

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

Citation: 2015 TMOB 97
Date of Decision: 2015-05-27

**IN THE MATTER OF AN OPPOSITION
by Omega SA (Omega AG) (Omega Ltd.)
to application No. 1,409,837(1) to extend
the statement of goods and services of
registration No. TMA763,227 for the
trade-mark U Design in the name of Guru
Denim Inc.**

Background

[1] Guru Denim Inc. (the Applicant) filed application No. 1,409,837(1) to extend the statement of goods and services of its registration No. TMA763,227 for the trade-mark shown below (the Mark).



[2] The application was filed on November 8, 2010. The statement of goods and services of the application, as amended on May 27, 2011, and corresponding claims are reproduced in Schedule A to this decision.

[3] The application was advertised in the October 19, 2011 issue of the *Trade-marks Journal*.

[4] Omega SA (Omega AG) (Omega Ltd.) (the Opponent) filed a statement of opposition on March 19, 2012. It raises several grounds of opposition under section 38 of the *Trade-marks Act*,

RCS 1985, c T-13 (the Act), but only in relation to the following goods applied for registration on the basis of proposed use in Canada:

(4) Precious metals and their alloys and goods in precious metals or coated therewith, namely jewellery, bracelets, pins, rings, earrings, necklaces, brooches, cufflinks, pendants, anklets, precious stones, and watches (the Opposed Goods).

[5] The grounds of opposition are summarized in Schedule “B” to this decision.

[6] The Applicant filed a counter statement denying all of the Opponent’s allegations.

[7] Both parties filed evidence, written arguments and were represented at the hearing held on February 26, 2015.

[8] The determinative issue in this proceeding is whether the Mark is confusing with the Opponent’s trade-mark OMEGA & Design, shown below, of registration No. TMDA5009.



[9] For the reasons that follow, I find that the opposition ought to be rejected.

Preliminary Remarks

[10] Although the parties in this proceeding are not related or affiliated, it emerged from the hearing that they are not strangers to one another.

[11] Indeed, prior to the hearing, the Applicant provided the Registrar and the Opponent with copies of decisions in New Zealand and Australia where the Opponent unsuccessfully opposed the registration of the Mark. The decision of the Intellectual Property Office of New Zealand is dated June 27, 2014 [*Guru Denim Inc v Omega SA (Omega AG) (Omega Ltd)* [2014] NZIPOTM 30]. The decision of the Australian Trade Marks Office is dated July 8, 2014 [*Omega SA (Omega AG) (Omega Ltd) v Guru Denim Inc* [2014] ATMO 62].

[12] At this juncture, I note that the Opponent has not raised any objections to the inclusion of those decisions in the Applicant's case law for the hearing. However, the Opponent submitted, and rightly so, that the Registrar is not bound by these foreign decisions. Furthermore, the Opponent argued that little weight, if any, should be given to foreign decisions.

[13] While the Applicant acknowledged that the foreign decisions it cited to support its case have no precedential value, the Applicant argued that they may be considered for their persuasive value. The Applicant's contention is not without merit. In that regard, I note the following comments of Member Herzig in *Origins Natural Resources Inc v Warnaco US Inc* (2000), 9 CPR (4th) 540 (TMOB) at 548: "... cases decided in foreign jurisdictions have no precedential binding authority on this Board but, in the appropriate circumstances, decisions of foreign Courts may be considered for their persuasive value."

Legal Onus and Evidential Burden

[14] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Evidence of Record

Opponent's Evidence

[15] The Opponent filed a Certificate of Authenticity of registration No. TMDA5009 for its trade-mark OMEGA & Design, shown below:



[16] The Opponent's trade-mark is registered in association with the following goods:

(1) Montres et boîtes pour montres; (2) Chaînes de montres, outils et accessoires ainsi que toutes fournitures et parties détachées employées dans l'horlogerie et la bijouterie y soient inclus; (3) Étuis et emballages, nommément: contenant sous forme de housses en tissus et boîte; compteurs et chronographes qui servent au chronométrage sportif; et appareils techniques et scientifiques pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie, nommément: la cellules photo-électriques, portails à contact, compteurs enregistreurs sur bande de papier, pistolets de start à contacts électriques.

[17] The registration claims use of the trade-mark in Canada since 1895 for goods (1), since 1939 for goods (2), and since 1950 for goods (3).

