



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

**Citation: 2015 TMOB 96
Date of Decision: 2015-05-29**

**IN THE MATTER OF AN OPPOSITION
by Wanted Shoes Inc. to application
No. 1,455,262 for the trade-mark WANT
LES ESSENTIELS DE LA VIE in the
name of Want Holdings Inc.**

[1] On October 14, 2009, Want Holdings Inc. (the Applicant) filed an application to register the trade-mark WANT LES ESSENTIELS DE LA VIE (the Mark) on the basis of its use in Canada in association with various bags, cases and paper products and its proposed use in association with various clothing and stationery products. The Goods (as amended) are:

(1) Valises, traveling bags, traveling sets for carrying cosmetics, garment bags for travel, vanity cases sold empty, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attache cases, briefcases, pouches for travel and for carrying merchandise, fine leather goods, namely pocket wallets, purses, key holders, card holders, MP3 cases, cellphone cases, & laptop cases; hand bags, pocketbooks, briefcase-type portfolios, billfolds, passport cases, business card cases, change purses; Paper and cardboard goods, namely, posters, product catalogs and brochures, notepads, notebooks, envelopes, writing paper, boxes of cardboard or paper, packing paper, bags of paper or plastic for packaging, labels, namely, hangtags. (*Goods(1) - Based on Use Since November 2006*)

(2) Lingerie, underwear, panties, slips, briefs, boxer shorts, pajamas, loungewear, sarongs, sleepwear, t-shirts, pants, socks, bathrobes, morning robes, swimwear and swim suits, resort-wear, beachwear, athletic shoes, bandannas, bathing trunks, belts,

Bermuda shorts, caps, golf shirts, gym shorts, gym suits, hats, jackets, jerseys, neckties, parkas, polo shirts, pullovers, rain coats, scarves, dress shirts, ski wear, slacks, sun visors, sweat bands, sweat suits, trousers, wetsuits and tank tops, sweaters, tank tops, skirts, dresses, board shorts, slippers, sandals; goods made of leather or of imitations of leather, namely boxes of leather or of leatherboard for travel purposes, envelopes of leather for merchandise packaging purposes; trunks; umbrellas, parasols, umbrellas for shading the sun, canes, walking stick seats ; satchels, hat boxes and shoe boxes for travel; paper and cardboard goods, namely, product picture albums, product magazines, calendars, indexes, photographs; pencils, pencil holders, fountain pens, ballpoint pens, inkstands, nibs of gold and playing cards. (*Goods(2) -Based on Proposed Use*)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 14, 2010.

[3] On December 14, 2010, Wanted Shoes Inc. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) The application does not conform to section 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) since the date claimed is not the date of first use of the Mark in Canada and the Mark has not been used in Canada since this date in association with Goods (1).
- (b) The application does not conform to section 30(e) of the Act since the Applicant did not intend to use the Mark in association with Goods (2).
- (c) The application does not conform to section 30(i) of the Act since the Applicant could not have been satisfied that it was entitled to use the Mark in association with the Goods.
- (d) The Applicant is not the person entitled to registration of the Mark in association with Goods (1) in accordance with sections 16(1)(a) and 16(1)(c) of the Act since the Mark is confusing with the trade-mark WANTED and trade-name Wanted Shoes Inc. previously used in Canada by the Opponent in association with footwear.
- (e) The Applicant is not the person entitled to registration of the Mark in association with Goods (2) in accordance with sections 16(3)(a) and 16(3)(c) of

the Act since the Mark is confusing with the trade-mark WANTED and trade-name Wanted Shoes Inc. previously used in Canada by the Opponent in association with footwear.

- (f) The Mark is not distinctive of the Goods nor has it been adapted to distinguish the Goods from the footwear of the Opponent sold in Canada under the trade-mark WANTED and the trade-name Wanted Shoes Inc.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. The Opponent filed as its evidence the affidavit of Allan Kishk. The Applicant filed as its evidence the affidavit of Dexter Peart. Both parties filed a written argument and attended a hearing on January 20, 2015.

Material Dates

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

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(1) - the date of first use alleged in the application;
- sections 38(2)(c)/16(3) - the filing date of the application; and
- sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

Evidential Burden and Legal Onus

[6] Before considering the issue of confusion between the parties' 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 the applicant to prove its case.

[7] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The 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 an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

Grounds of Opposition

Section 30(b) Ground of Opposition

[8] Section 30(b) of the Act requires that an applicant shall, in the case of a trade-mark that has been used in Canada, set out the date from which the applicant has used the trade-mark in association with each of the general classes of goods or services described in the application.

