

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

**Citation: 2015 TMOB 92**  
**Date of Decision: 2015-05-26**

**IN THE MATTER OF AN OPPOSITION by  
Phoenix Footwear Group, Inc. to application  
No. 1,298,372 for the trade-mark S (Design)  
in the name of Little Soles Inc.**

Introduction

[1] Phoenix Footwear Group, Inc. (the Opponent) opposes registration of the trade-mark S (Design) shown below (the Mark) that is the subject of application No. 1,298,372 by Little Soles Inc. (the Applicant).



[2] The application was filed on April 19, 2006 and is based on proposed use of the Mark in Canada in association with the goods "Children's, toddlers' and babies' footwear, namely, shoes,

sandals and boots” (the Goods), as revised by the Applicant during the examination of the application.

[3] The determinative issue in this proceeding is whether there is a likelihood of confusion under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) between the Mark and the Opponent’s trade-mark FOOT Design, (as shown below), which is registered under No. TMA620,409 for “Footwear, namely casual and dress shoes and sandals”:



[4] For the reasons explained below, the application is refused.

#### The record

[5] The statement of opposition was filed by the Opponent on February 3, 2012. By way of letter dated March 26, 2012, the Applicant requested an interlocutory ruling with respect to several of the Opponent’s grounds of opposition. By way of Office letter dated May 9, 2012, the Registrar granted in part the Applicant’s request and required the Opponent to file an amended statement of opposition reflecting the ruling made. By way of letter dated May 30, 2012, the Opponent filed an amended statement of opposition. The Applicant filed and served a counter statement on June 6, 2012 denying each of the grounds of opposition set out in the amended statement of opposition.

[6] As its evidence, the Opponent filed the affidavit of Alain Bédard, an archivist employed by the agents for the Opponent, sworn August 9, 2012 (the Bédard affidavit), as well as a certified copy of registration No. TMA620,409 for its FOOT Design trade-mark. The Bédard affidavit introduces into evidence a copy of a section 37(3) notice sent by the Registrar to the Opponent, advising of the forthcoming advertisement of the application for the Mark, as well as a copy of the file history of the Mark showing that the Opponent’s trade-mark FOOT Design was cited against the present application during examination.

[7] In support of its application, the Applicant filed the affidavit of its founder and designer, Jessica Jacobs, sworn November 5, 2013 (the Jacobs affidavit). The Jacobs affidavit provides general information on the Applicant's business and evidence of use of the Mark in Canada.

[8] None of the affiants were cross-examined.

[9] Only the Applicant filed a written argument. By way of letter dated April 9, 2014, the Opponent advised the Registrar that "in order to avoid any misunderstandings or surprises at the oral hearing, [it wished to] indicate that some of the allegations of this written argument are unsupported by the evidence or constitute an attempt to introduce evidence that is not of record." I will return to this point later.

[10] Both parties were represented at a hearing held on February 4, 2015. Prior to the hearing, by way of letter dated January 28, 2015, the Opponent further advised the Registrar that for the purpose of the hearing, it intended to rely solely on the non-registrability ground of opposition raised in paragraph 2.1 of the statement of opposition, which is based on section 12(1)(d) of the Act. Although the Opponent did not withdraw the other grounds, it conceded that there is not sufficient evidence to support them. In light of the position taken by the Opponent, I will only address the section 12(1)(d) ground in my decision and I am summarily dismissing the grounds of opposition based on conformity issues under section 30 of the Act, entitlement issues under section 16 of the Act, and distinctiveness issues under section 2 of the Act.

#### The parties' respective burden or onus

[11] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a 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)].

#### Analysis of the remaining ground of opposition

[12] As indicated above, the Opponent has pleaded that the Mark is not registrable having regard to section 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark

FOOT Design, which is registered under No. TMA620,409.

[13] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[14] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

#### The test for confusion

[15] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides 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 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.

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (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 have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (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 all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Consideration of the section 6(5) factors

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

[17] Both of the parties' trade-marks consist of a design, which in my view, would likely be viewed as being a footprint, particularly in the context of the associated goods. The Opponent's trade-mark is arguably slightly more obviously evocative of a footprint than the Mark due to its elongated shape, but overall, I consider it likely that both marks would simply be seen to be footprints. I therefore assess the inherent distinctiveness of the trade-marks at issue as about the same.

