



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

Citation: 2015 TMOB 141
Date of Decision: 2015-08-04

IN THE MATTER OF AN OPPOSITION

The Brick Warehouse LP	Opponent
and	
Kohl's Illinois, Inc.	Applicant
1,513,183 for THE BIG ONE	Application

Introduction

[1] The Brick Warehouse LP (the Opponent) opposes registration of the trade-mark THE BIG ONE (the Mark) applied for registration by Kohl's Illinois, Inc. (the Applicant) in association with a variety of goods, such as towels, wash cloths, rugs, picture frames, bedding, luggage, cookware, bakeware, glass kitchen storage containers, and in association with retail store services in the fields of consumer electronics, household appliances, furniture and bedding, and retail department store services.

[2] The grounds of opposition are premised on allegations of confusion between the Mark and the trade-mark THE BIG ONE previously used in Canada by the Opponent in association with, and in advertising for, the retail stores associated with its trade-mark THE BRICK and other associated trade-marks.

[3] For the reasons that follow, I find that the application ought to be refused.

The Record

[4] The application was filed under serial No. 1,513,183 on January 31, 2011. It is based on registration and use of the Mark in the United States. The full statement of goods and services of the application reads as follows:

Goods: (1) Towels and cloth bath mats. (2) Towels, namely, bath and hand towels; wash cloths; rugs, namely, throw rugs. (3) Picture frames. (4) Pillow shams; comforters; bed blankets; blanket throws. (5) Bedding, namely, bed-in-one bag sets; bed sheets; mattress pads, comforters. (6) Pillows. (7) Duffle bags; luggage. (8) Cutlery and flatware, namely, knives, forks, and spoons. (9) Cookware, namely, pots and pans; bakeware, namely, baking dishes, pans, and containers; glass kitchen storage containers; kitchen utensils, namely, spatulas and turners; drinking glasses, beverage ware.

Services: (1) Retail store services in the fields of consumer electronics, household appliances, furniture and bedding. (2) Retail department store services.

[5] The application was advertised in the January 25, 2012 issue of the *Trade-marks Journal*.

[6] The statement of opposition was filed on March 14, 2012. It raises two grounds of opposition under section 38 of the *Trade-marks Act*, RCS 1985, c T-13 (the Act).

[7] As a preamble to the grounds of opposition, the Opponent alleges being one of Canada's largest retailers of furniture, mattresses and box springs, household appliances, televisions and consumer electronic products, which have been sold through the Opponent's retail stores operated under the trade-marks THE BRICK, BRICK, URBAN BRICK, THE BRICK MATTRESS STORE and THE BRICK SUPERSTORE, and through its website. The Opponent also alleges that it has used the trade-mark THE BIG ONE in association with, and in advertising for, its retail stores and website for a number of years.

[8] The first ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark under section 16(2)(a) of the Act; the second one alleges that the Mark is not distinctive under section 2 of the Act. Each ground of opposition is premised on allegations of confusion between the Mark and the trade-mark THE BIG ONE previously used in Canada by the Opponent in association with the following services:

retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners; the retail sale of furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners, through retail stores and over the internet; electronic commerce services, namely operating a web site that sells furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners.

[9] The Applicant filed and served a counter statement denying both grounds of opposition.

[10] In support of its opposition, the Opponent filed an affidavit of Paul Comrie, including its Exhibits “A” to “J-3”. Mr. Comrie was not cross-examined.

[11] The Applicant elected not to file evidence in support of its application.

[12] Both parties filed written arguments and were represented at the hearing.

Legal Onus and Evidential Burden

[13] 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 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[14] Before analyzing the issues arising in this proceeding, I will first review the evidence filed by the Opponent through the affidavit of Paul Comrie, sworn on August 8, 2012.

Opponent's Evidence

[15] Mr. Comrie is the Senior Vice President, Merchandising, of the Opponent. He states that he has been employed by the Opponent “and its predecessor The Brick Warehouse Corporation and associated companies since 2001” [para 1 of the affidavit]. Mr. Comrie explains that The Brick Warehouse Corporation assigned all of its assets, including its retail stores and trade-marks, to the Opponent on May 1, 2004 [para 2 of the affidavit].

[16] For the purposes of my review of the affidavit, I have to make some preliminary remarks.

[17] First, Mr. Comrie explains using the term “my company” throughout his affidavit to refer to: (i) the Opponent for the period from May 1, 2014 to the date of his affidavit; (ii) The Brick Warehouse Corporation for the period from March 3, 1989 to May 1, 2014; and (iii) that company's predecessors for the period before March 3, 1989 [para 2 of the affidavit]. For ease of reference, I will still refer to the Opponent when reviewing the affidavit.

