



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

Citation: 2013 TMOB 170
Date of Decision: 2013-10-07

**IN THE MATTER OF OPPOSITIONS by
Zainab Ansell and Roger Ansell, a
partnership to application Nos. 1,215,860;
1,522,904; 1,522,906; and 1,522,907 for the
trade-marks ZARA KIDS, ZARA WOMAN,
ZARA MAN, and ZARA BABY respectively
in the name of Industria De Diseno Textil,
S.A.**

[1] Zainab Ansell and Roger Ansell, a partnership (the Opponent) opposes registration of the trade-marks ZARA KIDS, ZARA WOMAN, ZARA MAN, and ZARA BABY (sometimes collectively referred to as the Marks) that are respectively the subject of application Nos. 1,215,860; 1,522,904; 1,522,906; and 1,522,907 by Industria De Diseno Textil, S.A. (the Applicant).

[2] The particulars of the applications for the Marks are detailed in Schedule “A” to my decision.

[3] The Opponent alleges that the Applicant is not the person entitled to registration of the Marks and that the Marks are not distinctive under section 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because they are all confusing with the Opponent’s word and/or design marks ZARA TANZANIA ADVENTURES, ZARA TANZANIA ADVENTURES LOGO, ZARA TOURS, ZARA TRAVEL, and ZARA INTERNATIONAL that have allegedly been previously used or made known in Canada by the Opponent in association with travel agency services and the operation of a wildlife campsite. The Opponent further alleges that the applications for the

Marks do not comply with the requirements of section 30 of the Act in that the Applicant has not used the Marks in association with all of the wares and/or services set forth in its applications since the claimed date of first use or at all.

[4] For the reasons that follow, each of the Opponent's oppositions ought to be rejected.

The Record

[5] The statements of opposition were filed by the Opponent on September 6, 2011 (with respect to application Nos. 1,215,860 and 1,522,904) and September 19, 2011 (with respect to application Nos. 1,522,906 and 1,522,907). By way of letter dated October 12, 2011, the Applicant filed and served its counter statement in each case and also requested an interlocutory ruling with respect to some paragraphs of the statements of opposition. By way of Office letter dated November 22, 2011, the Registrar struck paragraphs 1(a) and (c) of each statement of opposition. The remaining grounds of opposition are those contained in paragraphs 1(b), (d) and (e), namely the non-entitlement, non-distinctiveness, and non-conformity grounds of opposition outlined above.

[6] As its evidence in each case, the Opponent filed a single affidavit (executed in four copies) of Shantelle Garrick, a secretary employed by the Opponent's agent, sworn February 13, 2012. By way of letter dated February 28, 2012, the Applicant advised the Registrar that it did not wish to submit evidence and that it objected to the admissibility of the Garrick affidavit on the basis that it emanates from an employee of the Opponent's agent. I will address that objection in more detail below in my analysis of the non-conformity ground of opposition.

[7] Both parties filed written arguments in each case and a single hearing was held at which only the Applicant was represented.

The parties' respective burden or onus

[8] The legal onus is on the Applicant to show that its applications do not contravene the provisions of the Act as alleged in the statements of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts

inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

[9] Applying these principles, the non-entitlement and non-distinctiveness grounds of opposition can be summarily dismissed for the reasons that follow.

Grounds of opposition summarily dismissed

The non-entitlement ground of opposition

[10] The non-entitlement ground of opposition can be summarily dismissed in each case because the Opponent has failed to show that as of the dates of first use claimed in the Applicant's applications (with respect to application Nos. 1,522,904; 1,522,906; and 1,522,907 for the trade-marks ZARA WOMAN; ZARA MAN; and ZARA BABY respectively), or as of the priority filing date of the Applicant's application (with respect to application No. 1,215,860 for the trade-mark ZARA KIDS), one or more of the Opponent's word and/or design marks ZARA TANZANIA ADVENTURES, ZARA TANZANIA ADVENTURES LOGO, ZARA TOURS, ZARA TRAVEL, and ZARA INTERNATIONAL had been previously used or made known in Canada and had not been abandoned as of the dates of advertisement of the applications [section 16(5) of the Act]. In fact, the Opponent did not file any supporting evidence or make any submissions with respect to this ground.

