

**IN THE MATTER OF AN OPPOSITION
by 3681441 Canada Inc. to application
No. 1,144,878 for the trade-mark BUFF &
Design filed by Caviro, S.L.**

On June 21, 2002, Caviro, S.L. (the “Applicant”) filed an application to register the trade-mark BUFF & Design (the “Mark”) as illustrated below



based on use and registration in Spain and proposed use in Canada. The statement of wares currently reads:

Clothing for women, men and children, namely, athletic clothing, beachwear, casual clothing, casual wear, children's clothing, baby clothes, outdoor winter clothing, rainwear, exercise clothes, maternity clothes, clothes for fishing, golf wear, ski-wear, formal wear, protective clothing, fire retardant clothing, bridal wear, undergarments, multipurpose wraps made of textiles for use as decorative headwear, head bands, arm bands, wrist bands and leg bands.

The application was advertised for opposition purposes in the *Trade-marks Journal* of March 3, 2004.

On April 30, 2004, Sarafina Invest Limited (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations.

On November 11, 2004, an assignment of the Opponent’s trade-marks was concluded in favour of 3681441 Canada Inc. On January 11, 2007 the Opponent was granted leave to file an amended statement of opposition reflecting the current owner of the trade-marks. The word “Opponent” will hereinafter refer to 3681441 Canada Inc.

In support of its opposition, the Opponent filed the statutory declaration of Gilbert Bitton sworn July 19, 2005, together with exhibits GB1 to GB17.

In support of its application, the Applicant filed the affidavit of Kelly Brady sworn April 20, 2006, including exhibits A to N.

On October 26, 2006, the Applicant was granted leave to file a supplemental affidavit of Kelly Brady sworn August 17, 2006.

Neither affiant was cross-examined. Each party filed a written argument. A hearing did not take place.

Grounds of Opposition

This opposition is based on five grounds: the first ground of opposition is pursuant to s. 38(2)(a) and s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c.T-13 (the “Act”). The second ground of opposition is based on s. 38(2)(b) and s. 12(1)(d) of the Act. In its third and fourth grounds of opposition the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and s. 16(3)(b) of the Act and the fifth ground of opposition is that the Mark is not distinctive.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is, however, an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [s. 16(3) of the Act];
- non-distinctiveness - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Ground of Opposition based on s. 12(1)(d)

The Opponent has pleaded that the Applicant's Mark is not registrable pursuant to s. 12(1)(d) of the Act because the Mark is confusing with the Opponent's registered trade-marks BUFFALO (word and design) certificates of registration numbers TMA313,138, TMA364,692, TMA369,788, TMA369,789, TMA443,164, TMA455,778, TMA459,795, TMA463,289, TMA477,383 and TMA488,554 in association with articles of clothing and clothing accessories.

As I am of the opinion that the Opponent's strongest case respecting this ground of opposition is in relation to its BUFFALO mark TMA443,164, I will focus my discussion on that one mark unless indicated otherwise.

The Opponent's initial burden with respect to this ground has been satisfied, as its registration is in good standing as of the date of my decision.

As the Opponent has met its evidentiary burden, the Applicant bears the legal onus of showing on a balance of probabilities that the marks at issue are not confusing. The presence of a legal onus on the Applicant means that once all the evidence is in, if a determinate conclusion cannot be reached, the issue must be decided against the Applicant.

The test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each trade-mark has been in use; c) the nature of the wares, 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.

The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Both the Applicant's Mark and the Opponent's trade-mark hold dictionary meanings in the English language. There is, however, no indication to suggest that these words convey any descriptive or misdescriptive meaning in relation to the character or quality of the Applicant's or the Opponent's wares. In this regard both marks are inherently distinctive.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Applicant has not provided evidence of use of its Mark since the filing of the application. The Opponent, on the other hand, has evidenced that its mark has become known through substantial and continuous promotion and use in Canada and internationally for over 20 years.

s. 6(5)(b) - the length of time each trade-mark has been in use

Use of a trade-mark in association with wares is defined under s. 4(1) and s. 4(3) of the Act, which read as follows:

s.4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

s. 4(3) A trade-mark that is marked in Canada on wares or on packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In the present circumstances only s. 4(1) of the Act is applicable. In this regard, the Applicant argues that the evidence filed, shows use of the BUFFALO trade-mark by an entity other than the Opponent, namely; Buffalo Inc. It submits that in the absence of a license agreement establishing control over the character and quality of the wares, use would not accrue to the benefit of the Opponent.

