

**IN THE MATTER OF AN OPPOSITION by McGregor
Industries Inc. to application No. 742,142 for the trade-mark
THE COMFORT SOCK filed by Simcan Enterprises Inc.**

On December 2, 1993, the applicant, Simcan Enterprises Inc., filed an application to register the trade-mark THE COMFORT SOCK based upon use of the trade-mark in Canada in association with “socks” since at least as early as October 12, 1993. The applicant disclaimed the right to the exclusive use of the word SOCK apart from its trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of June 22, 1994 and the opponent, McGregor Industries Inc., filed a statement of opposition on November 22, 1994, a copy of which was forwarded to the applicant on February 6, 1995. The applicant filed and served a counter statement on March 24, 1995 in which it generally denied the opponent’s grounds of opposition. The opponent filed as its evidence the affidavit of Abbey Lipson while the applicant submitted as its evidence the affidavit of James Simmons. Both Mr. Lipson and Mr. Simmons were cross-examined on their respective affidavits, the transcripts of the cross-examinations and the exhibits thereto, as well as the responses to undertakings given during the Simmons cross-examination, forming part of the opposition record. Additionally, the opponent requested and was granted leave pursuant to Rule 44(1) of the *Trade-marks Regulations* to submit the affidavit of Jordan Lipson as further evidence in this opposition. Both parties filed a written argument and both were represented at an oral hearing.

The first ground of opposition is based on Subsection 30(b) of the *Trade-marks Act*, the opponent alleging that the trade-mark has not been used in Canada by the applicant since October 12, 1993 as alleged in the present application. The legal burden or onus is on the applicant to show that its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. Further, to the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an evidential burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential

burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Moreover, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475]. Furthermore, the evidentiary burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b) of the *Act* is a light one [see *Tune Masters v. Mr. P's Mastertune*, 10 C.P.R.(3d) 84, at p. 89].

The opponent has argued that the label annexed as exhibit A to the Simmons affidavit, a representation of which appears below, does not show use of the trade-mark THE COMFORT SOCK and therefore the applicant has not used its trade-mark since the claimed date of first use, or at all.

The word THE appears in a smaller size lettering and is in lower case lettering whereas the words COMFORT SOCK appear in larger size capital letters. While the word THE adds little, if any,

inherent distinctiveness to the mark, I am of the view that the average consumer would likely perceive the mark THE COMFORT SOCK as used as creating a unitary impression in that the word THE bears no other significance separate and apart from the words COMFORT SOCK. I have therefore rejected the first ground of opposition.

The opponent next alleged that the applicant's trade-mark THE COMFORT SOCK is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* since the trade-mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares. Paragraph 12(1)(b) of the *Act* provides as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the trade-mark THE COMFORT SOCK is clearly descriptive of the character or quality of the applicant's socks must be considered from the point of view of the average consumer of those wares. Further, in determining whether the trade-mark THE COMFORT SOCK is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

While the legal burden is upon the applicant to show that its trade-mark is registrable, there is an initial evidential burden upon the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of the allegations that the trade-mark THE COMFORT SOCK is clearly descriptive or deceptively of the character or quality of the applicant's wares. Further, the opponent may rely upon the Simmons affidavit and the transcript of the Simmons cross-examination to meet its evidential burden.

The opponent disclaimed the right to the exclusive use of the word SOCK, the name of the applicant's wares, apart from its trade-mark. Further, the opponent referred to the transcript of the Simmons cross-examination and, in particular, to questions 69 to 71 and 169 to 173 and the accompanying responses concerning the significance of the word COMFORT and the words COMFORT SOCK together. As well, to meet its evidential burden, the opponent relied upon the following questions and answers appearing in the transcript of the cross-examination of James Simmons on his affidavit:

177. Q. Right, but it certainly was intended to provide comfort wasn't it?

A. I think the fact that we've included the name within the ... the word within the name bespeaks to that.

178. Q. Well, I don't think it necessarily does, so I'm asking you to agree or disagree with me on that. It was intended to provide comfort wasn't it?

A. What was intended to provide comfort?

179. Q. The sock.

A. The sock was intended to provide comfort.

....

