

**IN THE MATTER OF AN OPPOSITION by 9013-0501  
QUÉBEC INC. to application No. 779,602 for the trade-mark NO  
RAGE filed by International Clothiers Inc.**

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On April 5, 1995, the applicant, International Clothiers Inc., filed an application to register the trade-mark NO RAGE based upon proposed use of the trade-mark in Canada in association with “Clothing, namely, suits, jackets, pants, coats, vests, shirts, sweaters, T-shirts, blouses, dresses, skirts and shorts”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of September 27, 1995 and Diffusion Bel-Gam Inc. requested and obtained extensions of time on November 23, 1995 and February 27, 1996 to oppose the present application. A statement of opposition was filed on May 22, 1996, a copy of which was forwarded to the applicant on June 28, 1996. While the letter of May 22, 1996 which accompanied the statement of opposition indicated that the opponent was Diffusion Bel-Gam Inc., the statement of opposition identified the opponent as 9013-0501 QUÉBEC INC. No explanation was provided either in the statement of opposition or the accompanying correspondence as to why the opponent was changed from Diffusion Bel-Gam Inc. to 9013-0501 QUÉBEC INC. Further, while the Opposition Board would normally raise an objection to such a change in opponent, the Board inadvertently failed to do so in this case.

The applicant served and filed a counter statement on October 22, 1996 in which it identifies the opponent as 9013-0501 QUÉBEC INC. The opponent submitted as its evidence the affidavits of Hélène Parent, Alain Nolet and Éric d’Anjou and subsequently submitted further affidavits of Hélène Parent, Alain Nolet and Éric d’Anjou to replace the original affidavits which failed to include all the exhibits identified in each of the affidavits. The applicant filed as its evidence the affidavits of Chris Dejardin and Generosa Castiglione. The opponent also requested leave of the Registrar pursuant to Rule 44(1) of the *Trade-marks Regulations* to file an affidavit of Micheline Tellier as further evidence in this proceeding. However, the opponent’s request for leave was refused by the Opposition Board by way of the Office letter of August 17, 1998. Both parties submitted written arguments and both were represented at an oral hearing. Further, during the opposition, the applicant assigned the present application to No Fear, Inc.

The issue of the identity of the opponent in this proceeding was raised at the oral hearing. As the statement of opposition and the counter statement both identify the opponent as being 9013-0501 QUÉBEC INC., the parties agreed to proceed with the hearing and the rendering of a decision on the basis that the proper opponent of record in this proceeding is 9013-0501 QUÉBEC INC. Further, as the Opposition Board was, in part, responsible for the present situation in failing to object to the change in opponent when the statement of opposition was filed, I have waived the requirement that 9013-0501 QUÉBEC INC. request and obtain a retroactive extension of time to oppose the present application.

The following grounds of opposition are set forth in the statement of opposition:

- a) The present application does not comply with Subsection 30(i) of the *Trade-marks Act* in that the applicant and the opponent both operate in the clothing area and each party is generally familiar with the products and trade-marks of its competitors. The opponent has used the trade-marks ORAGE (registration No. 386,694) and ORAGE & Design (registration No. 452,745) since at least as early as September 1, 1988 and therefore the applicant could not have been satisfied that it was entitled to use its trade-mark NO RAGE in Canada in association with the wares covered in the present application in that, as of the filing date of its application, the applicant was aware of the use by the opponent of its trade-marks;
- b) The applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant's mark is confusing with its registered trade-marks ORAGE (registration No. 386,694) and ORAGE & Design (registration No. 452,745);
- c) The applicant is not the person entitled to registration of the trade-mark NO RAGE in that, as of the filing date of the present application, the applicant's trade-mark NO RAGE was confusing with its trade-marks ORAGE and ORAGE & Design which have been used in Canada, as described in detail in paragraph 4 of the statement of opposition;
- d) The applicant's trade-mark is not distinctive in that the trade-mark NO RAGE cannot distinguish and is not adapted to distinguish the applicant's wares as identified in the present application from the wares of others and more particularly from the opponent's wares in association with which the opponent has used its trade-marks in Canada.

