, and 2020 [Exhibit JO-3]; and representative photographs of the branded "tags", which I note are hangtags [Exhibit JO-2]. Only the first catalog and the first three archived webpages are from before the material date. However, to the extent that certain apparel photographs on the 2022 webpages appear to have the same branding as the drawings in the 2016 catalog, I am prepared to accept those particular 2022 images as confirming how the drawings are realized. Furthermore, in view of Mr. Odén's attestation to consistent branding on goods' tags, I am also prepared to accept the undated photographs of hangtags as being representative of the appearance of hangtags since before the material date.

[46] I note that the first three catalogs only provide drawings of the available products, whereas the fourth catalog provides some drawings and some photographs. The evidence in this case was filed electronically and, at high magnifications, the drawings in the 2016 catalog show the Elevenate Logo on the front of almost every garment and accessory and, occasionally, also on the back or sleeve. The depicted apparel includes jackets, pants, vests, knit sweaters, hoodies, tee-shirts, flannel shirts, tuques, and a neck gaiter tube. It is not possible to determine whether the trademark on the canvas belt is the Elevenate Logo or the E11 Design Mark, since the bottom of the trademark is obscured in the drawing; however, a photograph of what appears to be the same product in the 2021 catalog shows a partial Elevenate Logo stitched into the belt.

[47] Certain garments are depicted with a neck label bearing the Elevenate Logo; however, the evidence does not include any corroborating photographs of garments' actual neck labels. That said, the photographs at Exhibit JO-2 show the Elevenate Logo displayed on the hangtags of certain jackets, pants, and shorts, including a style of jacket reflected in the 2016 catalog. Given Mr. Odén's attestation to consistent branding on goods' tags, I am prepared to accept that the Elevenate Logo would have been displayed in this fashion on the Opponent's hangtags in general.

[48] With respect to advertising and promotion, the Elevenate Logo is displayed at the top of the Opponent's webpages as well as on the cover and back page of its catalogs. Mr. Odén does not provide circulation figures for the catalogs. However, he states that, since 2015, thousands of Canadians have accessed the Opponent's website, and he provides annual access figures from Google Analytics for the years 2015 to 2022, indicating how many users accessed the site from Canada, how many were new users, and how many sessions they opened on the site [para 22, Exhibit JO-6]. I note that there appears to be a discrepancy in the years 2015 and 2016, where zero users is indicated despite there being over 200 new users and over 300 sessions in each of those years. In subsequent years, most of the users are indicated as new users. There were several hundred users in each of 2017 and 2018; however, this includes users from after the material date of June 7, 2018. I would also note that there is no explanation of whether the "users" identified by the analytics would be only individuals

or might also include automated bots. In view of these deficiencies, I can only accord this evidence minimal weight.

[49] The Elevenate Logo is also displayed at the top of the invoices sent to distributors and resellers in Canada. However, Mr. Odén provides only one representative example of such invoices from before the material date, namely a 2015 invoice covering jackets, pants, vests, hoodies, crewnecks, beanies (tuques), and belts, totalling over €18,000 [paras 14–15, Exhibit JO-3].

[50] Mr. Odén confirms that, since 2015, Canadian resellers' physical stores and websites have continuously made the Elevenate Goods available for purchase by consumers in Canada in the same way, and he provides representative printouts from the websites of Sporting Life at *sportinglife.ca* (undated) and of SkiTown at *skitown.ca* (printed in 2022) offering the Opponent's Elevenate Goods for sale, including jackets, pants, hats, and belts [para 18, JO-4]. The printouts display branded clothing and the SkiTown printout also displays the Elevenate Logo at the top of the webpage. However, no information is provided on the extent to which Canadians may have accessed these or other reseller webpages or attended at resellers' physical clothing stores.