186. MR. FARFAN: Q. You don't agree with me that if you put the words comfort and sock together that they tell you that this is a sock that provides comfort.

A. If you put the words comfort and sock together than I need to agree with you, yes, one would believe that the product is a sock that provides comfort.

In addition to the foregoing, the exhibits to the affidavit of Abbey Lipson include reference to the following phrases and marks when referring to the opponent's hosiery in either its labels or its packaging, or in advertising and promotional materials which refer to the opponent's hosiery:

CUSHION SOLE for HEALTH & COMFORT

NEW COMFY CUSHION TOP

The Original CUSHIONED COMFORT

CUSHION COMFORT

The Original CUSHION COMFORT

LASTING COMFORT

The PATENTED SOFT WOOL AND NYLON INNER SOLE PROVIDES REAL

CUSHIONED FOOT COMFORT

Smoother Comfort!

In cushioned comfort and style

The soft, feather-like Cushion sole and the nylon and wool inner lined from top to toe, not only add to its unusual wearing qualities and comfort, but also guarantee it to be shrink resistant.

CUSHIONED Comfort! The Original Cushioned Comfort!

What comfort! What value!

GREATER COMFORT

THE MOST COMFORTABLE SOCKS YOU CAN WEAR!

One of Canada's best selling and most popular socks, Happy Foot Health Socks are knitted for carpet-like comfort to make your walking at home, on the street, or in the office, a real pleasure. There's more comfort in Happy Foot Health Socks by McGregor.

Put your best foot forward in comfort and style with McGregor hosiery for men and boys.

HAPPY FOOT HEALTH SOCKS delivers solid comfort always!

Cushioned Comfort

... You'll hear them say that McGregor Socks are tops for comfort, for style, for value.

FOR COMFORT FOR STYLE FOR VALUE

HAPPY FOOT HEALTH SOCKS deliver solid comfort - always!

... YOU'LL SEE WHAT COMFORT MEANS.

See the soft "Comfy cushion top" - complete comfort always

"Go easy" on cushioned soles in famous comfort-designed "HAPPY FOOT" socks.

50 years of comfort

THE ORIGINAL CUSHION SOLE COMFORT SOCK

MILLIONS OF GRATEFUL FEET ENJOY THE CUSHIONED COMFORT OF HAPPY FOOT EVERY DAY

Having regard to the extracts from the transcript of the Simmons cross-examination referred to above, as well as to the exhibits to the Lipson affidavit, it appears that the words COMFORT SOCK are descriptive of the character of the applicant's socks. Moreover, the addition of the word THE tends to emphasize this conclusion by imparting a laudatory connotation to the applicant's trade-mark THE COMFORT SOCK when considered in its entirety. I have concluded therefore that the opponent has met its evidential burden in relation to the Paragraph 12(1)(b) ground of opposition by showing that the applicant's trade-mark THE COMFORT SOCK might well be perceived by the average consumer as describing a sock that provides comfort to the wearer. Accordingly, the legal burden is upon the applicant to satisfy the Registrar that its trade-mark is registrable.

To determine whether the applicant has met the legal burden upon it in respect of the second ground, it is necessary to consider the affidavit of James Simmons filed by the applicant in support of its application. In this regard, James Simmons, President of the applicant, states that the applicant has continuously sold socks in association with its trade-mark THE COMFORT SOCK in Canada

since October 12, 1993 and has annexed to his affidavit what he describes as specimen packaging showing use of the trade-mark THE COMFORT SOCK. Mr. Simmons has identified the annual sales of socks bearing the trade-mark THE COMFORT SOCK from 1993 to August of 1996 inclusive, the total being in excess of \$72,000. However, even accepting that the applicant's evidence shows use of its trade-mark THE COMFORT SOCK in association with socks, I am not convinced that the dollar value or related volume of sales of the applicant's socks establishes that the applicant's mark has become known to any measurable extent in Canada.

