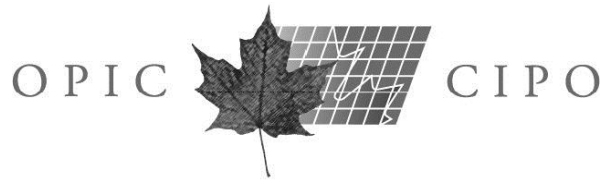


TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 155
Date of Decision: 2011-09-02

**IN THE MATTER OF AN OPPOSITION
by Nada Fashion Designs Inc. to
application No. 1,343,300 for the trade-
mark NO NADA & Design in the name of
Groupe Boyz Inc.**

The pleadings

[1] On July 13, 2007, Les Boxers Boyz Inc. (Boxers) filed an application for the registration of the trade-mark NO DADA & design, as illustrated below, based on proposed use:

 (the Mark).

[2] The Applicant is currently identified in the Register as Groupe Boyz Inc., as a result of Boxers having changed its name. I will refer to Boxers and/or Groupe Boyz Inc. without distinction as “the Applicant”.

[3] The Applicant amended its application for registration on July 17, 2008, such that the statement of wares now reads as follows:

[TRANSLATION] Clothing for children, namely t-shirts, jogging suits, fleece tops and pants, pants, dresses, skirts, sweaters, shirts, jackets, jumpsuits,

jumpers, sleepers, overalls, blouses, pyjamas, nightgowns, bathrobes, shorts, Bermuda shorts, underwear, boxer shorts, camisoles, tights, stockings, socks, rompers, snowsuits, tuques, scarves, belts, mittens, gloves, bathing suits, coats, raincoats, waterproof jackets, bomber jackets and hats (the Wares).

[4] This application was published for opposition purposes in the *Trade-marks Journal* on December 26, 2007. On April 28, 2008, Nada Fashion Designs Inc. (the Opponent) filed a statement of opposition, which the Registrar forwarded to the Applicant on May 27, 2008. On July 25, 2008, the Applicant filed a counter statement essentially denying all of the grounds of opposition described below.

[5] In support of the grounds of opposition described below, the Opponent filed as evidence the affidavit of Nada Shephred, the certificates of authenticity for the registered trade-marks and the application for registration No. 1,363,611. It also filed a copy of this file. For its evidence, the Applicant filed the affidavit of Nérée Arsenault. The parties filed written arguments and were represented at the oral hearing.

The grounds of opposition

[6] The grounds of opposition pleaded may be summarized as follows:

- 1) The application for registration does not comply with the requirements of section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), in that the Applicant could not state that it was satisfied that it was entitled to use the Mark in Canada in association with the Wares because of the existence of the Opponent's registered marks, its unregistered marks and its trade-names, as described in greater detail below;
- 2) The Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the following registered marks of the Opponent:

NADA, certificate of registration No. TMA 565.840 for jewellery;
NADA NUFF, certificate of registration No. TMA 478.859 for clothing;
- 3) The Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent's registered trade-marks listed above and with the mark NADA applied for in application for registration No. 1,363,611, based on use since

March 2002 in association with, among other things, clothing and accessories such as shoes, belts, gloves sandals and hats, all previously used and/or made known in Canada by the Opponent and/or its predecessors in title;

- 4) The Applicant is not the person entitled to registration of the Mark under section 16(3)(b) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent's registered trade-marks for which the Opponent's predecessors in title had applied for registration in Canada;
- 5) The Applicant is not the person entitled to registration of the Mark under section 16(3)(c) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent's trade-names Nada Fashion Designs Inc. and/or Nada, which were previously used in Canada by the Opponent and/or its predecessors in title.
- 6) The Mark is not distinctive within the meaning of section 2 of the Act because it does not actually distinguish and is not adapted to distinguish the Wares from the Opponent's wares and services.