[51] Mr. Odén also claims to know that the resellers have continuously sold such goods to Canadian consumers since 2015, from the fact that the Opponent has received repeated purchase orders from the Canadian distributors and resellers [para 19]. However, he does not mention whether the resellers receiving the goods necessarily resell them only in Canada or also abroad—whether online or through physical locations abroad. Without confirmation in this respect, and in the absence of any sales figures, any conclusions as to the number of goods ultimately sold in Canada would be speculative.

[52] In the end, it would appear that several thousand Canadians may have accessed the Opponent's website by the material date; however, the extent to which Canadians then purchased the goods through resellers, or the extent to which additional Canadians may have come to know the Elevenate Logo, either through the two named resellers or through any other resellers, or even through the Opponent's catalog, remains unclear.

In the circumstances, I am only able to conclude that the Elevenate Logo had become known in Canada to a slight extent at the material date.

[53] In view of the foregoing, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness, slightly favours the Opponent, owing to the Elevenate Logo's inherent distinctiveness and to it having become known in Canada to at least a slight extent by the material date.

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

[54] I would first note that I am not satisfied the Opponent has shown use of the Elevenate Logo in association with the pleaded "online retail sales of clothing and headgear". According to Mr. Odén, the Opponent does not sell at the retail level in Canada but rather sells to Canadian distributors and resellers. Furthermore, Mr. Odén does not indicate that any of the distributors or resellers are licensed to use the Elevenate Logo to brand their retail services. Although the Elevenate Logo is displayed on the SkiTown website, it is displayed as one of the brands of clothing sold and not as a brand used by the retailer to distinguish its retail store services. In any event, the printout from the SkiTown website postdates the material date.

[55] As for use of the Elevenate Logo in association with the goods "clothing, headgear", Mr. Odén does not specify whether the exhibited invoice from 2015 accompanied the goods at the time of transfer to the purchaser, and I note that this invoice is addressed to a different destination than the one for product delivery. Accordingly, I am unable to conclude that the invoice itself provided a notice of association between the Elevenate Logo and the invoiced goods at the time of transfer of the goods, as required by section 4 of the Act. However, I am satisfied that such a notice of association was provided by the actual garments.

[56] In this respect, although Mr. Odén does not provide images of branded clothing or hangtags earlier than the 2016 catalog, he attests that the Opponent's branding has been consistent from the outset, and the appearance of the Elevenate Logo on the 2015 invoice, as well as on the subsequent catalogs and webpages, appears to corroborate

this statement. In the absence of any contradictory evidence or cross-examination on this point, I am prepared to accept that the branding of the garments listed in the September 2015 invoice would be essentially the same as in the fall/winter 2016 catalog. Comparing the style names in this invoice with the images of product branding in the Opponent's 2016 catalog, I am satisfied that the Opponent has established use of the Elevenate Logo in association with certain jackets, vests, hoodies, crewneck knit sweaters, and tuques as of September 30, 2015. Conversely, the Application is based on proposed use. Accordingly, this factor favours the Opponent.

Sections 6(5)(c) & (d): Nature of the goods, services, businesses and trade

[57] Both parties' trademarks are for use in association with clothing and headwear, and there is nothing in the Application to suggest that the Mark would not be used in association with sportswear, athletic wear, or resort wear, including apparel suitable for skiing and other mountain activities. Nor is there any indication that the retail and wholesale store services provided under the Mark, including the online services, would not be in connection with such merchandise.

[58] The Application also includes goods in the nature of perfumery, cosmetics, spectacles and sunglasses, jewellery, bags and cases, footwear, and leather care products, as well as retail and wholesale store services therefor. I find such merchandise to be related to the Opponent's goods to the extent that it is in the nature of or connected with apparel and accessories, or at least wearable fashion products.

[59] Furthermore, in the absence of evidence from the Applicant contrasting the trade channels for its goods with those of the Opponent, I am not prepared to exclude a potential for overlap or similarity in the channels of trade, particularly as concerns clothing and headwear.

[60] Accordingly, these factors favour the Opponent, particularly in the case of the Applicant's clothing and headwear goods and its retail and wholesale store services for such goods.

