

**IN THE MATTER OF AN OPPOSITION
by Bonneterie D'Armor to Application
No. 1,114,618 for the trade-mark ARMOR
JEANS & Design filed by Le Château Inc.**

On September 11, 2001, Le Château Inc. (the "Applicant") filed an application to register the trade-mark ARMOR JEANS & Design (the "Mark"), as illustrated hereafter, on the basis of use in Canada since at least as early as September 1999.



The application was advertised in the *Trade-marks Journal* of February 19, 2003 for opposition purposes. Bonneterie D'Armor (the "Opponent") filed a statement of opposition on April 17, 2003. The Applicant filed a counter statement essentially denying the grounds of opposition on June 6, 2003. Both parties filed evidence. Neither party filed written arguments. Only the Applicant was represented at the oral hearing.

On September 26, 2005, the Applicant filed a revised application, which was accepted by the Registrar of Trade-marks on October 13, 2005. The statement of wares and services in the application currently reads as follows:

Wares: men's, women's and children's clothing, namely: shirts, sweaters, suits, sports jackets, topcoats, dresses, pants, coats, jumpsuits, vests, T-shirts, blazers, raincoats, ponchos, caftans, sweatshirts, sweat pants, jerseys, tunics, blouses, skirts; fashion accessories, namely: scarves, hats, belts, gloves, sunglasses, ties, handbags, purses, wallets, billfolds, umbrellas, handkerchiefs; footwear, namely: shoes, boots, sandals, slippers.

Services: Operation of departments within retail stores selling men's, women's and children's clothing, footwear and fashion accessories.

The right to the exclusive use of the word JEANS apart from the trade-mark has been disclaimed in association with men's, women's and children's clothing, namely: shirts, sweaters, suits, sports jackets, topcoats, dresses, pants, coats, jumpsuits, vests, T-shirts, blazers, raincoats, ponchos, caftans, sweatshirts, sweat pants, jerseys, tunics, blouses, skirts.

The Opponent did not request leave to file an amended statement of opposition following the acceptance of the revised application. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act* R.C.S. 1985, c. T 13 (the “Act”) since:
 - (a) the Applicant has not used the Mark in association with the wares and services identified in the application;
 - (b) alternatively or cumulatively, the Applicant has abandoned the Mark, in whole or in part;
 - (c) the statement that the Applicant is satisfied as to its entitlement to the use of the Mark is false in view of the content of the statement of opposition;
 - (d) the Applicant has not used the Mark since the date of first use claimed in the application.
2. The Mark is not registrable pursuant to s. 12(1)(d) since it is confusing with the Opponent’s registered trade-mark ARMOR LUX (TMA267,857) for clothing, namely sweaters, jackets, polo shirts, underwear, tuque and socks.
3. The Applicant is not the person entitled to registration of the Mark since:
 - (a) at the date of first use claimed in the application, the Mark was confusing with the trade-marks ARMOR LUX and ARMOR-LUX previously used in Canada in association with the Opponent’s wares, services and business in the field of clothing articles, contrary to s. 16(1)(a) of the Act;
 - (b) at the date of first use claimed in the application, the Mark was confusing with the trade-name BONNETERIE D’ARMOR previously used in Canada in association with the Opponent’s wares, services and business in the field of clothing articles, contrary to s. 16(1)(c) of the Act;
 - (c) contrary to s. 16(1) introductory of the Act (i) the application does not comply with the requirements of Section 30; (ii) the Mark is not a used one but rather a proposed one or an abandoned one, as the case may be; and (iii) the Mark is not registrable.

4. The Mark is not distinctive and is not adapted to distinguish the Applicant's wares and services from the wares or services of others (i) because of the content of the statement of opposition with respect to the adoption, use, making known and registration of the Opponent's trade-mark (as well as with respect to the use and making known of the Opponent's trade-name, as the case may be); (ii) as a result of a transfer of the Mark, more than one person had rights into the Mark and exercised these rights contrary to the provisions of Section 48(2) of the Act; and (iii) the Mark is used outside the scope of the licensed use provided for by Section 50.

As its evidence pursuant to rule 41 of the *Trade-marks Regulations (1996)* (the "Regulations"), the Opponent filed a Certificate of Authenticity of Registration No. TMA267,857 of April 2, 1982 for its trade-mark ARMOR LUX. As its evidence pursuant to rule 42 of the Regulations, the Applicant filed an affidavit of Juan-Alonso Papathanassiou, a paralegal employed by the Applicant, and an affidavit of Johnny Del Ciano, who has been employed by the Applicant since January 1997 and has been the Applicant's Director of Finance since October 6, 2000. None of the affiants has been cross-examined.