Burden of proof

[7] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent meets this requirement, the burden of proof shifts to the Applicant, who must satisfy the Registrar, on the balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

Grounds of opposition summarily dismissed

[8] The first ground of opposition, as worded, is not a ground of opposition in itself. Section 30(i) of the Act does not require the Applicant to state that it is satisfied that it is entitled to register the Mark. This statement appears in the application for registration.

The alleged existence of the Opponent's trade-marks and trade-names is by itself not enough to sustain a ground of opposition under section 30(i) of the Act. This section could for example be used as a basis for a ground of opposition where bad faith on the part of the Applicant is argued [see *Sapodilla Co. Ltd. c. Bristol Myers Co.* (1974), 15 C.P.R. (2d) 152]. The first ground of opposition is therefore dismissed.

[9] As regards the fourth ground of opposition, section 16(4) of the Act provides that the applications for registration on which the Opponent relies must be pending at the date of advertisement of the application for registration of the Mark (December 26, 2007). However, this is not the case, as the certificate of registration No. TMA478,859 for the mark NADA NUFF was issued on July 23, 1997, while the certificate of registration No. TMA565,840 for the mark NADA was issued on August 15, 2002. Thus, this ground of opposition is dismissed as well.

Ground of opposition under section 16(3)(a) of the Act

[10] The relevant date for analyzing this ground of opposition is the filing date of the application for registration (April 13, 2007) [see section 16(3) of the Act].

[11] The Opponent has the initial burden of proving previous use of its trade-mark or marks and that it had not abandoned this use at the date of advertisement of this application for registration [see section 16(5) of the Act]. For the purposes of this ground of opposition, I find that the Opponent has a greater chance of succeeding with the mark NADA, which was allegedly used in association with clothing and accessories. Thus, should I conclude that the Opponent has discharged its initial burden of proof and that, on a balance of probabilities, there is no risk of confusion between the Mark and the mark NADA, there would be no risk of confusion between the Mark and the mark NADA NUFF either.

[12] To avoid any ambiguity as to the legal basis for this ground of opposition, I would point out that the Opponent has clearly identified the trade-mark NADA in support of this ground by referring to its application for registration No. 1,363,611 for the mark NADA.

However, under section 16(3)(a) of the Act, it is not the application for registration in itself that is the basis for this ground, but the previous use of this trade-mark.

[13] Ms. Shephred is president of the Opponent. She explains that the Opponent was incorporated on December 31, 2002. The Opponent is the successor in title to Ms. Shephred, who did business under the company name NADA, registered on April 20, 2001. She filed a copy of the relevant documents attesting to this.

[14] The Opponent and its predecessor in title are in the business of designing, manufacturing, selling and offering clothing, handbags, jewellery and related items in association with the trade-mark NADA since at least as early as 2001.

[15] Generally speaking, direct sales are made to consumers after the consumers have seen the wares bearing the mark NADA on the Opponent's Web site, in fashion shows, on television or in newspaper advertisements, or after having heard about them by word of mouth.

[16] Ms. Shephred described the Opponent's future intentions regarding new business activities. These allegations are not relevant to this ground of opposition.

[17] She submits that each ware sold by her business between 2001 and 2008 bore a tag with "NADA" written on it. She filed an invoice from November 2001 for the tags bearing the mark NADA. I note that this invoice was issued to "Nada", the company name used by Ms. Shephred before the Opponent was incorporated.

[18] She filed the oldest sales invoice she could find for clothing bearing the mark NADA, which invoice is dated March 8, 2002. However, the Applicant notes that there is no reference to the mark NADA on the invoice. She also filed in a bundle (Exhibit 11) specimens of invoices to illustrate the sale of wares bearing the mark NADA. The Opponent argues that most of these invoices make no reference whatsoever to the mark NADA. I note that from September 2006 onward, the invoices refer to the Mark or the company name Nada.

[19] She filed advertising materials used to promote sales of wares bearing the mark NADA between 2002 and March 2007, as well as other specimens of such material distributed in Canada between April 2007 and November 2008 (date of her affidavit).

