



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

Citation: 2010 TMOB 148
Date of Decision: 2010-09-14

**IN THE MATTER OF AN OPPOSITION
by Gilmar S.p.A. to application
No. 1,260,615 for the trade-mark ICE
CAPADES in the name of Entertainment
Holdings, Inc**

The Pleadings

[1] On June 9, 2005 Entertainment Holdings, Inc. (the Applicant) filed an application to register the trade-mark ICE CAPADES (the Mark), application number 1,260,615 based on proposed use in Canada. On November 14, 2005 the Applicant amended its application such that it now covers:

Computer game programs; video game programs; interactive multimedia computer game software; pre-recorded audio cassettes, tapes, CD-ROMs and DVDs featuring ice skating shows and exhibitions and associated musical performances; pre-recorded video cassettes, tapes, CD-ROMs and DVDs featuring ice skating shows and exhibitions and associated musical performances; computer and video game cartridges, cassettes, DVDs, and CD-ROMs; decorative magnets; books, magazines, pamphlets, brochures, notebooks, story books, cookbooks, comic books and coffee table books about ice skating shows and exhibitions; postcards; posters; calendars; stickers; rubber stamps; stamp pads; story books; coloring books; children's activity books; trading cards; address books; paper party decorations; paper napkins; paper party bags; paper party hats; paper place mats; grocery bags; school and office supplies, namely erasers, pencils, pens, markers, and pencil cases; clothing, namely, hats, hat bands, vests, visors, pants, shirts, headbands, T-shirts, tank tops, jackets, shoes, boots, sandals, slippers, socks, bandanas, scarves, underwear, rainwear, sleepwear, caps, shorts, shirts, ties, sweatshirts, belts, sweatpants, masquerade and

Halloween costumes, and masks sold in connection therewith; hand-held unit for playing electronic and video games; toy action figures and accessories; board games; jigsaw puzzles; dolls and accessories therefore; rag dolls; bean bag dolls; porcelain dolls; soft sculpture dolls; soft sculpture plush toys; action figures and accessories therefore; puppets; paper dolls; stuffed animal toys (the Wares); and

Entertainment in the nature of television ice skating shows and live ice skating shows; entertainment in the nature of on-going ice skating television programs (the Services).

[2] The Applicant disclaimed “the right to the exclusive use of the word ICE in connection with the services applied for”.

[3] The application was advertised on March 29, 2006 in the *Trade-marks Journal* for opposition purposes. Gilmar S.p.A. (the Opponent) filed a statement of opposition on August 29, 2006. The Applicant filed a counter statement on September 24, 2007, denying all grounds of opposition listed below.

[4] The Opponent filed the affidavit of Angela Casiero as its evidence while the Applicant filed the affidavit of Laurie Jaegge. None of the deponents were cross-examined.

[5] Both parties filed written arguments and there was no oral hearing.

The Grounds of Opposition

[6] The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the Act) in that the Applicant had no intention to use the Mark in Canada with the Wares and Services. In particular the wares listed as “clothing, namely, hats, hat bands, vests, visors, pants, shirts, headbands, T-shirts, tank tops, jackets, shoes, boots, sandals, slippers, socks, bandanas, scarves, underwear, rainwear, sleepwear, caps, shorts, shirts, ties, sweatshirts, belts, sweatpants” (the Applicant’s Articles of Clothing) will be promotional items ancillary to the Applicant’s other wares and services, and thus, would not be used in the normal course of trade as prescribed by s. 4 of the Act;

2. The Application does not comply with the requirements of s. 30 the Act in that the Applicant could not have been satisfied as to its entitlement to use the Mark in association with the Applicant’s Articles of Clothing in Canada, given the Opponent’s previous use in Canada of the trade-marks referred to in the foregoing paragraphs in such a manner as to have become well-known;

3. The Mark is not registrable under s. 12(1)(d) of the Act because it is confusing with the Opponent's registered trade-marks ICEBERG, no. TMA345,589 and ICE B ICEBERG & Design, no. TMA657,827 both registered in association with clothing and accessories;

4. The Applicant is not the person entitled to registration of the Mark in that, contrary to s. 16(3)(a) of the Act, at the filing date of the application, it was confusing with the Opponent's trade-marks ICEBERG, ICE B ICEBERG & Design and ICE JEANS previously used or made known in Canada by the Opponent, in association with wares including articles of clothing and accessories;

5. The Applicant is not the person entitled to registration of the Mark in that, contrary to s. 16(3)(b) of the Act, at the filing date of the application, it was confusing with the Opponent's trade-mark ICE ICE ICEBERG for which an application had been previously filed on November 29, 2002 and on which convention priority was claimed for November 22, 2002;

6. The Mark is not distinctive because it is not capable of distinguishing the wares of the Applicant from the wares of the Opponent under its trade-marks mentioned above, nor is it adapted to distinguish them.

Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[8] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: The filing date of the application (June 9, 2005);

- The registrability of the Mark under s. 12(1)(d) of the Act: The date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)];
- Entitlement to the registration of the Mark, where the application is based on proposed use: The filing date of the application (June 9, 2005) [see s. 16(3) of the Act];
- Distinctiveness of the Mark: The filing date of the statement of opposition (August 29, 2006) is generally accepted to be the relevant date [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Grounds of Opposition Summarily Dismissed

[9] The Opponent has an initial evidential burden when alleging non-compliance with the provisions of s. 30(e) of the Act. There no facts alleged in Ms. Casiero's affidavit nor in Ms. Jaegge's affidavit that would support such ground of opposition. The first ground of opposition is therefore dismissed.

[10] With respect to the second ground of opposition, where an applicant has provided the statement required by s. 30(i) of the Act that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares and services described in the application, as the Applicant did, this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no evidence on file of that nature. The second ground of opposition is also dismissed.

[11] In order to meet its initial burden with respect to the fifth ground of opposition the Opponent must show that it had previously filed an application and that it was still pending at the advertisement date of the present application (March 29, 2006) [see s.16(4) of the Act].

[12] The Opponent has not specifically identified the application to be relied upon by failing to provide the application number in the statement of opposition nor filed a certified copy of such application as part of its evidence. Therefore the fifth ground has been insufficiently pleaded and

is dismissed [see *Polo Ralph Lauren L.P. v. Vancouver Polo Club* (1996), 72 C.P.R. (3d) 402 (T.M.O.B.)].

Grounds of opposition where evidence of prior use must be provided

[13] In order to succeed under the fourth (entitlement based on prior use) and sixth ground of opposition (lack of distinctiveness of the Mark in view of the Opponent's prior use of its trade-marks) the Opponent had to establish prior use of its alleged trade-marks within the meaning of s. 4(1) of the Act; that is to file evidence showing, at the time of the transfer of the property of the opponent's wares, in the normal course of trade, the opponent's trade-marks were marked on its wares themselves or on the packaging in which they were distributed.

[14] Ms. Casiero has been, since 2005, the Vice President of sales and public relations of Gilmar U.S.A. Inc., a wholly-owned subsidiary of the Opponent. She alleges that Gilmar U.S.A. Inc. distributes the Opponent's products throughout North America on its behalf. She alleges to have direct knowledge of the Opponent's sales and marketing activities in Canada in relation to the Opponent's Canadian registered trade-marks.

[15] She states that the Opponent is a high fashion clothing and accessories manufacturer, which distributes its clothing under the trade-marks ICEBERG, ICE B ICEBERG, ICE ICE ICEBERG and ICE JEANS. She refers in her affidavit to these trade-marks as the ICE family of marks. The Opponent's wares would be marketed to the fashion consumer, the trendy consumer and the luxury consumer.

[16] She provides the names of retail stores where the Opponent's products (which are not defined in her affidavit) are offered for sale. She alleges that "currently" those products are sold through the high-end chain of Canadian department stores, Holt Renfrew. She further alleges that the Opponent's clothing and accessories (once again not defined in her affidavit) have been distributed in Canada under its ICE family of marks for a "number of years", without identifying a time period. She does however provide the annual sales and advertising figures in Canada for the years 2003, 2004 and 2005.

[17] She alleges that products sold under the ICE family of marks are often covered in editorials of the fashion magazine Flaunt. However such activity would not constitute advertising of the Opponent's ICE family of marks. Moreover there is no evidence that Flaunt magazine circulates in Canada. Finally there is no mention of the time period when those editorials were published. In any event advertising of a trade-mark in association with wares does not constitute use of that mark within the meaning of s. 4(1) of the Act.

