



TRANSLATION
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 185
Date of Decision: 2016-12-06
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Michel Germain Parfums Ltd.

Opponent

and

DIESEL S.P.A.

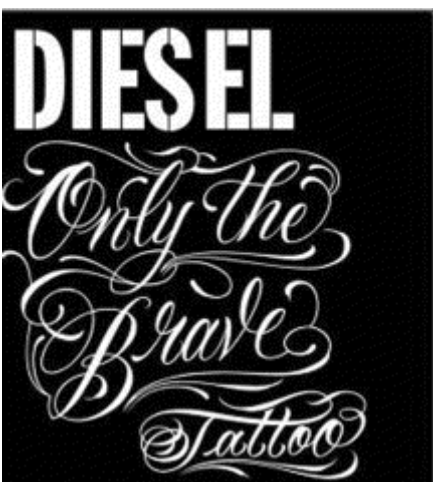
Applicant

**1,571,824 for DIESEL ONLY THE
BRAVE TATTOO and design**

Application

Introduction

[1] Michel Germain Parfums Ltd. (the Opponent) opposes the registration of the DIESEL ONLY THE BRAVE TATTOO and design trade-mark (reproduced hereinafter) (the Mark), covered by application No. 1,571,824 in the name of DIESEL S.P.A. (the Applicant), based on the proposed use in Canada in association with "eau de toilette" goods:



[2] The colour is claimed as a characteristic of the Mark. All the words are light blue on a black background.

[3] The Opponent bases its opposition on various grounds centered around the issue of compliance of the application with Section 30 of the Trade-marks Act, RSC 1985, c T-13 (the Act), i.e. the issue of the likelihood of confusion between the Mark and the TATTOO trade-mark registered on October 31, 2007 under No. TMA699,947 in association with the goods "perfumes, eau de parfum, eau de toilette" belonging to the Opponent and having allegedly been used by the Opponent in Canada.

[4] As my analysis will reveal, I find there is reason to reject the opposition.

The record

[5] The statement of opposition was originally filed on August 13, 2013, then amended voluntarily by the Opponent on August 19, 2014, with the permission of the Registrar.

[6] In support of its opposition, the Opponent filled, as chief evidence, an affidavit by one of its founding executives, Steven M. Bailey, dated February 21, 2014. Mr. Bailey was cross-examined on his affidavit, and the transcript of his cross-examination as well as the answers to the undertakings made during the latter were entered on the record. The Opponent also filed, as rebuttal evidence, an affidavit by Kerry Biggs, trade-mark agent with the firm representing the Opponent in these proceedings, dated October 15, 2015.

[7] In support of its application, the Applicant filed an affidavit by Naomi Côté-Laporte, a law student with the firm representing the Applicant in these proceedings, dated December 11, 2014, and an affidavit by Dean Philip Michaud, a civil law graduate of the University of Ottawa, dated February 4, 2015. Mr. Michaud was cross-examined with respect to his affidavit and the transcript of his cross-examination was made part of the record.

[8] Each of the parties filed a written argument and was represented at the hearing held in this file.

Analysis

The burden incumbent on the Parties

[9] It is initially up to the Opponent to establish that its opposition is well-founded. However, the legal onus of showing that the Mark is registrable falls to the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[10] Applying these principles in this case, four grounds of opposition argued by the Opponent can be summarily rejected, without it being necessary to reproduce them or discuss them at length.

Grounds of Opposition Summarily Rejected

[11] As conceded from the outset by the Opponent at the start of the hearing, the grounds of opposition based on the application's non-compliance with Sections 30(b) and (e) of the Act must be rejected, given that the Opponent did not meet its initial burden of proof regarding these grounds.

[12] As also conceded by the Opponent, the ground of opposition based on non-entitlement to registration within the meaning of Section 16(3)(b) of the Act must be rejected, given that the registration application for the TATTOO trade-mark alleged by the Opponent in support of such a ground had already been filed and thereby was not pending at the time of the announcement in the *Trade-marks Journal* on March 13, 2013.

[13] Moreover, the ground of opposition based on non-compliance of the application with Section 30(i) of the Act on the ground that the Applicant could not be satisfied that it was entitled to use the Mark in Canada, in that it should have known that it was confusing with the Opponent's TATTOO trade-mark, must also be rejected. Once an applicant has provided the statement required under Section 30(i) of the Act, such a ground of opposition should only be accepted in exceptional cases, such as when the evidence shows that the applicant was acting in bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. Nothing shows that the Applicant was in bad faith in the case at bar. Moreover, the Opponent made no representation in support of this ground.

