



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

**Citation: 2016 TMOB 107**  
**Date of Decision: 2016-07-04**

**IN THE MATTER OF AN OPPOSITION**

**JINX, Inc.**

**Opponent**

**and**

**JINXD Yoga Essentials Inc.**

**Applicant**

**1,572,869 for JINXD & Design**

**Application**

FILE RECORD

[1] On April 12, 2012, JINXD Yoga Essentials Inc. (“JYE”) filed an application to register the trade-mark JINXD & Design, shown below, based on proposed use in Canada in association with the goods listed below:



yoga clothing, athletic clothing, yoga mats, yoga mat covers, yoga mat carrying cases, yoga mat straps, yoga blocks, water bottles, athletic bags for yoga mats; hats and caps.

[2] The Examination Section of CIPO (Canadian Intellectual Property Office, under whose aegis this Board also operates) objected that the applied-for mark was not registrable, pursuant to s.12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. In this regard, the Examination Section took the view that the applied-for mark JINXD & Design was confusing with the registered mark JINX used in association with various items of clothing. The applicant responded (on April 10, 2013) to the Examination Report by arguing that the cited mark JINX was a dictionary word in common usage and therefore had very little inherent distinctiveness. The applicant further submitted, among other things, that weak marks are entitled to a narrow ambit of protection and, keeping in mind the differences between the marks in issue, confusion was unlikely to arise. It appears that the applicant's submissions were accepted (there is no indication on file) as the subject application proceeded to advertisement in the *Trade-marks Journal* issue of November 11, 2013.

[3] The subject application was then opposed, on February 10, 2014, by JINX, Inc., the owner of the mark JINX cited by the Examination Section. The Registrar forwarded a copy of the statement of opposition to the applicant on February 25, 2014, as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent's evidence consists of the affidavit of Brian Berling. The applicant's evidence consists of the solemn declarations of Jessica Kirzner; Philip Quadros; and Janet Dell'Orto. The opponent's evidence in reply consists of the affidavit of Laura Feehan. Both parties submitted written arguments, however, only the opponent was represented at an oral hearing.

#### STATEMENT OF OPPOSITION

[5] The grounds of opposition are succinctly pleaded and shown in full below:

2. The grounds of opposition are as follows:

(a) Pursuant to Section 38(2)(b) of the *Trade-marks Act*, the Applicant's Trade-mark is not registrable in view of Section 12(1)(d) of the *Trade-marks Act* because the Trade-mark is confusing with the following registered trade-marks owned by the Opponent:

<b>Trade-mark</b>	<b>Registration No.</b>	<b>Wares</b>
JINX	TMA 789529	(1) Clothing, namely shirts, pants, headwear, namely hats, caps, and beanies, underwear, creepers, namely one-piece garments for infants, pet clothing. (2) Key chains. (3) Mouse pads. (4) Printed materials, namely stickers, posters. (5) Backpacks. (6) Patches for clothing. (7) Clothing, namely shirts, headwear, namely hats, caps, underwear

(b) Pursuant to Section 38(2)(c) of the *Trade-marks Act*, the Applicant is not the person entitled to registration of the Trade-mark in view of Section 16(3)(a) of the *Trade-marks Act*, because at the date of filing of the Application (April 12, 2012), the Trade-mark was confusing with the following trade-marks owned by the Opponent, which have been registered by the Opponent with the United States Patent and Trademark Office and were previously used in Canada by the Opponent or its licensees in association with the following wares and services:

<b>Trade-mark</b>	<b>United States Registration No.</b>	<b>Wares and Services</b>
J!NX IDENTITY	3915031	Coats; Hats; Sweat shirts; T-shirts.
J!NX IDENTITY	3688767	Operating an on-line shopping site in the field of clothing.
J!NX	3500868	Metal key chains. Mouse pads. Stickers; Posters. Backpacks; Pet clothing. Headgear, namely, hats, caps, and beanies; Underwear; Creepers. Cloth patches for clothing; Embroidered patches for clothing.
J!NX	3734880	Wallets.
J!NX	3008512	Clothing, namely, t-shirts, jerseys, shirts, sweatshirts, jackets, underwear, shirts for children, and tank tops; headgear, namely caps, hats, and visors.

(c) Pursuant to Section 38(2)(d) of the *Trade-marks Act*, the Trade-mark is not distinctive within the meaning of Section 2 of the *Trade-marks Act*, as the Trade-mark does not actually distinguish the wares in association with which it may be used from the wares of the Opponent, nor is it adapted so as to distinguish them. Without limiting the generality of the foregoing, the Trade-mark cannot actually distinguish the wares of the Applicant described in the Application from the wares of the Opponent under the Opponent's trade-marks referred to above.