Applicant's Evidence

[18] The Applicant filed a Certificate of Authenticity of its registration No. TMA763,227 for the Mark registered in association with following goods:

(1) Clothing, namely, men's, women's, and children's pants, jeans, shorts, shirts, T-shirts, blouses, vests, skirts, jackets, coats, sweaters, sweatshirts, sweatpants, hats, belts and shoes. (2) Swimwear.

[19] The Applicant also filed an affidavit of Deborah Greaves, including its Exhibits "A" to "K". At the time of her affidavit, sworn on August 20, 2013, Ms. Greaves was the Secretary and General Counsel of the Applicant. Ms. Greaves was not cross-examined.

[20] I shall now review the evidence introduced by Ms. Greaves.

Affidavit of Deborah Greaves

[21] Ms. Greaves explains that the Applicant is headquartered in Vernon, California. Founded by the designer Jeffrey Lubell, the Applicant was incorporated in 2002. It designs, markets, sells

and distributes premium fashion apparel under the brand name TRUE RELIGION BRAND JEANS [paras 1, 3 and 5 of the affidavit].

[22] Ms. Greaves states that the Applicant adopted as its principal trade-mark “the distinctive word combinations TRUE RELIGION and TRUE RELIGION BRAND JEANS in combination with the unique design of a man playing a guitar” (subsequently referred to in the affidavit as TRUE RELIGION) [para 3 of the affidavit].

[23] Ms. Greaves states that the Mark is commonly referred to as the “U Design”. The Mark was launched in 2002 along with the Applicant’s adoption of the TRUE RELIGION brand. Since that time, the Mark has always been used on all of the Applicant’s denim products bearing the TRUE RELIGION brand [para 4 of the affidavit].

[24] Ms. Greaves explains that:

- the sale of denim products historically constituted 100% of the Applicant’s sales. Commencing in approximately 2005, the Applicant began to offer non-denim items for sale as well;
- the Mark, when used on the Applicant’s denim products bearing the TRUE RELIGION brand, is primarily used on the pocket part of the rear of denim items;
- the Mark has also been used on lining and hangtags as well as on non-denim apparel such as footwear, swimwear, hosiery and headwear; and
- the Applicant licenses the TRUE RELIGION brand and the Mark to be included on products sold by other companies; the Applicant has the right to approve or disapprove the licensees’ designs, products and wholesale customers. At the end of 2012, the licensed merchandise categories were fragrances, footwear, headwear (including scarves and gloves) and sunglasses.

[paras 7-9 and 31 of the affidavit]

[25] Examples of use of the Mark in association with denim and non-denim products are provided as Exhibits “A” and “C” to the affidavit.

[26] In terms of channels of trade, Ms. Greaves explains that the Applicant's TRUE RELIGION products bearing the Mark have been sold worldwide in some of the most exclusive retailers. In addition, the Applicant's products are sold directly through branded retail stores owned and operated by the Applicant. The style of the Applicant's stores is "Malibu hippie-bohemian chic". Since 2005, TRUE RELIGION brand apparel bearing the Mark has also been sold directly to consumers through the Applicant's website at *www.truereligionbrandjeans.com* [paras 16, 18-20 of the affidavit].

[27] I summarize as follows the evidence introduced by Ms. Greaves in regard to the use of the Mark in Canada by the Applicant:

- the Mark has been used on clothing since at least as early as December 31, 2003;
- the Mark has been used in association with the goods listed in the Applicant's registration No. TMA763,227 as well as in association with goods (1)-(3) and the services listed in application No. 1,409,837(1). As for goods (4), the Applicant has used the Mark in association with jewellery, namely necklaces, but has not yet used the Mark in association with watches;
- apparel bearing the Mark has been sold to a number of prestigious retailers through the Applicant's exclusive distributor ANV Clothing, Inc.;
- the Applicant owned and operated 11 branded retail stores at the date of the affidavit. Ms. Greaves provides a list of these stores located in the provinces of British Columbia, Alberta, Ontario and Quebec [Exhibit "G"]. She also files a picture of the Calgary store showing the Mark displayed in the store windows [Exhibit "H"];
- Canadians can and have purchased goods bearing the Mark through the website. For the period of August 19, 2010 to June 18, 2013, the number of unique Canadian visitors to the website was 1,769,263 [Exhibit "I"];
- Ms. Greaves files copies of redacted invoices for sales of goods associated with the Mark for the years 2009-2013 [Exhibit "F"]. She also files copies of redacted

invoices for the years 2005-2012 for online sales of goods bearing the Mark to Canadians [Exhibit “J”]; and

- from 2008 to the date of the affidavit, the Applicant’s sales of apparel bearing the Mark totaled in excess of USD\$51 million.