[9] The section 30(b) ground of opposition alleges that (1) the date claimed in the application, November 2006, is not the date of first use and (2) that the Applicant did not use the Mark in Canada with each of Goods (1) since this date. There is an initial evidential burden on the Opponent with respect to the issue of the Applicant's non-compliance with section 30(b) of the Act. This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230]. If there is evidence supporting the Opponent's allegations regarding the Applicant's claimed date of first use, then the Applicant has a legal onus to prove that it was using the Mark as of November 2006 [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38 (CanLII)].

The Opponent Meets Its Burden With Respect to Some of Goods(1)

[10] I find that Mr. Peart's, the Vice President of the Applicant, statement that the Applicant's licensee "designs, sells and distributes, among other things, functional, timeless, classic leather goods and accessories that are used in modern everyday life... under the WANT *Les Essentiels de la Vie* brand" raises a serious doubt as to whether the Applicant has used the Mark with the seemingly unrelated goods set out below:

Paper and cardboard goods, namely, posters, product catalogs and brochures, notepads, notebooks, envelopes, writing paper, boxes of cardboard or paper, packing paper, bags of paper or plastic for packaging, labels, namely, hangtags

As such, the Opponent has met its evidential burden with respect to these goods. As the Applicant has not substantiated use of the Mark in association with these goods pursuant to section 4 of the Act, this ground of opposition is successful with respect to them. Further, as the Opponent is successful in opposing these goods and the parties did not make any submissions at the hearing with respect to the issue of confusion concerning these goods, I will not discuss them further in this decision.

The Opponent Does Not Meet its Burden for Bags and Accessories

[11] With respect to the leather goods and accessories in Goods (1), the Opponent has focused on what is missing in the Peart affidavit to substantiate the Applicant's claimed date of first use as opposed to pointing out evidence that supports its allegations as set out in this ground of opposition. For example, the Opponent submits that the Order Form attached as Exhibit C to the Peart affidavit uses the trade-marks NARITA, ARLANDA, MALPENSA and DEURNE as opposed to the Mark. Further, only two invoices in Exhibit D are dated in November 2006 and reference only the De Gaulle 14 Leather Bag and Trudeau 17 Leather Bag. However, Mr. Peart's evidence is that the Mark appears directly on the Applicant's goods which are sold in a variety of styles with each style being named after an international airport including those listed above (Peart affidavit, para 9, Exhibit F).

[12] Although the Applicant could have provided more fulsome details pertaining to the use of the Mark in association with its leather goods and accessories dating back to at least as early as

November 2006, the fact that it has not done so does not mean that the Opponent meets its evidential burden. The lack of direct evidence of use of the Mark in association with each of the leather goods and accessories listed in Goods (1) does not lead to the inference that the Applicant has not properly used the Mark in association with these goods since the claimed date of first use. I am therefore unable to conclude that the Opponent has met its initial evidential burden with respect to the goods listed below. Accordingly, this ground of opposition is rejected for the following goods:

Valises, traveling bags, traveling sets for carrying cosmetics, garment bags for travel, vanity cases sold empty, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attache cases, briefcases, pouches for travel and for carrying merchandise, fine leather goods, namely pocket wallets, purses, key holders, card holders, MP3 cases, cellphone cases, & laptop cases; hand bags, pocketbooks, briefcase-type portfolios, billfolds, passport cases, business card cases, change purses;

Section 30(e) Ground of Opposition

[13] Section 30(e) of the Act requires, that in the case of a proposed trade-mark, the Applicant states that it intends to use the trade-mark in Canada.

[14] The section 30(e) ground of opposition alleges that the Applicant did not intend to use the Mark in Canada with each of Goods (2). The Opponent submits that the Applicant's evidence does not substantiate the Applicant's claim that it intends to use the Mark in association with Goods (2) since it only references classic leather goods and accessories such as purses, handbags, computer cases and shopping bags (Peart affidavit, para 4). Since, however, there is no requirement on the Applicant to show use of a trade-mark until it has been allowed [*Molson Canada v Anheuser-Busch, Inc* (2003), 29 CPR (4th) 315 at 334-335 (FC)], the fact that the Applicant has not yet begun to use the Mark in association with Goods (2) is not relevant. Accordingly, this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[15] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. 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 [*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.