[20] She explains that the Opponent periodically organizes fashion shows in which clothing bearing the mark NADA is presented using models. Such shows are expensive events. For example, a fashion show held in September 2004 cost at least \$15,000, while another in October 2008 allegedly cost approximately \$25,000.

[21] She submits that the Opponent was one of the four finalists in a televised competition, the 2004 TFI New Labels Fashion Design competition. She alleges that the broadcast was seen by thousands of viewers, but this is hearsay. However, she did file two articles about this competition, one published in the *National Post* (March 2004) and another in *Elle Canada* (undated).

[22] She filed copies of articles about the clothing collection bearing the mark NADA that were published in the magazines *Flare* and *NOW* before the relevant date (see Exhibit 37). However, there is no evidence that these magazines have a circulation in Canada.

[23] The rest of the evidence in Ms. Shephred's affidavit concerns events that occurred after the relevant date associated with this ground of opposition. However, I would like to refer to some of those pieces of evidence because they show that the Opponent had not abandoned the use of its mark NADA at the date of advertisement of this application for registration.

[24] Since September 2006, the Opponent has been taking part in trade fairs during which clothes bearing the mark NADA were exhibited. These clothes were also presented at the third edition of L'Oréal Fashion Week, in March 2007. Ms. Shephred filed an excerpt from this event's Web site in which the mark NADA can be seen in the background.

[25] On October 23, 2007, the Opponent took part in a subsequent edition of the same event. To show this, Ms. Shephred filed an article published on the Internet, as well as photographs found on the Web site of the newspaper *The Toronto Star*.

[26] The Applicant criticized some items of the ample evidence. It argued that there is no proof that the tags bearing the mark NADA were ever affixed to the Opponent's clothes. Furthermore, the Applicant argued that there is no mention of the mark NADA on the first invoices filed. The exhibits filed by Ms. Shephred complement the allegations in her affidavit. At paragraph 40 of her affidavit, Ms. Shephred clearly states that the tags were affixed to the items of clothing sold. This allegation must be read in conjunction with the filing of an invoice from November 2001 proving the purchase of tags bearing the mark NADA, as well as the filing of one of these tags [see Exhibit 8]. As regards the first invoices filed, the affiant states at paragraph 41 that they were for hats bearing the mark NADA. There was nothing preventing the Applicant from cross-examining Ms. Shephred on these allegations if it found them somewhat ambiguous.

[27] On the basis of this evidence, I conclude that the Opponent has discharged its initial burden of proof regarding previous use in Canada of its trade-mark NADA in association with clothing and accessories, and that the Opponent had not abandoned this use at December 26, 2007.

[28] The onus is now therefore on the Applicant to prove, on a balance of probabilities, that the Mark was not confusing with the trade-mark NADA at the date of filing of its application for registration.

[29] The applicable test in this case is described at section 6(2) of the Act. Thus, the use of the Mark will cause 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 wares and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same general class. A non-exhaustive list of relevant circumstances is set out at section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time that the trade-marks have been in use; the nature of the wares, services or

business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[30] The Supreme Court of Canada, in its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.*, 2011 SCC 27, interpreted section 6(2) and clarified the scope of the criteria set out at section 6(5) of the Act. This analysis shows that the most important factor is still the degree of resemblance between the marks at issue.

Inherent distinctiveness and the extent to which they have become known

[31] The word NADA has no meaning associated with articles of clothing, accessories or jewellery. However, the Applicant raises two arguments for minimizing the inherent distinctiveness of the mark NADA. First, it argues that NADA is a given name, as evidenced by the name of the Opponent's president, Nada Shephred. Apart from the identification of this person in her affidavit, I have no evidence that NADA would be recognized by Canadian consumers as a common given name.