As its first ground, the opponent alleged that the applicant's application does not comply with Subsection 30(i) of the *Act*. No evidence has been furnished by the opponent to show that the applicant was aware of the opponent's trade-marks prior to filing the present application. Moreover, even were the applicant to have had constructive notice of the opponent's registered trade-marks ORAGE and ORAGE & Design prior to filing its application, no evidence has been furnished to show that the applicant could not have been satisfied that it was entitled to use its trade-mark NO

RAGE in Canada in association with the wares covered in the present application on the basis *inter alia* that its trade-mark is not confusing with the opponent's marks. Thus, the success of the Subsection 30(i) ground is contingent upon a finding that the applicant's trade-mark is confusing with one or both of the opponent's trade-marks as alleged in the remaining grounds of opposition [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition relied upon by the opponent.

The second ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent claiming that the applicant's trade-mark is confusing with its registered trade-marks ORAGE (registration No. 386,694) and ORAGE & Design (registration No. 452,745). In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date. In this regard, the material date in respect of the Paragraph 12(1)(d) ground is as of the date of decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al.*, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the applicant's trade-mark NO RAGE as applied to "Clothing, namely, suits, jackets, pants, coats, vests, shirts, sweaters, T-shirts, blouses, dresses, skirts and shorts" is inherently distinctive. Likewise, the registered trade-marks ORAGE (registration No. 386,694) and ORAGE & Design (registration No. 452,745) covering:

"Vêtements de sport et accessoires pour hommes, femmes et enfants, notamment pantalons, chemises, shorts, jupes, blouses, costumes, manteaux, anoraks, tee-shirts, blousons, chandails, maillots de bain, sacs, bas, ceintures, chapeaux, tuques, foulards, gants et mitaines, chaussures, notamment souliers, pantoufles et bottes"  
(registration No. 386,694)

"Vêtements de sport et accessoires pour hommes, femmes et enfants, notamment pantalons, chemises, shorts, jupes, blouses, costumes, manteaux, anoraks, tee-shirts, blousons, chandails, maillots de bain, sacs, sacs à dos, bas, ceintures, chapeaux, tuques, casquettes, foulards, gants et mitaines, chaussures, notamment souliers, pantoufles et bottes"

(registration No. 452,745)

are inherently distinctive in that they are neither descriptive nor suggestive when applied to the wares identified above, nor do they possess any other significance which would detract from their inherent distinctiveness.

With respect to the extent to which the trade-marks at issue have become known [Para. 6(5)(a)], no evidence has been furnished by the applicant to show that its trade-mark NO RAGE has become known to any extent in Canada. In his affidavit, Mr. D'Anjou, President of Diffusion Bel-Gam Inc. and 9013-0501 QUÉBEC INC., states that 9013-0501 QUÉBEC INC. acquired the marks ORAGE and ORAGE & Design from Diffusion Bel-Gam Inc., as appears in the records of the Trade-marks Office. In this regard, the photocopy of registration No. 386,694 for the trade-mark ORAGE which is annexed to the Parent affidavit indicates that the trade-mark ORAGE was assigned from Diffusion Bel-Gam Inc. to 9013-0501 QUÉBEC INC. on January 5, 1995, the assignment being recorded in the Trade-marks Office on July 5, 1996. As a result, it would appear that Diffusion Bel-Gam Inc. had ceased to be the owner of the trade-marks relied upon in the statement of opposition in January of 1995, that is, prior to the date of advertisement of the present application in the *Trade-marks Journal* [September 27, 1995].

Mr. D'Anjou also states in his affidavit that "l'entreprise emploi les marques ORAGE et ORAGE & DESSIN depuis au moins aussi tôt que le 1<sup>er</sup> septembre 1988 sur des articles vestimentaires de même que sur des accessoires et ce, sans interruption jusqu'à aujourd'hui" and that the sales by "l'entreprise quant aux articles vestimentaires portant la marque ORAGE ont subit une croissance constante depuis sa mise en marché tel qu'il appert des chiffres de ventes ci-dessous". I have interpreted the reference to "l'entreprise" by Mr. D'Anjou and Mr. Nolet in their affidavits as being Diffusion Bel-Gam Inc. prior to January of 1995 and 9013-0501 QUÉBEC INC. subsequent to that date. Further, there is no reference in the opponent's evidence to the existence of a license arrangement whereby Diffusion Bel-Gam Inc. was licensed to use the trade-marks ORAGE and ORAGE & Design subsequent to the assignment of the marks to 9013-0501 QUÉBEC INC.