Non-entitlement – Sections 16(1)(a) and 16(1)(c)

[16] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in association with Goods (1) in view of the fact that it is confusing with Opponent's trade-mark WANTED and trade-name Wanted Shoes Inc. previously used in Canada in association with footwear.

[17] Prior to assessing whether or not there is any likelihood of confusion between the Mark and the Opponent's trade-mark and trade-name, it is necessary to determine whether the Opponent has met its evidential burden to show use of its trade-mark and trade-name prior to the material date November 2006 and non-abandonment as of July 14, 2010, the date of advertisement of the application [sections 16(1) and 16(5) of the Act].

The Opponent Meets Its Burden with respect to the Section 16(1)(a) Ground of Opposition

[18] Mr. Kishk, the Chief Operating Officer of the Opponent, provides evidence that the Opponent sold \$150,000 of shoes branded with the WANTED trade-mark on soles, hang tags or shoe boxes in Canada in 2006 and continued to do so through 2010 (Kishk affidavit, paras 12-14 and Exhibits F and G). This evidence is sufficient to meet the Opponent's evidential burden with respect to the section 16(1)(a) ground of opposition.

The Opponent Fails to Meet its Burden with respect to the Section 16(1)(c) Ground of Opposition

[19] The Opponent fails to meet its evidential burden with respect to the section 16(1)(c) ground of opposition as the Opponent has not evidenced use of the trade-name Wanted Shoes Inc. pursuant to section 4(1) of the Act [*Professional Publishing Associates Ltd v Toronto Parent Magazine Inc* (1986), 9 CPR (3d) 207 at 217 (FCTD)]. I do not consider the use of the domain name *wantedshoes.com* on the Opponent's catalogues and shoe boxes (Kishk affidavit, Exhibits B and G) to be use of the trade-name Wanted Shoes Inc. Further, there is no evidence that the invoices or packing lists featuring Wanted Shoes or Wanted Shoes Inc. (which I consider to be equivalent) were provided to customers at the time of transfer of the goods in November 2006 (as opposed to invoices with the trade-name Wanted Asia which appears on many of the representative invoices) (Kishk affidavit, Exhibits C, H). Accordingly, the section 16(1)(c) ground of opposition is rejected.

Is there Confusion Between the WANTED trade-mark and the Mark?

[20] The test to determine the issue of confusion is set out in section 6(2) of the Act where 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 goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): 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 goods and services or business; 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. The criteria in section 6(5) 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.

[21] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's WANTED trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20]. Furthermore, this consumer is either Anglophone, Francophone or bilingual in English and French [*Pierre Fabre Médicament v SmithKline Beecham Corp* (2001), 11 CPR (4th) 1 at para 15 (FCA)].

Inherent Distinctiveness

[22] This factor does not favour either party as the trade-marks have a similar degree of inherent distinctiveness since both trade-marks are composed of ordinary words commonly used in English or French all of which have a laudatory connotation. Specifically, the words “want” and “wanted” have a laudatory connotation indicating the need, desire or wish for [see, for example, the definition of “want” in the *Canadian Oxford Dictionary* (2nd ed); see *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 which confirms that I may take judicial notice of dictionary definitions]. Likewise, the phrase LES ESSENTIELS DE LA VIE suggests goods which are necessary for life.

Degree of Resemblance

[23] Regardless of whether an Anglophone, Francophone or bilingual consumer is considered, I find that this factor slightly favours the Applicant. The trade-marks are similar in appearance as they begin with the related words WANT and WANTED. The phrase LES ESSENTIELS DE LA VIE, however, reduces the similarity of the Mark as sounded and in the ideas suggested. For Francophone consumers, the WANTED or WANT component would be regarded as a foreign word. For English consumers, the phrase LES ESSENTIELS DE LA VIE would likely suggest the English word “essentials” due to the similarity of “essentiels” and “essentials”. While the Mark suggests that the associated goods are necessary, the Opponent's WANTED trade-mark has no such connotation. Finally, I also consider the fact that the Mark combines English and French components (which are not a translation of one another) to add a degree of interest.