I disagree. The Opponent has shown use of its mark by way of the statutory declaration of Gilbert Bitton. It is recalled that Mr. Bitton was not cross-examined and therefore his uncontested statements are considered to be true. He declares that he is the administrator and president of both 3681441 Canada Inc. (his “Company”) and Buffalo Inc. (the “Licensee”). He indicates at paragraph 4 of his statutory declaration that Buffalo Inc. entered into a license agreement, which took effect October 1, 2003 renewing its rights to use the trade-mark BUFFALO in association with clothing. Although Mr. Bitton was not as clear as he could have been regarding the parties involved in the license agreement, I can infer from a reading of the entirety of his testimony, that the license agreement referred to in paragraph 4 was concluded between Buffalo Inc. and the Opponent’s predecessor in title Sarafina Invest Limited. Mr. Bitton further declares that he is actively involved in the business affairs of both his Company and Buffalo Inc. (the Licensee), and as such he is well aware of the use of the BUFFALO trade-mark by Buffalo Inc.

Mr. Bitton attests to use by the Opponent of the BUFFALO mark in Canada substantively and continuously for more than twenty years, through its licensees, predecessors in title and any former licensees. He further states that since 1985 sales figures throughout North America, Asia and Australia are in excess of \$250,000,000. Buffalo Inc., as the Licensee of the Opponent, spends over \$1,000,000 annually to advertise the trade-mark BUFFALO. Mr. Bitton provides the breakdown of the annual advertising budget for the trade-mark BUFFALO in Canada from 1999 to 2004, which on average is over \$1,000,000 per annum.

Mr. Bitton explains that Buffalo Inc. is a manufacturer and importer of a wide range of clothing and deposes to the use of the BUFFALO trade-mark in Canada over a twenty year span. He describes that the BUFFALO trade-mark is affixed to each garment sold by his Company, through Buffalo Inc. (its Licensee), its predecessors in title and any former licensee. Exhibit GB-2 evidences hang tags to illustrate the manner in which the trade-mark is affixed to garments sold. The wording on the hang tags is: BUFFALO David Bitton. I further note that most of the evidence adduced shows use of the BUFFALO trade-mark concurrently with the additional wording : “ BUFFALO David Bitton”, “BUFFALO de France by David Bitton” or “BUFFALO Jeans”. Nevertheless, 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 [*Nightingale Interloc Ltd. v. Prodesign Ltd.*, (1984) 2 C.P.R. (3d) at 535, TMOB]. Since the word BUFFALO appears in a larger font and is usually seen above the additional wording, I consider this to be use of the trade-mark BUFFALO.

The license agreement referred to in the Bitton statutory declaration was not filed into evidence. However, I do not consider the absence of the license agreement to be fatal to the Opponent’s case. In this regard, it is apparent that Mr. Bitton, as the person in charge and in control of both the corporate owner of the trade-mark and of the corporate licensee of the mark, satisfies the need of control pursuant to s. 50 of the Act [*Petro-Canada c. 2946661 Canada Inc.* 83 C.P.R. (3d) 129]. I am therefore satisfied that the use of the BUFFALO mark by Buffalo Inc. (the Licensee) has been shown, and for the reasons above, said use accrues to the benefit of the Opponent.

It is recalled that the Applicant did not file evidence of use of its Mark, and in light of the Opponent's evidence, the extent to which the trade-marks have been in use, clearly favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

The wares covered in the Opponent's registration are essentially identical to the wares covered in the present application and in the absence of evidence to the contrary, I will presume they share the same channels of trade.

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

The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [*Effem Foods Ltd. v. Export/Import Clic Inc.* (1993), 53 C.P.R. (3d) 200 (F.C.T.D.); *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.A.)].

The Applicant's Mark comprises two features: a Design and the word BUFF. I consider it to be a unique artistic conception, in particular by the use of an unusual font forming the letters of the word BUFF, which is framed by a circle, wherein two arrows surround the word portion suggesting a circular movement to the mark. On the other hand the Opponent's mark is simply the word mark BUFFALO with no design element.

As such, the marks are significantly different in appearance. They are also sounded differently BUFF vs. BUFFALO. Finally, the ideas suggested are distinct. In terms of ideas suggested, the word BUFF holds several definitions, by way of example; it is either defined to mean “a well toned body”, “an expert in a specialized subject”, or “to polish”. BUFFALO is defined as “a city in the state of New York” or as “a type of ox”. Thus the ideas suggested by the marks at issue share no similarities.

Surrounding circumstances

As a surrounding circumstance, the Applicant filed State of the Register evidence by way of the Kelly Brady affidavit.

Ms. Brady provides copies of 202 trade-mark registrations and/or pending applications that include the word BUFFALO and/or a depiction of a buffalo.

State of the Register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.T.D.); *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

I consider the Brady affidavit and appended exhibits to be of limited relevance. Of the 202 registrations and/or pending applications referred to, 181 of these marks cover such a disparate aggregate of wares and/or services such as food, hunting gear, air gas filters, steam boilers, hydraulic shears, eau de vie, operating a camping ground, that I consider these trade-marks irrelevant to the issue at hand.