Remaining Grounds of Opposition

[14] The remaining grounds of opposition all revolve around the question of the likelihood of confusion between the Mark and the Opponent's TATTOO trade-mark.

[15] As my analysis will reveal, although the test for confusion remains the same, the initial burden of proof incumbent on the Opponent and the relevant applicable dates vary according to each of these grounds.

[16] I will begin my analysis regarding the ground based on the non-registrability of the Mark within the meaning of section 12(1)(d) of the Act, which represents the Opponent's strongest ground of opposition.

Non-registrability of the Mark

[17] The Opponent alleges that the Mark is not registrable within the meaning of Section 12(1)(d) of the Act since it is confusing with the Opponent's registered mark TATTOO described above.

[18] The relevant date for deciding on a ground of opposition based on the non-registrability of a trade-mark in regard to the confusion created with a registered trade-mark is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[19] I exercised my discretion and checked that the registration claimed by the Opponent in support of this ground is still in effect in the trade-marks register. Since this is the case, the Opponent has met the initial burden of proof incumbent on it. The Applicant must now show, according to the balance of probabilities, that there is no risk of confusion between the Mark and this mark registered by the Opponent.

The Test for Confusion

[20] The test for confusion is that of first impression and imperfect recollection. According to subsection 6(2) of the Act, 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, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[21] In deciding whether these trade-marks cause confusion, the registrar must take into account all circumstances in the case, specifically those listed in Section 6(5) of the Act, i.e. a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks or trade-names have been in use; c) the nature of the goods, services or business; d) the nature of the trade; e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight could be given to each of these factors, depending on the situation [see *Mattel, Inc v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)] for a more thorough examination of the general principles governing the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[22] The parties' marks both have inherent distinctiveness in the context of the perfumery products associated with them, in that they are not descriptive of them.

[23] Since the Mark is composed of several distinctive elements, including the word "DIESEL", that are unrelated to the Applicant's eaux de toilette, rather than the single word "TATTOO", I agree with the Applicant that its inherent distinctiveness is greater than that of the Opponent's mark. The word "TATTOO", used alone in the context of the Opponent's perfumery products, evokes the idea of a product applied to the skin (like a tattoo). I will return later to the ideas suggested by the marks in question in my assessment of the factor stated in Section 6(5)(e) of the Act.

[24] It is possible to increase the strength of a trade-mark by making it known through promotion or use.

[25] As indicated above, this application is based on the proposed use of the Mark in Canada. Since no evidence has been made part of the record regarding the extent to which the Mark would become known in Canada, I cannot conclude that the Mark has any acquired distinctiveness.

[26] Concerning the Opponent's evidence, neither can I conclude that the TATTOO trade-mark has become known in Canada so as to increase its distinctiveness significantly, as will emerge from my review hereinafter of Mr. Bailey's affidavit, considered in light of some of the highlights of his cross-examination and the responses to the undertakings made at that time.

Affidavit by Mr. Bailey

[27] Mr. Bailey affirms that the Opponent has sold perfumery products under the TATTOO trade-mark in Canada since 2004. In paragraph 4 of his affidavit, he affirms that, since the very first time the Opponent considered marketing its goods under this mark, including the very first sale of these goods to date, the Opponent always believed that:

...the trend of tattooing is and will become increasingly appealing to the Canadian public, and around the world, and that the trade-mark TATTOO used in association with the products that [the Opponent] develops and sells would therefore also likely appeal to a broad cross-section of the population.

[28] Mr. Bailey explains this is the reason why the Opponent took steps to register the TATTOO trade-mark in association with "perfumes, eau de parfum, eau de toilette". Mr. Bailey

refers collectively to these goods as the "Goods" ("*Goods*") and I will do the same in my review of his affidavit.

[29] Mr. Bailey affirms that all the Goods sold in association with the TATTOO trade-mark in Canada or exported internationally are manufactured in Canada and bear the mark, both directly on the bottles containing the Goods and on their outer carton packaging.

[30] Mr. Bailey affirms that the packaging of the Goods has evolved over the years. Under Exhibits B and C of his affidavit, he files colour photos of the packaging thus used for the Goods - version for men, between 2007 and today, and - version for women, between 2009 and today.