[18] Second, Mr. Comrie explains using the term “THE BRICK Banner Stores” as a collective reference to the retail stores operated by the Opponent and its franchisees under the trade-marks THE BRICK, BRICK, THE BRICK SUPERSTORE, THE BRICK MATTRESS STORE, URBAN BRICK and UNITED FURNITURE WAREHOUSE [para 11 of the affidavit]. However, the Opponent acknowledged in its written argument that THE BIG ONE has not been used in advertising for the UNITED FURNITURE WAREHOUSE retail stores [para 14 of the written argument].

[19] Accordingly, in my review of the evidence I will use the term “THE BRICK Stores” as a collective reference to the retail stores operated under the trade-marks THE BRICK, BRICK, THE BRICK SUPERSTORE, THE BRICK MATTRESS STORE and URBAN BRICK. I will refer to the UNITED FURNITURE WAREHOUSE retail stores as the “UFW Stores”. However, I will refer to the UFW Stores only when the evidence, as introduced by Mr. Comrie, does not allow me to distinguish the evidence for the UFW Stores from the one for THE BRICK Stores.

[20] Finally, it is of note that Mr. Comrie provides extensive evidence concerning the Opponent's business in general, THE BRICK Stores and the Opponent's website at

www.thebrick.com (the Website), as well as evidence concerning the use of THE BIG ONE by the Opponent.

[21] The Applicant contends that all of the evidence concerning the Opponent's business, THE BRICK Stores and Website is irrelevant in this proceeding because it has no bearing on the issues of whether and how the Opponent has used its alleged trade-mark THE BIG ONE. The Opponent submits that this evidence is relevant as it serves to put in context its use of the trade-mark THE BIG ONE. I agree.

[22] Accordingly, I will first review the evidence concerning the Opponent's business, THE BRICK Stores and Website found from paragraphs 3 to 21 of the affidavit. I will afterwards review the evidence concerning the trade-mark THE BIG ONE found from paragraphs 23 to 32 of the affidavit.

The Opponent's business, THE BRICK Stores and Website

[23] I summarize as follows the testimony of Mr. Comrie concerning the Opponent's business, THE BRICK Stores and Website:

- the Opponent is one of Canada's largest volume retailers of household furniture, mattresses, appliances and home electronic products;
- the Opponent carries on business through company operated stores and through franchisees. Prior to 1999, all of the retail stores were company operated stores;
- THE BRICK retail stores have been operated at various locations in Canada for over thirty years. These retail stores have sold furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners;
- BRICK retail stores have been operated in the province of Quebec since 2004; they sell the same products as THE BRICK retail stores;
- THE BRICK SUPERSTORE retail stores have been operated in Ontario since 2006; they sell the same products as THE BRICK retail stores;

- THE BRICK MATTRESS STORE retail stores have been operated since 2005; they sell primarily mattresses and box springs;
- URBAN BRICK retail stores have been operated since 2008; they sell primarily household furniture intended for consumers living in apartments;
- photographs of representative store fronts for THE BRICK Stores are filed as Exhibits A to D and E-2;
- as of March 31, 2012, there were 199 THE BRICK Stores locations throughout Canada (157 THE BRICK retail stores; 17 BRICK retail stores; 23 THE BRICK MATTRESS STORE retail stores; and 2 URBAN BRICK retail stores);
- for each of the fiscal years 2005 to 2010 (ending December 31st), retail sales of THE BRICK Stores and UFW Stores exceeded \$1 billion. For the year ended December 31, 2011, retail sales exceeded \$1.2 billion;
- the goods sold in THE BRICK Stores are also available for sales through the Website, which has been in operation since 1998. Retail sales from the Website exceeded \$10 million for each of the fiscal years 2005 to 2011; they exceeded \$7 million for the period of January 1st through July 15, 2012; and
- for each of the five years preceding the date of the affidavit, the Opponent has spent in excess of \$60 million in advertising its THE BRICK Stores, UFW stores and Website in Canada through several means including, but not restricted to, newspaper, radio, national and local television advertisements, direct marketing pieces, flyers, coupons, printed advertisements, and emails.

The Opponent's trade-mark THE BIG ONE

[24] At paragraph 22 of his affidavit, Mr. Comrie states that the trade-mark THE BIG ONE is one of many trade-marks used by the Opponent to advertise and promote the sale of goods from THE BRICK Stores and the Website. He explains:

22. [...] For over eleven years my company has employed the mark THE BIG ONE in advertising flyers, in newspaper advertisements, on promotional mugs distributed to customers and potential customers, in television advertisements, in email

marketing and on the Website. THE BIG ONE is a brand used to designate a special promotion that has been run at least once per year for at least eleven years.

