



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

**Citation: 2013 TMOB 81**  
**Date of Decision: 2013-05-08**

**IN THE MATTER OF AN OPPOSITION  
by Rhythm Holding Limited to  
application No. 1,450,846 for the trade-  
mark RHYTHM in the name of Lynda  
Bockler**

I. Background

[1] Lynda Bockler (the Applicant) applied for registration of the trade-mark RHYTHM (the Mark) based upon proposed use in Canada in association with several wares that may be generally described as: underwear, loungewear and sleepwear; health and food supplements; food and beverages; and personal care items. The statement of wares of the application of record, as amended on June 18, 2010, is reproduced in Schedule “A” to this decision.

[2] Rhythm Holding Limited (the Opponent) brought an opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the grounds that: (i) the application does not conform to the requirements of section 30 of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(b) of the Act in view the Opponent’s previously filed applications for the trade-marks RHYTHM Design and RHYTHMLIVIN, which are detailed in Schedule “B” to this decision; and (iii) the Mark is not distinctive within the meaning of section 2 of the Act.

[3] Each party filed evidence and written arguments. Both parties attended a hearing.

## II. Relevant Dates

[4] The material date for considering the conformity of the application to the requirements of section 30 of the Act is the filing date of the application, namely September 8, 2009 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[5] The material date for considering the Applicant's entitlement to the registration of the Mark under section 16(3)(b) of the Act is also the filing date of the application.

[6] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition, namely September 28, 2010 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## III. The Issues

[7] The issues to be resolved in this opposition are:

1. Did the Applicant intend to use the Mark in Canada when she filed the application?
2. Could the Applicant have been satisfied of her entitlement to use the Mark in Canada when she filed the application?
3. Was the Applicant the person entitled to registration of the Mark at the filing date of the application?
4. Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

[8] The third and fourth issues both revolve around the likelihood of confusion between the Mark and the Opponent's trade-marks RHYTHM Design and RHYTHMLIVIN.

## IV. Onus on the Parties

[9] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the Applicant bears the legal burden or onus to establish, on a balance of probabilities, that the Mark is registrable [see *John Labatt Ltd v*

*Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

V. Evidence on the Record

V.1 Opponent's Evidence

[10] The Opponent filed an affidavit of Hung Ho (Maurice) Wong, sworn April 15, 2011. Mr. Wong, who identifies himself as the sole director of the Opponent, was not cross-examined.

[11] The Opponent also filed certified copies of registration Nos. TMA797,545 and TMA797,543 of May 13, 2011 that resulted from its alleged applications for the trade-marks RHYTHMLIVIN and RHYTHM Design respectively. It should be noted in passing that the Opponent filed the certified copies of the registrations as further evidence with leave of the Registrar. However, the Opponent did not seek leave to amend its statement of opposition to plead a ground of opposition under section 12(1)(d) of the Act, in view of confusion with its *registered* trade-marks RHYTHM Design and RHYTHMLIVIN, which I pointed out to the Opponent at the hearing.

V.2 Applicant's Evidence

[12] The Applicant, who has been self-represented throughout the proceeding, filed a document in the form of a three-page letter of August 15, 2011 with attachments. The letter is from the Applicant herself, but it is not signed by the Applicant. Each page of the document is signed by a commissioner for oaths. The following sentence is hand written at the bottom of the first page above the signature of the commissioner for oaths: "Declared before me at the City of Calgary, in the Province of Alberta, this 15<sup>th</sup> day of August, 2011." While it suggests that the document is intended to be a statutory declaration, the Applicant does not declare to the truth of the contents to make it a proper statutory declaration [see section 41 of the *Canada Evidence Act*, RSC 1985 c C-5].

[13] The Opponent's written argument references the document filed by the Applicant as an "unsigned argument". Thus the Applicant has been alerted of her failure to sign the document once she received the Opponent's written argument from the Registrar. Further, the Registrar

considers having the authority to raise on his own the admissibility of a defective affidavit or statutory declaration, especially since the *Trade-marks Regulations*, SOR/96-195 require that evidence be submitted by way of affidavit or statutory declaration [see *Sara Lee Global Finance LLC v Abderahmane Magagi*, 2005 CanLII 78232 (TMOB)].