Mr. D'Anjou also sets out in paragraph 6 of his affidavit the annual sales by "l'entreprise" from 1990 to October of 1996 inclusive of articles of clothing bearing the mark ORAGE, the total sales exceeding \$21,000,000. Further, in paragraph 6 of his affidavit, Mr. Nolet states that all the articles of clothing and accessories sold by "l'entreprise" bear the mark ORAGE. However, the opponent has failed to adduce any evidence showing the manner in which its trade-mark ORAGE is brought to the attention of the average consumer in association with any of the wares covered in its registrations. Rather, the only exhibits adduced by the opponent are photocopies of invoices attached to the Nolet affidavit and these exhibits arguably show use of the trade-name ORAGE VETEMENTS SPORTS / SPORTS WEAR and not use of the trade-mark ORAGE. Moreover, these documents would not be brought to the attention of the average consumer of the opponent's wares.

Having regard to the significant volume of sales evidenced by the opponent and the fact that Mr. Nolet has stated that the opponent's clothing and accessories bear the trade-mark ORAGE, and considering further that this evidence has not been challenged by way of cross-examination, I have concluded that, despite the deficiencies in the opponent's evidence, the extent to which the trade-marks at issue have become known clearly weighs in the opponent's favour. Likewise, the length of time the trade-marks at issue have been in use [Para. 6(5)(a)] is a further factor which favours the opponent.

As for the nature of the wares [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, the applicant's suits, jackets, pants, coats, vests, shirts, sweaters, T-shirts, blouses, dresses, skirts and shorts are essentially identical to the wares covered in the opponent's registrations. Further, and in the absence of any evidence to the contrary, I would expect that the channels of trade of the parties would or could overlap.

Considering the degree of resemblance between the trade-marks at issue in appearance or sound or in the ideas suggested by them [Para. 6(5)(e)], I consider there to be some similarity in appearance and no resemblance in the ideas suggested by the trade-marks NO RAGE and ORAGE. As for the sounding of the trade-marks NO RAGE and ORAGE, the opponent submitted that the average francophone would pronounce the marks in a similar manner whereas the applicant has

argued that the average anglophone would sound the trade-marks at issue differently. However, no evidence has been furnished by either party relating to the sounding of the trade-marks at issue by either the average anglophone or francophone or, more importantly, by the average bilingual consumer.

Having regard to the bilingual character of Canada, I am of the view that the issue of confusion must be assessed in a bilingual context wherein one accords as much importance to the French language as to the English language [see, in this regard, *Etablissements Leon Duhamel, now K Way International v. Créations K.T.M. Inc.*, 11 C.P.R. (3d) 33]. I would also note the following comments of the Hearing Officer in *Les Vins La Salle Inc. v. Les Vignobles Chantecler Ltée*, 6 C.P.R. (3d) 533, at pages 535 to 536:

“In the present case, the most important circumstances in determining whether the applicant's trade mark is confusing with the opponent's trade mark are the inherent distinctiveness of the trade marks and the degree of resemblance between them in appearance and sound and in the ideas suggested by them. The significance of these circumstances is naturally very dependent upon the linguistic context in which they are considered. The applicant submitted as reasons for concluding that the trade marks are not confusing that as used in association with wines, the word "plaisir" in French suggests that the drinking of the wine will result in pleasure and that therefore it is a weak part of both the applicant's and the opponent's trade marks in terms of inherent distinctiveness. The applicant also submitted that the ideas suggested in French by the trade marks are quite different. At p. 8 of the applicant's argument it is stated:

D'une part, la marque "PLAISIR DIVIN" de l'Opposante employée en liaison avec des vins connote un vin fournissant une joie ou une émotion agréable réservée aux dieux. ... Par contre, la marque "PLAISIR D'AMOUR" connote plutôt le caractère romantique et intime associé à la consommation du vin."

As pointed out by the opponent, however, the reaction of a unilingual anglophone to these trade marks would be quite different. A unilingual anglophone would likely react to the word "plaisir" as a coined word. He might guess that it is a French word but he would have no knowledge as to its meaning.

Given the bilingual nature of Canada and bearing in mind the recent comments of Joyal J. in *Boy Scouts of Canada v. Alfred Sternjakob GmbH & Co. KG et al.* (1984), 2 C.P.R. (3d) 407 at pp. 412-3 and Strayer J. in *Scott Paper Co. v. Beghin-Say S.A.* (F.C.T.D., May 21, 1985, unreported, T-1543-84) at pp. 9-10 [since reported 5 C.P.R. (3d) 225 at p. 231] it is evident that the question of confusion should be assessed in a bilingual context in which both the English and French languages are accorded equal importance. It appears to me that there are two basic ways in which this goal might be accomplished: i) assess the question of confusion in the context of unilingual francophones, unilingual anglophones and bilingual persons and then if two trade marks are confusing to the average member of any of these groups conclude that the trade marks are confusing, or ii) assess the question of confusion in the context of bilingual persons only. The former approach would appear to be flawed in that it is inconsistent with the long established principle that trade marks which are descriptive in English or French of the wares or services with