[18] She states that the Opponent routinely advertises its clothing and accessories sold under the ICE family of marks in many United States and other foreign publications that "are regularly distributed or spillover into Canada". There is no sample of such advertisements and any allegation of spillover is hearsay evidence.

[19] In summary, there is no documentary evidence filed to support any of the allegations described above: no invoices, samples of labels or hangtags, pictures of garments, or the like bearing the ICE family of marks. Without such documentary evidence the Opponent has failed to establish use of its ICE family of marks in Canada, within the meaning of s. 4(1) of the Act, in association with its wares prior to any of the relevant dates listed above [see *Redsand Inc. v. Thrifty Riding & Sports Shop Ltd.* (1997), 74 C.P.R. (3d) 373 (FCTD)]. Moreover, in so far as the fourth ground of opposition is concerned, the Opponent's evidence described above, does not established that it had not abandoned its use of its ICE family of marks prior to the advertisement of the present application [see s.16(5) of the Act]. Finally, in the absence of any documentary evidence to substantiate the allegations contained in Ms. Casiero's affidavit I cannot conclude that the Opponent's ICE family of Marks was known to some extent in Canada so as to negate any distinctiveness of the Mark.

[20] For all these reasons the Opponent has failed to meet its initial burden with respect to the fourth and sixth grounds of opposition. Consequently they are dismissed.

Registrability of the Mark under s. 12(1)(d) of the Act

[21] The Opponent alleges that the Mark is not registrable pursuant to s. 12(1)(d) of the Act as it would be confusing with its registered trade-marks ICEBERG, certificate of registration TMA345,589 and ICE B ICEBERG & Design, certificate of registration TMA657,827. It has not

filed, as part of its evidence, a certified copy of these registrations. However the Registrar has a discretionary power to verify the register where s. 12(1)(d) is pleaded as a ground of opposition. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)]

[22] I have exercised my discretion to verify the register and confirm that certificate of registration TMA345,589 for the trade-mark ICEBERG is in good standing as of today's date and is in the name of the Opponent. It was issued on September 30, 1988 and is now registered in association with "purses and belts, knitted vests, waistcoats, shirts, dresses, jackets and jerkins, coats, raincoats; fur jackets and coats, leather and skin jackets and coats, skirts, trousers, jeans, catsuits, shorts, sashes, scarves, foulards, gloves, shawls, handkerchiefs, socks". Certificate of registration TMA657,827 for the trade-mark ICE B ICEBERG & Design is also in good standing as of today's date and is in the name of the Opponent. It was issued on February 2, 2006 based on used in Canada since at least as early as January 25, 2004 and is now registered in association "leather and imitation of leather, namely, jackets, coats, pants, skirts, shorts, gilets, tops, backpacks, purses, wallets, key holders; trunks and traveling bags; animal skins; hides; walking sticks; whips, harness and saddlery; athletic clothing; beachwear; casual clothing; casual wear; children's clothing; baby clothes; outdoor winter clothing; rainwear; exercise clothing; clothes for fishing; golf wear; ski wear; formal wear; protective clothing; bridal wear; undergarments; athletic footwear; beach footwear; children's footwear; infant footwear; outdoor winter footwear; rain footwear; exercise footwear; golf footwear; ski footwear; evening footwear; protective footwear; bridal footwear; hats, caps and helmets". Therefore the Opponent has met its initial burden with respect to this ground of opposition.

[23] I must now determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the Opponent's registered trade-marks ICEBERG and ICE B ICEBERG & Design. I believe that the Opponent has a stronger case with the trade-mark ICEBERG.

[24] The test to decide if there is a likelihood of confusion is set out in s. 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person,

whether or not the wares and services are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[25] The Mark consists of the combination of the common English word “ice” and the coined word “capades”. This combination makes the Mark inherently distinctive. The Opponent’s trade-mark ICEBERG is also inherently distinctive when used in association with the wares listed above.