Additional surrounding circumstance: Use of other E11 trademarks

[61] I note that each jacket and pant bearing the Elevenate Logo also has at least one other related marking, for example, the E11 Design Mark on the front, back, sleeve, side, hood, zipper pulls, decorative studs, or button/snap fasteners, or the Condensed Logo on the back, sleeve, side, or waistband. Moreover, garments lacking the Elevenate Logo display the E11 Design Mark or Condensed Logo instead; for example, certain tuques display the E11 Design Mark while other tuques, the “Backside” style of jacket, and the “Arpette” style of pant display the Condensed Logo.

[62] In my view, such additional marking may increase consumers’ tendency to perceive the E11 Design element as also being a trademark in its own right. Consumers exposed to the Condensed Logo would also be exposed to the idea of the E11 Design being followed immediately by something other than the phrase “state of elevenate”. However, I do not consider the likelihood of confusion with the Mark to increase significantly as a result. In this respect, I note that the common feature of the Opponent’s trademarks is not merely the sequence “E11” but rather a particular design and, as discussed above, I am not satisfied that consumers would necessarily associate the alphanumeric sequence “E11” with the Opponent in the absence of the specific stylization of the E11 Design element. I would also note that, in the Condensed Logo, the E11 Design is followed immediately by the word “elevenate”, which is a key feature of the Elevenate Logo. In the Mark, the sequence “E11” is followed by the suffix “EME”, which is unrelated to the Elevenate Logo.

[63] At best for the Opponent, I would be prepared to accept its concurrent use of the E11 Design Mark and Condensed Logo as increasing the reputation of the individual features of the Elevenate Logo. However, although the E11 Design Mark and Elevenate Logo appear to be marked on the majority of the goods in the 2016 catalog, the Condensed Logo appears on a smaller fraction, and it is not shown to be marked on any of the styles listed in the 2015 invoice. In the absence of revenue or advertising figures broken down by trademark, it is not possible to ascertain to what extent each trademark was used or promoted prior to the material date, and thus to what extent the

reputation of the Elevenate Logo might be reinforced by each of the other two trademarks.

[64] For these reasons, I find that the evidence of use of the E11 Design Mark and Condensed Logo in addition to the Elevenate Logo ultimately has little bearing on the assessment of the likelihood of confusion between the Elevenate Logo and the Mark.

Additional surrounding circumstance: Examination history

[65] Mr. Odén notes that, on September 5, 2019, the Opponent filed application no. 1,989,609 under the Madrid Protocol to register the E11 Design Mark in Canada for use in association with the goods “clothing, footwear, headgear” (in Nice Class 25) and “gymnastic and sporting articles not included in other classes” (in Nice Class 28) [para 23, Exhibit JO-7]. On February 8, 2021, this application received the above-referenced Examiner’s Report, objecting that there is a likelihood of confusion between the E11 Design Mark and the Mark, particularly in respect of the goods clothing, footwear, and headgear [para 25, Exhibit JO-8]. In the Opponent’s submission, as it has already been determined that the Mark would be likely to cause confusion with the Opponent’s Trademarks, and the Applicant filed no evidence in the present opposition to address the Examiner’s assessment, registration of the Mark must be refused.

[66] However, the exhibited Examiner’s Report is not a final refusal of the application; the Examiner merely provides the preliminary view that the Opponent does not *appear* to be entitled to registration in view of the cited trademarks, and the Opponent is invited to make submissions in response, which may overcome the preliminary objection.

[67] More importantly, however, the Registrar in an opposition proceeding will not be bound by an examiner’s decision on a related file, since the examiner will not have had before him or her the evidence and arguments submitted by the parties in the opposition case. I must come to a decision taking into consideration all of the evidence of record and the arguments raised by both parties in the present opposition proceeding. Even in the absence of evidence or argument from the Applicant, it may still be found, upon review of the Opponent’s evidence and arguments, that on a balance of probabilities confusion is unlikely.