[paras 4, 12, 14, 15, 17, 18, 21, 22 and 30 of the affidavit]

[28] Ms. Greaves also introduces evidence with respect to the worldwide promotion of goods bearing the Mark [paras 24-28 of the affidavit]. As far as the Canadian market is concerned, suffice it to say that the testimony of Ms. Greaves is that:

- the Applicant attends on a regular basis premiere fashion international trade shows which are attended by retail buyers from Canada;
- the Applicant’s denim apparel, particularly jeans bearing the Mark, has been featured as leading fashions items in various international fashion magazines, including *Lou Lou*, *Vogue*, *Elle*, *W*, *inStyle*, *Marie-Claire*, *Esquire*, *Harpers Bazaar*, *GQ*. Further adding to brand exposure and awareness in the Canadian market is the fact that international celebrities, such as Britney Spears, Jessica Simpson, and Beyoncé, are repeatedly photographed while wearing jeans bearing the Mark. Ms. Greaves files copies of representative print media publicity that were published in 2012 and earlier [Exhibit “K”]; and
- from 2010 to the date of the affidavit, the Applicant has expended a total amount of USD\$181,306 for the promotion of goods bearing the Mark in Canada.

[29] To conclude my review of her affidavit, I note that Ms. Greaves references the Applicant’s ownership of registrations for the Mark for apparel and related apparel accessories or for jewellery and watches in other countries; she provides copies of the certificates of registration [paras 10-11 and Exhibits “D”-“E” of the affidavit].

Grounds of Opposition Summarily Dismissed

[30] Not only did the Opponent restrict its evidence to a Certificate of Authenticity of its registration No. TMDA5009, but the Opponent did not make any representations concerning the grounds of opposition raised under sections 38(2)(a), (c) and (d) of the Act.

[31] Accordingly, I summarily dismiss each of these grounds of opposition for the reasons that follow.

Non-conformity to the Requirements of Section 30 of the Act

[32] The material date for considering the conformity of the application to the requirements of section 30 of the Act is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[33] The ground of opposition premised on the general allegation that the Applicant is not a “person” is dismissed for the Opponent’s failure to meet its evidential burden.

[34] Likewise, each of the grounds of opposition alleging that the application does not conform to the requirements of section 30(e) of the Act is dismissed for the Opponent’s failure to meet its evidential burden.

[35] I now turn to the three-pronged ground of opposition alleging non-conformity to the requirements of section 30(i) of the Act.

[36] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant’s statement untrue such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

[37] Furthermore, assuming that the prong of the ground of opposition based on the violation of section 22 of the Act is a valid ground of opposition, it is dismissed for the Opponent’s failure

to adduce evidence supporting a likelihood of depreciation of goodwill [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC)].

[38] Finally, the prong of the ground of opposition based on the violation of section 7(b) of the Act is dismissed for the Opponent's failure to meet its evidential burden. Suffice it to say that Opponent did not adduce evidence to establish a reputation in its alleged trade-marks.

Non-entitlement Grounds of Opposition

[39] The ground of opposition based upon section 16(3)(a) of the Act is dismissed for the Opponent's failure to show that its alleged trade-marks had been used or made known in Canada before the filing date of the application for the Mark.

[40] The ground of opposition based upon the introductory paragraph of section 16(3) of the Act is dismissed for being improperly pleaded. The introductory paragraph of section 16(3) does not form the basis of a ground of opposition, as defined in section 38(2) of the Act, since section 16(3) of the Act as a whole relates to the entitlement grounds of opposition.

Non-distinctiveness Ground of Opposition

[41] The first prong of the ground of opposition is dismissed for the Opponent's failure to meet its evidential burden. More particularly, the Opponent has failed to show that its alleged trade-marks had become known sufficiently in Canada as of the filing date of the statement of opposition, namely March 19, 2012, to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[42] I find that the second and third prongs of the ground of opposition do not contain sufficient allegations of facts to enable the Applicant to reply thereto. Accordingly, both prongs are dismissed for being insufficiently pleaded. Alternatively, they are dismissed for the Opponent's failure to meet its evidential burden.

[43] The fourth and last prong of the ground of opposition is dismissed for the Opponent's failure to adduce evidence in support of its allegations that the Mark is purely functional or only serves as an embellishment and/or decoration.

