

IN THE MATTER OF AN OPPOSITION by  
C. & J. Clark International Limited to application  
No. 857,097 for the trade-mark ALTREKS filed  
by Leisure Time Distributors Ltd. (now known as  
ROI Recreation Outfitters Incorporated)

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On September 24, 1997, the applicant, Leisure Time Distributors Ltd., filed an application to register the trade-mark ALTREKS based on proposed use of the mark in Canada by either itself or a licensee. The applicant subsequently changed its name to ROI Recreation Outfitters Incorporated. The application was advertised for opposition purposes on March 25, 1998. The application as advertised covers the following wares: “Footwear, namely boots and shoes”. C. & J. Clark International Limited filed a statement of opposition on August 25, 1998, a copy of which was forwarded to the applicant on September 25, 1998.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (“the Act”) because it is confusing with the trade-marks TREK & Design (shown below), registered under No. TMA 192,125 for use in association with “footwear, namely boots, shoes and slippers” and NATURE TREK, registered under No. TMA 235,655 for use in association with “boots and shoes”.



The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act, because, as of the applicant’s date of filing,

the applied for mark was confusing with the opponent's above noted trade-marks which had been previously used in Canada. The final ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks TREK and NATURE TREK. In this regard, the opponent submits that it and its predecessor-in-title, have used TREK and NATURE TREK as trade-marks in Canada for several years in association with "footwear, namely boots, shoes, and slippers" and "boots and shoes" respectively. Given the long history of use of the opponent's marks, the opponent submits that confusion would be quite likely as the applicant's wares would be sold through the same channels of trade.

The applicant filed a served a counter statement. The opponent's Rule 41 evidence consists of the affidavit of Mr. Eli Boles, Controller of C. & J. Clark Canada, a subsidiary of the opponent. The applicant's Rule 42 evidence comprises the affidavit of Lynda Maureen Palmer, independent trade-mark searcher. Only the opponent filed a written argument and an oral hearing was not conducted.

### The Opponent's Evidence

In his affidavit, Mr. Boles explains that he is the Controller of C. & J. Clark Canada ("Clark Canada"), a fully owned subsidiary of the opponent, C. & J. Clark Canada International Limited ("Clark International"). Clark Canada carries on business importing, selling, distributing and marketing in Canada footwear emanating from or authorized by Clark International.

Mr. Boles states at paragraphs 7 and 8 of his affidavit that the trade-mark TREK & Design has been used in Canada since at least as early as August 1971 in association with "footwear, namely boots, shoes, and slippers" and the trade-mark NATURE TREK was first used in Canada in the late 1970's in association with "boots and shoes". Attached as Exhibits A and B

to his affidavit are copies of registrations with respect to these trade-marks.

At paragraph 9 of his affidavit, Mr. Boles shows sales in Canada of Clark Canada footwear sold in association with the “TREK” marks to have exceeded \$1,000,000 for each of the years between 1994 and 1998. He explains that the accounting system allows segregation between footwear sold in association with the TREK trade-marks and the other footwear sold or distributed by Clark Canada. Attached as Exhibit C to his affidavit is representative publicity and promotional material relating to footwear which Mr. Boles states was sold in association with the TREK trade-marks. Mr. Boles explains that this material is representative only and certainly not exhaustive of the kind of material so used in Canada since 1990 of the Clark International footwear sold in Canada in association with the TREK trade-marks. I note that in the representative material submitted by Mr. Boles, there is no use shown of either the opponent’s TREK and Design mark or the opponent’s NATURE TREK mark in association with footwear. What is shown is the appearance of the mark TREK as a component of other marks used in association with footwear in a copy of a 1997 Clarks England catalogue and in an original 1999 Clarks England catalogue.

### The Applicant’s Evidence

Ms. Palmer states that she carried out an investigation of the records in the Canadian Trade-Marks Office on May 25, 1999, to ascertain the State of the Register as regards extant trade-marks consisting of or involving the word TREK in the footwear field. Attached as Exhibit A to her affidavit are the results of her search. Of the applications and registrations found by Ms. Palmer, there were only 3 third party registrations for marks incorporating the word TREK for footwear and 4 third party applications for similar marks, 3 of which appeared to be in opposition.