In assessing the Paragraph 12(1)(b) ground, I have also considered whether or not other traders in the hosiery industry would likely wish to use the mark THE COMFORT SOCK to describe their hosiery. In my view, the opponent's evidence certainly points to the use of the word "comfort" for several years in referring to its socks, as well as establishing that it adopted and applied the mark THE ORIGINAL CUSHION SOLE COMFORT SOCK to its socks. Accordingly, I am satisfied that other traders might well wish to use descriptive phrases similar to the applicant's mark in referring to their hosiery.

The applicant submitted that the decision of Board Member Herzig in *Quaker Oats Co. of Canada v. Absopure Water Co.*, 61 C.P.R. (3d) 537 supports its position that its trade-mark THE COMFORT SOCK is not clearly descriptive of its wares. The *Quaker Oats* case related to the trade-mark THE HYDRATION DRINK as applied to "drinking water" and, at pages 539-540 of the reported decision, Board Member Herzig commented as follows:

In my view, the evidence does not support the conclusion that the phrase "the hydration drink" clearly describes the character or quality of drinking water, or its effect. The mark does not, for example, describe any level of constituents that might be present in water, or describe any specific hydration state. In my view, the mark is a coined phrase suggesting that drinking the opponent's water will raise or maintain the hydration state of the body at a desirable level. Of course, a mark may be suggestive without being clearly descriptive. I find some similarities between this case and the PIZZA PIZZA case decided by Mr. Justice Rouleau, reported at *Pizza Pizza Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 202, 19 B.L.R. 305 (F.C.T.D.), where Mr. Justice Rouleau stated as follows, at pp. 203-4:

The expression "pizza pizza" is not a linguistic construction that is a part of normally acceptable spoken or written English. Duplication is well-established as a method of naming commercial firms, and in my opinion, repetition of a word has become well-established, accepted and understood as indicating trade names or trade marks of commercial enterprises.

The applicant's approach is not to promote the purchase of pizza in

general, but their client's products, from specific outlets, persuading the consumer that the applicant is distinctive and identifiable by this trade name. They have in fact "coined" a phrase. The court is satisfied that the proposed trade mark, having no specific descriptive connotation, is capable of distinguishing the wares of the respondent from the wares of others. The words "pizza pizza" together do not go together in a natural way and the court is satisfied that they do not have a descriptive meaning. The words are capable of acquiring the specified meaning as a trade mark.

Similarly, in the instant case, the expression "the hydration drink" is not a linguistic construction that is part of normally accepted spoken or written English. The words "the hydration drink" do not go together in a natural way. In view of the foregoing, the first ground of opposition is rejected.

There is no evidence to support the second ground of opposition that the applied-for mark is the name of the wares. In any event, such a finding would be inconsistent with my finding that the applicant has coined a phrase. Accordingly, the second ground is rejected. As the third ground is dependant on a favourable finding on either of the preceding grounds, it too is rejected.

In the present case, the opponent's adoption of its mark THE ORIGINAL CUSHION SOLE COMFORT SOCK, whether as a trade-mark or otherwise, supports the conclusion that the applicant's trade-mark THE COMFORT SOCK is not so unusual a construction of the English language that it would not be adopted and used by other traders in the hosiery industry. Furthermore, in *Harvey Woods Ltd. et al. v. Sanitized Process (Canada) Ltd.*, 15 C.P.R. (3d) 342, an opposition to register the certification marks THE DEODORANT SOCK for "hosiery" and DEODORANT UNDERWEAR for "underwear", Board Member Martin commented as follows at page 346 of the reported decision:

"As for the second ground of opposition in each case, I agree with the opponents' contention that each of the applied for trade marks is clearly descriptive of the character (and possibly quality) of the associated wares. However, the applicant, in each case, claimed and was accorded the benefit of s. 14 of the Act and this effectively eliminates the opponents' second ground of opposition."

In view of the above, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the Paragraph 12(1)(b) ground. Moreover, the applicant's evidence does not establish that the applicant's trade-mark THE COMFORT SOCK is registrable in view of Subsection 12(2) of the *Trade-marks Act*.