[14] The Applicant's failure to sign the document is not a technical deficiency; rather it goes to the basis of the document being a statutory declaration. This also applies to the Applicant's failure to declare to the truth of the content of the document. Accordingly, I conclude that the document filed by the Applicant is not admissible as evidence in this opposition and so I will not discuss it further. In any event, the document would not have been of assistance to the Applicant's case even if admissible. The statements contained in the letter essentially amount to the Applicant's opinions on matters that are not relevant to the determination of the issues or opinions on the questions of fact and law to be determined by the Registrar in the opposition.

[15] Finally, I am not prepared to comply with the Applicant's oral request to access the websites referenced in her written argument. In opposition proceedings, the Registrar will have regard to only certain limited subject matter in the absence of it being properly proven in evidence (such as a dictionary definition or the status of a trade-mark registration that forms the basis of a pleading).

## VI. Analysis of the Issues

### VI.1 Did the Applicant intend to use the Mark in Canada when she filed the application?

[16] This issue arises from the ground of opposition alleging that the application does not conform to the requirements of section 30 of the Act because the Applicant did not intend to use the Mark in association with the wares described in the application [section 30(e) of the Act].

[17] I dismiss the ground of opposition and so decide this issue in favour of the Applicant.

*Reasons*

[18] The Opponent did not file any evidence to establish that the Applicant falsely made the statement that she intended to use the Mark by herself and/or through a licensee in Canada in association with the wares listed in the application [see *Home Quarters Warehouse, Inc v Home Dépôt, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); and *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

VI.2 Could the Applicant have been satisfied of her entitlement to use the Mark in Canada when she filed the application?

[19] This issue arises from the ground of opposition alleging that the application does not conform to the requirements of section 30 of the Act because the Applicant could not be satisfied that she was entitled to use the Mark in Canada in association with the wares described in the application [section 30(i) of the Act].

[20] I dismiss the ground of opposition and so decide this issue in favour of the Applicant.

*Reasons*

[21] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant 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, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Those circumstances do not exist in this case.

VI.3 Was the Applicant the person entitled to registration of the Mark at the filing date of the application?

[22] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(3)(b) of the Act because the Mark is

confusing with the Opponent's trade-marks RHYTHM Design and RHYTHMLIVIN for which applications were filed on October 2, 2008.

[23] I decide this issue partly in favour of the Opponent and partly in favour of the Applicant. More particularly, I accept the ground of opposition for the following wares (collectively the Related Wares):

men's, women's and children's underwear garments, namely, boxers, boxer shorts, jockstraps, lowrise, thongs, boyleg, g-string, long leg, slips, and camisoles, briefs, panties, undershirts, brassieres, sleep dresses, thermal ladies and men's underwear, nightgowns, peignoirs, caftans, pajamas, sleep shirts, rompers, lounge wear, sleepwear namely corsets, basques, baby dolls, bra sets, teddies, chemises, full slips, half slips, lingerie, robes, smoking jackets, stockings, nylons, socks, slippers, hosiery, kerchiefs and hankies.

[24] However, I dismiss the ground of opposition for the following wares (collectively the Non-related Wares):

towels; posters; health foods and supplements for general well-being, namely vitamins, minerals, dietary vitamins, mineral and herbal supplements (tablets and powdered), namely, meal replacement bars, protein and meal replacement drinks, diuretics, dried herbs and herb extracts, herbal laxatives and herbal digestive tonics; breakfast cereals, bread, biscuits, fruit juices, vegetable juices, dried fruits, edible nuts, vegetable oils and edible oils. Toiletries and cleansing products for male and female, namely facial cleansing creams, facial emollient creams, facial masks, hand and body lotions, hand and body foams, body gels, soaps, lathers, shaving creams, hair shampoos, hair conditioners, hairspray, hair mousses, hair gels; male and female cosmetics and implements, namely eyeliner, eye shadow, cheek colour, lipstick mascara, perfume, cologne, eau de toilette, nail polish, hair combs, hair brushes.

