



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

**Citation: 2015 TMOB 121
Date of Decision: 2015-07-03**

IN THE MATTER OF AN OPPOSITION

Boutique Jacob Inc.	Opponent
and	
Joseph Limited	Applicant
1,424,610 for the trade-mark JOSEPH	Application

Summary

[1] Joseph Limited is a fashion house founded by Joseph Ettedgui in 1972. It designs a full JOSEPH collection of clothing for women and runs JOSEPH branded stores and concessions in department stores. In 2001, Joseph Limited began selling clothing in Canada. In 2009, it filed an application to register the trade-mark JOSEPH in association with a variety of goods including perfumery, cosmetics, footwear, handbags and hats and a variety of retail services.

[2] Boutique Jacob Inc. alleges that the application for JOSEPH is confusing with its trade-mark JOSEF applied-for and/or registered for use in association with goods and services including clothing, jewellery, perfumery and the operation of a business specializing in the retail sale of ladies' clothing. Despite alleging this, Boutique Jacob Inc. has not, with respect to the

issue of confusion, filed any evidence other than a certified copy of its registration for the trade-mark JOSEF or made any submissions.

[3] In this case, the fact that the trade-marks at issue are given names and lack inherent distinctiveness impacts the confusion analysis. Where trade-marks are weak, consumers are expected to be more on guard to the differences between them and owners are held to accept some risk of confusion. In view of this and the other circumstances discussed below, I find that Joseph Limited has proven that there is not a reasonable likelihood of confusion between the Opponent's JOSEF trade-mark and the JOSEPH trade-mark for the following goods and services in the application:

(1) cosmetics; non medicated toilet preparations, namely, deodorant, body lotion, face cream, shampoo, conditioner, hair spray; essential oils for personal use; hair lotions; dentifrices; leather and imitations of leather; travelling trunks; travelling bags; cosmetic and garment bags; briefcases; umbrellas; walking sticks; suitcases; wallets; footwear, namely boots, slippers, sandals, athletic shoes, dress shoes and casual shoes; headgear, namely hats, caps and bridal head pieces.

(1) Retail services connected with the sale of perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear; mail order retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear; electronic shopping retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear.

[4] Given that the trade-marks are identical as sounded and nearly identical in appearance and in view of the fact that the following goods and services are the same as Boutique Jacob's goods and services, I find that Joseph Limited has failed to prove that there is not a reasonable likelihood of confusion for:

Perfumery; solid bar and liquid soaps for body and face; handbags; shoulder belts,

Retail services connected with the sale of, belts, clothing; mail order retail services connected with belts, clothing; electronic shopping retail services connected with belts, clothing.

File Record

[5] On January 15, 2009, Joseph Limited (the Applicant) filed an application to register the trade-mark JOSEPH (the Mark) in association with the following Goods and Services (as amended) on the basis of its proposed use in Canada:

(1) Perfumery; cosmetics; non medicated toilet preparations, namely, deodorant, body lotion, face cream, shampoo, conditioner, hair spray; solid bar and liquid soaps for body and face; essential oils for personal use; hair lotions; dentifrices; leather and imitations of leather; travelling trunks; travelling bags; handbags; cosmetic and garment bags; shoulder belts; briefcases; umbrellas; walking sticks; suitcases; wallets; footwear, namely boots, slippers, sandals, athletic shoes, dress shoes and casual shoes; headgear, namely hats, caps and bridal head pieces.

(1) Retail services connected with the sale of perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear; mail order retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear; electronic shopping retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 21, 2012.