Analysis of the Remaining Ground of Opposition

[44] The ground of opposition that remains to be decided alleges that the Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's trade-mark OMEGA & Design of registration No. TMDA5009.

[45] The material date for considering the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[46] Having exercised the Registrar's discretion, I confirm that registration No. TMDA5009 is extant. Since the Opponent has met its evidential burden, the question becomes whether the Applicant has met its legal onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's registered trade-mark.

[47] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[48] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401

(SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.

[49] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis by considering that factor. Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the marks.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[50] At the outset, I note that neither in written nor oral arguments did the Opponent reference, intentionally or not, the meaning of the elements forming its trade-mark. However, the Opponent did not dispute the Applicant's submissions that OMEGA is a dictionary word often used to denote the ultimate limit or set of a series and that Ω is the symbol for the Greek letter "omega".

[51] As I may refer myself to dictionaries, I confirm that the *Canadian Oxford Dictionary* provides the following definitions for the word "omega": "1. the last (24th) letter of the Greek alphabet (Ω , ω). 2. the last of a series."

[52] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks.

[53] Examining the degree of resemblance, the Supreme Court of Canada writes in *Masterpiece*, at paragraph 62: "Resemblance is defined as the quality of being either like or similar [between objects of the same kind presenting identical features] under the definition of 'resemblance'" [...]. In paragraph 64, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[54] For the reasons that follow, I find that the trade-marks do not resemble one another and so I find that the section 6(5)(e) factor significantly favours the Applicant.

[55] I find that the trade-marks differ in terms of sound by virtue of the fact that, as a design with no wording, the Mark is not susceptible of being sounded, whereas the Opponent's trade-mark would be sounded as "OMEGA".

[56] That being said, as I understand the Opponent's submissions, it does not argue that the trade-marks are similar in sound. Rather, the Opponent argues to similarity between the trade-marks in appearance and in the ideas they suggest. In that regard, the Opponent submits that the Mark highly resembles the Ω symbol which is the dominant element of its trade-mark. The Opponent also contends that, when considering the degree of resemblance between the trade-marks, the possibility of the Mark being viewed upside down supports a finding of a likelihood of confusion.

[57] To best explain the Opponent's contention, although lengthy, I find it useful to reproduce the following excerpts of its written argument:

32. Si la Requérente obtient l'enregistrement de la Marque en liaison avec les marchandises (4), elle pourra employer cette Marque à sa guise. Par exemple, la Marque pourrait se retrouver sur la partie supérieure d'une petite boîte qui contiendrait le bijou, la bague, les boucles d'oreille, le collier, la broche, les boutons de manchette ou la montre que mettrait en marché la requérante. Si la Marque de la requérante est effectivement présente sur le dessus de cette petite boîte, il ne serait pas facile pour le consommateur de déterminer si la Marque est à l'endroit ou à l'envers (puisque'il ne s'agit pas d'un mot ou encore d'un dessin facilement « reconnaissable »). Nous sommes d'avis qu'il s'agit d'une circonstance importante qui est, bien sûr, reliée à la circonstance du degré de ressemblance entre les marques que doit considérer le registraire.

33. Le registraire a tenu compte d'un risque semblable dans la décision Levi Strauss & Co. c. Benetton Groupe Spa, 1997 CanLII15757 (CA TMOB) où le registraire a écrit ceci en ce qui concerne la question du degré de ressemblance entre les marques en cause dans cette affaire :

As for Section 6(5)(e) of the Act, neither mark is susceptible of being sounded and neither suggests any idea in particular. However, I find that there is a fair degree of visual resemblance between them. Both marks could be characterized as a double arcuate design. As noted by the opponent, when the applicant's mark is

turned upside down (as it might appear on a pair of jeans on display in a retail store), it bears a fairly high degree of resemblance to the opponent's mark.

34. *Dans la mesure où il existe certaines circonstances où le consommateur ne pourra déterminer si la Marque de commerce de la requérante est présentée à l'endroit ou à l'envers, nous sommes d'avis que cela confirme la probabilité des confusion entre les marques des parties, considérant le degré de ressemblance entre celles-ci.*

[...]