#### *Reasons*

[25] The Opponent has met its burden of evidencing that each alleged application was filed before the application for the Mark and was pending at the date of the advertisement of the Mark in the *Trade-marks Journal*, namely August 25, 2010 [section 16(4) of the Act]. Thus, the question becomes whether the Applicant has met her legal onus to show that the Mark was not reasonably likely to cause confusion with the Opponent's trade-marks RHYTHM Design (No. 1,413,113) and RHYTHMLIVIN (No. 1,431,115) as of September 8, 2009.

[26] In view of the Applicant's submissions, I first note that the fact that the Opponent's alleged applications were not cited during the examination of the application for the Mark is of no significance in the opposition.

[27] Indeed, the decisions by the Examination Section of the Canadian Intellectual Property Office are not binding and have no precedential value in determining the registrability of a trade-mark in opposition proceedings; the Examination Section does not have before it evidence that is filed by parties in opposition proceedings [see *Chanel S de RL v Marcon* (2010), 85 CPR (4th) 399 (TMOB)]. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage. More particularly, at the examination stage, the Registrar is under an obligation to advertise an application unless he is satisfied that the trade-mark is not registrable [section 37 of the Act]. At the opposition stage, the burden is on the applicant to satisfy the Registrar that the trade-mark is registrable.

[28] 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.

[29] In applying the test for confusion, I 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 the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [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.]

[30] I consider that comparing the Mark and the trade-mark RHYTHM Design effectively decides the outcome of the section 16(3)(b) ground of opposition. In other words, if confusion is

not likely between the Mark and the trade-mark RHYTHM Design, then it would not be likely between the Mark and the mark RHYTHMLIVIN. Accordingly, my following assessment of the surrounding circumstances of this case focuses on the likelihood of confusion between the Mark and the trade-mark RHYTHM Design of application No. 1,413,113. That said, it should be noted that Mr. Wong essentially introduces the evidence by collective reference to the Opponent's trade-marks RHYTHM Design and RHYTHMLIVIN, which is reflected by my use of the terms "Opponent's Marks".

[31] In *Masterpiece, supra*, the Supreme Court of Canada discusses the importance of the degree of resemblance between trade-marks in conducting an analysis of the likelihood of confusion. In the reasons for judgment, Mr. Justice Rothstein states at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[32] Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the Mark and the trade-mark RHYTHM Design.

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

[33] The section 6(5)(e) factor favours the Opponent. As the word "rhythm" forms each mark, there are no differences between them in sound and in the ideas suggested by the marks. Also, the marks are virtually identical in appearance since the word "rhythm" is detectable in the trade-mark RHYTHM Design despite its design feature.

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

[34] Neither party is favoured by the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the trade-marks.



[35] Both the Mark and the trade-mark RHYTHM Design possess some measure of inherent distinctiveness. Although the word “rhythm” is an ordinary word of the English language, it has no descriptive or suggestive connotation in the context of the wares associated with each mark. Further, the inherent distinctiveness of the marks is the same. Indeed, its design feature does not increase the inherent distinctiveness of the trade-mark RHYTHM Design since the fanciful script and the font employed are intrinsic with the word forming mark [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex C)].

[36] In addition to the fact that the application for the Mark is based upon proposed use, there is no evidence to conclude that the Mark had become known in Canada through promotion or use at the material date. Likewise, there is no evidence to conclude that the trade-mark RHYTHM Design had become known in Canada through promotion or use at the material date. More particularly:

- there is no evidence to support Mr. Wong’s allegation that the trade-mark RHYTHM Design was first used in Canada by R.G.I. Limited, the predecessor-in-title of the Opponent, in 2008 [para 6.1 of the affidavit];
- Mr. Wong does not provide evidence showing use or advertisement of the trade-mark RHYTHM Design by R.G.I. Limited before the acquisition of its assets by the Opponent on August 31, 2009 [para 2.1 of the affidavit]; and
- the evidence provided about the use and advertisement of the Opponent’s Marks in Canada by the Opponent itself is subsequent to the material date.

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

[37] This factor is not relevant.