Extent Known and Length of Time in Use

[24] This factor favours the Opponent whose evidence is that it introduced the WANTED brand in Canada in 2000 and in 2006 it sold over \$150,000 of WANTED branded women and children's footwear in Canada through retailers and its website *www.wantedshoes.com* (Kishk affidavits, paras 6-7, 12). Further, the WANTED brand has also been promoted in Canada through the distribution of catalogues and featured in magazines (Kishk affidavit, paras 11, 16 and Exhibits E and I). While the Opponent's sales for 2006 are given for May-December 2006, it seems reasonable to infer that a fair percentage of these sales occurred prior to November 2006. In contrast, the Applicant's evidence is that the Mark was conceived in 2006 and advertising expenditures in Canada for products sold under the Mark in 2006 were \$21,7000 (Peart affidavit, para 6, 19). Mr. Peart also attaches invoices showing sales of a small quantity of leather bags to Holt Renfrew in November 2006 (Peart affidavit, Exhibit D).

Nature of the Goods and Trade

[25] When assessing the issue of confusion in the context of section 16 of the Act, it is the actual goods and/or services sold under an opponent's mark and the goods and/or services as specified in the application that are compared [*London Life Insurance Company v Manufacturers Life Insurance Company*, (1996), 67 CPR (3d) 563 (TMOB)]. The Opponent's evidence of sales relates solely to women's and children's footwear. In contrast, the Applicant's products are bags and leather accessories. I do not find the fact that the Opponent's footwear are fashion items as are the Applicant's bags and accessories to result in a significant overlap in the nature of the goods.

[26] The evidence shows that the Opponent's and the Applicant's goods are sold in different channels of trade. The Opponent's women's and children's shoes, boots, sandals, sneakers, slippers, mules, slip-ons, and athletic footwear are sold at the mass merchandisers Winners, Sears Canada, and Wal-Mart (Kishk affidavit, para 7) and through the Wanted Shoes website and catalogues (Kishk affidavit, para 6) at an inexpensive price point (between \$12.94-80) (Kishk affidavit, Exhibits D and I). The Applicant's leather goods, bags, and cases are sold at high-end retailers including Holt Renfrew, Gravity Pope Tailored Goods and on-line through Barneys and Nordstroms (Peart affidavit, paras 14-15) at a cost ranging from \$75 for an iPod case to \$1795

for a travel bag (Peart affidavit, Exhibit C). The difference in the nature of the trade (mass merchants versus high end retailers selling expensive, exclusive items) significantly favours the Applicant since the goods of each party are sold in different types of stores and there is no evidence that the channels of trade of the parties are likely to mix at any time in the near future [*Jacques Vert Group Limited v YM Inc (Sales)*, 2014 FC 1242 at paras 45-46].

Conclusion

[27] The issue is whether a consumer, who has an imperfect recollection of the Opponent's trade-mark WANTED, will, upon seeing the Mark be likely to believe that their associated goods share a common source. Section 6(2) of the Act is not concerned with confusion between the marks themselves, but rather confusion as to the source of the goods.

[28] While I acknowledge that the Opponent's WANTED trade-mark has been used to some extent in Canada since 2000, and that such use may have helped to increase the distinctiveness of the trade-mark, I find that the differences in the trade-marks of the parties as sounded and in ideas suggested combined with the differences between the nature of the goods and their channels of trade is sufficient to preclude a likelihood of confusion regardless of whether a consumer is Anglophone, Francophone or bilingual. The section 16(1)(a) ground of opposition is rejected.

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

[29] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to sections 16(3)(a) and (c) of the Act on the basis that the Mark is confusing with the Opponent's WANTED trade-mark and the trade-name Wanted Shoes Inc. With respect to these grounds of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark and trade-name prior to the Applicant's filing date and non-abandonment of its trade-mark and trade-name as of July 14, 2010 [sections 16(3) and 16(5) of the Act].

The Opponent Meets Its Burden with Respect to the Section 16(3)(a) and 16(3)(c) Grounds of Opposition

[30] The Opponent's evidence shows that it was using the Wanted Shoes trade-mark on women's footwear and shoeboxes (Kishk affidavit, para 4, Exhibits F and G) and the Wanted Shoes Inc. trade-name on invoices at the material date for this ground of opposition (Kishk affidavit, para 9, Exhibit C). As such, the Opponent meets its evidential burden for these grounds of opposition. Although my discussion below will focus on the Opponent's use of the trade-mark WANTED, my findings are also applicable to its use of the trade-name Wanted Shoes.

Inherent Distinctiveness and Degree of Resemblance

[31] My findings discussed with respect to the section 16(1)(a) ground of opposition above with respect to the inherent distinctiveness of the trade-marks and degree of resemblance apply equally here and will not be discussed further.