[7] On May 18, 2012, Boutique Jacob Inc. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

(a) the application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) since the following Goods and Services are not described in ordinary commercial terms;

- leather and imitation of leather;

- retail services connected with the sale of perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear;
- mail order retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear; and
- electronic shopping retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, belts, umbrellas, clothing, footwear and headgear;

- (b) the application does not comply with section 30(e) of the Act since the Applicant did not intend to use the Mark in Canada with each of the Goods and Services, or alternatively, the Mark had previously been used in Canada;
- (c) the application does not comply with section 30(i) of the Act as the Applicant could not be satisfied that it is entitled to use the Mark in Canada since the Applicant was well aware of the existence of the Opponent's trade-mark and trade-name;
- (d) the Mark is not registrable pursuant to section 12(1)(a) of the Act as the Mark is a word which is primarily merely the name or the surname of an individual and the Mark was not distinctive at the filing date of the Application;
- (e) the Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with registration No. TMA139,323 for the trade-mark JOSEF;
- (f) the Applicant is not the person entitled to registration under section 16(3)(a) of the Act as the Mark is confusing with the Opponent's trade-mark JOSEF previously used or made known in Canada;

- (g) the Applicant is not the person entitled to registration under section 16(3)(b) of the Act as the Mark is confusing with the Opponent's applications for JOSEF filed on December 19, 2005 and December 15, 2006 under application Nos. 0283084-01 and 0283084-03;
- (h) the Applicant is not the person entitled to registration under section 16(3)(c) of the Act as the Mark is confusing with the Opponent's trade-name JOSEF; and
- (i) the Mark is not distinctive since it does not actually distinguish or is adapted to distinguish or is capable of distinguishing the Goods and Services of the Applicant from the Goods and services of others including the Opponent or, alternatively, the Mark has lost distinctiveness due to improper assignment,

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

[9] The Opponent filed as its evidence the declaration of Steven Xuefeng Qi and a certified copy of registration No. TMA139,323. The Applicant filed as its evidence the affidavits of Catherine Palmer and Michael Stephan and the two affidavits of Carloyn Hewitt (the first affidavit sworn October 9, 2013 and the second affidavit sworn May 14, 2014).

[10] Only the Applicant filed a written argument and attended a hearing held on February 17, 2015.

Material Dates and Onus

[11] The material dates with respect to the grounds of opposition are as follows:

-sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

-sections 38(2)(b)/12(1)(a) of the Act - the filing date of the application [*Calvin Klein Trademark Trust v Wertex Hosiery Inc* (2004), 41 CPR (4th) 552 (TMOB)];

-sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];

-sections 38(2)(c)/16(3) of the Act – the filing date of the application; and

- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[12] Before considering the issue of confusion between the parties' trade-marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[13] With respect to (i) above, there is an evidential burden on the opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

Grounds of Opposition

Section 30(a) Ground of Opposition

[14] The Opponent alleges that the application does not conform to the requirements of section 30(a) of the Act as the application does not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under section 30(a) is a light one and may be met through argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104; *Air Miles International Trading BV v Deutsche Lufthansa AG* (2010), 89 CPR (4th) 230 (TMOB) at para 30]. In this case, the Opponent has not made any submissions, nor filed any evidence directed to this ground. The Opponent, therefore, fails to meet its initial burden. The section 30(a) ground of opposition is rejected.

Section 30(e) Ground of Opposition

[15] There is no evidence that the Applicant did not have the intention to use the Mark or commenced use of the Mark in association with the Goods and Services in advance of filing the application. While the Applicant's affiant, Ms. Palmer, its Legal and Administrative Director, explains in para 5 of her Affidavit that "the Applicant has used the trade-mark JOSEPH, by itself and through its licensees, distributors, and wholesale customers, in association with clothing at least since 2001 in Canada", the subject application does not include clothing. The section 30(e) ground of opposition is therefore rejected.