[6] As will become apparent from discussion later in these reasons for decision, each of the grounds of opposition turns on the issue of confusion between the applied-for mark and the opponent's mark JINX used in association with clothing. The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability pursuant to s.12(1)(d); (ii) the date of filing the application (April 12, 2012) with respect to the ground of opposition alleging non-entitlement pursuant to s. 16(3)(a); and (iii) the date of filing the statement of opposition, in this case February 10, 2014, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD). In the circumstances of this case, nothing turns on whether the issue of confusion is assessed at a particular material date.

[7] Before discussing the issue of confusion, I will review the parties' evidence, the evidential burden on the opponent, the legal onus on the applicant, the meaning of confusion within the context of the *Trade-marks Act*, and the legislative framework to assess confusion.

OPPONENT'S EVIDENCE

*Brian Berling*

[8] Mr. Berling identifies himself as the Director of Operations for the opponent company – a California corporation. Mr. Berling notes that the opponent is the owner of the Canadian registered mark JINX as well as the owner of several USA registrations for the marks JINX & Design and JINX Identity & Design, illustrated below, which marks have also been used in Canada.

J!NX      J!NX      J!NX IDentity

The opponent refers to its marks collectively as “the Jinx Trade-marks” and I will do likewise.

[9] For the purposes of this opposition, I consider that the two above illustrated JINX & Design marks are permitted variations of the opponent's word mark JINX: in this regard see

*Promafil Canada Ltée v. Munsingwear Inc.*, (1992) 44 C.P.R. (3d) 59 at p.64 (FCA), reversing 29 C.P.R. (3d) 391. From this perspective, the opponent's Jinx Trade-marks consist of two, rather than four marks, namely, the word marks JINX and JINX IDentity. The "look" of the opponent's marks as they are used in the marketplace, that is, in forms other than block script or as a component of a logo, is nevertheless a relevant factor in assessing trade-mark confusion, as will be discussed later.

[10] The opponent is based in the United States, selling and shipping products directly to Canadian customers through its online store. The opponent has also partnered with third party retail and wholesale distributors who, since as early as August 2003, have sold the opponent's products in Canada, that is, the products specified in the opponent's Canadian registration, under the opponent's Jinx Trade-marks. Attached as Exhibit M to Mr. Berling's affidavit is a list of the opponent's distributors which includes clothing stores, electronics stores, and specialty stores such as comic book, video game and collectibles stores.

[11] As of August 2014, the opponent's products included 190 different styles of women's clothing and 35 different types of accessories in its online store. In 2013 the opponent sold about 36,680 units of clothing in Canada through its online store; about 7% of sales represent women's clothing.

[12] The total volume of product sales in Canada through the opponent's distributors increased from 945 units in 2009 to 109,040 units in 2013. In 2013, about 11% of the units sold represent women's clothing. The opponent promotes its products, sold under its Jinx Trade-marks, through online advertisements and on social media accounts that it operates.

[13] It is difficult to come to any definitive conclusions regarding the acquired distinctiveness of the opponent's mark JINX as the opponent's evidence conflates use and promotion of the JINX & Design marks together with the mark J!NX IDentity. Nevertheless, having regard to the exhibit material attached to Mr. Berling's affidavit, which exhibits illustrate use of the JINX & Design marks, I am prepared to infer that as of the date of filing of the applied-for mark JINXD

& Design (April 12, 2012), the opponent's mark JINX, used in association with clothing, had acquired at least a minimal reputation in Canada.

[14] I have also noted, from a review of the exhibit material, that the opponent almost always uses its JINX & Design marks together with a stylized design of a skull, in the logo shown below:



[15] As will be discussed later, the fact that the opponent's mark JINX & Design was, at all material times, most often seen in a logo comprised in part of a skull design is a circumstance that is prejudicial to the opponent's case.

#### APPLICANT'S EVIDENCE

*Jessica Kirzner*

[16] Ms. Kirzner identifies herself as President of the applicant company. She describes the nature and operation of the applicant's business in paras. 3 -5 of her affidavit, shown below,

3. JYE is a manufacturer and distributor of yoga apparel and accessories for the active woman.

4. JYE carries on its foregoing operations in liaison with Jeno Neuman & Fils Inc. ("JNF"). More specifically, JYE has established a financial relationship with JNF, whereby JNF is responsible for all costs relating to the manufacture, marketing, promotion and sale of wares bearing the mark JINXD YOGA ESSENTIALS & Design. As such, all invoices relating to the sale of wares bearing the mark JINXD YOGA ESSENTIALS & Design are in the name of JNF.

5. Notwithstanding the foregoing relationship between JYE and JNF, all steps, decisions and actions taken with respect to the manufacture, marketing, promotion and sale of wares bearing the mark JINXD YOGA ESSENTIALS & Design have been and are taken by JYE.

