



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

Citation: 2015 TMOB 21
Date of Decision: 2015-01-30

**IN THE MATTER OF AN OPPOSITION
by Cartier International AG to
application No. 1,276,683(02) for the
trade-mark CARTISE in the name of
Cartise Sports Inc.**

[1] Cartier International AG (the Opponent) opposes registration of the trade-mark CARTISE (the Mark) that is the subject of an application to extend the statements of goods and services of Registration No. TMA679,917, filed under application No. 1,276,683(02) by Cartise Sports Inc. (the Applicant).

[2] Filed on January 24, 2012, the application is based on use of the Mark in Canada since at least as early as October 2009 in association with the goods “Bags, namely purses, handbags and clutch bags”, as well as proposed use of the Mark in Canada in association with the goods “Jewellery, namely earrings, necklaces, bracelets & brooches; belts” and the services “On-line wholesale and retail store services featuring jewellery, bags and clothing”.

[3] The Opponent alleges that: (i) the application does not comply with the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12 of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under section 16 of the Act; and (iv) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I refuse the application.

The Record

[5] The Opponent filed its statement of opposition on March 11, 2013. The Applicant then filed and served its counter statement on April 16, 2013 denying all of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Simone Ndiaye, a trade-mark agent trainee employed with the Opponent's trade-mark agent, and certified copies of registration Nos. TMA297,248 and TMA146,843, the particulars of which are set out in Schedule "A" to this decision. The affiant was not cross-examined. The Applicant did not file any evidence in support of its application.

[7] Both parties filed a written argument; an oral hearing did not take place.

The Parties' Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 [see *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[9] I will now consider the grounds of opposition, starting with the section 12(1)(d) ground.

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[10] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with the Opponent's registered trade-mark CARTIER, particulars of which are set out in Schedule "A" to this decision.

[11] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[12] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[13] Having exercised the Registrar's discretion, I confirm that both registrations for the Opponent's trade-mark CARTIER are in good standing.

[14] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

[15] For the reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

The test for confusion

[16] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[17] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 has been in use; (c) the nature of the goods, 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 [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc*

v Alavida Lifestyles Inc (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[18] I will now turn to the assessment of the section 6(5) factors.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[19] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks. I assess the Applicant's Mark to have a fair degree of inherent distinctiveness given that CARTISE is a coined term that is neither descriptive nor suggestive of the applied for goods or services. In comparison, the term CARTIER possesses little inherent distinctiveness in view of its surname significance. *The Canadian Oxford Dictionary* defines "Cartier" as the surname of Prime Minister Sir George-Etienne Cartier of the Province of Canada from 1857 to 1858, and the surname of the French explorer Jacques Cartier who made three voyages to Canada between 1534 and 1541. I note that the Opponent also provides evidence pertaining Louis-François Cartier, founder of Société Cartier in 1847 [Wikipedia entry on "Cartier (jeweler)" attached as Exhibit SN-1 to the Ndiaye affidavit].

[20] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. As mentioned above, the Applicant did not file any evidence in this proceeding. I now turn to the evidence introduced by the Opponent through the Ndiaye affidavit regarding the trade-mark CARTIER.

[21] While the Applicant did not raise the issue in its written argument, it did indicate that it will be challenging the admissibility of the Ndiaye affidavit, as part of the statement it made pursuant to Rule 42 of the *Trade-marks Regulations*. Even so, I note that the Applicant did not provide the reasons for its objection, nor did it make additional submissions on this point in the present proceeding. In any event, I am of the view that it is necessary to address the admissibility and the reliability of the Opponent's evidence as part of my analysis.

[22] In this regard, I am not prepared to find the Ndiaye affidavit inadmissible. While it would appear that the Opponent has elected to introduce evidence related to contentious issues in the present proceeding, such as the reputation of the Opponent's trade-mark, via a person who is employed by its trade-mark agent instead of an independent witness [see *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2005) 2005 FC 1254 (CanLII), 43 CPR (4th) 21 (FC); aff'd (2006), 2006 FCA 133 (CanLII), 53 CPR (4th) 286 (FCA)], I am cognizant of the fact that the Ndiaye affidavit contains statements of facts as opposed to opinions or allegations that may qualify as opinions. I also note that the Applicant elected not to cross-examine the affiant. Under these circumstances, I will have regard to the Ndiaye affidavit. I now turn to the probative value of the evidence presented.