[32] The Applicant also alleges that the evidence shows that NADA is a word in several languages. To substantiate this claim, the Applicant pleads that the Opponent itself, for the examination of its application for registration No. 1,363,611 for the trade-mark NADA, provided translations of the word NADA from foreign languages [see Exhibit 6 in the affidavit of Ms. Shephred]. Finally, the Applicant filed as an appendix to its written arguments excerpts from Spanish–English and Portuguese–English dictionaries.

[33] Words in foreign languages have a measure of inherent distinctiveness unless the evidence shows that the meaning of the foreign word is known to the Canadian consumer. I have no evidence on record that the average Canadian consumer would be able to recognize the meaning of the word NADA in languages other than French and English. Even if I considered the excerpts from foreign-language dictionaries filed by the Applicant, despite the fact that they were not filed in evidence, and the definitions that the Opponent attributed to the word NADA in the examination of its application for registration No. 1,363,611, none of these definitions can be connected to the nature or

quality of clothing. I therefore conclude that the trade-mark NADA has a measure of inherent distinctiveness.

[34] The same is true of the Mark. It consists of the word element NONADA and a graphic element. I therefore find that the Mark, when taken as a whole, has a slightly higher inherent distinctiveness than the Opponent's mark NADA because of its graphic element.

[35] I did not consider the allegations in the affidavit of Mr. Arsenault, the Opponent's president, to the effect that the word element of the Mark means NO NO because he does not indicate how he arrived at that conclusion.

[36] A trade-mark's inherent distinctiveness may be enhanced by the use of that trade-mark. Since the relevant date for this ground is the date of filing of the application for registration, and since the application is based on a proposed use, I cannot consider any evidence of use of the Mark before that date. As regards the evidence of use of the mark NADA described above, it shows that the mark NADA was known in Canada at April 13, 2007. However, since I have no sales figures for clothing or accessories in association with the trade-mark NADA, it is difficult to determine the degree to which the mark NADA had become known in Canada at the relevant date.

[37] Since the inherent distinctiveness of the Mark is slightly greater than that of the Opponent's trade-mark NADA but the trade-mark NADA is better known in Canada than the Mark, the first factor described in section 6(5)(a) of the Act does not favour either party and is not a determinative factor in the present case.

The length of time that the marks have been in use

[38] Considering the evidence described above and the relevant date, I find that this factor favours the Opponent.

The nature of the wares, services or business; the nature of the trade

[39] I stated that the application for registration had been amended on July 17, 2008, to change the statement of wares. This amendment was to add the words [TRANSLATION] “for children” after the word [TRANSLATION] “clothing” at the very beginning of the naming of the wares. The wares thus went from [TRANSLATION] “Clothing” to [TRANSLATION] “Clothing for children”. I find it reasonable to conclude that the Applicant amended its application for registration to be able to plead that the wares sold by the parties differ in terms of their nature and market niches.

[40] The Opponent argues that the Registrar cannot consider this amendment because the relevant date for this ground of opposition is the date of filing of the original application for registration. Whatever amendment is made, the fact remains that the Wares are clothing.

[41] The evidence shows that the Opponent and its predecessor in title used the mark NADA in association with clothing. Therefore, there is an overlap between the Wares and the wares sold by the Opponent under the trade-mark NADA.

[42] Regarding the nature of the parties’ business activities, the Applicant pleads that the Opponent’s target clientele is interested in high fashion, while the Applicant’s target market is children. I note, however, that in both cases, the buyers are adults.

[43] Ms. Shephred alleges in her affidavit that the Opponent sells its clothing to individuals directly and to merchants, either directly or through sales agents who then sell these clothes to other merchants (paragraph 25 of her affidavit). Mr. Arsenault, meanwhile, alleges that the Applicant sells its clothing to merchants for resale. I note that for this reason, there is a similarity in the nature of the parties’ business: the sale of clothing.

[44] The factors described in sections 6(c) and (d) of the Act therefore favour the Opponent.