Material dates

The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with s. 30 of the Act is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. The material date for considering the issue of confusion pursuant to s. 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. The material date for considering the circumstances respecting the issue of entitlement pursuant to s. 16(1) of the Act is the date of first use alleged in the application. The material date with respect to the ground of opposition based upon distinctiveness has been generally accepted as the date of filing of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Analysis of the grounds of opposition

From the outset, I dismiss the non-entitlement ground of opposition based upon the introductory wording of s. 16(1) of the Act. In my view, the introductory wording of s. 16(1) of the Act is not a basis of a ground of opposition as defined in s. 38(2) of the Act. Section 16(1) of the Act as a whole relates to the entitlement ground of opposition. For all intents and purposes, I note that the allegations in support of that ground of opposition are identical to those supporting the grounds of opposition pleaded under s. 38(2)(a) and s. 38(2)(b) of the Act. Consequently, if I have erred in dismissing the ground of opposition, I will decide its outcome in deciding these other grounds of opposition.

I shall now consider the remaining grounds of opposition.

Section 30

The first, second and fourth pleadings in the statement of opposition relate to non-compliance with s. 30(b) of the Act whereas the third pleading relates to non-compliance with s. 30(i) of the Act. There is an initial evidential burden on the Opponent to establish the facts relied upon in support of the grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *Joseph E. Seagram & Sons Limited v. Seagram Real Estate Ltd.* (1984) 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)].

Section 30(b)

The evidentiary burden on the Opponent with respect to the ground of opposition based upon non-compliance with s. 30(b) is lower [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Although the Opponent may rely upon the Applicant's evidence to meet its initial burden, it must show that the evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

The Opponent did not allege any facts supporting the grounds of opposition based upon non-compliance with s. 30(b) nor did it file any evidence relating thereto. Further, the Applicant's evidence is not clearly inconsistent with the Applicant's claims. I therefore dismiss the grounds of opposition identified at paragraph 1(a), (b) and (d).

Section 30(i)

The Opponent has essentially alleged that the Applicant falsely made the statement that it was entitled to use the Mark in view of the content of the statement of opposition. The fact that the application is being opposed does not support a ground of non-compliance with s. 30(i) of the Act. I therefore dismiss the ground of opposition identified at paragraph 1(c) on the basis that it has been improperly pleaded. Should I be wrong in so finding, I would still dismiss the ground of opposition because there is no evidence that the Applicant did not truthfully make the statement required by s. 30(i) of the Act. In my opinion, where an applicant has provided the statement required by s. 30(i), the ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155].

Section 12(1)(d)

Although I agree with the Applicant's position that the Opponent has shown little interest in this proceeding (the Opponent not having filed any evidence of use nor a written argument or not having requested an oral hearing), by providing a Certificate of Authenticity of Registration No. TMA 267,857 for the trade-mark ARMOR LUX (the "Opponent's Mark") the Opponent has discharged its initial burden to establish the facts relied upon in support of the ground of opposition. The burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks.

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.

In *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, Justice Binnie commented as follows:

54 *Within the “all the surrounding circumstances” test, s. 6(5) of the Act lists five factors to be considered when making a determination as to whether or not a trade-mark is confusing. These are: “(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 the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them”. The list of circumstances is not exhaustive and different circumstances will be given different weight in a context-specific assessment. See *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.). In opposition proceedings, as stated, the onus is on the applicant (here the respondent) to show on a balance of probabilities that there is no likelihood of confusion.*

(...)

56 *What, then, is the perspective from which the likelihood of a “mistaken inference” is to be measured? It is not that of the careful and diligent purchaser. Nor, on the other hand is it the “moron in a hurry” so beloved by elements of the passing-off bar: *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.*, [1979] F.S.R. 113 (Ch. D.), at p. 117. It is rather a mythical consumer who stands somewhere in between, dubbed in a 1927 Ontario decision of Meredith C.J. as the “ordinary hurried purchasers”: *Klotz v. Corson* (1927), 33 O.W.N. 12 (Sup. Ct.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677, at p. 693. In *Delisle Foods Ltd. v. Anna Beth Holdings Ltd.* (1992), 45 C.P.R. (3d) 535 (T.M.O.B.), the Registrar stated at pp. 538-39:*

When assessing the issue of confusion, the trade marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent’s mark who might encounter the trade mark of the applicant in association with the applicant’s wares in the marketplace.