[23] As part of her affidavit, Ms. Ndiaye produces a large volume of articles extracted from various websites as Exhibits SN-1 and SN-2, purported to show the notoriety of the Opponent's trade-mark CARTIER around the world and in Canada. The exhibits include:

- Printouts on "Cartier (jeweler)" from Wikipedia with information on the history of Cartier, its retail operations around the world, as well as its collections of products;
- Photos of watches bearing the trade-mark CARTIER are shown on various printouts;
- News article published in July 2010 on La Presse's website located at *affaires.lapresse.ca* on the value of family jewellery, with a reference to CARTIER;
- News article published in July 2011 on Radio-Canada's website located at *m.radio-canada.ca* on Prince Monaco's wedding, with a reference to CARTIER rings; and
- Two articles published on Elle Canada's website located at *www.ellecanada.com* on jewellery worn by celebrities, with references to a CARTIER diamond bracelet and a CARTIER diamond ring.

[24] Without any context or information regarding the websites attached as Exhibits SN-1 and SN-2, the large majority of the printouts cannot be relied upon to establish the truth of their content [see *ITV Technologies Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 (FCTD), affirmed by (2005), 38 CPR (4th) 481 (FCA)]. Even so, evidence from Wikipedia has been given some weight in past decisions provided that the other party had an opportunity to reply to the evidence [see for example *Canadian Council of Professional Engineers v Alberta Institute of*

Power Engineers (2008), 71 CPR (4th) 37 (TMOB) and *Calgary Flames Limited v 1072160 Alberta Inc*, 2012 TMOB 100]. In this case, I note that the nine-page Wikipedia entry on “Cartier (jeweler)” makes no reference to the jeweler’s presence in Canada. Moreover, it is not clear what is the relationship between the Opponent and the numerous entities referenced in the entry including Société Cartier, Compagnie Financière Richemont SA, Cartier Monde, Cartier SAA, Cartier International, Cartier Foundation, etc. The Opponent, Cartier International AG, does not appear to be mentioned in the Wikipedia entry.

[25] Attached as Exhibit SN-3 of the Ndiaye affidavit are printouts bearing the trade-mark CARTIER from a website located at *www.cartier.com*, with information on Canadian retail locations, as well as printouts from a website located at *www.antoine-laoun.com*, including a photo of a “Boutique Cartier” where the trade-mark CARTIER can be seen in a prominent display in a retail setting along with a showcase of bags and what appeared to be various leather goods. Attached as Exhibit SN-4 of the Ndiaye affidavit are additional printouts from *www.cartier.com* with photos of belts, rings, bracelets, necklaces, earrings, chains, pendants, brooches, charms, clocks, hand bags, small leather goods, and timepieces, as seen on the website.

[26] In terms of the printouts from *www.cartier.com*, while the trade-mark CARTIER is shown in a prominent manner on every page, I would point out that the Opponent never established whether these are extracted from its own website, or that of a third party. In terms of use of the trade-mark on goods, with the exception of bracelets and rings that clearly bear the trade-mark CARTIER, none of the remaining goods bear the trade-mark CARTIER. Thus, I am unable to determine the manner in which the trade-mark CARTIER is associated with the remaining goods in the printouts. As for printouts from *www.antoine-laoun.com*, I will simply note that they cannot be relied upon to establish the truth of their content without any additional information [see *ITV Technologies Inc, supra*].

[27] When the Internet evidence is viewed in its entirety, without any information on the number of Canadians who have accessed any of these websites, or the length of time these articles have been made available on the Internet, I see little probative value in the printouts produced by Ms. Ndiaye. It would appear that trade-mark CARTIER has received some media exposure on the Internet. However, in the absence of any other evidence of use and/or promotion

of the Opponent's trade-mark in Canada such as sales and advertising information, I am unable to determine the extent to which the trade-mark CARTIER has become known in Canada.

[28] Accordingly, the section 6(5)(a) factor does not significantly favour either party.

Section 6(5)(b) – the length of time the trade-marks have been in use

[29] The Applicant did not provide any evidence of use of the Mark in the present proceeding.

[30] In comparison, while the Opponent's registrations are based on use, this can establish no more than *de minimis use* of the trade-mark CARTIER in Canada [see *Entre Computer Centres Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. *De minimis use* does not support a conclusion that the Opponent's trade-mark has been used continuously. Moreover, as per my review of the Ndiaye affidavit, I am not satisfied that the Opponent has shown use of the trade-mark CARTIER in Canada within the meaning of the Act.

[31] Accordingly, the section 6(5)(b) factor slightly favours the Opponent, but not significantly.

Sections 6(5)(c) and (d) – the nature of the goods, services, trade and business

[32] When considering sections 6(5)(c) and (d) of the Act, it is the statements of goods and services as defined in the application for the Mark and in the Opponent's registration Nos. TMA146,843 and TMA297,248 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording.