The non-distinctiveness ground of opposition

[11] The non-distinctiveness ground of opposition can be summarily dismissed in each case because the Opponent has failed to show that as of the filing dates of the statements of opposition, one or more of its word and/or design marks ZARA TANZANIA ADVENTURES, ZARA TANZANIA ADVENTURES LOGO, ZARA TOURS, ZARA TRAVEL, and ZARA INTERNATIONAL had a substantial, significant or sufficient reputation in Canada so as to

negate the distinctiveness of the Marks [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. In fact, the Opponent did not file any supporting evidence or make any submissions with respect to this ground.

[12] This leaves us with the non-conformity ground of opposition in each case.

Remaining ground of opposition

The non-conformity ground of opposition

[13] As indicated above, the Opponent has pleaded that the Applicant has not used the Marks as alleged in its applications. More particularly, with respect to application Nos. 1,522,904; 1,522,906; and 1,522,907 for the trade-marks ZARA WOMAN; ZARA MAN; and ZARA BABY respectively, the Opponent has pleaded that the Applicant has not used the marks in Canada in association with each of the wares and services set forth in its applications since the claimed dates of first use, or at all [contrary to section 30(b) of the Act]. With respect to application No. 1,215,860 for the trade-mark ZARA KIDS, which is based on used and registration of the mark in Spain, the Opponent has pleaded that the Applicant has not used the mark in Spain in association with each of the services set forth in its application [contrary to section 30(d) of the Act].

[14] The material date to consider this ground of opposition is the filing date of each of the Applicant's applications [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) (with respect to section 30(b) of the Act); and *Austin Nichols & Co, Inc v Cinnabon, Inc* (2000), 5 CPR (4th) 565 (TMOB) (with respect to section 30(d) of the Act)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) or (d) of the Act are more readily available to the Applicant, the evidential burden on the Opponent with respect to such a ground of opposition is less onerous [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)].

[15] To support its factual allegations, the Opponent relies on the Garrick affidavit that purports to introduce into evidence the results of various searches conducted on the website www.zara.com and the Internet Archive Wayback Machine digital library at

<http://wayback.archive.org>.

[16] As indicated above, the Applicant objects to the admissibility of the Garrick affidavit. I shall thus determine first whether the Garrick affidavit is admissible or not.

The admissibility of the Garrick affidavit

[17] Relying primarily on the decision in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA), the Applicant submits that the Garrick affidavit is inadmissible in its entirety as it comes from an employee of the Opponent's agent, and relates to the one and only point of substance and controversy remaining in these proceedings. In the alternative, the Applicant submits that little weight, if any, should be given to the affidavit since there is so little in it which is admissible or reliable.

[18] By contrast, the Opponent submits that the Garrick affidavit is admissible as it does not comprise any contentious opinion evidence whatsoever. In support, the Opponent relies on the decisions of the Registrar in *Mr Lube Canada Inc v Denny's Lube Centre Inc* (2008), 73 CPR (4th) 308; *Canadian Council of Professional Engineers v Alberta Institute of Power Engineers* (2008), 71 CPR (4th) 37; and *Canadian Jewellers Assn v American Gem Society* (2010), 86 CPR (4th) 131.

[19] The Federal Court of Appeal makes it clear that "it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give opinion evidence on the most crucial issues in the case" [*Cross-Canada, supra*, at para 4]. While the Court is less clear on how solely non-opinion evidence furnished by a firm's employee should be treated, it does state that "it is improper for a solicitor to compromise his independence by acting in a proceeding in which a member of his firm has given affidavit evidence on a point of substance" [*Cross-Canada, supra*, at para 7].

[20] For the purpose of determining the admissibility or weight to be given to the Garrick affidavit, I will first briefly go over that affidavit.