[38] The Mark was applied for registration based upon proposed use in Canada. The application for the trade-mark RHYTHM Design was also based on proposed use. Further, as discussed above, the evidence does not establish use of the trade-mark RHYTHM Design in Canada as of the material date.

*Section 6(5)(c): the nature of the wares, services or business; and*

*Section 6(5)(d): the nature of the trade*

[39] The Opponent is favoured by the overall consideration of the sections 6(5)(c) and (d) factors, but only to the extent that the Related Wares are concerned.

[40] Indeed, since the Related Wares associated with the Mark are essentially clothing items, I agree with the Opponent that they overlap with the clothing items listed in the statement of wares of the application for the trade-mark RHYTHM Design its application; this is true even if I disregard sport clothing items, such as ski suits, ski pants, ski bibs, ski jackets. Also, the wares “kerchiefs” and “slippers” included in the Related Wares are found in the Opponent’s application.

[41] However, I agree with the Applicant that there are significant differences between the Non-related Wares associated with the Mark and the wares identified in the application for the trade-mark RHYTHM Design.

[42] I would add that I disagree with the Opponent’s oral submissions that its application for the trade-mark RHYTHM Design covers toiletries and cosmetic products. The Opponent’s application references “toiletries and cosmetic bags”, which I read as bags for holding toiletries and cosmetics, especially in the context of the statement of wares of the application for the trade-mark RHYTHM Design. My reading is reinforced by Mr. Wong’s statement that the Opponent sells clothing, ski gear, *bags*, accessories and footwear [para 2.6 of the Wong affidavit]. In other words, I find that “toiletries and cosmetic bags” are not toiletries or cosmetic *per se*.

[43] Insofar as the nature of the trade is concerned, the evidence is to the effect that the Opponent entered into a distribution agreement with Griffintown Distribution, a division of Dogree (the Distributor), on February 8, 2010 granting it the exclusive right to sell and distribute wares associated with the Opponent’s Marks in Canada [para 6.3 of the Wong affidavit].

[44] The Opponent did not evidence the markets for the distribution of its wares. However, Mr. Wong explains that the Distributor purchases and pays for the wares; the Opponent delivers the wares to the Distributor’s office in Montreal in accordance with purchase orders submitted by the Distributor; the wares are delivered to the Distributor either with the Opponent’s Marks

embedded in them or with swing tags bearing the Opponent's Marks [paras 6.4 to 6.6 of the Wong affidavit].

[45] In the present state of affairs, it seems unlikely that the Related Wares associated with the Mark would be sold and distributed by the Opponent's Distributor. However, there is no evidence to conclude that the Related Wares would not be carried in stores that would carry the clothing items associated with the trade-mark RHYTHM Design. Also neither the application for the Mark, nor the application for the trade-mark RHYTHM Design, contains restrictions regarding the markets for the distribution of the wares.

[46] In the absence of evidence from the Applicant, for the purposes of assessing confusion, I conclude that there is potential for overlap between the nature of the trade for the Related Wares and the clothing items listed in the application for the trade-mark RHYTHM Design. However, despite the absence of evidence from the Applicant, I find it reasonable to conclude that there is no potential for overlap between the nature of the trade for the Non-related Wares and the wares listed in the application for the trade-mark RHYTHM Design.

*Conclusion on the likelihood of confusion*

[47] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[48] Given the degree of resemblance between the marks, the overlap between the nature of the wares and the potential for overlap between the nature of the trade, I conclude that the Applicant has not discharged her legal onus to establish that, as of September 8, 2009, there was no reasonable likelihood of confusion between the Mark in association with the Related Wares and the trade-mark RHYTHM Design for the clothing items identified in application No. 1,413,113. Given my conclusion, I see no need to decide on the likelihood of confusion between the Mark for the Related Wares and the trade-mark RHYTHMILIVIN of application No. 1,413,115.