Section 30(i) Ground of Opposition

[16] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark because it was aware of the Opponent's trade-mark and trade-name rights. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Section 16(3)(a), 16(3)(c) and 2 Grounds of Opposition

[17] The grounds of opposition based on sections 16(3)(a) and 16(3)(c) and 2 of the Act are rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-marks or trade-name were used, made known or had a reputation in Canada as of the applicable material dates. Although the Opponent's registration for its trade-mark refers to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

Section 12(1)(a) – Not Primarily Merely a Surname

[18] With respect to the ground of opposition based on section 12(1)(a) of the Act, the Opponent filed the declaration of Mr. Qi, an employee of its agent, who performed a variety of searches. Mr. Qi's telephone directory searches establish that Joseph is the surname of a number

of people residing in Canada (Qi declaration, Exhibits SQ-1 – SQ-7). However, the other searches performed by him show that Joseph is also a very popular baby boy name in Canada (Qi declaration, Exhibits SQ-8 – SQ-10). While the material date for this ground of opposition is the filing date of the application, this does not preclude the consideration of evidence arising subsequent to that date insofar as it may indicate a situation existing as of the material date [see *Bacardi & Co v Jack Spratt Manufacturing* (1984), 1 CPR (3d) 122 at 125-126 (TMOB)]. As a result, the Opponent has failed to meet its burden of establishing that either a majority of Canadians or even a majority of Canadians in a significant area of Canada would recognize the Mark as a surname or primarily merely a surname [see *Nationwide Manufacturing Ltd v Robert Morse Appliances Ltd* (1989), 27 CPR (3d) 112 (TMOB); *Juneau v Chutes Corp* (1986), 11 CPR (3d) 260 (TMOB)]. Accordingly, this ground of opposition is rejected.

Section 12(1)(d) Ground of Opposition

[19] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent’s registered trade-mark set out below.

Registration No. Trade-mark Goods and Services

TMA139,323	JOSEF	<p><u>GOODS:</u> (1) Ladies' dresses, coats, suits, blouses, slacks, skirts, shorts, gowns (2) Clothing namely, outerwear namely anoraks, cover-ups, exercise and loungewear namely track pants, underwear and sleepwear namely dressing gowns, hosiery, nightgowns, socks, stockings, tights, bustiers, headwear namely berets; bags namely canvas bags. (3) Clothing namely blazers, cardigans, jackets, jerseys, polo shirts, pullovers, shirts, sweaters, tank tops, t-shirts, camisoles, turtlenecks, vests, jumpers, bermuda pants, jeans leggings, pants, pantskirts, trousers, un-constructed suits, crop pants, outerwear namely parkas, raincoats, shells, windbreakers, exercise and loungewear namely sweatshirts, headwear namely hats, toques, accessories namely ascots, belts, gloves, mittens, scarves, shawls, ties; bags namely handbags, purses. (4) Jewelry.</p>
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SERVICES:

(1) Operation of a business specializing in the retail sales of ladies' clothing and accessories.

[20] I have exercised my discretion and checked the Register to confirm that this registration is extant. Therefore, the Opponent has met its initial burden with respect to this ground.

[21] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the *Trade-marks Act*:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services are of the same general class.

[22] Thus, the issue is not confusion between the trade-marks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Goods and Services, sold in association with the trade-mark JOSEPH, would believe that those items were produced or authorized or licensed by the Opponent.

[23] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances” including those specifically mentioned in section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent Distinctiveness

[24] As the parties' trade-marks are each comprised of a given name (see, for example, Qi declaration, SQ8-10), they have, if any, a very low degree of inherent distinctiveness [*Glaskoch B. Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co* (2006), CanLii 80333 (TMOB)].

Degree of Resemblance Between the Trade-marks

[25] As to the degree of resemblance between the trade-marks at issue, I find the trade-marks to be nearly identical in appearance, and identical in sound and ideas suggested, both trade-marks suggesting the idea of the given name of an individual related to the goods and services at issue.