[31] Mr. Bailey affirms that the very first sale of the Goods displaying the TATTOO trade-mark was made by export to the United States on June 21, 2004. In this regard, under Exhibit D of his affidavit, he files a copy of the invoice attesting to the sale of 11 "*tattoo edp* [eau de parfum] *spray 75 ml*" and one "*tattoo edp* [eau de parfum] *spray tester 75 ml*", among other goods, for a cumulative value of 341 dollars.

[32] Mr. Bailey affirms that the Opponent subsequently had "*much success*" selling the TATTOO Goods in Canada and exporting them to the United States.

[33] In paragraph 9 of his affidavit, Mr. Bailey provides the sales figure for the TATTOO Goods, detailed as follows:

Year	Sales in Canada	Export sales to the U.S.
2009	<i>"In excess of"</i> \$126	<i>"In excess of"</i> \$332,300
2010	<i>"In excess of"</i> \$4,400	<i>"In excess of"</i> \$5,800
2011	<i>"In excess of"</i> \$359	<i>"In excess of"</i> \$10,300
2012	<i>"In excess of"</i> \$15,900	<i>"In excess of"</i> \$24,400
2013	<i>"In excess of"</i> \$13,100	<i>"In excess of"</i> \$42,100

[34] Under Exhibit E of his affidavit, Mr. Bailey also files a representative sample of invoices attesting to the sale of the Goods between the years 2009 and 2013.

[35] Mr. Bailey affirms these sales result, in part, from the advertising the Opponent produced for the Goods on its website *www.michelgermain.com*, from which it has been possible to purchase and deliver the TATTOO Goods both in Canada and the United States since September 10, 2009. To this effect, he files excerpts from the website under Exhibit F of his affidavit. He adds that the website receives 61,000 visitors per year.

[36] Mr. Bailey affirms that the Opponent has also sold the TATTOO Goods to various retailers in Canada and the United States for resale to the general public, including in pharmacies, department stores, duty-free shops and independent boutiques, such as CVS Caremark Corporation (CVS) pharmacies in the United States and Winners Merchants International in Canada.

[37] Mr. Bailey affirms that in 2009 and 2010, the Opponent spent \$10,982.88 to develop a presentation unit to display the TATTOO Goods at some of its retailers. In support of his affidavit, under Exhibit G, he files representative photos of the presentation unit that was used at independent boutiques, including Tweed & Hickory in Cornwall, Ontario, Scents Forever in Calgary, Alberta, and Fragrance Boutique in Yellowknife, Northwest Territories.

[38] Mr. Bailey adds that another promotional tool consists of perfume testers bearing the TATTOO trade-mark, which have been distributed free of charge to the Opponent's retailers in Canada and the United States. He affirms that between 2009 and 2011, more than 100 testers were distributed in Canada and more than 6,200 in the United States.

[39] Mr. Bailey affirms that the Opponent "*polices the marketplace regularly to ensure [its] TATTOO trade-mark is distinctive*".

[40] Mr. Bailey concludes his affidavit by expressing his personal opinion as to the probability of confusion between the marks in question, which opinion turns out to be irrelevant in the case at bar. It is up to the Registrar to settle this mixed question of fact and law with regard to the evidence of record.

[41] During Mr. Bailey's cross-examination, the Applicant attempted to obtain more information concerning the extent of the use that would have been made of the TATTOO trade-mark by the Opponent between the years 2004 and 2009, beyond the one and only invoice of June 21, 2004 filed as Exhibit D. Without going into the details of the objections and/or questions taken under advisement and the answers obtained, it emerges from Mr. Bailey's entire cross-examination that no additional information could be obtained from the Opponent. It is sufficient to note that the Opponent went so far as to affirm that such information would be irrelevant in the present case. Yet this position is contradictory with the one taken both in its written argument and during the hearing, that it had demonstrated the continuous and substantial use of the TATTOO trade-mark in Canada for over a decade.

[42] Although no evidence of use of the Opponent's registered mark is required as such to argue a ground of opposition under Section 12(1)(d) of the Act, it nonetheless remains that the extent and duration of the use made of the TATTOO trade-mark turn out to be relevant circumstances regarding the test for confusion laid down in Section 6(5) of the Act. In the circumstances, in view of the little information I have, and as pointed out to the Opponent during the hearing, I cannot determine the duration and the extent to which the TATTOO trade-mark become known and was actually used in Canada between the years 2004 and 2009.