[25] Mr. Comrie goes on to provide the following evidence with respect to the use of trademark THE BIG ONE by the Opponent in advertising:

- flyers from the Opponent, distributed through national and local newspapers and through the mail, are filed as Exhibits “F-1” to “F-5”. Mr. Comrie states that:
 - over 5 million copies of the flyer dated July 10, 2009 were distributed [Exhibit “F-1”];
 - over 9 million copies of each of the flyers dated November 12, 2010 and November 19, 2010 were distributed [Exhibits “F-2” and “F-3”]; and
 - over 4,5 million copies of the flyer dated November 11, 2011 were distributed [Exhibit “F-5”];
- copies of full page advertisements that have appeared in the following newspapers are filed as Exhibits “G-1” to “G-3”:
 - the July 17, 2009 editions of *Calgary Herald*, *Edmonton Journal*, *Montreal Gazette*, *Ottawa Citizen*, *Toronto Star*, *Vancouver Province*, *Vancouver Sun*, *Victoria Times Colonist*, *Winnipeg Free Press*, *Regina Leader Post*, and *Edmonton Sun*;
 - the November 12, 2010 editions of the *Calgary Sun*, *Edmonton Sun*, *Ottawa Sun*, *Toronto Star*, and *Vancouver Sun*; and
 - the November 8, 15 and 18, 2011 editions of the *Kelowna Daily Courier*;
- copy of a screen shot of the Website featuring an advertisement for a THE BIG ONE promotion run in 2004 is filed as Exhibit “H-1”;
- the flyers for THE BIG ONE promotion are also featured on the Website. Copies of screen shots featuring the flyers of November 2010 and November 2011 are filed as Exhibits “H-2” and “H-3”;

- 60,000 mugs bearing the trade-mark were given to customers and potential customers in 2009. The free mug given that year is shown on the flyer filed as Exhibit “F-1”;
- the trade-mark would have been shown and spoken in television advertisements that ran in July 2009, November 2010 and November 2011;
- copies of mailers for a THE BIG ONE promotion at URBAN BRICK retail stores in Toronto and Vancouver in November 2010 and in Toronto in November 2011 are filed as Exhibits “I-1” to “I-3”. These mailers were distributed through the mail. 125,000 copies of mailers were distributed in November 2010, while 80,000 copies were distributed in November 2011; and
- subscribers of the Opponent’s service marketed under the brand “ebrick”, which provides information on store offerings and openings, have received emails (ebrick messaging) featuring the trade-mark. Snapshots of ebrick messaging sent in July 2009, November 2010 and November 2011 are filed as Exhibits “J-1” to “J-3”. Since September 2008, there have always been over 100,000 members who have been sent weekly ebrick messaging.

Analysis of the Issues

[26] The issues arising from the grounds of opposition are:

1. Was the Applicant the person entitled to registration of the Mark as of the filing date of the application?
2. Was the Mark distinctive of the Applicant’s goods and services as of the filing date of the statement of opposition?

[27] I will analyse these issues in turn.

Was the Applicant the person entitled to registration of the Mark as of the filing date of the application?

[28] This issue arises from the first ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(2)(a) of the Act because, at the filing date of the application, the Mark was confusing with the trade-mark THE BIG ONE previously used in Canada by the Opponent in association with the services described in the statement of opposition as:

retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners; the retail sale of furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners, through retail stores and over the internet; electronic commerce services, namely operating a web site that sells furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners.

[29] In order to meet its evidentiary burden under the pleaded ground of opposition, the Opponent must show that it had used the trade-mark THE BIG ONE in Canada prior to January 31, 2011 and had not abandoned it as of the date of advertisement of the application, namely January 25, 2012 [section 16(5) of the Act].

[30] The Applicant contends that it is clear that the Opponent's evidence does not support its claim of prior use of the trade-mark THE BIG ONE in association with retail store services. The following excerpts of its written argument provide an overview of the Applicant's submissions in this regard:

28. [...] The Opponent's evidence clearly indicates that the phrase THE BIG ONE (almost always used in close association with the trademark (*sic*) THE BRICK or BRICK-formative marks) has been used solely "to designate a special promotion that has been run at least once per year for at least eleven years." Therefore, any use of the phrase THE BIG ONE (alone or in association with the trademark (*sic*) THE BRICK or BRICK-formative marks) is not use as a trademark (*sic*) because:

- (a) the Opponent has only used the phrase THE BIG ONE in association with an annual sale. Case law is clear that there must be a benefit offered to a third party before one can consider a trademark (*sic*) to be used in association with

a service. Sales are within the normal expectation of purchasers in connection with the sale of goods: as there is no unexpected third benefit, such promotional use cannot be considered to be used as a trademark (*sic*); and