[21] Ms. Garrick states that she is a secretary employed by the agent of record for the Opponent. She has held this position since April, 2008 [para 1 of her affidavit].

[22] Ms. Garrick states that as part of her secretarial duties, she has occasions to access various online databases and to conduct online searches through various search engines [para 3 of her affidavit].

[23] Ms. Garrick states that she “received instructions to access the Applicant’s website at *www.zara.com*” and:

- to conduct searches for a number of wares in the search box provided. More particularly, Ms. Garrick lists a total of 31 items searched, including “walking sticks”, “whips”, saddlery”, “harnesses”, etc. She attaches to her affidavit as Exhibit “A” the printouts of the results of these searches dated February 9, 2012 [paras 4 and 5 of her affidavit];
- to click on the link for “STORES”. Under the region of “Canada”, she was instructed to conduct searches for the provinces and territories of Canada in the search box provided. She attaches to her affidavit as Exhibit “B” the printouts of the results of these searches dated February 9, 2012 [paras 6 and 7 of her affidavit];
- to click on the links “WOMAN”, “MAN”, “CAMPAIGN”, and “KIDS”. She attaches to her affidavit the following exhibits:
 - Exhibit “C-1” a screenshot of the webpage for the link “WOMAN”; and as Exhibit “C-2” printouts of the webpages for each of the sub-links under “WOMAN”, namely: Blazers, Dresses, Skirts, Trousers, Jeans, etc., all dated February 10, 2012 [para 8 of her affidavit];
 - Exhibit “D-1” a screenshot of the webpage for the link “MAN”; and as Exhibit “D-2” printouts of the webpages for each of the sub-links under “MAN”, namely: Jackets and Parkas, Blazers, Suits, Trousers, Jeans, etc., all dated February 10, 2012 [para 9 of her affidavit];
 - Exhibits “E-1”, “E-2” and “E-3” screenshots dated February 10, 2012 of the webpages for each of the sub-links under “CAMPAIGN”, namely “WOMAN”, “MAN” and “KIDS” respectively [para 10 of her affidavit]; and

- Exhibit “G-1” a screenshot of the webpage for the link “KIDS”; and as Exhibit “G-2” printouts of the webpage for each of the sub-links under “KIDS”, namely: Girl, Boy, Baby Girl, etc., all dated February 13, 2012 [para 12 of her affidavit].

[24] Ms. Garrick states that on February 10, 2012, she “also received instructions to access the Internet Archive Wayback Machine digital library at <http://wayback.archive.org> and search the website address www.zara.com. [She] clicked on May 8, 1999, the only archived date available for that year.” She attaches to her affidavit as Exhibit “F-1” a screenshot printed for the year 1999 and as Exhibit “F-2” a printout of the archived webpage for May 8, 1999 [para 11 of her affidavit].

[25] In the present cases, I agree with the Applicant that the Garrick affidavit relates to a contested issue, that is whether or not the Applicant has used the Marks as alleged in its applications. On the other hand, I agree with the Opponent that a parallel can be made between the present cases and the decisions of the Registrar relied upon by it, wherein the decision to consider affidavit evidence given by an employee turned on whether or not contentious *opinion* evidence of the type adduced in *Cross-Canada* was given.

[26] That said, I do not find it necessary to discuss those decisions further. Nor do I consider it necessary to rule on the admissibility of the Garrick affidavit because, even if I were to find it admissible, I would still find that no weight ought to be given to it since it provides little, if any, relevant or reliable evidence.

[27] As stressed by the Applicant, there is no evidence that the website www.zara.com belongs to the Applicant. The mere fact that Ms. Garrick baldly states that she was instructed “to access the Applicant’s website at www.zara.com” does not establish that this website belongs to the Applicant. Except for Exhibit “F-2” that apparently pertains to an unrelated software company, none of the exhibits attached to the Garrick affidavit provide any indication as to the ownership of the domain name [zara.com](http://www.zara.com) or the entity operating the website www.zara.com. As a result, I agree with the Applicant that the Opponent has failed to establish a connection between the website www.zara.com and the Applicant [see *Quiksilver International Pty Ltd v Equinox Entertainment Limited* 2010 TMOB 59 CanLII].