[43] For the period between the years 2009 and 2013, the Applicant argued that the Opponent's evidence also contains a number of deficiencies and contradictions. Without going into the details thereof, the Applicant primarily argues the deficiencies and contradictions in the sales figures provided in paragraph 9 of Mr. Bailey's affidavit and the fact the Opponent's TATTOO trade-mark is used essentially for export to the United States and "residually" within Canada.

[44] More specifically concerning the sales figures, it emerges from Mr. Bailey's cross-examination that he did not personally verify the sales figures indicated in paragraph 9 of his affidavit, but that he instead had obtained them from his associate Eric Cook. In response to Mr. Bailey's undertakings, a second table containing "*more specific sales figures*" was provided by the Opponent, namely:

Year	Sales in Canada	Export sales to the U.S.
2009	\$486.58	\$333,819.47
2010	\$4,617.55	\$6,481.16
2011	\$2,923.45	\$47,785.94
2012	\$39,637.00	\$269,203.00
2013	\$24,632.80	\$174,054.20

[45] By performing a comparative exercise between this second table and the one provided previously in paragraph 9 of Mr. Bailey's affidavit, the Applicant argues that substantial differences exist that are simply inexplicable. It submits that the figures alleged in paragraph 9 are doubtful and that there is no reason to believe the same does not apply to the figures provided in response to the undertakings. The Applicant thereby submits that the Registrar cannot take the Opponent's figures into account and must consider that the Opponent has not proved that its mark had acquired distinctiveness by use and/or promotion. In default of adherence to this reasoning, the Applicant submits that the Registrar must at least account for [TRANSLATION] "these contradictions and deficiencies between two documents that are deemed to respond to each other, and draw negative inferences from them" regarding the use and/or promotion of the Opponent's mark since 2009.

[46] I am not convinced this is a case where such negative inferences should be drawn.

[47] As indicated in the table presented in paragraph 9 of Mr. Bailey's affidavit, the sales figures originally submitted were accompanied by the mention "*In excess of*". In the responses to the undertakings incorporating the second table described above, the Opponent explains that:

Upon reviewing the sales figures supplied to Mr. Bailey in support of his statement in paragraph 9, it was discovered that the sales figures for 2009-2013 are actually in excess of the figures in paragraph 9.

[48] The figures specified exceed those provided in the first table. They do not contradict them.

[49] In short, I find that it is not appropriate to call into question the sales figures provided in the second table.

[50] Concerning the use for export, the Applicant argues that it emerges from Mr. Bailey's entire cross-examination that the vast majority of the visitors to the Opponent's website come from the United States. Moreover, the vast majority of sales indicated in paragraph 9 of Mr. Bailey's affidavit (and in the second table) concern sales for export to the United States. The Applicant points out that during his cross-examination, Mr. Bailey admitted that Canadians, "*other than the truck driver or a theft*", are not exposed to the goods bound for export to the United States. Drawing a parallel with *Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 (FCTD), in which it was determined that the distinctiveness of a trade-mark must be assessed with regard to the Canadian market as opposed to foreign markets, the Applicant submits that the evidence of use of the TATTOO trade-mark in the United States does not allow the inference that this mark thereby acquired distinctiveness with Canadian consumers. The Applicant submits that it was up to the Opponent to establish the positive influence of exports to the United States on the Canadian domestic market, on the reputation of its mark with Canadian consumers, which it has not done.

[51] On this subject, the Applicant argues that the notion of use within the meaning of Section 4(3) of the Act, which takes exports into account, is different from that of Section 6 of the Act. It argues that the latter section is interested in the acquired distinctiveness of a trade-mark, which depends exclusively on the knowledge Canadian consumers may have of this mark.

[52] Concerning Mr. Bailey's assertion that the Opponent "*has had much success selling TATTOO-branded [registered products] in Canada and exporting [same] from Canada to the United States*", the Applicant submits that the Opponent instead enjoys a debatable reputation with its consumers.

