



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

**Citation: 2011 TMOB 172**  
**Date of Decision: 2011-09-17**

**IN THE MATTER OF AN OPPOSITION  
by The John Forsyth Shirt Company Ltd.  
to an application to extend the statement  
of wares of registration No. TMA617,206  
(Application No. 1165888) for the trade-  
mark TIGER CUB in the name of Golf  
Source International Ltd.**

[1] The trade-mark TIGER CUB (the Mark) was registered by Golf Source International Ltd. (the Applicant) on August 20, 2004, for “golf clubs; golf bags; golf accessories, namely embraces [sic] golf balls, golf tees and golf markers.” On July 11, 2007, the Applicant filed an application to extend the statement of wares of its registration to include the following wares, as revised:

Golf shirts, golf pants, baseball caps, golf wind shirts, golf socks, golf rain suits, golf gloves.

[2] The extension application was based on proposed use of the Mark in Canada with these wares.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 21, 2009.

[4] On April 2, 2009, The John Forsyth Shirt Company Ltd., (the Opponent) filed a statement of opposition against the application. The first ground of opposition is that the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because

it is confusing with the registered trade-marks of the Opponent, as listed in the attached Schedule A. The second ground is that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) because, at the date of filing of the application, the Mark was confusing with the Opponent's registered marks listed in the attached Schedule A which had been previously used in Canada. As its third ground, the Opponent argues that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(b) of the Act because the Mark was confusing with the Opponent's registered mark listed in the attached Schedule B, an application for which had been previously filed in Canada. The final ground of opposition is that the application should be refused because the Mark is not distinctive pursuant to s. 38(2)(d) and s. 2 of the Act because the Mark does not actually distinguish and is not adapted to distinguish the wares in association with which it is used or proposed to be used by the Applicant from the wares and services of others including the Opponent because it is confusing with the Opponent's registered trade-marks.

[5] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[6] The Opponent's r.41 evidence consists of the affidavit of Fatima DaPonte, a legal assistant with the Opponent's firm whose affidavit attaches certified copies of each of the Opponent's registrations. The Applicant's r.42 evidence consists of the affidavit of Thomas Cahill, President and Founder of the Applicant. As its r. 43 evidence, the Opponent filed the affidavit of Wendell Wilkinson, Vice-President of Operations of the Opponent. There were no cross-examinations on any of this evidence.

[7] Both the Applicant and the Opponent filed written arguments. Neither party requested an oral hearing.

#### Onus and Material Dates

[8] 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 [see *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.)].

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

- s. 12(1)(d) - the date of my decision [see *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 [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

#### Preliminary Issues

#### Evidence in Reply

[10] In its written argument, the Applicant objected to the Opponent's reply evidence filed February 25, 2010, on the basis that it was not proper reply evidence. Pursuant to r. 43 of the *Trade-mark Regulations* proper reply evidence is evidence strictly confined to matters in reply.

[11] The Applicant's affiant, Mr. Cahill, states the following at paragraphs 6 and 7 of his affidavit:

6. I have been involved in the selling and marketing of golf products throughout my career, namely since 1973. I have never heard of the Opponent's alleged TIGER brand clothing.

7. Attached hereto as Exhibit 1 is a copy of the search results showing that there are no items under the name TIGER on the Opponent's website for Canada. Also attached hereto as part of Exhibit I is a printout of the search results for the term Tiger at [www.sportchek.ca](http://www.sportchek.ca), the largest retailer of sports clothing in Canada and again there were no products of the Opponent; at most, there were two results for t-shirts for the TIGER-CATS football team.

[12] Mr. Wilkinson, the Opponent's affiant, states the following at paragraph 2 of his affidavit:

2. In paragraph 7 of his affidavit Mr. Cahill claims that he cannot find any evidence of use of the TIGER BRAND marks by the Opponent in Canada.

[13] His affidavit then sets out, *inter alia*, particulars of the Opponent's sales of TIGER marks in Canada, photos of examples of products sold by the Opponent under its TIGER marks, newspaper advertisements for the TIGER marks, information about where the Opponent's TIGER wares are generally sold and information about the Opponent's history.

[14] I agree with the Applicant that Mr. Wilkinson misstated Mr. Cahill's evidence. In this regard, Mr. Cahill did not state that he could not find evidence of use of the Opponent's marks in Canada. Instead, as noted above, he indicates that he had never heard of the Opponent's TIGER clothing and that he did not find any of the Opponent's TIGER wares on either the Opponent's website or the [www.sportchek.ca](http://www.sportchek.ca) website. In my view, Mr. Wilkinson's extensive evidence of use and advertising of its TIGER marks does not properly reply to Mr. Cahill's evidence and instead should properly have been submitted as the Opponent's evidence in chief [see *Bombardier Ltd. v. Restrictive Trade Practices Com'n* (1980), 48 C.P.R. (2d) 248 at 257 (F.C.T.D.)]. I have therefore disregarded the evidence of Mr. Wilkinson for the reason that it is not strictly confined to evidence in reply.