[33] Both parties' goods and services cover fashion accessories such as bags, jewellery, and belts.

[34] Neither the Opponent's registrations nor the subject application contains any restriction on the parties' channels of trade. In the absence of evidence from the Applicant, since the parties' goods are identical, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

[35] Accordingly, the section 6(5)(c) and (d) factors favour the Opponent.

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

[36] In *Masterpiece*, the Supreme Court of Canada noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks.

[37] When the parties' trade-marks are considered in their entirety, there are clear similarities in appearance and in sound between them as they both begin with "CARTI". It is noted that the first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)]. As for ideas suggested, the Opponent's trade-mark CARTIER evokes the idea of a surname while the Applicant's Mark does not suggest any idea in particular.

[38] Accordingly, the section 6(5)(e) factor favours the Opponent.

Additional surrounding circumstances – Family of marks

[39] Attached as Exhibit SN-5 to the Ndiaye affidavit are printouts from the CIPO's Canadian Trade-marks Database providing the particulars of nine of the Opponent's registrations for trade-marks that contain the word "CARTIER". In order to rely on a family of marks, the party must evidence use of those trade-marks in the marketplace [see *McDonald's Corp v Yogi Yogurt* (1982), 66 CPR (3d) 101 (FCTD)]. No such evidence of use has been provided.

Additional surrounding circumstances – Notoriety of CARTIER

[40] In its written argument, the Opponent submitted that as a further surrounding circumstance, I should consider the notoriety of the trade-mark CARTIER. In support, the Opponent cites *Cartier Inc v Cartier Optical Ltd* (1988) 20 CPR (3d) 68 (FCTD) where *based on the evidence of that case*, Justice Dubé found that the trade-mark CARTIER is well known in Canada in association with articles of jewellery.

[41] Each case must be decided on its own merits. Suffice it to say that as per my review of the Ndiaye affidavit, the evidence submitted by the Opponent in the present proceeding does not allow me to draw any meaningful conclusion regarding the extent to which the trade-mark CARTIER has become known in Canada. Thus, the notoriety of the Opponent’s trade-mark CARTIER is not a significant surrounding circumstance in this case.

Conclusion

[42] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances including overlap between the parties’ goods and services, the potential for overlap between the channels of trade, and clear similarities between the parties’ trade-marks, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and CARTIER.

Does the application conform to the requirements of section 30 of the Act?

[43] In its statements of opposition, the Opponent alleges that:

1. the Applicant did not commence use of the Mark on the alleged date of first use in association with “Bags, namely purses, handbags and clutch bags” or that the alleged use did not constitute “use” within the meaning of the Act, contrary to section 30(b) of the Act;
2. the Applicant never intended to use the Mark in association with “Jewellery, namely earrings, necklaces, bracelets & brooches; belts” and “On-line wholesale and retail store services featuring jewellery, bags and clothing”, contrary to section 30(e) of the Act;

3. the statement that the Applicant is satisfied as to its entitlement to use the Mark in Canada is false, contrary to section 30(i) of the Act in view of the Applicant's knowledge of the Opponent's use of its family of CARTIER marks.

[44] The Opponent has failed to satisfy its initial evidentiary burden to put into issue the application's conformity with the requirements of section 30.

[45] The material date for considering the circumstances with respect to the ground of opposition based upon non-compliance with section 30 is the filing date of the application, i.e. January 24, 2012 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[46] An opponent's initial burden under section 30(b) can be met by reference not only to its own evidence but also that of the applicant's [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. As mentioned above, the Applicant did not file any evidence of use of the Mark in the present proceeding. In terms of the Opponent's evidence, attached as Exhibit SN-6 to the Ndiaye affidavit are printouts from a website located at *www.cartise.ca*, said to be extracted on August 15, 2013. The printouts bear the trade-mark CARTISE in a stylized font, together with photos of women's clothing and the notation "©2013 Cartise" at the bottom of most pages. There is also a list of three "Cartise Boutiques" located in Quebec. Setting aside the question of whether or not this website belongs to the Applicant and the fact that these printouts are dated after the material date, nothing in these webpages puts into question the Applicant's alleged date of first use of October 2009 with "bags, namely purses, handbags and clutch bags".

[47] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act. Thus the issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act. The Opponent has failed to provide any evidence or submissions in support of this ground of opposition.

[48] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the

required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Opponent did not provide nor refer to any evidence in support of either section 30(i) ground of opposition.

[49] Consequently, I dismiss all of the non-conformity to section 30 grounds of opposition in view of the Opponent's failure to meet its initial burden in each case.

Was the Mark Distinctive of the Applicant's Goods and Services at the Date of Filing of the Statement of Opposition?