The degree of resemblance between the trade-marks

[45] It is trite law that to determine the similarities and differences between marks, we must consider the marks as a whole and not try to view the characteristics of each in isolation. It has been recognized that the first portion of a trade-mark is the most important when distinguishing trade-marks [see *Masterpiece op.cit.*, para. 63]. However, in the case of the Mark, this factor is less important, given that the English word “NO”, which simply represents the negation of the portion that follows this word, is not by itself distinctive. Hence the English word “NO” emphasizes the word or words that follow it.

[46] The marks resemble each other phonetically because of the presence of the word NADA, which by itself is distinctive. The graphic elements are not significant enough to make an impression on the memory of the average consumer such that he or she could identify the Mark by the graphic elements alone. In terms of the ideas suggested by the marks in this case, I understand that the word “NO” connotes negation. However, it is the negation of the word NADA that is the distinctive component of the Mark.

[47] At the oral hearing, the Applicant pleaded that the Mark was actually NONADA, since there was no space between the letter O and the second N. Furthermore, the first three letters forming the word NON are in upper case, while the other letters are in lower case. Thus the Mark could just as well be pronounced NON-ADA, making the parties’ marks even less similar phonetically. I have no evidence on record on this subject. However, I note that although there are no colour claims in this application, the first two letters forming the word NO are paler than the letters forming the word NADA. Although a Francophone might pronounce the Mark “NON-ADA”, I find that there is another equally plausible possibility, which is that an Anglophone or a bilingual person might pronounce the word portion of the Mark “NO-NADA”.

[48] On the whole, this factor too favours the Opponent.

[49] On the basis of this analysis, I find that there is a degree of resemblance between the marks and a similarity between the wares. This is enough for me to conclude that the Applicant has not discharged its burden of proving, on a balance of probabilities, that

there was no risk of confusion between the Mark and the Opponent's trade-mark NADA at the date of filing of this application for registration. I therefore allow the third ground of opposition.

Ground of opposition based on the non-distinctiveness of the Mark

[50] The relevant date for this ground of opposition is the date of filing of the statement of opposition, that is, April 28, 2008 [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) and *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]. The Opponent must therefore first show that at this date, its trade-marks were sufficiently known in Canada [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)].

[51] I would point out that this date, which is before the relevant date for the ground of opposition analyzed above, has no effect on the analysis of the criteria under section 6(5) of the Act, except as follows. The evidence of use described above would be sufficient to conclude that the Opponent discharged its burden of proving that its mark NADA was known in Canada at April 28, 2008. In addition to this evidence, there is the fact that the Opponent took part in the fifth edition of L'Oréal Fashion Week, held on March 18, 2008. To corroborate this allegation, the Opponent filed photographs that were taken at this event and posted on the Web site of the *National Post*, as well as photographs from an interview with Jeanne Beker broadcast on the Web site of Fashion Television. It also filed excerpts from the Web site of the Juno Awards containing a brief description of the Opponent's business, which was one of the sponsors of the awards ceremony held the weekend of April 5 and 6, 2008.

[52] Similarly, for this ground of opposition, I also considered the Applicant's evidence to the effect that it has been selling the Wares in association with the Mark since May 2007. This evidence does nothing to change my conclusion that the Opponent's trade-mark was better known in Canada than the Mark at the relevant date. Likewise, my conclusion favouring the Opponent with regard to the length of the use of the marks remains unchanged.

[53] As regards Mr. Arsenault's allegation to the effect that the Applicant is a manufacturer and distributor of clothing for children and teenagers and has been since 1998, this has no impact on my conclusion that the factors described in sections 6(5)(c) and (d) of the Act favour the Opponent. The parties in this case work in the same field: the sale of clothing.

[54] For the same reasons as those described under the preceding ground of opposition, I also allow the ground of opposition based on the non-distinctiveness of the Mark.

Remaining grounds of opposition

[55] Since the Opponent has succeeded under two of its grounds of opposition, there is no need to analyze the second and fifth grounds of opposition.

Decision

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

Jean Carrière
Member
Opposition Board
Canadian Intellectual Property Office

Certified true translation
Michael Palles