[49] Insofar as the Non-related Wares are concerned, I am satisfied that the differences in the nature of the wares and the nature of the trade are sufficient to shift the balance of probabilities

in favour of the Applicant. Thus, I conclude that the Applicant has discharged her legal onus to establish that, as of September 8, 2009, there was no reasonable likelihood of confusion between the Mark in association with the Non-related Wares and the trade-mark RHYTHM Design of application No. 1,413,113. As I previously indicated that comparing the Mark with the trade-mark RHYTHM Design effectively decides the issue, I conclude that the Applicant has discharged her legal onus to establish that, as of September 8, 2009, the Mark in association with the Non-related Wares was not reasonably likely to cause confusion with the Opponent's trade-mark RHYTHMILIVIN of application No. 1,413,115.

VI.4 Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

[50] This issue arises from the ground of opposition alleging that the Mark does not distinguish and is not adapted distinguish the wares of the Applicant from the Opponent's wares.

[51] I dismiss the ground of opposition and so decide this issue in favour of the Applicant.

*Reasons*

[52] I am not satisfied that the Opponent has discharged its initial evidentiary burden to show that its trade-marks RHYTHM Design and RHYTHMILIVIN were sufficiently known in Canada as of September 28, 2010 to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[53] First, the evidence provided by the Opponent is either insufficient or too vague and ambiguous to show continuous use of the trade-marks RHYTHM Design and RHYTMLIVIN in Canada since 2008 for the following reasons:

- the Opponent did not provide evidence showing use or advertisement of the Opponent's Marks by its predecessor in title, namely R.G.I. Limited;
- although Mr. Wong affirms that the Opponent acquired the rights into the marks from R.G.I. Limited on August 31, 2009, a fair reading of his affidavit leads me to

conclude that the Opponent did not use the marks in Canada before entering into the distribution agreement with the Distributor on February 8, 2010; and

- the wholesale sales figures for the wares sold under the Opponent's Marks in Canada for the period of January 1 to December 31, 2010, which totaled over \$175,000, are not broken down by month [para. 7.11 of the Wong affidavit]. Accordingly, it could be that they relate to wholesale sales that occurred after September 28, 2010; and
- even if I was prepared to infer that a significant part of the wholesale sales figures relate to sales that occurred before September 28, 2010, they are not broken down by trade-marks, or by wares or even by category of wares referenced by Mr. Wong, that is clothing, ski gear, bags, accessories and footwear.

[54] The Opponent's evidence regarding advertisement and promotion of the trade-marks RHYTHM Design and RHYTMLIVIN in Canada is also open to criticism.

[55] For one thing, the evidence about the Distributor's attendance at various trade shows in Canada is prima facie inadmissible hearsay evidence since it is based on information provided to Mr. Wong by Danny Delage, the Vice President of the Distributor [paras 7.2 to 7.7 of the Wong affidavit]. Mr. Wong does not explain why it was necessary for him to obtain the information from Mr. Delage instead of the latter providing the evidence. That said, I am prepared to infer that the information would be provided to the Opponent in the normal course because the Distributor may be required by the Opponent to attend or participate in various marketing events [para 7.1 of the Wong affidavit]. Accordingly, I am prepared to give some weight to the evidence. Nonetheless, I consider this evidence does not assist the Opponent's case for the following reasons:

- the evidence relating to the "KnowShow" trade show held in Vancouver in January 2011 and the "Trends the Apparel Show" trade show held in Edmonton in March 2011 is subsequent to the material date;
- there is no evidence about the number of Canadian retailers having attended the "KnowShow" trade show held in Vancouver from August 11 to 13, 2010 and the "Trends the Apparel Show" trade show held in Edmonton from September 9

to 13, 2010; without such evidence, I am not prepared to conclude that those two trade shows, which were held within a period of less than two months before the material date, resulted in the Opponent's Marks having acquired a significant reputation in Canada; and

- apart from the fact that the screenshots from the website for the "KnowShow" trade show are from March 22 and April 6, 2011, there is no evidence as to the extent to which the website has been accessed by Canadians [para 6.14 and Exhibit MHW-6 of the Wong affidavit].