With these general principles in mind, I shall review the evidence that I consider relevant in the assessment of the above-identified factors. However, I note from the outset that I do not afford weight to Mr. Del Ciancio’s opinion with respect to the notoriety and goodwill attaching to the Mark since it relates to the issues to be decided by the Registrar. I also do not

afford any significance to the results of online Internet searches that were conducted by Mr. Papathanassiou concerning the Opponent and its trade-marks. In addition to the hearsay deficiency of Mr. Papathanassiou's written testimony based on the contents of the websites, I find that these websites cannot serve as evidence with respect to the use of the Opponent's Mark in Canada.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

The word "armor" found in each trade-mark is a common English word. While Mr. Papathanassiou introduced into evidence definitions from online dictionaries, I refer to *The Canadian Oxford Dictionary*. The word "armor" is a variation of the word "armour" whose first meaning is "protective clothing, made of fabric, metal plates, or chain mail, designed to deflect or absorb the impact of weapons, bullets, etc.". The word JEANS has a descriptive connotation in association with clothing. I would further note that since the words ARMOR and JEANS form the essential part of the Mark, the design feature of the Mark does not increase its inherent distinctiveness. I agree with the Applicant's submission that LUX is suggestive of luxury. Therefore, I find that neither trade-mark can benefit from a high level of inherent distinctiveness.

The Applicant operates 172 retail stores selling men's, women's and children clothing, footwear and fashion accessories. There are 168 retail stores located throughout Canada and 4 in the New York City area. Mr. Del Ciancio states that the Applicant offers a wide range of products "*by managing five (5) unique businesses under one umbrella brand- Ladieswear, Junior Girl (girls aged 8-14), Menswear, Footwear and Accessories*".

Mr. Del Ciancio deposes that the Mark is used and advertised in approximately all of the Applicant's retail stores. He does not provide specific information on the advertisement in the retail stores. Mr. Del Ciancio further states that the Mark is advertised through the Applicant's website since September 2004 and he provides pages from the website. While these pages display ARMOR JEANS in close proximity to pants, blazers, and dresses, there is no information on the number of Canadians having accessed the website.

According to the yearly figures provided for the years 1999 to 2004, the approximate dollar value of gross sales of “*ARMOR JEANS & Design wares and services throughout Canada and in the U.S.A.*” amounted to \$66,660,895, which corresponds to a total volume of 1,501,889 units sold. For the same period, the Applicant expended an approximate total amount of \$778,803 in advertising the wares and services associated with the Mark in Canada and the United States. Since 168 of the 172 retail stores operated by the Applicant are located in Canada, I find it reasonable to conclude that the sale and advertisement figures mostly relate to Canada. However, neither the sale figures nor the advertising figures are broken down by wares.

The Opponent’s Mark has matured to registration following the filing of the declaration of use on October 8, 1981. In the absence of any evidence of use, the most that I can presume from the mere existence of the registration is that there has been *de minimis* use of the trademark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Although I believe that Mr. Del Ciancio’s affidavit is open to criticism in several areas, I find it reasonable to conclude that the Mark has become known to a greater extent than the Opponent’s Mark. Still, I cannot determine whether the Mark is equally known for men’s, women’s, children’s clothing, fashion accessories and footwear or for the operation of departments within retail stores selling men’s, women’s, children’s clothing, footwear and fashion accessories.

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

There is no evidence for concluding to continuous use of the Opponent’s Mark since the filing of the declaration of use on October 8, 1981.

Mr. Del Ciancio states that the Applicant has been selling “*a large number of clothing, footwear and fashion items*” under the Mark since the fall of 1999. He attaches as Exhibit “A” to his affidavit “*a sampling of purchase invoices for each year of the relevant period (from September 1999 until today) [November 3, 2004] on which the trade-mark appears, as well as the company name, as given to the Le Château customers*”. Having reviewed Exhibit “A”, I conclude that it does not consist of invoices relating to the sale of

wares in association with the Mark, but rather consists of invoices and orders relating to the purchase by the Applicant of ARMOR JEANS labels. The Applicant's agent at the hearing acknowledged this fact.