## The Grounds of Opposition

Each of the grounds of opposition turn on the issue of confusion between the applicant's mark ALTREKS and the opponent's marks TREK and Design and NATURE TREK, as registered and previously used in Canada in association with footwear. The material date for the Section 12(1)(d) ground of opposition is the date of my decision (see Park Avenue Furniture Corporation v. Wickes/ Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)), while the material dates for assessing the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's filing date (i.e. September 24, 1997) and the date of opposition (i.e. August 25, 1998). In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including, but not limited to, the criteria which are specifically enumerated in s.6(5) of the Act. Further, the Registrar must bear in mind the legal burden is on the applicant to establish that there would no reasonable likelihood of confusion between the trade-marks of the parties as of the material dates noted above.

As for Section 6(5)(a) of the Act, none of the marks at issue possess a high degree of inherent distinctiveness when used in association with footwear because they each suggest that the wares are designed for walking or hiking. The applicant's mark possesses a slightly higher degree of inherent distinctiveness than both of the opponent's marks, however, because it is a coined word.

With respect to the extent to which the trade-marks have become known, Mr. Boles provides sales figures of footwear sold under the opponent's "TREK marks" exceeding \$1,000,000 for each of the years between 1994 and 1998. Although Mr. Boles states that his company's accounting system allows segregation between the footwear sold in association with

the TREK trade-marks and the other footwear sold or distributed by Clark Canada, he does not explain whether the “TREK marks” he is referring to include other TREK marks of the opponent. Given that the publicity and promotional material alleging to relate to footwear sold in association with and depicting the opponent’s TREK marks does not show use of either of the opponent’s registered TREK marks, but instead shows use of other TREK marks in association with footwear, it is questionable whether the sales figures provided by Mr. Boles only relate to the opponent’s registered TREK marks. In any event, as the opponent’s evidence was not contradicted, I am prepared to find that the opponent’s marks have become known to some extent in Canada. As the applicant has provided no evidence of acquired distinctiveness of its mark, this factor favours the opponent.

With respect to s.6(5)(b) of the Act, the opponent’s marks have been used in Canada since as early as August 1971, and the late 1970's respectively, while the applicant’s mark is based on proposed use and the applicant has filed no evidence of use of its mark. This factor therefore favours the opponent.

With respect to the parties’ wares (s.6(5)(c)) and channels of trade (s.6(5)(d)), as the wares of the parties are the same, I would expect that the parties’ channels of trade would overlap.

As for s.6(5)(e) of the Act, the opponent’s NATURE TREK mark and the applicant’s ALTREKS mark bear some degree of similarity in appearance and sounding because both of them include the component TREK. Although the opponent’s TREK and Design mark also includes the component TREK, I consider the degree of visual resemblance between it and the applicant’s mark to be less because of its distinctive design component. With respect to the ideas suggested by the marks, although they are similar insofar as each of the marks suggest the idea of

walking or hiking, the applicant's ALTREKS mark suggests the idea of "all purpose" hiking or walking while the opponent's TREK and Design mark simply suggests the idea of hiking or walking and the opponent's NATURE TREK mark suggests the idea of walking or hiking in a natural environment.

As a further surrounding circumstance, I have considered the applicant's state of the register evidence. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R. (3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R. (3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R. (3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

The Palmer affidavit evidences 3 third party registrations for marks incorporating the word TREK for footwear and 4 third party applications for similar marks, 3 of which appear to have been in opposition at the time Ms. Palmer's search was conducted. In my view, the existence of three registrations, and less than four applications, without any evidence of use in the marketplace, is insufficient to allow any conclusions to be made about possible common adoption of such marks in the marketplace.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and in particular to the fact that there is some degree of similarity between the trade-marks at issue as applied to identical wares which could travel through the same channels of trade, I find that the applicant has failed to meet

the legal burden upon it in respect of the issue of confusion. Consequently, the applicant's trade-mark ALTREKS is not registrable and not distinctive, and the applicant is not the person entitled to its registration.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 27th DAY OF March, 2002.

C. R. Folz  
Member,  
Trade-Marks Opposition Board