36. *Nous sommes d'avis qu'il existe un haut degré de ressemblance entre les marques en cause puisqu'elles comprennent chacune un symbole très semblable. Dans le cas de la Marque, ce symbole est renversé. Toutefois, comme nous venons de l'expliquer, cette circonstance ne suffit pas du tout à éliminer la probabilité de confusion dans les circonstances, cette probabilité demeure.*

37. *Ainsi, au niveau de la présentation et des idées suggérées, les marques de parties ont un haut degré de ressemblance. Au niveau du son, la marque enregistrée de l'opposante comprend également le terme OMEGA; toutefois, puisque la Marque de la requérante reprend également un symbole très semblable, nous sommes d'avis que le degré de ressemblance entre les marques demeure important. Ce critère favorise l'opposante.*

[58] In support of its argument that it may not be easy for a consumer to determine whether the Mark is shown upright or upside down, the Opponent pointed out to the following example of use of the Mark found in Exhibit "C" to the Greaves affidavit, which example seems to show the Mark displayed on the side piece of a spectacle frame:



[59] As a first matter, I acknowledge that the Registrar in *Levi Strauss & Co, supra*, took into consideration the fact that the applicant's mark might appear upside down on a pair of jeans on display in a retail store. Still, the case before me is distinguishable as the Opponent's trade-mark is not solely a design. It also involves a word element.

[60] As a matter of fact, I disagree with the Opponent that the Ω symbol is the dominant element of the Opponent's trade-mark. Indeed, viewing the Opponent's trade-mark as a whole, I consider that the symbol and the word OMEGA are equally dominant.

[61] The Opponent's argument that the possibility of the Mark being viewed upside down supports a finding of a likelihood of confusion leads me to revert to the foreign decisions referenced by the Applicant, in particular to the decision of the Australian Trade Marks Office where the same argument was apparently raised by the Opponent.

[62] The Hearing Officer, Trade Marks Hearings, of the Australian Trade Marks Office concluded to significant differences between the parties' trade-marks and even if the Mark is considered from a different view point, namely upside down. I particularly note the following findings and observations made by the Hearing Officer:

22. The symbol used by the opponent is the well known symbol for the last letter of the Greek alphabet, Omega. It is circular in shape which is further emphasized by the opponent's use of the word OMEGA in its trade mark. [...]. Even taking into consideration the possibility that the applicant's trade mark when used on a watch face may be seen upside down, it is clearly not the omega symbol. It is not a symbol representative of anything I am aware of. Instead, on the correct orientation it resembles a stylized letter U. [...].

[63] Not only do I concur with the above observations and findings, but I find that they apply to the case before me. [See by way of analogy *Vincor International IBC Inc v Oenoforos AB*, 2011 TMOB 93 (CanLII) where Member Robitaille concurred with the analysis of both the Opposition Division of the Office for Harmonization in the Internal Market (OHIM) and the Fourth Board of Appeal of the OHIM concerning the degree of resemblance between the trade-marks and saw no reasons to say things differently].

[64] In the end, having made my own analysis of the degree of resemblance between the Mark and the Opponent's trade-mark OMEGA & Design, I find that there are significant differences between the trade-marks and even if there is a possibility that the Mark be viewed upside down.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[65] For the reasons that follow, I conclude that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, favours the Applicant.

[66] Both parties' marks possess some inherent distinctiveness as they are neither descriptive nor suggestive of their respective goods. However, I find that the inherent distinctiveness of the Opponent's trade-mark is lower than that of the Mark. Indeed, the Mark consists of a somewhat unique design whereas the Opponent's trade-mark consists of a dictionary word and a Greek letter representing the word "omega".

[67] Furthermore, there is no evidence to conclude that the Opponent's trade-mark has become known to any extent in Canada. The mere existence of the Opponent's registration can establish no more than minimal use and cannot give rise to an inference of significant and continuous use of the trade-mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[68] By comparison, even though the Opponent rightly submits that the evidence as introduced by Ms. Greaves does not allow concluding on the extent to which the Mark has become known in association with the Opposed Goods, the evidence is clearly sufficient to conclude that the Mark has become known to a significant extent in Canada in association with fashion apparel.

[69] I disagree with the Opponent's suggestion that the extent to which the Mark has become known in Canada in association with fashion apparel is not relevant, especially as there is arguably a connection between the Opposed Goods and fashion apparel. Indeed, as stated by Member Robitaille in *Emilio Pucci International BV v El Corte Ingles, SA*, 2011 TMOB 32 (TMOB) at paragraph 57: "An argument can be made that [...jewellery...] may to some extent be considered as 'clothing' or 'fashion' accessories. Jewellery, costume jewellery and watches in particular are decorative items that supplement and complement clothes."