[17] I conclude from the quoted paragraphs, above, that JNF has an implied license to use the applied-for mark JINXD & Design and that use of the mark in Canada by JNF inures to the benefit of the applicant pursuant to s.50(1) of the *Trade-marks Act*.

[18] The applicant launched the JINXD YOGA ESSENTIALS website in September 2014 at which time goods bearing the applied-for mark became available for purchase online. The applicant promotes its mark on social media namely, Facebook and Instagram. In October 2013 the applicant began selling yoga mats bearing the applied-for mark to Sports Experts in Montreal. In 2014 the applicant began selling yoga mat covers and yoga mat bags bearing the applied-for mark to a variety of retailers including yoga studios, bookstores, gyms, as well as big box retailers such as Winners.

[19] Clothing bearing the applied-for mark has been available through JYE's website since 2014, at which time JYE also began selling clothing to yoga studios and retail stores. Attached as Exhibit J are flyers distributed to retailers to advertise the applicant's wares. One of the flyers describes the applicant's goods in the following terms:

JINXD is a new brand specializing in yoga apparel and accessories designed for the active woman who wants to look and feel fabulous all day. Everyday !

I note that while the applicant's advertising refers exclusively to women's clothing, the clothing specified in the subject application is not similarly restricted.

[20] Since 2013, sales of yoga mats, yoga mat covers, yoga mat carrying cases and clothing bearing the applied-for mark have totalled about \$50,000 while advertising expenditures, including print and the Internet, totalled about \$20,000.

[21] Ms. Kirzner addresses the issue of the parties' different clientele at para. 24 of her affidavit:

24. Upon review of the Website of the Opponent ([www.jinx.com](http://www.jinx.com)), it was clear to me that there are major differences in all aspects of the businesses of JYE and the Opponent. More specifically:

(a) The wares of JYE target the active woman who practices yoga and wants to look great, whereas from the Opponent's Website, it appears that the wares of the Opponent target gamers, two entirely different clienteles.

(b) The JINXD YOGA ESSENTIALS & Design Mark is entirely different from the following JINX & Design logo that appears on the first results page of a Google search of the Opponent and on the Opponent's home page (although on the home page the skull is next to the mark JINX & Design)



The look and feel of the Website of the Opponent made it clear to me that JYE and the Opponent are targeting entirely different clienteles and that neither clientele would confuse one brand with the other.

*Philip Quadros*

[22] Mr. Quadros identifies himself as President of JNF, the company referred to by Ms. Kirzner and the applicant's implied licensee. His affidavit serves to confirm the business relationship between the applicant and JNF described by Ms. Kirzner.

*Janet Dell'Orto*

[23] Ms. Dell'Orto identifies herself as a trade-mark agent and an employee of the firm which filed the subject trade-mark application. Subsequent to the opponent filing its statement of opposition, she carried out a search on the Internet for third parties using the mark JINX in association with clothing. It appears from her evidence that two third parties, who may be referred to as "Zazzle" and "Cafepress," use the mark JINX in association with T-shirts.

OPPONENT'S REPLY EVIDENCE

*Laura Feehan*

[24] Ms. Feehan identifies herself as an employee of a law firm. She reviewed the Internet websites referred to by Ms. Dell'Orto. The pertinent portions of her affidavit are reproduced below:



3. My review of the Zazzle and CafePress websites disclosed that each of those websites allows its users to submit their own custom clothing designs to the website, and the user-designed clothing is then displayed for other users to purchase. It appears that most and potentially all of the products sold at these websites are user-designed.

4. Attached hereto as Exhibit "A" is a collection of screenshots from the Zazzle website, including portions of Zazzle's User Agreement, which explain how users can submit and sell their custom clothing designs through the Zazzle website.

5. Attached hereto as Exhibit "B" is a collection of screenshots from the CafePress website which explain how users can submit and sell their custom clothing designs through that website.

6. My searches of the Zazzle and CafePress websites' products disclosed many user designs which share words or aspects of other popular clothing brand names such as Guess, Coach, and Converse. Attached hereto as Exhibit "C" is a collection of screenshots from the Zazzle and CafePress websites showing examples of such user designs.

[25] After reviewing Ms. Feehan's evidence, I have concluded that the applicant has not demonstrated any third party use (within the meaning of s.4 of the *Trade-marks Act*) of the mark JINX in association with clothing.

#### Legal Onus and Evidential Burden

[26] As mentioned earlier, before considering the issue of confusion between the parties' marks, it is necessary to review (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[27] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the

statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

#### MEANING OF CONFUSION

[28] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

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 . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[29] Thus, s. 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s. 6(2) is whether consumers shopping for yoga clothing and yoga accessory items would believe that the applicant's yoga goods, sold under the mark JINXD & Design, were made by the opponent or that the applicant was authorized or licensed by the opponent, whose clothing is sold under its JINX and JINX IDentity marks. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

#### *Test for Confusion*

[30] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “ all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of*

*Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[31] As the opponent's mark JINX resembles the applied-for mark JINXD & Design more closely than the opponent's mark JINX IDentity resembles the applied-for mark, a consideration of the issue of confusion between the two first mentioned marks will be determinative of the issue of confusion.