[53] In particular, the Applicant argues that the Opponent provided no evidence proving the good reputation enjoyed by the TATTOO trade-mark, although questioned on this subject during

Mr. Bailey's cross-examination. In particular, the Applicant attempted to prove that the American pharmacy chain CVS (at the origin of the order of more than \$300,000.00 in 2009) had stopped ordering the Opponent's TATTOO goods in fall 2009 (which was admitted by the Opponent) because it had a bad experience with these goods. The Applicant also attempted to learn the extent to which the Opponent's TATTOO goods had been the subject of consumer complaints. Since the Opponent ultimately refused to answer these questions on the ground they were irrelevant in the context of these proceedings, the Applicant asked the Registrar to draw a negative inference from all these refusals and to consider that the Opponent's mark has a dubious reputation with consumers.

[54] In default of adherence to this reasoning, the Applicant submits that the Registrar must at least admit that the Opponent has not provided any evidence indicating the good reputation of its mark with consumers, which significantly diminishes the Opponent's claims regarding the use and promotion of its mark since 2009.

[55] It is a fact that the majority of the sales realized by the Opponent concern sales for export to the United States. The sales figures provided both in the first table and in the second speak for themselves. I also agree with the applicant that, in the circumstances of this case, it cannot be concluded that the use made through sales for export to the United States has contributed in any way to increasing the extent to which the TATTOO trade-mark has become known in Canada.

[56] However, I am not prepared to draw negative inferences from the Opponent's refusal to answer the Applicant's questions concerning the business relationship with CVS or the consumer complaints the Opponent might or might not have received. It is sufficient to point out that just because goods may have been the subject of complaints does not mean that they did not become known. In this sense, the Opponent was justified in refusing to answer the Applicant's questions on the grounds they were irrelevant in the context of this opposition.

[57] This having been said, I agree with the Applicant that it cannot be concluded that the Opponent's TATTOO mark has become known substantially in Canada. The figures concerning the sales realized in Canada for the period between the years 2009 and 2013 are modest. Moreover, apart from the mere advertising on the Opponent's website beginning in the year 2009, or through the presentation unit to display the TATTOO Goods at certain retailers

in 2009 and 2010, I cannot conclude that the TATTOO Goods received significant advertising or promotion.

[58] In summary, I am not prepared to conclude that the Opponent's TATTOO trade-mark has become known in Canada in such manner as to increase its distinctiveness significantly. At most I am prepared to conclude that the TATTOO trade-mark has been used and become known modestly in Canada, so as to diminish slightly the difference between its weaker inherent distinctiveness and the greater distinctiveness of the Mark.

The period during which the trade-marks have been in use

[59] During the hearing, the Opponent argued that the TATTOO mark had been used in Canada for over a decade, thus contrasting with the total absence of use of the Mark.

[60] In view of the ambiguities and deficiencies raised earlier in my review of Mr. Bailey's testimony, I find, however, that the Opponent's evidence at most allows me to conclude the continuous use of the TATTOO mark in Canada since 2009.

[61] Whatever the case may be, I agree with the Opponent that this factor nonetheless favours it, given the absence of use of the Mark.

Type of goods, services or enterprises and the nature of the trade

[62] The parties' goods are identical, or to all intents and purposes identical.

[63] I agree with the Opponent that, in the absence of evidence to the contrary, it cannot be concluded that their marketing channels (sic - voices) differ.

[64] These two factors therefore also favour the Opponent.

The degree of resemblance between the trade-marks in the presentation or sound, or in the ideas they suggest

[65] As recalled by the Supreme Court in the *Masterpiece* case cited above, in paragraph 49, the degree of resemblance between the trade-marks in appearance or sound or in the ideas

suggested by them is the factor that is often likely to have the greatest effect on the confusion analysis and the one that proves decisive in most cases.

[66] Moreover, as previously mentioned, it is well-established in case law that the likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), in paragraph 34].

[67] Also, it is true that in certain cases the first word will be the most important element in establishing the distinctiveness of a trade-mark, the Supreme Court stipulates in paragraph 64 of the *Masterpiece* case that “a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.”

[68] Applying these principles to this case, I agree with the Applicant that significant differences exist between the parties’ marks and that it is easy to distinguish them.