Section 6(5)(b) – the length of time the trade-marks have been in use

[70] One may understand that it may be difficult for the Opponent to provide evidence of use of its trade-mark since the claimed dates of first used, the earliest dating as far back as 1895. Still, it remains that the Opponent has not provided any evidence of use of its trade-mark in Canada for any period of time.

[71] As for the Mark, it has been applied for registration in association with the Opposed Goods on the basis of proposed use in Canada. Furthermore, although the testimony of Ms. Greaves is that use of the Mark has commenced in association with necklaces, there is no clear indication of the date of first use. Nonetheless, the Applicant's evidence establishes that the Mark has been used in Canada for several years in association with fashion apparel, which in my view ultimately lends supports to the Applicant's case.

Sections 6(5)(c) and (d) – the nature of the goods and business; the nature of the trade

[72] It is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[73] Both the statement of goods of the registration and the Opposed Goods include "watches". Also, I find that the Opponent's argument that the Opposed Goods consisting of jewelry overlap with its registered goods "... *toutes fournitures et parties détachées employées dans ... la bijouterie...*" (supplies and spare parts used in jewelry) is not without merit.

[74] In terms of the nature of its trade, the Applicant's evidence is that the goods associated with the Mark, which would include the Opposed Goods, are sold through branded retail stores owned and operated by the Applicant, through the Applicant's website as well as by third party retailers.

[75] The Opponent did not file any evidence concerning the channels of trade for its registered goods. Further, even though the Opponent's registration does not contain any restrictions with

respect to the markets for the distribution of its registered goods, in the present state of affairs, it seems unlikely that the Opponent's goods would be carried in any of the Applicant's stores or would be sold through the Applicant's website. However, to the extent that the Applicant's goods are also sold by third party retailers, it seems to me that there might be a potential for overlap in the nature of the trade.

[76] In any event, in attempting to establish confusion, it is not necessary to prove that the parties' goods are sold in the same outlets, as long as the parties are entitled to do so [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD)].

Conclusion on the likelihood of confusion

[77] The legal onus rests on the Applicant to show that, as of today's date, the Mark in association with the Opposed Goods is not reasonably likely to cause confusion with the Opponent's registered trade-mark OMEGA & Design. This means that the Applicant must prove that the absence of confusion is more probable than its existence. Section 6(2) of the Act is not concerned with confusion between the trade-marks themselves, but rather confusion as to the source of the goods or services.

[78] As indicated before, the Supreme Court of Canada stated in *Masterpiece, supra*, that the degree of resemblance between marks is often likely to have the greatest effect on the confusion analysis. The Court also stated:

[49] [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar [...].

[79] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Although the Opponent is favoured by the overall consideration of the section 6(5)(c) and (d) factors insofar as the Opposed Goods are concerned, I do not consider those factors to be of significance in the present case.

[80] Indeed, having considered all of the factors enumerated at section 6(5) of the Act, in particular the lack of resemblance between the trade-marks and the extent to which the Mark has

become known in Canada in association with fashion apparel, I am satisfied that the Applicant has discharged its legal onus to establish that the Mark in association with the Opposed Goods is not reasonably likely to cause confusion with the Opponent's trade-mark OMEGA & Design.

[81] I wish to add that I find that the degree of resemblance between the trade-marks has the greatest effect on the confusion analysis in the present case. Thus, as I concluded that the trade-marks do not resemble one another, even if I had disregarded the acquired distinctiveness of the Mark in Canada in association with fashion apparel, the overall outcome in the present case would have been the same.

[82] Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Disposition

[83] Having dismissed every ground of opposition, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Statement of Goods and Services and Claims of Application No. 1,409,837(1)

GOODS:

- (1) Body and beauty care preparations, namely shower gel, bath gel, perfumery, colognes, bath oils, after shave lotions, deodorants, eau de toilette, eau de parfum, body lotions and creams, and non-medicated skin care preparations.
- (2) Eyewear, namely eyeglass frames, eyeglass lenses, eyeglass cases, eyeglasses, spectacle cases, spectacle frames, spectacle glasses, spectacles, sunglasses, and parts and fittings for all the aforesaid goods.
- (3) Leather and imitations of leather, namely wallets, cases, key cases, bags, namely overnight bags, travelling bags, handbags, backpacks, purses, and clutches.
- (4) Precious metals and their alloys and goods in precious metals or coated therewith, namely jewellery, bracelets, pins, rings, earrings, necklaces, brooches, cufflinks, pendants, anklets, precious stones, and watches.