Extent Known and Length of Time in Use

[26] While the Opponent's registration is based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the trade-mark has become known to any significant extent, nor that the trade-mark has been used continuously. The Applicant also submitted that Ms. Hewitt's evidence suggests that the Opponent's registered trade-mark is not currently in use since the Opponent filed a Notice of Intention with the Office of the Superintendent of Bankruptcy showing its total liabilities as exceeding \$85 Million and total assets of \$1.00 (Hewitt affidavit, sworn May 14, 2014, Exhibit A). I do not find that this evidence assists the Applicant's case as it does not reliably indicate whether the Opponent's trade-mark is in use or not.

[27] The Applicant's affiant, Ms. Palmer's evidence is that:

- The Applicant has used the trade-mark JOSEPH in association with clothing since at least 2001 in Canada and handbags since 2013 (Palmer affidavit, paras 5-6, Exhibit B).
- The Applicant has used the JOSEPH trade-mark since February 1, 2013 in Canada in association with electronic shopping retail services (Palmer affidavit, para 8, Exhibits F and G).

- JOSEPH brand clothing, handbags and retail services have been advertised throughout Canada (Palmer affidavit, para 11). Exhibit D to the Palmer affidavit also includes examples of press primarily for JOSEPH brand clothing but also handbags.
- Retail sales of clothing and handbags from 2001-July 2013 have been in the millions of dollars Canadian (Palmer affidavit, para 9).

[28] This factor favours the Applicant slightly as it has shown some use of the Mark in association with some of the Goods and Services, whereas the Opponent has shown no use of its trade-mark.

Nature of the Goods and Services

[29] This factor favours the Opponent with respect to the following Goods and Services which appear in its registration:

handbags; shoulder belts

retail services connected with the sale of belts, clothing; mail order retail services connected belts, clothing; electronic shopping retail services connected with belts, clothing.

[30] With respect to the remaining Goods and Services, while there is certainly some overlap, in the absence of evidence or submissions from the Opponent as to the precise nature of its goods and services it is difficult to determine the extent and significance of overlap.

Nature of the Trade

[31] In the absence of evidence from the Opponent, this factor favours the Applicant. The Applicant's evidence is that its clothing and handbags are haute couture high end fashion items and are carried by stores in Canada including Holt Renfrew, T.N.T., and Hudson's Bay Company and are sold at on-line retailers such as *www.net-a-porter.com* and *www.shopbop.com* (Palmer affidavit paras 12, 15-16). By way of example, the Applicant's purses available on *www.net-a-porter.com* range from \$445-945 dollars (Palmer affidavit, Exhibit H). The Applicant's evidence also includes an affidavit from Mr. Stephan, a private investigator (Stephan

affidavit, para 1). Mr. Stephan attended a Holt Renfrew store and a T.N.T. store at which products bearing the trade-mark JOSEPH were sold but no products bearing the trade-mark JOSEF were available (Stephan affidavit, para 6.) Although I recognize that there are no restrictions in Opponent's registration to any particular channel of trade, I do have some evidence from the Applicant that the Opponent's products don't appear to be sold through the same channels.

Surrounding Circumstance: Jurisprudence Concerning Weak Trade-marks

[32] The jurisprudence on weak trade-marks supports the Applicant's position. It is well settled that trade-marks consisting of given and surnames names are entitled to a very small ambit of protection [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD), at 24; *Joseph Ltd v XES-NY Ltd* (2005), 44 CPR (4th) 314 (TMOB)] and that comparatively small differences will suffice to distinguish between weak marks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used
...

[33] A party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian*, supra], there is no evidence that the Opponent's trade-mark JOSEF has been used in Canada to any extent.

Conclusion

[34] The question posed by section 6(5) of the Act is whether customers of the Goods and Services, provided under the trade-mark JOSEPH, would believe that those goods and services were provided or authorized or licensed by the Opponent owing to its trade-mark JOSEF.