- (b) the Opponent has only used the phrase THE BIG ONE in a clearly descriptive way to advertise a big, annual sale. This is expressly recognized by an associated tagline which is seen throughout the samples of advertising and promotional materials from 2011: “an event so big ... it could only be called one thing”. (see Exhibits F-4; G-3; H-3; I-3; J-3). The phrase THE BIG ONE was not used as a trade-mark to distinguish the Opponent’s retail store services from those of others. This distinguishing function has been consistently performed by the Opponent’s registered trade-mark THE BRICK (or a BRICK-formative mark), which is almost always displayed in close proximity to the phrase THE BIG ONE. In other words, if consumers were asked where they purchased goods they obtained at the annual sale, the consumer would say THE BRICK (or one of the other BRICK-formative retail banners owned by the Opponent).

[31] As a first matter, I acknowledge that where THE BIG ONE appears in advertising and promotional material for THE BRICK Stores, it often *but not always* appears in proximity to the trade-mark THE BRICK “or BRICK-formative marks”. However, this is not detrimental to the Opponent’s case.

[32] For one thing, there is nothing in the legislation that prohibits the use of two or more trade-marks simultaneously [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. Furthermore, as elaborated in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at 538:

Use of a mark in combination with additional material constitutes use of the mark *per se* as a trade-mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade-mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing [...] or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name [...]

[See also *Canada (Registrar of Trade marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]

[33] In the present case, given the positioning and the use of the different fonts, sizes and colours, I am of the view that the words THE BIG ONE as a matter of first impression would

have been perceived as a separate trade-mark despite having been used in conjunction with other trade-marks for THE BRICK Stores.

[34] By the same token, I disagree with the Applicant's submissions that "the Opponent has only used the phrase THE BIG ONE in a clearly descriptive way". Again, the use of different fonts, sizes and colours distinguishes THE BIG ONE from the surrounding text, such as the "tagline" referenced by the Applicant.

[35] In the end, I am satisfied that the Opponent's evidence establishes use of THE BIG ONE as a trade-mark. Thus, I shall now turn to the question of whether the evidence satisfactorily establishes prior use and non-abandonment of the trade-mark THE BIG ONE by the Opponent.

[36] To begin with, I note that I have no reasons to question Mr. Comrie's sworn statement as to the use of the Opponent's trade-mark THE BIG ONE for "over eleven years" [para 22 of the affidavit]. In fact, while the Applicant contends that THE BIG ONE has not been used in association with the services alleged in the statement of opposition, the Applicant does not seem to dispute that the Opponent had used THE BIG ONE for eleven years at the date of Mr. Comrie's affidavit.

[37] That being said, at the oral hearing, the Applicant argued that the use of THE BIG ONE only once a year, as opposed to continuous use throughout the year, is not sufficient for the Opponent discharging its evidentiary burden under the non-entitlement ground of opposition, in that it is insufficient to show that the Opponent had an established reputation in the trade-mark as of January 31, 2011.

[38] Suffice it to say that all that the Opponent needs to establish under section 16 of the Act is use of its alleged trade-mark in Canada in association with its alleged services within the meaning of the Act [see *Optic Nerve Art & Design Ltd v Optic Nerve Design* 2005 CarswelNat 4746 (TMOB)]. In that regard, I would remind that section 4(2) of the Act provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[39] Also, the law is clear that there is no distinction in the Act between primary, incidental or ancillary services. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service [*Venice Simplon-Orient-Express, Inc v Société Nationale des Chemins de Fer Français SNCF* (2000), 9 CPR (4th) 443 (FCTD); *TSA Stores Inc v Canada (Registrar of Trade-marks)*, 2011 FC 273, 91 CPR (4th) 324].

[40] It is apparent that the description of the services in the statement of opposition contains overlapping and redundant terms in the sense that the performance of one service necessarily implies the performance of another. For instance, the performance of “*retail store services associated with selling [...]*” necessarily implies “*the retail sale of [...] through retail stores [...]*”. Likewise, “*the retail sale of [...] over the internet*” seemingly implies “*electronic commerce services, namely operating a website that sells [...]*”.

[41] In any event, given the parties’ submissions, the issue can be decided by considering the use of THE BIG ONE by the Opponent in association with the alleged services “*retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners*”. Thus, I will be focussing on those services in discussing the parties’ submissions as well as referring to them broadly as retail store services.

[42] The Applicant devoted a significant part of its written and oral submissions to arguing that the use of THE BIG ONE in association with an annual sale cannot be deemed to be used in association with retail store services. Although lengthy, I have chosen to reproduce the following excerpts of its written argument to reflect the gist of the Applicant’s submissions.