[56] Second, in addition to its hearsay deficiencies, the evidence about the display of the wares associated with the Opponent's Marks in show rooms is of no assistance to the Opponent for the following reasons:

- there is no mention of the date(s) when the photographs showing the display of the wares and the Opponent's Marks in the Distributor's permanent show room in Montreal were "personally taken, or caused to be taken" by Mr. Delage. All that can be concluded is that these photographs were provided to Mr. Wong for the purposes of his affidavit sworn April 15, 2011 and so subsequently to the material date [paras 7.8 and 7.9 and Exhibits MHW-10 and MHW-11 of the Wong affidavit]; and
- the evidence about the display of the wares associated with the Opponent's Marks in a show room in Toronto, rented by a representative of the Distributor, covers the period of February 20 to 28, 2011 [para 7.10 and Exhibit MHW-12 of the Wong affidavit].

[57] Third, the evidence about the promotion of the Opponent's Marks on the website *www.rhythmivin.com* operated by the Opponent's subsidiary Rhythm Group Pty Ltd, under license from the Opponent, is also of no assistance to the Opponent's case [paras 6.10 to 6.13 of the Wong affidavit]. Indeed:

- while Mr. Wong states that the Opponent's Marks have been promoted prominently on the website since August 2009, the screenshots of pages from the

website appended as Exhibits MHW-2, MHW-3 and MHW-5 are from April 7, 2011;

- there is no evidence establishing the number of Canadians that would have accessed the website at anytime whatsoever; and
- I do not think it is reasonable for the Opponent to categorize its expenditure of \$200,000 to maintain the website during the period of January to December 31, 2010 as “promotion and advertising expenditure”; rather it seems to me that this is a cost for the conduct of the Opponent’s business [para 7.12 of the Wong affidavit].

[58] Finally, there is no evidence as to the nature of the promotional or advertising activities covered by the Opponent’s “general” expenditures of \$80,000 for the period of January 1 to December 31, 2010 [para 7.11 of the Wong affidavit]. Also, the Opponent did not provide any breakdown, be it by month, by trade-marks, by wares or by category of wares, of the total amount of \$80,000 spent for promoting and advertising the wares associated with the Opponent’s Marks in Canada.

[59] In concluding on this issue, and extrapolating from the evidence, I would add that I disagree with the Opponent’s contention that its case would have been stronger under the non-distinctiveness ground of opposition. Therefore, even if I had found the Opponent’s evidence sufficient to discharge its initial evidentiary burden, I would likely have decided the non-distinctiveness ground of opposition in the same manner as the non-entitlement ground of opposition.

## VII. Disposition

[60] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act for the following wares:

men’s, women’s and children’s underwear garments, namely, boxers , boxer shorts, jockstraps, lowrise, thongs, boyleg, g-string, long leg, slips, and camisoles, briefs, panties, undershirts, brassieres, sleep dresses, thermal ladies and men’s underwear, nightgowns, peignoirs, caftans, pajamas, sleep shirts, rompers, lounge wear, sleepwear namely corsets, basques, baby dolls, bra sets, teddies, chemises, full slips,

half slips, lingerie, robes, smoking jackets, stockings, nylons, socks, slippers, hosiery, kerchiefs and hankies.

[61] However, I reject the opposition under section 38(8) of the Act for the following wares:

towels; posters; health foods and supplements for general well-being, namely vitamins, minerals, dietary vitamins, mineral and herbal supplements (tablets and powdered), namely, meal replacement bars, protein and meal replacement drinks, diuretics, dried herbs and herb extracts, herbal laxatives and herbal digestive tonics; breakfast cereals, bread, biscuits, fruit juices, vegetable juices, dried fruits, edible nuts, vegetable oils and edible oils. Toiletries and cleansing products for male and female, namely facial cleansing creams, facial emollient creams, facial masks, hand and body lotions, hand and body foams, body gels, soaps, lathers, shaving creams, hair shampoos, hair conditioners, hairspray, hair mousses, hair gels; male and female cosmetics and implements, namely eyeliner, eye shadow, cheek colour, lipstick mascara, perfume, cologne, eau de toilette, nail polish, hair combs, hair brushes.

[See *Produits Menager Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCDT) as authority for a split decision.]