#### Section 16 and s. 38(2)(d) Grounds of Opposition

[15] In view that I have disregarded the reply affidavit of Mr. Wilkinson, the only evidence of the Opponent is the affidavit of Ms. Daponte, which, as previously noted, introduces as exhibits certified copies of the Opponent's registered marks which are being relied upon in this opposition. It has been previously held that, where the only evidence consists of a certified copy of the opponent's registration, the Registrar will assume only *de minimus* use of the opponent's trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Therefore the filing of certified copies of the Opponent's registrations in the present case will not support the Opponent's evidential burden with respect to grounds of

opposition based on allegations of non-entitlement or non-distinctiveness. These grounds are therefore dismissed.

#### Section 12(1)(d) Ground

[16] The next ground to be considered is whether the Mark is confusing with any of the Opponent's TIGER marks noted above pursuant to s. 12(1)(d) of the Act. I will assess the likelihood of confusion between the Applicant's Mark and the Opponent's trademark TIGER, as registered under No. TMA186812, as that represents the Opponent's strongest case.

#### *the test for confusion*

[17] 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 or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services 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 or trade-names and the extent to which they have become known; b) the length of time each 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[18] The Supreme Court of Canada discussed the appropriate process for assessing all of the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 S.C.C. 27; *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. In *Masterpiece* in particular, the Court stated that the most significant factor for the confusion analysis is the degree of resemblance, and as a result, most confusion analyses should begin with this factor. Using this approach I shall now assess all of the surrounding circumstances.

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

[19] There is a considerable degree of resemblance in all respects between the marks at issue. In fact, the Applicant has adopted the entirety of the Opponent's registered mark as the first component of its Mark.

*s. 6(5)(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known*

[20] The marks of both parties are inherently distinctive as there is no natural association between a tiger or tiger cub and clothing.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. As I have not had regard to the Opponent's evidence of use of its marks, I cannot conclude that the Opponent's mark has become known to any significant extent in Canada.

[22] On the other hand, the affidavit of the Applicant's affiant, Mr. Cahill, establishes that the Applicant has already registered the Mark in Canada in connection with golf clubs, golf bags, and golf accessories and has used the Mark in association with such wares since at least as early as 2004. Further, the Mark has been used with golf shirts, golf pants, caps, golf wind shirts, golf socks, golf rain suits and golf gloves, since at least as early as the fall of 2007. The Mark visibly appears on the product when it is sold, such as on neck labels, hang tags, and on outside surfaces of the product, photocopies of samples of which are attached as Exhibit C to his affidavit. As Mr. Cahill failed to provide any sales or advertising figures, however, it is difficult to determine to what extent the Mark has become known in Canada. I therefore do not find that this factor favours either party.

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

[23] I do not consider the length of time each of the marks has been used to favour either party. As noted above, while Mr. Cahill testifies that the Applicant has used the Mark with the applied for wares since the fall of 2007, there is no indication regarding the extent of use. As for

the Opponent, while the Opponent's registration is based on use of its mark since at least as early as 1954 with the wares marked (1), the filing of a certified copy of a registration can only support an assumption of *de minimus* use of the registered trade-mark [*Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

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

[24] When considering the wares, services and trades of the parties, it is the statement of wares 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.)].

[25] At paragraph 5 of his affidavit, Mr. Cahill explained the differences between the specific wares of the parties. He noted that the registered wares of the Opponent do not include the Applicant's applied for wares. In this regard, he notes that athletic shirts would not have a collar while golf shirts do, golf pants have a different pocket as compared to gym shorts, and golf wind shirts and rain suits are designed differently from jogging suits. While I agree that there are differences between the specific items of clothing of the parties, I still consider there to be overlap between the parties' wares because both parties' wares include sportswear. Further, while I note from the Applicant's evidence that its applied for wares appear to be marketed toward children, in the absence of a restriction in the Applicant's statement of wares, I cannot consider that fact since the Applicant is seeking protection for a broader statement of wares in which clearly there would be overlap between the parties' wares and the channels of trade.