[69] The Opponent's TATTOO trade-mark is composed only of the word "TATTOO", while the Mark is composed of five words. Visually, due to the layout of the word "DIESEL" and the different font used for it in relation to the words "ONLY THE BRAVE TATTOO", I agree with the Applicant that the word "DIESEL" is the dominant element. As noted by the Applicant, the words "ONLY THE BRAVE TATTOO" are in cursive form, which renders them less easily legible than the word "DIESEL", which uses a script font. In addition, the last word "TATTOO" uses the smallest font and is not so easy to read. Finally, it is clearly seen that the Mark is a verb phrase, "DIESEL, ONLY THE BRAVE TATTOO", as opposed to the Opponent's trade-mark, which is limited to the single word "TATTOO".

[70] Phonetically, I agree with the Applicant that the Mark also differs significantly from the Opponent's mark. A five-word phrase, as opposed to a single word, will necessarily be pronounced differently and in a longer space of time by consumers, whether they are Anglophone, Francophone or bilingual.

[71] Returning to the ideas suggested by the marks in question, I agree with the Applicant that the "same idea" is not "conveyed to the mind of the somewhat-hurried consumer" [*Veuve Clicquot, supra*, para 35].

[72] Without going so far as to agree with the Applicant that the word "DIESEL" included in the Mark [TRANSLATION] "benefits from undeniable recognition" as a trade-mark of the Applicant (no evidence of this has been filed by the Applicant to support such a claim), I agree with the Applicant that the Mark [TRANSLATION] "aims at a consumer interested in the Diesel goods who considers himself non-conformist, self-confident, ready to dare". The clear emphasis placed on the word "DIESEL", followed by the phrase "ONLY THE BRAVE TATTOO", evoking the idea of bravery associated with the act of tattooing, supports this conclusion.

[73] In comparison, the Opponent's mark does not evoke this aspect of non-conformism or bravery. The word "TATTOO", used alone in the context of the Opponent's perfumery products, evokes the idea of a perfume that impregnates the skin of the person who wears it and possibly distinguishes that person (like a tattoo).

[74] In this regard, the Applicant submits that the Opponent's mark sends a message of social acceptance of the tattooing trend by the consumer, instead of a message of non-conformism. It also reminds us that Mr. Bailey clearly confirms this hypothesis by attesting in paragraph 4 of his affidavit that the tattooing trend is and will become "*increasingly appealing*" for the Canadian population and around the world, and that the TATTOO trade-mark, used in association with the goods the Opponent develops and sells, would also become attractive for a large section of the population.

[75] In this sense, the Applicant submits that the Opponent's TATTOO trade-mark addresses a broader audience seeking to follow the majority, the trend. In short, the marks have different bases.

[76] I agree with the Applicant. As noted above, Mr. Bailey affirms unequivocally that the TATTOO trade-mark was adopted by the Opponent, considering the tattooing trend as an "appealing" practice within the Canadian population. I find it reasonable to have faith in this assertion by Mr. Bailey, which directly concerns the idea evoked by the TATTOO trade-mark.

[77] In conclusion, I will add that, contrary to the position taken by the Opponent during the hearing, the fact the word "TATTOO" is used as a verb in the phrase "ONLY THE BRAVE TATTOO", thereby answering the question formulated by the Opponent's agent during the hearing: "*Only the brave do what? They tattoo*", does not make this word the dominant element of the Mark. The Mark must be considered as a whole, which includes the first portion composed of the word "DIESEL", which in itself has no relationship with the Applicant's perfumery products, and the "subject group", "ONLY THE BRAVE", preceding the verb ""TATTOO".

[78] In summary, the fact that the Mark incorporates the totality of the TATTOO trade-mark does not lead me to conclude that the Mark shares a material resemblance with it in presentation, sound or the ideas suggested. On the contrary, I find that significant differences exist, visually, phonetically and in the ideas suggested by the parties' marks. Consequently, my overall assessment of this fifth factor favours the Applicant.

Additional Circumstances

[79] The Applicant submits that tattooing is not only a fashion but a real [TRANSLATION] "social phenomenon", which therefore cannot belong to anyone. It submits that the term "TATTOO" is commonly used [TRANSLATION] "in all types of industry [sic]", and specifically in "the industry of goods applied to the skin".

[80] Without going into detail on the Applicant's claims, I retain that it basis them on the following elements in particular:

- the evidence submitted via Mr. Michaud's affidavit;
- the evidence submitted via Mr. Bailey's testimony;
- the evidence submitted via Ms. Biggs' affidavit; and
- the complete record of examination regarding the Opponent's TATTOO registered trade-mark, filed via Ms. Côté-Laporte's affidavit.