39. In [*Kraft Ltd v Canada (Registrar of Trade Marks)*, [1984] 2 FC 874], the Federal Court found that price discounts made available to consumers through a coupon program constituted a benefit to consumers, because the coupon program at issue was “not something which is a normal contractual requirement or within the normal expectation of the purchaser in connection with the sale of goods.” In the present case, clearance sales (at varying frequencies) are firmly embedded in the consciousness of consumers of home furnishings and electronic goods. Such products are subject to depreciation in value as time goes on, due to changes in fashion, styles or technology. Accordingly, consumers know that the initial full retail price is simply the price for that product at that particular time. Sale for such products only confer the appearance of a price discount on

ordinary prices, since the Opponent's goods are actually worth less on the market than they were previously. Accordingly, and in contrast to a coupon program, THE BIG ONE sale does not reflect any true discount on normal, ordinary process, but rather the clearance of items with depreciated values.

40. In *Ralston Purina Co. v. Effem Foods Ltd* (1997), the Board found that two marks were not registrable for use in association with "advertising, marketing and promotional services relating to the pet foods of the applicant." The Board held:

[W]hile there is nothing in the Act that restricts a service to one that is *not* merely incidental or ancillary to the sale of goods, there is still a requirement that there be a service offered to some third party before a statement of services will be accepted. In this case the applicant's services are described as "advertising, marketing and promotional services...". I do not think that the term "advertising" or "marketing" describe a service to the public in this case as this seems to me to fall in the same category as the services in the *Carling O'Keefe Breweries of Canada Ltd.-Brasseries Carling O'Keefe du Canada Ltée* case where the only person who would benefit is the applicant.

Ralston Purina Co. v. Effem Foods Ltd., [1997] 81 C.P.R. (3d) 528

41. When advertising and promotion are entirely self-serving, that is intended to increase the applicant's sales by making the public aware of its product, trademark rights cannot enure to such use. In this case, the phrase THE BIG ONE was used to advertise a big annual sale, and to increase traffic in the Opponent's retail stores. No particular benefit to a consumer is provided by such advertisements; the sale price is determined by the retailer, and consumers either take it or leave it.

Ralston Purina Canada Inc. v. Effem Foods Ltd., [2000] 5 C.P.R. (4th) 398

[43] The submissions of the Applicant were addressed by the Opponent at the hearing where the Opponent first pointed out that it is not relying upon prior use of the trade-mark for "advertising" or "marketing" services of its goods. It is relying upon prior use in association with the retail sale of goods through THE BRICK Stores. What follows is my summary of the oral submissions of the Opponent:

- the affidavit of Mr. Comrie evidences that the Opponent has performed retail store services in Canada. The special promotion that has been run at least once a year forms an integral part of the retail store services;

- there is no basis for the Applicant’s argument that no third party received a benefit from the annual sale conducted as part of the Opponent’s retail store services. The offering of a lower price is clearly a benefit to the consumers; and
- the fact that the trade-mark THE BIG ONE is used in promoting an annual sale does not change the fact that the trade-mark has been used in advertising of THE BRICK Stores. In other words, the trade-mark THE BIG ONE has been used in advertising of the Opponent’s retail store services as required by section 4(2) of the Act.

[44] As each case must be decided on its own facts, when considering the facts of this case, I essentially agree with the Opponent’s submissions that its evidence is more than sufficient for me to conclude that the Opponent’s prior use of the trade-mark THE BIG ONE can be deemed use in association with retail store services under the Act. In other words, the Applicant did not convince me that it must be concluded that the Opponent had not used the trade-mark THE BIG ONE in association with retail store services as of the filing date of the application.

[45] In the end, further to my review of the affidavit of Mr. Comrie, I am satisfied that the Opponent has evidenced its performance of “retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners” and the use of the trade-mark THE BIG ONE in advertising for those services prior to January 31, 2011 as well as non-abandonment of the trade-mark as of January 25, 2012.

[46] The question becomes whether the Applicant has met its legal onus to show that, as of January 31, 2011, the Mark was not reasonably likely to cause confusion with the Opponent’s trade-mark THE BIG ONE previously used in association with retail store services.

Likelihood of confusion

[47] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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 the trade-marks have been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the 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 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

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

[49] The Opponent submits that the parties' trade-marks possess the same measure of inherent distinctiveness whereas the Applicant contends that the Mark possesses more inherent distinctiveness. In this regard, the Applicant submits that there is no descriptive connotation attaching to THE BIG ONE for its goods and services whereas THE BIG ONE used for "a big 'once a year' clearance sale" is highly suggestive, if not clearly descriptive, of the Opponent's services.