[50] The Opponent has pleaded that the Mark does not and cannot act to distinguish the Applicant's goods and services from those of the others, including the Opponent, nor is it adapted so to distinguish them, in view of the provisions of section 2 of the Act.

[51] In order to meet its initial burden, the Opponent is required to show that at least one of its alleged trade-marks had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

[52] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely March 11, 2013 [see *Metro-Goldwyn-Mayer Inc*]. For the reasons that follow, I dismiss the ground of opposition for the Opponent's failure to satisfy its initial burden.

[53] At the outset of the discussion, I note that the Ndiaye affidavit revolves around the use and the reputation of the trade-mark CARTIER, with no evidence pertaining to the use or promotion of any other trade-marks alleged by the Opponent in its statement of opposition.

[54] In terms of the trade-mark CARTIER, as per my review of the Ndiaye affidavit, I am unable to determine the extent to which it has become known in Canada in view of the many

deficiencies with the Opponent's Internet evidence and the lack of sales and advertising information related to the Opponent's goods and services in Canada.

[55] In view of the foregoing, I am not satisfied that the Opponent's trade-mark CARTIER had become known sufficiently to negate the distinctiveness of the Mark in Canada, as of March 11, 2013.

Remaining Grounds of Opposition

[56] As I have addressed three grounds of opposition and I have decided one of them in favour of the Opponent, I will not consider the grounds of opposition based on non-entitlement.

Disposition

[57] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application to extend the statements of goods and services filed under application No. 1,276,683(02), under section 38(8) of the Act.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Opponent’s Registered Trade-mark	Reg. No.	Goods and Services
CARTIER	TMA146,843	<p>Goods:</p> <p>(1) Articles of jewelry for personal wear, and watches.</p> <p>(2) Articles of jewelry for personal wear, pearls, jade, watches, and articles of solid or plated silverware namely, table flatware and hollowware, candelabra, bonbon cases, jewelry cases, crosses, rosaries and buckles.</p> <p>(3) Leather goods, namely purses, pocketbooks, combination pocketbooks and shopping bags, wallets, billfolds, key cases, card cases, brief cases, photograph cases, leather clock cases, travelling cases and overnight bags both fitted and unfitted.</p> <p>(4) Stationery namely writing and letter paper, envelope openers, ink stands, desk sets, ungraduated rulers, blotters, desk pads, desk calendars and calendar holders , diaries and covers therefor, address books, writing cases, memorandum books, pads, loose-leaf covers and binders and fountain pens.</p> <p>(5) Articles of jewelry for personal wear, articles of solid or plated silverware namely, table flatware and hollowware, toilet articles namely, silver military brushes, dresser sets, fitted toiletry bags, combs and comb cases, holders for cosmetics, candelabra, bonbon cases, jewelry cases, crosses, rosaries, buckles.</p> <p>(6) Watches and clocks.</p> <p>(7) Purses and pocketbooks.</p> <p>(8) Envelope openers, desk sets, ungraduated rulers, blotters, desk pads, desk calendars and calendar holders, diaries, and covers therefor, address books, writing cases, memorandum books, pads, loose-leaf covers and binders and fountain pens.</p> <p>(9) Combination pocketbooks and shopping bags, wallets, billfolds, key cases, card cases, brief cases, photograph cases, leather clock cases, travelling cases and overnight bags, both fitted and unfitted.</p> <p>(10) Precious metal ware namely, the following articles made, in whole or in part, of precious metals or plated with the same: viz., combs and comb cases, jewel boxes and</p>

Opponent's Registered Trade-mark	Reg. No.	Goods and Services
		<p>cases, hat ornaments, tie clips, fobs, charms, bracelets, watch bracelets and buckles therefor not including watches, cuff links, collar buttons, shirt studs, waist coat buttons, lockets, brooches, hair ornaments, earrings, hat pins, jewelry clips, jewelry novelties, holders for cosmetics, eyeglass cases, cigar and cigarette cases and boxes and snuff boxes, cigarette and cigar holders, ash trays, bowls, vases, key chains, finger rings, thimbles, check book covers, mesh bags, candlesticks, encrusted or otherwise ornamented with either or both precious metals and jewels.</p> <p>(11) Lighters and parts therefor.</p> <p>(12) Perfumes, pencils and luggage.</p> <p>Services:</p> <p>(1) All services incidental to, connected with or involved in the operation of a retail jewellery, smoker's supply, luggage, watch, cosmetics, stationery and gift store, or boutique within a store.</p>
CARTIER	TMA297,248	<p>Goods:</p> <p>(1) Belts.</p>