which they are associated are weak and only entitled to a narrow ambit of protection: see, e.g., *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101. If one followed the former approach, one would have to conclude that most trade marks which are descriptive in the English language only are still strong because they would have no meaning for an average unilingual francophone and vice versa. This could effectively permit individuals to obtain monopolies in descriptive words which would clearly be contrary to the public interest and to the intent of the Trade Marks Act. The latter approach of considering the question of confusion in the context of bilingual persons only is somewhat artificial in that only a minority of Canadians are actually bilingual; however, because of the above discussed flaw with the former approach, I consider it much more reasonable to follow the latter approach.

Considering then the question of confusion from the point of view of a bilingual person, he would be aware of the descriptive connotations of the word "plaisir" in association with wine and of the difference in the ideas suggested by the two trade marks and, accordingly, he would probably be less likely to be confused than a unilingual anglophone. Nevertheless, having regard to all the other circumstances, I do not consider that this awareness is sufficient to avoid the likelihood of confusion. Both trade marks consist of two parts, the first in each case being "plaisir" and the second parts "divin" and "d'amour" being of about equal length and both starting with the letter "d". In my view, for an average bilingual person of ordinary intelligence having an imperfect recollection of the opponent's trade mark PLAISIR DIVIN and seeing the applicant's trade mark PLAISIR D'AMOUR as a matter of first impression there would still be a fairly high degree of resemblance."

In the present case, I believe that the average bilingual Canadian would immediately recognize the applicant's trade-mark as comprising the English words NO and RAGE and therefore would pronounce the applicant's trade-mark NO RAGE as those words would be sounded in the English language. Further, since the opponent's trade-mark ORAGE has no meaning in the English language, it would in my opinion be sounded by the average bilingual Canadian as it would be sounded in the French language. As a result, I find there to be relatively little similarity in the sounding between the trade-marks at issue.

As a further surrounding circumstance in relation to the issue of confusion, the applicant submitted marketplace evidence by way of the Dejardin affidavit. Mr. Dejardin states that he purchased a pair of jeans bearing the word "Rage" at the Wal-Mart department store in the Lincoln Heights Galleria in Ottawa on July 2, 1997 and has annexed photocopies of the jean stitching and labels bearing the words "Rage" and "Rage Jeanswear Co." to his affidavit. This evidence confirms that the trade-mark RAGE is being used in the marketplace in Canada in association with jeans although the extent of such use cannot be ascertained from the applicant's evidence. The Dejardin affidavit also shows that the trade-mark STORM is in use in Canada in association with caps although I consider this evidence of limited relevance to the issue of confusion between the

applicant's mark NO RAGE and the opponent's trade-marks ORAGE and ORAGE & Design.

The opponent also submitted state of the register evidence in support of its application. That evidence does show that there are existing registrations for the trade-marks OUTRAGE, RAGE and ASPHALT RAGE. The registered trade-mark RAGE covers wet suits, water ski gloves and the like which are related to the wares covered in the applicant's registrations for the trade-mark NO FEAR, registration No. 449, 765 and 452,509, but otherwise differ from the wares associated with the applicant's trade-mark NO RAGE and the opponent's marks ORAGE and ORAGE & Design. Further, I am not prepared to draw any inferences concerning the use of these marks in the marketplace in Canada based on the existence of only two trade-mark registrations. The Castiglione affidavit also introduces into evidence photocopies of registrations including the word ORANGE which I consider to be of little relevance to the issues in this proceeding.

Having regard to the above and, in particular, to the minimal resemblance between the trade-marks at issue when considered in their entireties, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark NO RAGE and the opponent's registered trade-marks ORAGE and ORAGE & Design. I have therefore dismissed the Paragraph 12(1)(d) ground of opposition. Further, in view of the foregoing, I am satisfied that the applicant has met the legal burden upon it of showing that there would be no reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's filing date or the date of opposition, the material dates for considering the issue of confusion in relation to the non-entitlement and non-distinctiveness grounds of opposition. I have therefore rejected these grounds of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 29<sup>th</sup> DAY OF JULY, 1999.



G.W. Partington  
Chairperson  
Trade-marks Opposition Board