[50] I disagree with the Applicant's contention that the Mark is inherently more distinctive. Indeed, it remains that THE BIG ONE is an expression that suggests something that would be major or big. Thus, I find that neither trade-mark is inherently strong. Further, I assess their inherent distinctiveness as about the same.

[51] I now turn to the parties' submissions concerning the extent to which the Opponent's trade-mark had become known in Canada at the relevant date.

[52] The Applicant contends that the Opponent's trade-mark does not benefit of any significant acquired distinctiveness because although it may have been used for 11 years, the trade-mark "was used only for a limited part of those 11 years, to advertise a short-term sale". For its part, the Opponent contends that the trade-mark THE BIG ONE has become well known in Canada because of its wide and extensive use in the advertising of THE BRICK Stores.

[53] I acknowledge that the evidence shows use of the Opponent's trade-mark THE BIG ONE once a year and for a short period of time during a given year. Still, it can be concluded from the evidence that this use has occurred throughout Canada. Furthermore, whether or not the Opponent rightly submits that its trade-mark THE BIG ONE had become well known in Canada the evidence does show significant distribution of advertising material displaying the trade-mark at the material date. In this regard, I stress that according to the affidavit of Mr. Comrie:

- several million copies of each of the Opponent's flyers of July 10, 2009, November 12, 2010 and November 19, 2010 were distributed in [para 23; Exhibits "F-1" to "F-3" of the affidavit];
- advertisements have appeared in newspapers of major Canadian cities on July 17, 2009 and November 12, 2010 [para 24; Exhibits "G-1" and "G-2" of the affidavit]. I can take judicial notice that major daily newspapers of major Canadian cities have a substantial circulation [see *Northern Telecom Ltd v Nortel Communications Inc* (1988), 14 CIPR 104 (TMOB)];
- 125,000 copies of mailers for a THE BIG ONE promotion at URBAN BRICK retail stores were distributed in November 2010 [para 28; Exhibits "I-1" and "I-2" of the affidavit]; and
- over 100,000 subscribers of the Opponent's "ebrick" service have received emails featuring the trade-mark in July 2009 and November 2010 [para 32; Exhibits "J-1" and "J-2" of the affidavit].

[54] In the end, surely there is sufficient evidence for me to conclude that the Opponent's trade-mark THE BIG ONE had become known to some extent throughout Canada as of January 31, 2011. By comparison, the Mark had not become known to any extent.

[55] Accordingly, I find 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 Opponent.

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

[56] As I understand the Applicant's submissions, it contends that this factor does not favour the Opponent because although the latter may have used the trade-mark THE BIG ONE for 11 years, it did so only once a year and for a short period of time each year.

[57] However, what is to be considered under section 6(5)(b) of the Act is the length of time for which a party has evidenced use of its trade-mark in Canada pursuant to section 4 of the Act; not the extent to which the trade-mark has become known in Canada as a result of this use.

[58] As per my review of the affidavit, not only did Mr. Comrie provide documentary evidence showing use of the trade-mark THE BIG ONE in advertising for the years 2009 and 2010, but he did provide a copy of a screen shot of the Website featuring an advertisement for a THE BIG ONE promotion run in 2004 [para 25; Exhibit "H-1" of the affidavit]. In other words, the documentary evidence supports Mr. Comrie's sworn statement that the Opponent had used the trade-mark THE BIG ONE for "over eleven years" at the time of his affidavit. In any event, as previously indicated, I have no reasons to question Mr. Comrie's sworn statement.

[59] Accordingly, the section 6(5)(b) factor favours the Opponent.

Sections 6(5)(c) and (d) - The nature of the goods and services; the nature of the trade

[60] The Applicant contends that these factors support its view that there is no reasonable likelihood of confusion between the trade-marks.

[61] However, it is of note that the Applicant's submissions as to differences in the nature of the parties' services partly rest on its contention that the Opponent's trade-mark is associated with promotional services; not retail store services. As I have found that the Opponent has established use of its trade-mark in association with retail store services, the Applicant's

submissions revolving around its contention as to the services associated with the Opponent's trade-mark are moot.

[62] Furthermore, I agree with the Opponent that there is no distinction between its retail store services and the services described in the application for the Mark as "(1) *Retail store services in the fields of consumer electronics, household appliances, furniture and bedding*". I also agree with the Opponent that its retail store services are of the same nature as the services described in the application for the Mark as "(2) *Retail department store services*".

[63] In turning to the consideration of the nature of the goods, I first recall that they are described in the application as:

(1) Towels and cloth bath mats. (2) Towels, namely, bath and hand towels; wash cloths; rugs, namely, throw rugs. (3) Picture frames. (4) Pillow shams; comforters; bed blankets; blanket throws. (5) Bedding, namely, bed-in-one bag sets; bed sheets; mattress pads, comforters. (6) Pillows. (7) Duffle bags; luggage. (8) Cutlery and flatware, namely, knives, forks, and spoons. (9) Cookware, namely, pots and pans; bakeware, namely, baking dishes, pans, and containers; glass kitchen storage containers; kitchen utensils, namely, spatulas and turners; drinking glasses, beverage ware.