#### SECTION 6(5) FACTORS

*First Factor - the inherent distinctiveness of the marks and the extent to which they have become known*

[32] The opponent's mark JINX possesses a fair degree of inherent distinctiveness because, although it is a dictionary word, it has no descriptive or suggestive connotation in relation to the character or quality of the opponent's clothing. The applied-for mark also possesses a fair degree of inherent distinctiveness. In this regard, the applied-for mark is comprised of two dominant components namely, the stretching cat design figure and the term JINXD. The stretching cat figure is not particularly distinctive and the component JINXD would be perceived as the past tense of the word JINX. The mark as a whole is to some extent suggestive of the applicant's goods owing to the component "Yoga" and also owing to the idea of a yoga pose suggested by the stretching cat figure. Overall, the applied-for mark is to a minor extent more inherently distinctive than the opponent's mark, owing to the visual impact of the applied-for mark as a whole.

[33] As discussed earlier, owing to the summary nature of the opponent's evidence concerning sales under its marks, I am not prepared to infer anything more than a minimal reputation for its mark JINX at any material time. Further, at all material times the public was more familiar with the opponent's logo which included a skull design than with the opponent's mark JINX: see paras. 14-15, above. The applicant's mark JINXD & Design had not acquired any distinctiveness

as of the earlier material dates, however, the evidence shows that the applied-for mark had acquired some distinctiveness at the latest material date.

[34] In view of the foregoing, I have concluded that the first factor does not favour either party to any significant extent at any material date.

*Second Factor- the length of time each mark has been in use*

[35] The length of time that the parties' marks have been in use favours the opponent, as Mr. Berling's unchallenged testimony evidences use of the opponent's mark JINX in Canada since 2003. However, quantitative data for sales of clothing under the opponent's marks are only evidenced from 2009 onwards, and because of the imprecise nature of the opponent's evidence, it is not possible to ascertain the extent of use of the mark JINX as opposed to JINX IDentity. The applicant has evidenced use of the applied-for mark JINXD and Design since 2014. The length of time that the parties' marks have been in use favours the opponent at all material times, however, owing to the imprecise evidence of the extent of use of the mark JINX , it is not a significant advantage to the opponent.

*Third and Fourth Factors- the nature of the goods and trades*

[36] There is potential overlap between the parties' goods in respect of yoga clothing and athletic clothing; and overlap in respect of hats and caps. Otherwise the parties' goods are dissimilar. Further, from my review of the evidence it appears to me that, at all material times, the parties target and cater to different niche clientele through entirely distinct channels of trade. The third and fourth factors, considered together, therefore favour the applicant.

*Fifth Factor- resemblance in appearance or sound of the marks or in the ideas suggested*

[37] The parties' marks resemble each other visually, aurally and in ideas suggested owing to the strong resemblance between the component JINXD appearing in the applied-for mark and the opponent's mark JINX. However, the overall visual impact of the applied-for mark is different than the opponent's mark owing to the placement of a dominant design feature, namely the cat figure, above the other dominant component JINXD. Visually the marks in issue are significantly more different than alike. The applied-for mark would likely be pronounced simply as "jinxed"

which is very similar in sounding to the opponent's mark JINX. The opponent's mark suggests the idea of "bad luck" as does the applied-for mark, however, the applied-for mark also suggests the ideas of "yoga" and "stretching," the latter idea prompted by the cat design figure. The ideas suggested by the parties' marks are somewhat more different than alike. Considering all three aspects of resemblance together, I find that the parties' marks are somewhat more different than alike owing to their visual differences and to the differences in the ideas that the marks suggest.

DISPOSITION

[38] Having regard to the above factors, I have concluded that the balance of probabilities weighs slightly in favour of finding that the applied-for mark JINXD & Design and the opponent's mark JINX are not confusing at any of the material dates. Essentially the same considerations as above apply to the opponent's mark JINX IDentity, except that there is less of a resemblance between it and the applicant's mark. It follows that the applied-for mark is not confusing with the opponent's mark JINX IDentity at any material time. Accordingly, the opposition is rejected.

[39] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

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Myer Herzig, Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2016-04-16

**APPEARANCES**

Nathan Woodruff

FOR THE OPPONENT

No one appearing

FOR THE APPLICANT

**AGENTS OF RECORD**

Thompson Woodruff

No agent appointed

FOR THE OPPONENT

FOR THE APPLICANT