The following are appended as specimens of use of the Mark: hangtags for jeans (Exhibit "B"), interior and exterior clothing labels (Exhibits "C") and photographs of in-store merchandising (Exhibit "D"). I remark that all the clothing labels are identical to some hangtags and that not all labels and hangtags display the Mark. Notwithstanding these remarks, I am satisfied that there is evidence of labels and hangtags displaying the Mark. The Applicant's agent at the hearing acknowledged that the photographs do not show the Mark displayed in the retail store, but rather show labels and hangtags affixed on clothing.

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

In considering the nature of the wares and services and the nature of the trade, it is the statement of wares and services in the application and the statement of wares in the registration that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *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.)].

The Opponent's Mark is registered in association with "vêtements, nommément chandails, vestes, polos, sous-vêtements, toques et bas" (the "registered wares"). I conclude that "men's, women's and children's clothing, namely: shirts, sweaters, suits, sports jackets, topcoats, dresses, pants, coats, jumpsuits, vests, T-shirts, blazers, raincoats, ponchos, caftans, sweatshirts, sweat pants, jerseys, tunics, blouses, skirts" as well as "fashion accessories, namely scarves, hats, belts, gloves, ties, and handkerchiefs" are similar, some items being identical, to the registered wares. I find that "handbags" and "purses" could be considered as clothing accessories and thus could overlap with the registered wares. Although the registered wares differ from "sunglasses, wallets, billfolds, and umbrellas", the Applicant has categorized the aforesaid wares as fashion accessories and therefore, they may not be said to be unrelated to the registered wares. The wares "footwear, namely: shoes, boots, sandals,

slippers” are different but are related to clothing items. I would add that the agent for the Applicant at the hearing noted that the nature of the wares is the same.

Only the Applicant has evidenced its channels of trade. In that regard, Mr. Del Ciancio states that the wares sold and services offered under the Mark are sold only in the Applicant’s stores and have never been sold in stores not belonging to the Applicant. However, the statement of wares in the application does not restrict their marketing to any particular channel of trade. The statement of services in the application is restricted to “operation of departments within retail stores selling men’s, women’s and children’s clothing, footwear and fashion accessories”. There is no evidence whatsoever to indicate that the Opponent has any intention of venturing into the field of operating retail stores for the sale of the registered wares. Still, the statement of wares and services of the application suggests a connection between the services listed in the application and the registered wares.

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

I do not consider that the design features of the Mark are sufficient to result in important differences between the trade-marks when viewed. Both trade-marks consist of two words and differ only with respect to their last word. It is well recognized that the first portion of each trade-mark is important when comparing the respective trade-marks for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183]. The difference in the last words, namely “jeans” and “lux”, arguably result in differences between the ideas suggested.

Additional circumstances

Since there is no evidence directed to the use of the Opponent’s Mark in Canada, I find that it is of little consequence that no one under Mr. Del Ciancio’s direct or indirect supervision has reported an incident of confusion. For the same reason, I find that Mr. Papathanassiou’s statement that neither a customer nor an employee of the Applicant has ever reported to him an incident of confusion between the trade-marks is of little consequence.

In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. I find that the balance of probabilities is evenly balanced between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the registered trade-mark ARMOR LUX, I must decide against the Applicant. I therefore find that the ground of opposition based upon s. 12(1)(d) of the Act is successful.

Non-entitlement

Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no risk of confusion, the Opponent has the initial onus of proving that its alleged trade-marks and trade-name were being used at the date of first use claimed in the application and that use had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act]. Since the Opponent has not filed any evidence of use, I find that it has not discharged its initial onus of showing prior use of its alleged trade-marks and trade-name. I therefore dismiss the grounds of opposition based upon non-entitlement pursuant to s. 16(1)(a) and s. 16(1)(c) of the Act.

Distinctiveness

The ground of opposition based upon non-distinctiveness appears to be pleaded as a three-prong ground of opposition.

With respect to the first pleading, there was an initial burden on the Opponent to show that its trade-mark or trade-name had become known sufficiently as of April 17, 2003 to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. As the Opponent did not do so, I reject the first pleading of the ground of opposition.

The Opponent did not allege any facts supporting the second and third pleadings, nor did it file any evidence relating thereto. I therefore reject the second and third pleadings of the ground of opposition.

Conclusion

Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I refuse the application to register the Mark pursuant to s. 38(8) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 28th DAY OF DECEMBER 2006.

Céline Tremblay
Acting Chairperson
Trade-marks Opposition Board