[64] The Applicant essentially argues that the Opponent's trade-mark is not associated with any goods.

[65] Based on my understanding of its written and oral arguments, the Opponent essentially contends that it must be concluded that there is an overlap between any of the Applicant's goods corresponding to goods sold in the Opponent's retail stores. At the hearing, the Opponent did cite a few cases to support its contention. Among those cases, I note *Modern Houseware Imports Inc v Alta Culture Inc*, 2008 CanLII 88161 (TMOB), where it was concluded to some overlap between picture frames on one hand, and online retail services in the field of housewares and gifts on the other hand; and *Nature's Source Inc v Natursource Inc*, 2009 CanLII 90388 (TMOB), aff'd 2012 FC 917, where it was concluded to some overlap between food items on one hand, and the retail store services specializing in the sale of nutritional supplements, vitamins and mineral supplements, herbal supplements, and diet and weight loss products and fitness products on the other hand.

[66] While it is trite law that each case must be decided on its own facts, I do find that there is merit to the Opponent's contention. In my view, the goods listed at (1), (2) and (3) in the application fall within the category of home furnishings; those listed at (4), (5) and (6) fall within the category of bedding. Thus, I conclude to some overlap between the goods listed from (1) to (6) and the Opponent's retail store services. Conversely, I conclude that the goods listed at (7), (8) and (9) in the application do not overlap with the Opponent's retail store services.

[67] While the Opponent did not expand on the nature of the trade either in its written argument or at the hearing, the Applicant did so, especially in its written argument. The Applicant structures its submissions in two prongs.

[68] First, the Applicant submits that the evidence establishes that the Opponent sells a wide variety of third party branded goods in its retail stores.

[69] If the Applicant argues that it must be concluded from the evidence that the Opponent does not manufacture any of the goods sold in its retail stores, I agree. However, if the Applicant argues that the Opponent's evidence establishes that the retail sale of goods exclude the manufacturing of goods, I disagree. I would add that the Applicant itself is seeking registration of the Mark for retail store services associated with the selling of goods in respect of which it is also seeking registration of the Mark.

[70] Second, the Applicant submits that "it is clear that the retail store services offered by each of the Applicant and Opponent would be in their own separately branded retail outlets".

[71] Because the Applicant did not file any evidence, I find its comment about its "own branded retail stores" to be somewhat ambiguous. Is it meant as a reference to stores that would be operated in association with a banner other than the Mark? To stores that would be operated under a different banner than the Mark, but in conjunction with it?

[72] In the end, with due respect for the Applicant, what is clear is that it has elected to file no evidence to distinguish the market for its goods and services from the market for the Opponent's retail store services, i.e. the ordinary Canadian consumers. Thus, in the absence of evidence from

the Applicant, for the purposes of assessing confusion, I conclude that there is a potential for overlap in the nature of the trade associated with the trade-marks at issue.

[73] Accordingly, I find that each of the sections 6(5)(c) and (d) favour the Opponent when considering the services associated with the Mark as well as the goods listed from (1) to (6) in the application for the Mark.

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

[74] 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.

[75] The Applicant does not dispute that the trade-marks at issue are identical. Still, the Applicant contends that “this should not be the determining factor in the present opposition” because the present case is similar to the circumstances found in *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD), aff’d (1993) 49 CPR (3d) 217 (FCA), where the trade-mark K.C. MASTERPIECE & Design applied for registration in association barbeque sauce was held to be not confusing with the trade-mark MASTERPIECE for cake and chocolate.

[76] In that regard, the Applicant argued that in the *Clorox Co* case, the Federal Court accorded little weight to the trade-marks resemblance, or to the fact that they were both used in the same general category. Suffice it to say that I agree with the Opponent that the *Clorox Co* case is distinguishable from the present case, if only because the trade-marks in that case were not identical.

[77] As there are no differences between the trade-marks at issue, I find that the section 6(5)(e) factor significantly favours the Opponent.

Additional surrounding circumstances

[78] Both in written and oral arguments, the Applicant submitted that the following additional surrounding circumstances should be given significant weight in the confusion analysis: 1) the

Opponent's use of the THE BIG ONE in association with time limited promotional services, rather than retail services; and 2) the Opponent's "longstanding and very consistent practice" of displaying THE BIG ONE in conjunction with its trade-mark THE BRICK (or BRICK-formative marks).