Mr. Michaud's affidavit

[81] The goal of Mr. Michaud's affidavit is to prove that he was able to order online various perfumery products containing the word "TATTOO" from Canada, namely the following goods:

- *Tattooed for women, by Inky Perfume* [Exhibit DPM-1];
- *That's Amore! Tattoo Lei for women by Gai Mattiolo*; and *That's Amore! Tattoo Lei for men by Gai Mattiolo* [Exhibits DPM-2 and DPM-3];
- *Rose Tattoo for men & women by Neil Morris* [Exhibits DPM-4 and 5]; and
- *Tattoo Girl by Johan B* [Exhibit DPM-6].

[82] However, it is appropriate to note that Mr. Michaud indicates in his affidavit that he was still on a waiting list to be able to purchase *That's Amore!* products. *Tattoo for men and women* at the time he signed his affidavit. It also emerges from Mr. Michaud's cross-examination that his online purchases are not necessarily representative of what is found in traditional physical stores.

Mr. Bailey's testimony

[83] The Applicant reminds us that in paragraph 17 of his affidavit, Mr. Bailey affirms that the Opponent "*polices the marketplace regularly to ensure [its] Tattoo Trade-mark is distinctive*".

[84] When questioned on this subject during his cross-examination, Mr. Bailey responded in the affirmative to the question "*Have you found potentially offending products in the Canadian and U.S. Marketplace as a result of the policing in the marketplace that you have been conducting [...]?*".

[85] The following questions ensue:

Q. So my first question will be : Have you found offending products in the Canadian Markeplace?

A. Yes, "Diesel Only The Brave Tattoo".

Q. Okay. Any others?

A. I believe so; but I would need that to be confirmed.

[86] The Applicant also argues that, during his cross-examination, Mr. Bailey answered the question "*Are you aware that there are manufacturers/producers of products that put the word 'Tattoo' on their product, in various industries, various fields of business*" with "*Somewhat aware*". I reproduce the complete exchange:

A. Somewhat aware. But in general, the reason why the 'Tattoo' Mark is of interest to us is the fact that there is so little and that we would be the only ones in the Perfume Sector to have the Mark all on our own.

Q. Okay. But do you agree that there are other companies out there which --

A. Somewhat. There are not many. So it is something that -- I can't say that it's prolific. I am somewhat aware. But in comparison to, you know, many -- You know, it is very small, very tiny, in comparison to -- It is very small. There is nothing to compare it to. Somewhat aware. There are very few.

Mr. MIKUS: I would like the Witness, as an Undertaking, to identify the other uses of the word « Tattoo » by Traders in different industries that he is aware of, that he just mentioned.

Ms. DUMOUCHEL: Subject to that being physical correspondence and being more than "somewhat aware" of it, if anything exists in his files, we will take it under Advisement.

[87] The Applicant submits that Mr. Bailey subsequently refused to respond, both in his cross-examination and in the responses to the undertakings made during the cross-examination, to the subsequent questions related to the assertion contained in paragraph 17 of his affidavit. However, I note that in response to the specific undertaking reproduced above, the Opponent indicated that: "*The affiant is unable to confirm any use of TATTOO in Canada in association with any particular goods or services, apart from the applicant.*"

[88] The Applicant asks the Registrar to draw negative inferences from these many refusals to answer and to consider that [TRANSLATION] "Mr. Bailey had knowledge of many third-party goods sold in Canada during the relevant period, the name or mark of which incorporates the term 'tattoo'".

Ms. Biggs' affidavit

[89] The goal of Ms. Biggs' affidavit is to respond to Mr. Michaud's affidavit, in particular, by filing excerpts from the record of the registration application for the TATTOOED BY INKY trade-mark submitted by Apra International LLC (Apra) to the *United States Patent & Trademark Office* (USPTO). These excerpts show that this application to the USPTO was discontinued by Apra following an opposition by the Opponent.

[90] The Applicant points out this evidence proves that the first use of the TATTOOED BY INKY mark dates back to July 1, 2009 and that, consequently, the Opponent had known of this perfume by a long time. Moreover, even if the TATTOOED BY INKY mark were not registered, it still remains in use, because Mr. Michaud was able to procure this perfume.