[26] The distinctiveness of a trade-mark may be enhanced through use or extensive promotion in Canada. As discussed previously, there is no evidence of use of the Opponent’s trade-mark in Canada within the meaning of s. 4(1) of the Act. As for the Mark, the application is based on proposed use and the Applicant’s evidence to be reviewed hereinafter does not include evidence of use of the Mark. Therefore it is impossible to determine to what extent these marks are known in Canada at this time. Overall the first factor described in s. 6(5) does not favour either of the parties.

[27] As for the length of time the parties’ respective trade-marks have been in use in Canada, as stated previously, there is no evidence of use of the Mark. Certificate of registration TMA345589 does not contain a statement of use of the trade-mark ICEBERG in Canada as it was issued on the basis of use and registration in Italy. Therefore I cannot even infer *de minimis* use of the trade-mark ICEBERG in Canada. This factor does not favour either of the parties.

[28] As for the nature of the wares and services of the respective parties, there is clearly an overlap between the Applicant’s Articles of Clothing and the clothing items listed in registration number TMA345589. As for the other wares enumerated in the application, and the Services there is no connection with the Opponent’s wares. This factor favours the Opponent only in so far as the Applicant’s Articles of Clothing are concerned.

[29] In the absence of evidence on the Applicant's channels of trade I can presume that, for the Applicant's Articles of Clothing, the channels of trade could be the same as those used by the Opponent for its clothing items since those wares fall in the same general class of wares. With respect to the remainder of the wares and the Services described in the application, in view of the difference in the natures of those wares and the Services, when compared to the Opponent's wares described in its registration, I conclude that the channels of trade for those wares and the Services would be different than those used by the Opponent for its wares. In view of the above, this factor favours the Opponent only with respect to the Applicant's Articles of Clothing.

[30] The degree of resemblance between two trade-marks is the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. One must look at the marks in their totalities and should not dissect each one of them into their components.

[31] The first component of the parties' respective trade-marks is identical, namely the component "ICE". However the Mark as a whole is a coined expression while the Opponent's trade-mark ICEBERG is a French and English common word. The idea suggested by the parties' trade-marks is also different. The Mark refers to "an escapade on ice" while the Opponent's trade-mark ICEBERG refers to a floating mass of ice. Therefore, despite the presence of the word "ICE" in the Mark, I conclude that, taken as a whole, the Mark does not resemble the Opponent's registered trade-mark ICEBERG in sound, meaning and appearance. Overall this factor does favour the Applicant.

[32] As an additional surrounding circumstance the Applicant filed the affidavit of Laurie Jaegge. She has been a trade-mark assistant for the Applicant's agent firm. She performed a search of the register for trade-marks containing the word "ice" in "class 25". Her search revealed 164 trade-marks, 94 of which are registered trade-marks. She filed what has been identified as "a Summary View of the Canadian Trade-marks Register produced by Onscope".

[33] I cannot consider that portion of the evidence for the following reasons. There is no information on how the search was performed. Do the results of the search include expunged trade-marks registrations and abandoned applications? More importantly there is no information provided as to what wares and/or services are covered by "class 25". Finally the document filed

as Exhibit B to her affidavit is a summary. We have no information on the list of wares or services covered by the cited applications or registrations and on the identity of the owner of those applications or registrations. Consequently I cannot infer from such evidence that there is on the marketplace common use of trade-marks containing the word “ice”.

[34] I wish to add that in Ms. Casiero’s affidavit, there is reference to a family of trade-marks. However as discussed above, there is no evidence of use of any of the trade-marks that would be part of such a family of trade-marks. In the absence of evidence of use of any of those trade-marks, the Opponent cannot rely on the concept of a family of trade-marks [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)].

[35] From this analysis I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent’s registered trade-mark ICEBERG. I reach this conclusion on the basis that overall the marks do not resemble one another, phonetically, visually and in the ideas suggested by them. Moreover there is no similarity in the nature of the wares covered by the Opponent’s registrations and the Wares and Services except for the Applicant’s Articles of Clothing. But in this latter case, the difference in the parties’ respective trade-marks is sufficient to overcome any likelihood of confusion.

[36] The end result would be the same in determining the likelihood of confusion between the Mark and the Opponent’s registered trade-mark ICE B ICEBERG & Design as the degree of resemblance would be more remote in view of the differences between those marks visually, phonetically and in their meaning.

[37] Therefore the third ground of opposition is dismissed.

Disposition

[38] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office