[68] Accordingly, I do not consider the examination history of the Opponent's own application to be a relevant surrounding circumstance.

Conclusion

[69] For the Applicant to meet its legal burden, the Registrar must be reasonably satisfied that, on a balance of probabilities, the registration sought is unlikely to create confusion; the Registrar need not be satisfied beyond doubt that confusion is unlikely [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29].

[70] Following my analysis of all the surrounding circumstances, I find that the differences between the parties' trademarks are sufficient to avoid a likelihood of confusion as to the source of their respective goods and services, as a matter of first impression and imperfect recollection, despite the prior use of the Elevenate Logo in Canada and despite the overlap in the parties' goods and services and likely channels of trade.

Likelihood of confusion with the E11 Design Mark

[71] The Opponent's E11 Design Mark does not include the phrase "state of elevenate" as a distinguishing feature. However, I find the absence of that phrase insufficient to tip the balance in the Opponent's favour.

[72] The E11 Design Mark still differs from the Mark visually, phonetically, and in ideas suggested. The Opponent's trademark consists of an arrangement of simple strokes forming a somewhat ambiguous design that, on its own, may be perceived as the alphanumeric sequence "E11", but could also have other interpretations. By contrast, the Mark has the appearance of a coined word wherein some of the letters are rendered as numerals. Although there may be some similarity in sound and ideas suggested to francophone consumers if the E11 Design Mark is sounded as "*E onze*" (E eleven) and the Mark is sounded as "*E onzième*" (E eleventh), the Mark possesses added ambiguity in that it might also be sounded as "*elle aime*" (she likes) or "*elle me...*" (to me she...). The ideas suggested when the Mark is sounded in these manners are absent from the E11 Design Mark.

[73] As noted above, trademarks consisting primarily of a simple combination of letters and/or numerals are generally considered to possess a low degree of inherent distinctiveness [see *GSW, supra*, and *Noxzema, supra*]. Design features comprising simple line patterns are also generally considered not to be particularly strong [see *e.g. Levi Strauss & Co v Vivant Holdings Ltd* (2003), 34 CPR (4th) 53 (TMOB)]. However, I find some complexity in how the strokes making up the E11 Design Mark are arranged to suggest simultaneously both an alphanumeric sequence and pairs of skis, and I find that this design concept imparts a fair degree of inherent distinctiveness. Trademarks consisting of a simple combination of letters or numerals tend to owe what inherent distinctiveness they have to their design features and, in the present case, the Opponent's design features have not been reproduced in the Mark. Moreover, I also find the Mark to possess a certain measure of inherent distinctiveness, as a coined word wherein certain letters have been replaced with numerals.

[74] The evidence of use of the E11 Design Mark on invoiced garments and their tags, and of its display in promotional catalogs and online advertising, is not greater than in the case of the Elevenate Logo.

[75] I would also note that most of the garments depicted in the exhibited catalogs as being branded with the E11 Design Mark are also directly branded with either the Elevenate Logo or the Condensed Logo. It would also appear to be the Elevenate Logo that is displayed on hangtags. Furthermore, the Opponent's goods are promoted through its catalog and website, both of which prominently display the Elevenate Logo. In the circumstances, it is not clear to what extent prospective purchasers would interpret a different trademark beginning with the characters "E11", but with neither the graphic features of the E11 Design nor the concurrent "elevenate" branding, as indicating the same source. I find this contextual consideration to be a mitigating factor in favour of the Applicant.

[76] Again, following my analysis of all the surrounding circumstances, I find that the differences between the parties' trademarks are sufficient to avoid a likelihood of confusion as to the source of the parties' respective goods and services, as a matter of

first impression and imperfect recollection, despite the prior use of the E11 Design Mark in Canada and despite the overlap in the parties' goods and likely channels of trade.

Conclusion with respect to the entitlement ground of opposition

[77] In view of all the foregoing, I am satisfied that, on a balance of probabilities, the Mark was not reasonably likely to create confusion with either the Elevenate Logo or the E11 Design Mark at the material date. The Applicant has thus met its legal burden and the entitlement ground of opposition in respect of these two trademarks is rejected.