[28] In addition, all of the webpages and printouts attached to the Garrick affidavit postdate the material date to assess each of the non-conformity grounds of opposition raised in these proceedings, except for the archive webpages filed as Exhibits “F-1” and “F-2” discussed below. Further, it is unclear how searches conducted in 2012 could locate evidence of use from the years 1991, 1999, 2000 or 2004 as alleged in the Applicant’s applications.

[29] Reverting to Exhibits “F-1” and “F-2”, Exhibit “F-1” merely consists, as I read it, of a “calendar view” that “maps the number of times <http://www.zara.com> was crawled by the Wayback Machine, not how many times the site was actually updated.” I fail to understand how the fact that the website would have “been crawled 784 times going all the way back to December 5, 1998”, provides any information as to what the website looked like or to whom it belonged to at that time. Exhibit “F-2” relates to a software company named “Xara Ltd” and indicates “784 captures” between “5 Dec 98 – 19 Jul 11”. Interestingly, these number and time period apparently match the ones indicated in Exhibit “F-1”. In other words, Exhibits “F-1” and “F-2” do not assist the Opponent.

[30] Other deficiencies with the Garrick affidavit include the following facts:

- Ms. Garrick’s searches apparently purported to locate wares as opposed to the Marks themselves;
- except for application No. 1,215,860 for the trade-mark ZARA KIDS, the Applicant’s applications do not claim that the Marks have been used on the Internet; and
- with respect to application No. 1,215,860 for the trade-mark ZARA KIDS, Ms. Garrick’s searches apparently purported to Canada as opposed to Spain.

[31] To sum up, the Garrick affidavit is of no assistance to the Opponent.

Conclusion regarding the non-conformity ground of opposition

[32] In view of my findings made above as to the weight to be given to the Garrick affidavit, I find that the Opponent has failed to satisfy its evidential burden in respect of each of the non-conformity grounds of opposition. Accordingly, each of these grounds is dismissed.

Disposition

[33] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject each of the oppositions pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Trade-mark	Appl'n No. / Appl'n Date	Wares and/or Services (as last amended by the Applicant) Claims
ZARA KIDS	1,215,860 2004-05-05	<p>Advertising, namely: database marketing services in the form of compiling customer specific databases for marketing purposes and consulting, designing, printing and collecting marketing information; promoting the sale of credit card accounts through the administration of incentive award programs, advertising agency services, advertising the wares and services of others, electronic billboard advertising of the wares and services of others, licensing of advertising slogans. Business management services; business administration services; office functions, namely: computerised data processing and data base management and organisation of exhibitions for commercial and advertising purposes. Shop-window display services, in-store demonstration of goods by showing and displaying the goods and their uses and benefits; publication of publicity texts for third party. Organization of trade fairs for commercial and advertising purposes, organization of exhibitions for commercial or advertising purposes; sales promotions for others through the distribution of a loyalty customers card; franchising business management assistance. Management assistance to a business handling orders through global communication networks, credit and shopping card business management assistance, modelling services for advertising or sale promotion purposes. Promoting shopping centres for others through the distribution of printed material and promotional contests; management of malls (shopping centres); retail sales services in shops or through global communications networks of clothing, clothing accessories, headgear, underwear, bath robes, swimsuits, footwear, handbags, perfumes, watches, jewellery and imitation jewellery, sunglasses, towels, cds, dvds, textiles and textile goods, games and toys, notebooks, agendas; public auctioneering. Retail store, computerized online retail, and catalogue services in the fields of housewares, furniture, home furnishings, glassware, tableware, gifts, household linens, dinnerware, cookware, clothing, clothing accessories, beauty and personal care products, leather goods, luggage and bags</p> <p>Priority Filing Date: April 30, 2004, Country: SPAIN, Application No:2594328 in association with the same kind of services. Used in SPAIN.</p>