[79] At this juncture, I do not see any need for a lengthy discussion of the first additional surrounding circumstance advanced by the Applicant. For one thing, I already found that the Opponent has shown its use of the trade-mark THE BIG ONE in association with retail stores services within the meaning of the Act. Furthermore, I have already addressed the Applicant's submissions concerning the Opponent's use of the trade-mark THE BIG ONE only once a year, including in the consideration of the extent to which it had become known at the relevant date.

[80] To the extent that the Applicant seems to argue that THE BIG ONE has been used by the Opponent as a secondary mark, I stress that the Act does not distinguish between primary and secondary marks [see *Groupe Procycle Inc v Chrysler Group LLC*, 2010 FC 918, 87 CPR (4th) 123].

[81] I have previously acknowledged that where THE BIG ONE appears in advertising and promotional material for THE BRICK Stores, it often but not always appears in proximity to the trade-mark THE BRICK (or BRICK-formative marks). Nonetheless, I do not agree with the Applicant's suggestion that this circumstance by itself must lead to a finding of no likelihood of confusion. In other words, the Applicant did not convince me that this additional circumstance outweighs all of the other surrounding circumstances of this case favouring the Opponent.

Conclusion on the likelihood of confusion

[82] 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.

[83] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors enumerated at section 6(5) of the Act and their relative importance, I am not satisfied that the Applicant has discharged its legal onus of establishing that, as of January 31, 2011, there was no reasonable likelihood of confusion

between the Mark in association with the Applicant's services and goods (1) to (6) listed in the application for the Mark and the Opponent's trade-mark THE BIG ONE in association with "*retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners*".

[84] I am also not satisfied that the Applicant has discharged its legal onus of establishing that, as of January 31, 2011, there was no reasonable likelihood of confusion between the Mark in association with the Applicant's goods (7) to (9) listed in the application for the Mark and the Opponent's trade-mark THE BIG ONE in association with the aforementioned retail store services. Indeed, despite my finding that these goods do not overlap with the Opponent's retail store services, when I factor in the other circumstances enumerated at section 6(5) of the Act, at best for the Applicant I find that there is an even balance of probabilities between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that, as of January 31, 2011, there was no reasonable likelihood of confusion between the parties' trade-marks, I must decide against the Applicant.

[85] Accordingly, the non-entitlement ground of opposition is successful.

Was the Mark distinctive of the Applicant's goods and services as of the filing date of the statement of opposition?

[86] This issue arises from the second ground of opposition alleging that the Mark is not distinctive under section 2 of the Act in that it does not distinguish, nor it is adapted to distinguish the Applicant's goods and services from the services of the Opponent, by reason of the advertising, use and reputation of the Opponent's trade-mark THE BIG ONE.

[87] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[88] As with the non-entitlement ground of opposition, I find that considering the use of THE BIG ONE by the Opponent in association with “*retail store services associated with selling furniture, home furnishings, mattresses, box springs, bedding, household appliances, televisions, audio and video equipment, consumer electronics, barbecues and air conditioners*” will be sufficient to decide the issue.

[89] However, contrary to the non-entitlement ground of opposition where the Opponent only had to show prior use of its alleged trade-mark pursuant to section 4(2) of the Act, here the Opponent has to show that its alleged trade-mark, as of March 14, 2012, had a substantial, significant or sufficient reputation in Canada in association with its retail services so as to negate the distinctiveness of the Mark. Accordingly, the Applicant’s contention that the use of the trade-mark THE BIG ONE only once a year and for a limited period of time each year is insufficient to show that the Opponent had established a reputation in the trade-mark THE BIG ONE has more merit under the non-distinctiveness ground of opposition.

[90] When assessing the section 6(5)(a) factor under the non-entitlement ground of opposition, I found that there was sufficient evidence for me to conclude that the Opponent’s trade-mark had become known to some extent throughout Canada. However, the question remains whether the affidavit of Mr. Comrie is sufficient to establish that, as of March 14, 2012, the reputation of the trade-mark THE BIG ONE in Canada was substantial, significant or sufficient so as to negate the distinctiveness of the Mark. That being said, I find that it is unnecessary to answer this question.

[91] Indeed, even if I were to find that the Opponent has not met its evidentiary burden, and thus dismiss the non-distinctiveness ground of opposition, the opposition would still succeed under the non-entitlement ground of opposition. If I were to find that the Opponent has met its evidentiary burden, the difference in material dates would not impact my previous analysis of the surrounding circumstances of this case. Thus, the outcome of the non-distinctiveness ground of opposition would be the same that the outcome of the non-entitlement ground of opposition.

Disposition

[92] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

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

Hearing Date: 2015-05-13

Appearances

Christopher P. Brett For the Opponent

Alexander Sarabura For the Applicant

Agents of Record

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