DISTINCTIVENESS UNDER SECTION 2 OF THE ACT

[78] The Opponent also pleads that the Mark is not distinctive of the Applicant's goods and services within the meaning of section 2 of the Act, because the Mark does not actually distinguish, nor is it adapted to distinguish, those goods and services from the goods and services of the Opponent, considering the prior and continuing use and/or making known of the Opponent's Trademarks.

[79] The material date for this ground of opposition is December 21, 2021, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed, an opponent relying on its own trademark must establish that the trademark had become sufficiently known in Canada as of this date to negate the distinctiveness of an applicant's trademark. In this respect, an opponent has the initial burden to show that its trademark was known in Canada to some extent at least, *i.e.* that its reputation was "substantial, significant or sufficient", or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. In either case, an opponent cannot simply assert that its trademark was known; there must be clear evidence of the extent to which it was known [*Bojangles, supra*; *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10].

[80] The later material date for this ground of opposition allows additional evidence to be considered; specifically, the last three catalogs and the last archived webpage, as well as additional analytics figures for the Opponent's website and additional

representative examples of invoices. However, for the same reasons that were discussed under the entitlement ground, I find the evidence falls short of establishing that the Opponent's Trademarks were known in Canada to a sufficient extent to negate the distinctiveness of the Mark, even at the later material date.

[81] The images in the subsequent catalogs are generally of much lower resolution, such that not all markings can be made out; however, the overall branding appears to be consistent with that in the 2016 catalog. Additional garments depicted in the subsequent catalogs include shorts, skirts, training tights (leggings), short-sleeve jerseys, lightweight long-sleeve tops, tank tops, and baseball caps; however, no markings are visible on the tights and tank tops. The 2019 catalog also includes the ski strap accessory, which appears to be marked with the Elevenate Logo. Most of these goods are covered by the additional invoices—consisting of a 2018 invoice addressed to Sporting Life and eighteen invoices dating from 2018 to 2021 addressed to the distributor Momentum Distribution Inc. Mr. Odén explains that, since September 2019, the Opponent has sold its goods exclusively through this distributor, which was appointed to market and sells the goods to resellers operating clothing stores such as Sporting Life and SkiTown [para 17]. Most of the invoices cover a variety of garments and are for several units of each size and colour ordered, but some invoices list only one unit of each colour of a garment. Most of the invoices have totals in the thousands or tens of thousands of dollars, but some totals are lower.

[82] In any event, as noted above, Mr. Odén does not mention whether the resellers receiving the goods necessarily resell them only in Canada or also abroad. Nor does he state whether Momentum Distribution Inc. is only permitted to distribute the goods in Canada or whether some of the invoiced goods may be destined for other markets. Without confirmation in these respects, and in the absence of any sales figures, any conclusions as to the number of the Opponent's goods ultimately sold in Canada would be speculative.

[83] The additional website analytics figures indicate that the number of "users" of the Opponent's website in Canada grew from over 900 in 2019 to over 3000 in 2021

[Exhibit JO-6]. However, I do not consider such figures to constitute evidence of a reputation for the Opponent's Trademarks that is "substantial, significant or sufficient" to negate the distinctiveness of another trademark. Otherwise, the extent to which Canadians may have come to know the Opponent's Trademarks through resellers' stores, or even through the Opponent's catalogs, remains unclear, since no sales or advertising figures for the stores or circulation figures for the catalogs are provided. In the circumstances, I am only able to conclude that the Opponent's Trademarks have become known in Canada to a slight extent, which is insufficient to meet the Opponent's evidential burden.

[84] In view of the foregoing, the non-distinctiveness ground of opposition is rejected, as the Opponent has failed to meet its evidential burden.

DISPOSITION

[85] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Opponent: Fasken Martineau DuMoulin S.E.N.C.R.L., SRL

For the Applicant: ROBIC