[35] Having regard to the section 6(5) factors, including the low inherent distinctiveness of trade-marks comprised of a given name, that small differences may suffice to distinguish between weak marks, that there is no evidence that the Opponent's trade-mark has become known to any extent or that the parties' channels of trade are similar, I find that the Applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the opponent's mark JOSEF for the following Goods and Services:

(1) Perfumery; cosmetics; non medicated toilet preparations, namely, deodorant, body lotion, face cream, shampoo, conditioner, hair spray; solid bar and liquid soaps for body and face; essential oils for personal use; hair lotions; dentifrices; leather and imitations of leather; travelling trunks; travelling bags; cosmetic and garment bags; briefcases; umbrellas; walking sticks; suitcases; wallets; footwear, namely boots, slippers, sandals, athletic shoes, dress shoes and casual shoes; headgear, namely hats, caps and bridal head pieces.

(1) Retail services connected with the sale of perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear; mail order retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear; electronic shopping retail services connected with perfumery, cosmetics, beauty care products, make-up, cases for spectacles and sunglasses, jewellery, leather goods, umbrellas, footwear and headgear.

[36] With respect to the following Goods and Services, the balance of probabilities tips slightly in favour of the Opponent given that each of these Goods and Services are of an identical or similar nature to those registered by the Opponent and the ground of opposition is successful for:

handbags; shoulder belts;

retail services connected with the sale of, belts, clothing; mail order retail services connected with belts, clothing; electronic shopping retail services connected with belts, clothing

[37] My conclusions on the section 12(1)(d) ground may well have been different if the Opponent had filed any evidence or made any submissions on this ground of opposition.

Section 16(3)(b) Ground of Opposition

[38] The Opponent also alleges that the Mark is confusing with two of its previously filed applications for JOSEF: 0283084(01) filed on December 19, 2005 and registered on June 6, 2012 for use in association with jewellery and 0283084(03) filed on 2006-12-15 and inactivated on 2012-05-18 for perfume and soaps for personal use. I have exercised the Registrar's discretion to confirm that these applications were filed prior to the Applicant's filing date and were still pending as of the Applicant's filing date as required by sections 16(3)(b) and 16(4) of the Act [*Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 at 529]. Although the application for perfume and soap was subsequently abandoned, this is not a relevant surrounding circumstance [*ConAgra Inc v McCain Foods Ltd* (2001), 14 CPR (4th) 228 (FCTD); *Corporativo de Marcas GJB v Bacardi & Company Limited*, 2015 TMOB 51].

[39] With respect to application No. 0283084(01) for jewellery, confusion between the Mark and the Opponent's trade-mark JOSEF for use in association with jewellery was assessed as part of the section 12(1)(d) ground of opposition. Nothing in the different material date changes my conclusion and this ground of opposition is rejected.

[40] With respect to application No. 0283084(03), the results are similar to those in the section 12(1)(d) ground of opposition and this ground of opposition is successful for only the Goods that are the same as the Opponent's applied-for goods, in this case perfumery and solid bar and liquid soaps for body and face. With respect to the remaining Goods and Services, in the absence of evidence or submissions I decline to find that these goods and services are of the same nature as the goods in the Opponent's application No. 02382084(03). Bearing in mind the low inherent distinctiveness of trade-marks consisting of given names, that small differences may suffice to distinguish between weak marks, that there is no evidence that the Opponent's trade-mark has

become known to any extent, or that the parties' channels of trade overlap, I find that the Applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the Opponent's mark JOSEF for the Goods and Services except for perfumery and solid and bar liquid soaps.

Disposition

[41] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,424,610 with respect to the goods and services set out below and I reject the opposition with respect to the remainder of the goods and services, pursuant to section 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

perfumery; solid bar and liquid soaps for body; handbags; shoulder belts;

retail services connected with the sale of, belts, clothing; mail order retail services connected with belts, clothing; electronic shopping retail services connected with belts, clothing

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-02-17

Appearances

No one appearing

For the Opponent

Michelle Wassenaar

For the Applicant

Agents of Record

Davies Ward Phillips & Vineberg LLP

For the Opponent

Method Law Professional Corporation

For the Applicant