		Registered in or for SPAIN on October 15, 2004 under No. 2594328
ZARA WOMAN	1,522,904 2011-04-08	Leather and imitations of leather; goods made of these materials, namely: animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, bags for climbers, bags for campers, beach bags, handbag frames, umbrella or parasol frames, mountaineering sticks, handbags, key cases, attaché cases, purses not of precious metal, school bags, garment bags for travel, hat boxes of leather, sling bags for carrying infants, wheeled shopping bags, flower pots and decorative pots of leather or of leather board, decorative boxes of leather, jewellery boxes of leather, music boxes of leather and pencil boxes of leather, decorative boxes of vulcanised fibre, school satchels, pocket wallets, briefcases, vanity cases sold empty, collars for animals, leather leashes, leather leads, umbrella covers, saddle cloths for horses, backpacks, horse blankets, haversacks, halters, envelopes and pouches of leather for packaging, riding saddles, pads for horse saddles, umbrella rings, blinders [harness], harness fittings, harness for animals, walking stick seats, bandoliers, tool bags of leather sold empty, chain mesh purses, muzzles, bridles [harness], leather board, travelling trunks, shopping bags, straps for soldiers' equipment, harness straps, straps of leather [saddlery], straps for skates, trimmings of leather for furniture, leather straps, butts [parts of hides], curried skins, cat o' nine tails, coverings of skins [furs], stirrup leathers, part of rubber for stirrups; reins, suitcases, moleskin [imitation of leather], fur-skins, chamois leather, nose bags [feed bags], net bags for shopping, knee-pads for horses, fastenings for saddles, card cases, note cases, traces [harness], valves of leather, stirrups. Ready-made clothing for women, men and children, namely: athletic clothing, baby clothing, casual clothing, children's clothing, dress clothing, fire protective clothing, fire retardant clothing, fishing clothing, infant clothing, motorcyclist protective clothing, radiation protective clothing, sports clothing, sun protective clothing, outdoor winter clothing, belts, jackets, bibs, not of paper; bathrobes; swimming costumes, boas (to wear around the neck), underwear, babies' pants, scarves, hoods, money belts (clothing), wet suits for waterskiing, ties, corsets, sashes, fur stoles, girdles, shawls, gloves, waterproof clothing, mantillas, stockings, socks, neck scarves, textile nappies, pyjamas, veils, braces, layettes, collars, singlets, mittens, bow ties, pareos, cuffs, dress shields, masquerade costumes, beach dresses. Footwear (except orthopaedic footwear), namely: athletic footwear, beach footwear, casual

		<p>footwear, children's footwear, evening footwear, exercise footwear, fire protective footwear, golf footwear, infant footwear, rain footwear, outdoor winter footwear, ski footwear, sports footwear, bathing sandals, soles, heels, insoles. Headgear, namely: headbands, beret, bonnets, caps, bathing caps, hoods, hats, ear muffs, bandanas, cap peaks.</p> <p>Retail sale of clothing, clothing accessories, hats, footwear, watches and clocks, eyeglasses, sunglasses, sports glasses, CDs, DVDs, leather and artificial leather goods, luggage and bags, jewellery, imitation jewellery, stationery, umbrellas, beach towels, textiles and textile goods, hair ornaments, games and toys, sport articles.</p> <p>Used in CANADA since at least as early as December 3, 1999.</p>
ZARA MAN	1,522,906 2011-04-08	<p>Wares and Services: Same as those for ZARA WOMAN.</p> <p>Used in CANADA since at least as early as December 3, 1999 on wares.</p> <p>Used in CANADA since at least as early as December 3, 1991 on services.</p>
ZARA BABY	1,522,907 2011-04-08	<p>Wares and Services: Same as those for ZARA WOMAN.</p> <p>Used in CANADA since at least as early as June 2000.</p>