As its third ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark THE COMFORT SOCK in view of the prior use by the opponent of several trade-marks including the trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK in association with hosiery. The opponent has, by way of the affidavits of Abbey Lipson and

Jordan Lipson, established that it has used the trade-mark in Canada in association with socks since August 31, 1993 by virtue of the sale of socks by the opponent to The Primary Layer, a division of Norm Thompson Inc., of Portland, Oregon, United States of America. The details relating to this transaction are outlined in the affidavit of Jordan Lipson and that affidavit was not challenged by way of cross-examination by the applicant. As noted in paragraph 11 of the Jordan Lipson affidavit, the packing slip noted that this was a “SPECIAL ORDER - APPROVED BY JORDAN LIPSON” because this was the first time the opponent was shipping the product with the new labels bearing the mark THE ORIGINAL CUSHION SOLE COMFORT SOCK and because it was being shipped directly by the opponent to the customer rather than effecting the transaction through the opponent’s wholly-owned subsidiary, American Essentials Inc., which is located in New York and which has handled the opponent’s business in the United States since July 1, 1988.

The label associated with the socks which were shipped to The Primary Layer, a photocopy of which is annexed to both Lipson affidavits, shows the manner of use by the opponent of the trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK in association with socks. Furthermore, having regard to the provisions of Subsection 4(3) of the *Trade-marks Act*, the August 31, 1993 transaction described in the Lipson affidavits constitutes use of the trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK in Canada in association with socks. The applicant submitted that my decision in *Redsand Inc. v. Thrifty Riding and Sports Shop Ltd.*, 66 C.P.R. (3d) 250 was authority for the proposition that an opponent would not meet its evidential burden with respect to an allegation of non-entitlement by merely filing evidence of prior use in association with export sales. In the *Redsand Inc.* case, the opponent, situated in California, submitted evidence of three invoices relating to sales of its wares to a company located in Vancouver, B.C. and sought to rely upon the transactions as showing use of its trade-marks REDSAND and REDSAND & Design in Canada within the scope of Subsection 4(1) of the *Act*. This decision is of no relevance whatsoever to the interpretation of Subsection 4(3) of the *Trade-marks Act*.

Abbey Lipson states in paragraph 10 of his affidavit that since the August 31, 1993 transaction, the opponent has expanded its sales and use of the new label and has developed similar

labels emphasizing the trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK. Having regard to the opponent's evidence, I am satisfied that the opponent has met its burden under Subsections 16(5) and 17(1) of the *Trade-marks Act* of establishing its prior use of the trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK in Canada, as well as showing that it had not abandoned the mark as of the date of advertisement of the present application in the *Trade-marks Journal* [June 22, 1994]. Consequently, the legal burden is upon the applicant to establishing that there would be no reasonable likelihood of confusion between its trade-mark THE COMFORT SOCK and the opponent's trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK as of the applicant's claimed date of first use [October 12, 1993], the material date for considering the Paragraph 16(1)(a) ground. 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 those which are specifically enumerated in Subsection 6(5) of the *Act*.

The applicant's trade-mark THE COMFORT SOCK is clearly descriptive when applied to socks and therefore possesses little, if any, inherent distinctiveness. The opponent's trade-mark THE ORIGINAL CUSHION SOLE COMFORT SOCK is highly suggestive if not descriptive of its wares and it too possesses little inherent distinctiveness. As of the applicant's date of first use, neither of the trade-marks had become known in Canada. Likewise, the length of time the trade-marks had been in use as of the material date is not a particularly relevant surrounding circumstance in the present case. The wares of the parties are identical and, as there is no limitation in the channels of trade associated with the wares covered in the present application, it must be assumed that the channels of trade of the parties could potentially overlap. The trade-marks are similar in appearance and in sounding, as well as in the ideas suggested. Moreover, as a further surrounding circumstance in respect of the issue of confusion, the opponent has shown that it has used a number of marks and phrases over many years which include the word COMFORT in referring to its socks. Having regard to the degree of resemblance between the trade-marks at issue as applied to identical wares which could travel through the same channels of trade, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. Thus, this ground of opposition is also successful.

In view of the above, I do not propose to consider the final ground relating to the alleged non-distinctiveness of the applicant's trade-mark as it too would likely be successful. Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 25th DAY OF NOVEMBER, 1998.

G.W. Partington
Chairperson
Trade Marks Opposition Board