*further surrounding circumstances*

[26] As a further surrounding circumstance, there is the evidence introduced by Mr. Cahill concerning the state of the Trade-mark Register. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*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.C.T.D.)]. Inferences about the state of the marketplace can only be

drawn from state of the register evidence where large numbers of relevant registrations are located [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[27] A review of the Cahill search results reveal about ten relevant registered third party TIGER marks for clothing, standing in the name of eight different owners. In my view, the existence of ten relevant registrations owned by eight different owners is insufficient in number to make any inferences about the state of the marketplace. While Mr. Cahill's Internet searches may have revealed a handful of results for web pages containing the term "tiger" together with the term "shirts", this evidence is not sufficient to show use of such marks in the Canadian marketplace pursuant to s. 4(1) of the Act. Therefore, in the absence of evidence of actual use of TIGER marks for clothing in the marketplace, the Applicant's state of the register evidence is of little value.

[28] The Applicant further argues that another surrounding circumstance to consider is the lack of confusion between the marks despite more than two years of alleged co-existence. It is of course not necessary for the Opponent to evidence confusion in order for me to find that there is a likelihood of confusion but the absence of confusion despite the overlap of the wares and channels of trade could result in a negative inference being drawn about the Opponent's case [see *MonSport Inc. v. Vetements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.); *Mercedes-Benz A.G. v. Autostock Inc.* (1996), 69 C.P.R. (3d) 518 (T.M.O.B.)]. In the present case, however, the relatively short period of alleged co-existence and the lack of admissible evidence that either party's mark has been used in Canada to any great extent prevent me from drawing any negative inference.

### *Conclusion*

[29] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees TIGER CUB on the Applicant's golf clothing at a time when he or she has no more than an imperfect recollection of the Opponent's TIGER trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].



[30] In view of my findings above, the high degree of resemblance between the marks in appearance, and the fact that the parties wares overlap, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares associated with the Opponent's TIGER mark and the Applicant's TIGER CUB mark were manufactured, sold or performed by the same person.

[31] The s. 12(1)(d) ground of opposition therefore succeeds.

Disposition




[32] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application to extend the wares pursuant to s. 38(8) of the Act.

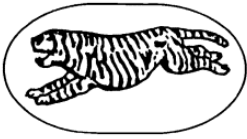

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Cindy R. Folz  
Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule A


### Registered Trade-marks

| TRADE-MARK  | Registration No. | Wares/Services   |
|---|------------------|--|
| <p>TIGER &amp; Design</p>          | TMA678590        | Clothing, namely, pants, shorts, shirts, blouses, jackets, underwear, lingerie, sleepwear, sweaters, coats, dresses, skirts, sweatshirts, T-shirts, tank tops, halter tops and vests |
| <p>TIGER'S HEAD Design</p>        | TMA321196        | Men's and boys' T-shirts, underwear, pants, shorts, tank tops, swim suits, fleece vests, sweatshirts and sweatpants.   |
| <p>TIGER BRAND &amp; Design</p>  | TMA115111        | Briefs, drawers, pullover shirts, athletic shirts and T-shirts (all otherwise known as underwear).   |
| TIGER   | TMA186812        | <p>Men's and boys' briefs, drawers, pullover shirts, athletic shirts, and T-shirts.</p> <p>Men's and boys' long sleeved knitted shirts.</p> <p>Men's and boys' jogging suits.</p>    |

|   |           |  |
|---|-----------|--|
|   |           | <p>Men's and boys' button shirts.</p> <p>Men's and boys' gym shorts.</p> <p>Ladies' jump suits and jogging suits.</p> <p>Ladies' outer shirts.</p> <p>Ladies' dresses, blouses, gym shorts, and bathing suits.</p> <p>Ladies' halters.</p> |
| <p>TIGER DESIGN</p>    | TMDA5874  | <p>Knitted underwear.</p> <p>T-shirts, fleece vests, sweatshirts, sweatpants, shorts, tank tops, swim suits, pants, shirts, dresses and skirts.</p>  |
| <p>TIGER BRAND</p>  | TMDA39406 | <p>Knitted underwear.</p>  |
| <p>TIGER DESIGN</p>  | TMA373597 | <p>Men's, ladies' and children's clothing, namely shirts, tops, T-shirts, sweat shirts, sweat pants, jumpsuits, shorts, pants, body wear, namely stretch tights and tops; dresses, skirts and sweaters.</p>                                |

## Schedule B

### Registered Trade-mark

| Trade-mark  | Appn No. | Registration No. | Regn. Date | Wares and/or Services   |
|---|----------|------------------|------------|---|
| TIGER BRAND & Design<br> | 1262827  | TMA703001        | 2007-12-12 | Clothing, namely pants, shorts, shirts, blouses, jackets, underwear, sleepwear, sweaters, dresses, skirts, sweatshirts, T-shirts, tank tops, halter tops and vests. |