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



## Schedule "A"

### Statement of wares of application No. 1,450,846

Men's, women's and children's underwear garments, namely, boxers, boxer shorts, jockstraps, lowrise, thongs, boyleg, g-string, long leg, slips, and camisoles, briefs, panties, undershirts, brassieres, sleep dresses, thermal ladies and men's underwear, nightgowns, peignoirs, caftans, pajamas, sleep shirts, rompers, lounge wear, sleepwear namely corsets, basques, baby dolls, bra sets, teddies, chemises, full slips, half slips, lingerie, robes, smoking jackets, stockings, nylons, socks, slippers, hosiery, kerchiefs and hankies; towels; posters; health foods and supplements for general well-being, namely vitamins, minerals, dietary vitamins, mineral and herbal supplements (tablets and powdered), namely, meal replacement bars, protein and meal replacement drinks, diuretics, dried herbs and herb extracts, herbal laxatives and herbal digestive tonics; breakfast cereals, bread, biscuits, fruit juices, vegetable juices, dried fruits, edible nuts, vegetable oils and edible oils. Toiletries and cleansing products for male and female, namely facial cleansing creams, facial emollient creams, facial masks, hand and body lotions, hand and body foams, body gels, soaps, lathers, shaving creams, hair shampoos, hair conditioners, hairspray, hair mousses, hair gels; male and female cosmetics and implements, namely eyeliner, eye shadow, cheek colour, lipstick mascara, perfume, cologne, eau de toilette, nail polish, hair combs, hair brushes.

Schedule "B"

<u>Trade-mark</u>	<u>Appl. No. / Filing Date</u>	<u>Wares</u>
 (RHYTHM Design)	1,413,113 Oct. 2, 2008	(1) Backpacks, duffel bags, knapsacks, day packs, tote bags, messenger bags, all-purpose sport bags, purses, wallets, suitcases, travelling bags, beach bags, handbags, toiletries and cosmetic bags, briefcases, satchels and portfolios, cases for personal organisers, cases, trunks, luggage articles made of leather and imitation leather; bandannas, headbands, wristbands, bathing suits and trunks, beachwear, swimwear, beach and bathing coverups, bikinis, clothing belts, bermuda shorts, blouses, coats, gloves, gym shorts, jackets, pants, parkas, polo shirts, ponchos, pullovers, shirts, skirts, slacks, sweatpants, sweatshirts, sweatshorts, sweaters, T-shirts, tank tops, tops, wet suits, jackets, jeans, ski suits, ski pants, ski bibs, ski jackets, trousers, shorts, knit shirts, wind resistant jackets, hats, scarves, gloves, mittens; caps, visors, headbands, ear muffs, bandanas, ear warmers, ear bands, sweatbands, kerchiefs, head scarves and ski masks; men's, women's and children's shoes, athletic and sports shoes, sneakers, boots, sandals and slippers; surfboards, bodyboards, kneeboards, wakeboards, sailboards, surf skis, snowboards, snow skis, water-skis, skateboards, kiteboards, rollerblades, roller skates, scooters (toys), ski bindings, ski poles, sailboard sails, kiteboard sails, surf ski paddles, wax for skis and surfboards; fittings and accessories for the foregoing goods; parasols, umbrellas.
RHYTHMLIVIN	1,413,115 Oct. 2, 2008	(1) Bandannas, headbands, wristbands, bathing suits and trunks, beachwear, swimwear, beach and bathing coverups, bikinis, clothing belts, bermuda shorts, blouses, coats, gloves, gym shorts, jackets, pants, parkas, polo shirts, ponchos, pullovers, shirts, skirts, slacks, sweatpants, sweatshirts, sweatshorts, sweaters, T-shirts, tank tops, tops, wet suits, jackets, jeans, ski suits, ski pants, ski bibs, ski jackets, trousers, shorts, knit shirts, wind resistant jackets, hats, scarves, gloves, mittens; men's, women's and children's shoes, athletic ( <i>sic</i> ) and sports shoes, sneakers, boots, sandals and slippers; caps, visors, headbands, ear muffs, bandanas, ear warmers, ear bands, sweatbands, kerchiefs, head scarves and ski masks.