Of the remaining trade-marks, 21 are relevant in that the statement of wares and/or services relate to clothing and/or to retail sale of clothing. Of these 21, the Opponent owns 16 and the Applicant owns 2. Which only leaves 3 relevant registrations owned by 2 different entities.

Such evidence falls significantly short of what is required to draw any inferences about the state of the marketplace.

As a further surrounding circumstance, I have considered the Opponent's argument that it uses BUFF as an abbreviated form of its BUFFALO trademark. In support of its contention, the Opponent filed evidence attempting to show a tendency in the trade to abbreviate its trade mark by way of 1) an internal newsletter entitled "*The News Buff*" and 2) illustrations displaying BUFF either on the front or the back of jerseys.

In this regard, the Applicant submits that since the Opponent did not, in the context of any grounds of its statement of opposition, rely on any rights in respect of the alleged abbreviation BUFF, that it is not appropriate to consider potential confusion with any use by the Opponent of BUFF.

I agree with the Applicant. None of the grounds of opposition refer to the Opponent's alleged abbreviated form. As such, I consider that I am precluded from making a determination in this regard.

Alternatively, should I be wrong in my above analysis, I am not convinced that BUFF would be perceived by the average Canadian consumer as an abbreviated form of the trade-mark BUFFALO. Even if it could, the Opponent has not adduced evidence of a tendency in the trade to abbreviate its BUFFALO trade-mark. In this regard, the newsletter entitled "*The News Buff*" is an internal publication distributed to the Opponent's employees only. As for the illustration of jerseys depicting BUFF, although Mr. Bitton makes a bald assertion that this clothing has been sold through Buffalo Inc., he fails to provide any evidence substantiating sales in Canada.

Conclusion re likelihood of confusion

Although the majority of the s. 6(5) factors favour the Opponent, it is recalled that these enumerated factors need not be attributed equal weight. "Realistically appraised it is the degree of resemblance between trade-marks in appearance, sound or in the ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a

subservient role in the over-all surrounding circumstances” [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.), at 149, affirmed (1982), 60 C.P.R. (2d) 70 (F.C.A.)].

I find that the average Canadian consumer of clothing, who has an imperfect recollection of



BUFFALO, is not likely to assume that clothing associated with share the same source as a matter of first impression. Despite the acquired reputation by the Opponent, the considerable differences between the marks appear to me to be sufficient to make confusion unlikely. Thus, the s. 12(1)(d) ground fails.

Section 16(3)(a) Ground of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) of the Act because as of the filing date of the application, it was confusing with the Opponent’s previously used trade-mark BUFFALO. The Opponent has met its initial burden by showing that its mark BUFFALO was used prior to the filing of the application and was not abandoned at the date of advertisement.

The analysis of the likelihood of confusion under this ground of opposition does not differ significantly from that under the s. 12(1)(d) ground. Accordingly, its outcome is the same and the s. 16(3)(a) ground of opposition also fails.

Section 16(3)(b) Ground of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(b) of the Act. The Opponent has met its initial burden by showing that its trade-mark applications: 772,225, 1,129,838 and 1,131,817 were filed in Canada prior to the filing date of the application, and that its applications were pending at the date of advertisement of the Mark.

The analysis of the likelihood of confusion under this ground of opposition does not differ significantly from that under the s. 12(1)(d) ground. Accordingly, its outcome is the same, the s. 16(3)(b) ground of opposition also fails.

Distinctiveness Ground of Opposition

The Opponent has pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's wares from the wares associated with the Opponent's trade-marks.

In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition the Opponent's mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. Mr. Bitton's evidence satisfies the Opponent's initial burden.

The analysis of the likelihood of confusion under this ground of opposition does not differ significantly from that under the s. 12(1)(d) ground. Accordingly, this ground of opposition also fails.

Section 30(i) Ground of Opposition

The Opponent has pleaded that the application does not conform to the requirements of s. 30 of the Act because the Applicant cannot be satisfied that it is entitled to use the Mark in light of the previous facts alleged by the Opponent. This ground cannot succeed for several reasons: 1) the Opponent did not plead or show that the Applicant was aware of the Opponent's use; 2) this ground is contingent upon a finding that the marks at issue are confusing, which has not been found to be the case; and 3) where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant, which is not the case here. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. Accordingly, this ground of opposition also fails.

Disposition

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act,
I reject the opposition pursuant to s. 38(8).

DATED AT GATINEAU, QUÉBEC, THIS 24th DAY OF MARCH 2009.

Lynne Pelletier

Member

Trade-marks Opposition Board