Ms. Côté-Laporte's affidavit

[91] The Applicant argues that, in a letter dated September 21, 2005, in response to an examination report, the Opponent held the following position:

The cited application and subject trade-mark both include the common element TATTOO. However, this word has been commonly registered in the name of different traders in different fields of interest. [...] The cited applicant's TATTOO GOO product is a cream merely used for tattoos. [...] In summary, given the co-existence of the common element TATTOO on the register, and the differences in their respective wares and areas of trade, there is no likelihood of confusion on the Register, or in the marketplace between the subject application and the cited application. [Underlining added by the Applicant].

[92] The Applicant argues that, by these remarks, the Opponent concedes that the word "TATTOO" is commonly used in all industries, but above all, more specifically, it specifies this word is commonly used in the cosmetics industry. Consequently, the Opponent's TATTOO trade-mark does not benefit from a high degree of distinctiveness. The Applicant submits that the Opponent is in a poor position to claim the contrary in the context of these proceedings and should be opposed by estoppel.

Conclusion – Additional Circumstances

[93] I find it is unnecessary to decide on the weight to grant to all these additional circumstances to conclude in favour of the Applicant in this case.

[94] This having been said, I will simply note that I have the state of the register evidence, to which reference is made in the response to the examination report refiled in Ms. Côté-Laporte's affidavit, and which dates back over 10 years. Moreover, even if I accepted to draw negative inferences from the Opponent's refusal to answer questions concerning its knowledge of the existence of third-party goods containing the word "TATTOO" in their trade names or trade-marks, I find this cannot allow me to go so far as to conclude that such goods exist on the Canadian market. At most, I would be prepared to recognize the existence of three products purchased by Mr. Michaud. In other words, I would not be prepared to conclude that the word "TATTOO" is widespread as a trade-mark component in association with perfumery products, in view of the evidence (or absence of evidence) in this case.

Conclusion – Likelihood of Confusion

[95] As indicated on page 163 in the *Dion Neckwear* case cited above, the registrar does not have to be convinced beyond all doubt that there is no likelihood of confusion. Indeed, "[t]he "beyond doubt" standard imposes an insurmountable burden because certainty in matters of likelihood of confusion is rare". [Also see *John Labatt Ltd v Molson Companies Ltd, supra*].

[96] Given my analysis above, I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent's TATTOO trade-mark would be unlikely to conclude that the Applicant's eaux de toilette originate from the same source or are otherwise related to or associated with the Opponent's goods.

[97] I find in effect that the differences existing between the parties' marks are determinant in themselves and more than sufficient to outweigh the factors favouring the Opponent in this case.

[98] Consequently, I reject the ground of opposition based on the non-registrability of the Mark.

Non-entitlement to Registration

[99] To discharge its initial burden regarding Section 16(3)(a) of the Act, the Opponent must prove that its TATTOO trade-mark had been used in Canada previous to the date of filing of this application, and had not been discontinued on the date of its announcement in the *Trade-marks Journal*, in this instance March 13, 2013 [Section 16(5) of the Act]. Contrary to the position taken by the Applicant, I find this initial burden has been satisfied in the case at bar. Although non-exhaustive and imperfect, the evidence of use of the TATTOO in Canada, introduced via Mr. Bailey's affidavit, is sufficient.

[100] The difference between the relevant dates really has no impact on my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act.

[101] Consequently, I reject the ground of opposition based on non-entitlement to registration pursuant to section 16(3)(a) of the Act.

Non-distinctiveness of the Mark

[102] To meet its initial burden of proof in regard to non-distinctiveness, the Opponent must show that its TATTOO trade-mark had become sufficiently known in Canada on the date of the statement of opposition, i.e. August 13, 2013, such as to deny the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)].

[103] Contrary to the position taken by the Applicant, I find this initial burden has been satisfied in the case at bar. Although non-exhaustive and imperfect, the evidence of use of the TATTOO in Canada, introduced via Mr. Bailey's affidavit, is sufficient. The TATTOO trade-mark does not need to become "*well-known*" in Canada. I find the sales of TATTOO perfumery products realized by the Opponent, although modest, are sufficient in this case.

[104] The difference between the relevant dates really has no impact on my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under Section 12(1)(d) of the Act.

[105] Accordingly, I reject the ground of opposition based on non-distinctiveness.

Decision

[106] In exercising the authority delegated to me pursuant to Section 63(3) of the Act, I reject the opposition in application of Section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS REGISTERED IN THE CASE**

DATE OF HEARING: 2016-11-15

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