Extent Known and Length of Time in Use

[32] The factors considering the extent known and length of time in use of the trade-marks of the parties favours the Opponent. Its WANTED trade-mark has been in use since 2000 (Kishk affidavit, para 7) versus the Mark which was introduced in 2006 (Peart affidavit, para 6, Exhibit D). Further, in 2009 sales of WANTED brand footwear exceed \$150,000 (Kishk affidavit, para 12) and this brand has also been promoted through the distribution of catalogues and featured in magazines (Kishk affidavit, paras 11, 16 and Exhibits E and I). In contrast, the Applicant does not provide any evidence that use of the Mark had commenced with Goods (2) at the material date.

Nature of the Goods and Trade

[33] With respect to the nature of the goods, the following items are identical or have a significant degree of overlap with the goods sold by the Opponent: socks, athletic shoes, slippers, sandals and shoe boxes for travel. Furthermore, I consider that the goods described as loungewear, sleepwear, beachwear and resort-wear may also include footwear of the type sold by

the Opponent and therefore there is a strong degree of overlap between these goods and the Opponent's goods. With respect to the remaining goods, any overlap in the nature of goods resides solely in the fact that they like footwear may be considered fashion items, which I do not consider sufficient to give rise to a significant overlap in the nature of the goods. Further, there is no evidence on which I could base an inference that the trades would overlap to any extent as the evidence is that the Applicant consistently sells its goods at high-end, exclusive retailers whereas the Opponent does not. As such, I conclude that there is unlikely to be an overlap with respect to the channels of trade.

Conclusion

[34] Given the similarity in the nature of the goods and the degree of resemblance between the trade-marks, I find that the Applicant has not met its legal onus for the following goods: loungewear, sleepwear, socks, resort-wear, beachwear, athletic shoes, slippers, sandals and shoe boxes for travel regardless of whether the consumer is Anglophone, Francophone or bilingual. The section 16(1)(a) and 16(1)(c) grounds of opposition are successful for these goods.

[35] Given that there is no overlap between the nature of goods and trade of the remaining goods set out in Goods (2), the differences between the Mark and the Opponent's trade-mark and trade-name are sufficient to enable them to be distinguished from one another whether the consumer is Anglophone, Francophone or bilingual. Accordingly, while the Opponent has met its burden, the Applicant has also met its legal onus of proving that there is no reasonable likelihood of confusion with respect to the goods listed below.

Lingerie, underwear, panties, slips, briefs, boxer shorts, pajamas, sarongs, t-shirts, pants, bathrobes, morning robes, swimwear and swim suits, bandannas, bathing trunks, belts, Bermuda shorts, caps, golf shirts, gym shorts, gym suits, hats, jackets, jerseys, neckties, parkas, polo shirts, pullovers, rain coats, scarves, dress shirts, ski wear, slacks, sun visors, sweat bands, sweat suits, trousers, wetsuits and tank tops, sweaters, tank tops, skirts, dresses, board shorts, goods made of leather or of imitations of leather, namely boxes of leather or of leatherboard for travel purposes, envelopes of leather for merchandise packaging purposes; trunks; umbrellas, parasols, umbrellas for shading the sun, canes, walking stick seats ; satchels, hat boxes; paper and cardboard goods, namely, product picture albums, product magazines, calendars, indexes, photographs; pencils, pencil holders, fountain pens, ballpoint pens, inkstands, nibs of gold and playing cards.

Distinctiveness Ground of Opposition

[36] I will not discuss this ground of opposition in detail as it does not favour the Opponent any more than the section 16(1) and 16(3) grounds of opposition which have been discussed above. As with respect to the section 16(3) grounds, given the overlap in the nature of the goods described as loungewear, sleepwear, socks, resort-wear, beachwear, athletic shoes, slippers, sandals and shoe boxes for travel and the Opponent's footwear, the opposition is successful for these goods. Given the differences between the nature of the remaining goods and trade and trade-marks of the parties, the evidence of the Opponent's use and advertising of its WANTED trade-mark and Wanted Shoes trade-name is not extensive enough to negate the distinctiveness of the Mark for use with the remaining goods in the application as of the material date of December 14, 2010

Disposition

[37] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to:

paper and cardboard goods, namely, posters, product catalogs and brochures, notepads, notebooks, envelopes, writing paper, boxes of cardboard or paper, packing paper, bags of paper or plastic for packaging, labels, namely, hangtags, loungewear, sleepwear, socks, resort-wear, beachwear, athletic shoes, slippers, sandals and shoe boxes for travel

and reject the opposition with respect to the remaining pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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