SERVICES:

- (1) Advertising and promotions of goods and services of others available by electronic mail order and the internet; advertising, marketing and sales promotional services of the goods and services of others via television and direct mail; providing home shopping services offering a wide variety of goods in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery via television; mail order and catalog services offering a wide variety of goods in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery via a global computer network; retail services, namely retail store services in the fields of personal care products, toiletries, cosmetics, fragrances, bags, leather and imitations of leather goods, eyewear and jewellery; online retail services, namely on-line department store services; advertising the goods and services of others via a global computer network; business management; business administration.

CLAIMS:

Used in CANADA since at least as early as November 18, 2008 on goods (1).

Used in CANADA since at least as early as December 15, 2009 on goods (2).

Used in CANADA since at least as early as April 15, 2008 on goods (3).

Used in CANADA since at least as early as May 21, 2005 on services.

Proposed Use in CANADA on goods (4).

Schedule “B”

Summary of the Grounds of Opposition – Restricted to the Opposed Goods



1. Pursuant to section 38(2)(a) of the Act, the application does not conform to the requirements of section 30 of the Act. In particular:
 - 1.1 At the filing date of the application, the Applicant used, or had used, the Mark in Canada with all or some of the Opposed Goods, contrary to section 30(e) of the Act.
 - 1.2 The trade-mark proposed to be used is not the Mark, contrary to section 30(e) of the Act.
 - 1.3 Alternatively or cumulatively, the Applicant did not intend to use the Mark in Canada by itself, through a licensee or by itself and through a licensee, contrary to section 30(e) of the Act.
 - 1.4 The Mark is not a trade-mark because it is purely functional; it only serves as an embellishment or decoration on the Opposed Goods, contrary to section 30(e) of the Act.
 - 1.5 The Applicant falsely made the statement that it is entitled to use the Mark in Canada because of the allegations contained in the statement of opposition, including the Applicant’s knowledge of the Opponent’s rights, contrary to section 30(i) of the Act, in particular for the following reasons:
 - 1.5.1 the use of the Mark infringes the Opponent’s rights;
 - 1.5.2 the use of the Mark is contrary to the provisions of section 22 of the Act; and
 - 1.5.3 the adoption and use of the Mark is contrary to section 7(b) of the Act.
 - 1.6 The Applicant is not a “person” within the meaning of the Act.
2. Pursuant to section 38(2)(b) of the Act, the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with Opponent’s trade-mark OMEGA & Design of registration No. TMDA5009 for the following goods:

(1) Montres et boîtes pour montres; (2) Chaînes de montres, outils et accessoires ainsi que toutes fournitures et parties détachées employées dans l'horlogerie et la bijouterie y soient inclus; (3) Étuis et emballages, nommément: contenants sous

forme de housses en tissus et boîte; compteurs et chronographes qui servent au chronométrage sportif; et appareils techniques et scientifiques pour l'électricité, l'optique, la télégraphie, le cinéma, la radio, la téléphonie, la télégraphie, nommément: la cellules photo-électriques, portails à contact, compteurs enregistreurs sur bande de papier, pistolets de start à contacts électriques.

3. Pursuant to section 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Mark under section 16 of the Act.

3.1 Contrary to section 16(3)(a) of the Act, at the relevant time, the Mark was confusing with the Opponent's trade-marks shown below, previously used or made known in Canada in association with the above-identified goods.

-  OMEGA or any variation;
-  or any variation.

3.2 Contrary to the introductory paragraph of section 16(3) of the Act:

- 3.2.1 the application does not conform to section 30 of the Act;
- 3.2.2 the Mark is not a proposed use one but rather a used one;
- 3.2.3 the Mark is not a trade-mark; and
- 3.2.4 the Applicant is not a "person".

4. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive under section 2 of the Act since:

- 4.1 The Mark does not distinguish the Opposed Goods from the goods and services of others, including the Opponent's goods.
- 4.2 The Applicant has allowed third parties to use the Mark in Canada outside the scope of the licensed use provided by section 50 of the Act.
- 4.3 As a result of a transfer of the Mark more than one person had rights into the Mark and exercised them, contrary to section 48(2) of the Act.
- 4.4 The Mark is purely functional or only serves as an embellishment and/or decoration on the Opposed Goods.