[18] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[19] There is no evidence that the Opponent's trade-mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent whatsoever in this country. The mere existence of registration No. TMA620,409 can establish no more than minimal use of the Opponent's trade-mark and cannot give rise to an inference of significant or continuing use [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

[20] By comparison, the Jacobs affidavit attests to the following facts:

- the Applicant was founded on December 22, 2005 [para 1];
- the Applicant adopted and commenced use of the Mark in association with the Goods since at least as early as March 2006. The Applicant commenced promoting and selling the Goods under the Mark to retailers in North America by attending trade shows where retailers were able to obtain information about the Applicant's Goods and place orders. As well, the Applicant sold its Goods through regional sales representatives that were contacted by retailers of children's toddlers' and babies' footwear and had become aware of the Applicant's Goods when displayed at these trade shows, or from word of mouth referrals, or from promotional material about the Applicant's Goods, or by way of its website [para 4];

- the Applicant has invested considerable resources, time and expertise in designing, promoting and selling the Goods [para 8]. Notably, no marketing figures are provided;
- the Applicant has sold the Goods bearing the Mark to over 450 specialty retailers and boutiques that sell children's, toddlers and babies' footwear in North America since at least as early as May 2006 to the time of swearing the affidavit;
- since at least as early as May 2006 to the time of swearing the affidavit, the Applicant has generated sales of approximately 1 million dollars selling the Goods under the Mark [para 11]. I note that no breakdown per country is provided.

[21] In support of her assertions of use of the Mark, Ms. Jacobs attaches the following exhibits to her affidavit:

- Exhibit C: a copy of the Applicant's sell sheets and catalogues, which display the Applicant's Goods bearing the Mark and which would be distributed at trade shows, or sent to retailers and customers of children's, toddlers' and babies' footwear upon request. Upon review of this exhibit, I note that none of the sell sheets and catalogues are dated. Also, there is no indication how many are typically distributed;
- Exhibit D: a copy of the WHOIS search results regarding the Applicant's domain name *www.littlesoles.ca* registered on May 3, 2006;
- Exhibit E: copies of excerpts printed from the Applicant's website on November 4, 2013. These excerpts include the Applicant's homepage, the story of the Applicant, the Applicant's news, a list of retailers of the Applicant's Goods, information about the Applicant's collections and orthotic solutions for toddlers and children, customer service contact information for customers and retailers of children's, toddlers' and babies' footwear and product information about the Applicant's products.

The excerpts include a province by province listing of the Applicant's customers, namely specialty retailers and boutiques that sell children's, toddlers' and babies'

footwear.

The excerpts also include references to the Applicant having been featured in print media, as well as on radio and television programs, and to awards received from parenting, family and pregnancy magazines, DisneyFamily.com and iParenting. However, it is not possible to determine to what extent the Mark has been expressly referred to in these appearances, features and awards.

The excerpts further include a copy of the section of the website where thank you notes written to the Applicant by Hollywood celebrities can be viewed. Again, it is not possible to determine to what extent the Mark has been expressly referred to in these thank you notes. There is also no indication how many Canadians visited the Applicant's website.

- Exhibit F: a sampling of the Applicant's monthly order processing summaries dated from October 2009 to July 2011, relating to the sale of the Goods bearing the Mark, as well as a sampling of invoices for sales of these products dated January 30 and February 5, 2013;
- Exhibits G and H: copies of photographs of the boxes and bags in which the Goods sold by the Applicant bearing the Mark are transferred to its customers. Upon review of these exhibits, I note that the Mark is prominently displayed on the lids of the boxes as well as on the bags;
- Exhibit I: copies of photographs showing the Goods bearing the Mark;
- Exhibit J: copies of undated promotional materials showing the Mark as applied to the Goods. There is no indication how many are typically distributed; and
- Exhibit K: a copy of a promotional item that was distributed by the Applicant at a Las Vegas trade show in 2009, which Ms. Jacobs represents was well attended by representatives from Canadian retailers of children's, toddlers' and babies' footwear. Ms. Jacobs explains that this promotional item provided a ballot for retailers to submit to win a prize at the Toronto Shoe Show & ABC Kids Expo Show, at which

the Applicant also promoted the Goods bearing the Mark in 2009.

[22] In the absence of sales figures relating specifically to Canada or more detailed information about promotional expenses or publicity in this country, I agree with the Opponent that it is difficult to determine the extent to which the Mark has become known in Canada in association with the Goods. That said, the fact remains that in view of the evidence furnished by the Applicant, I am able to conclude that the Mark has been used and become known to a greater extent in Canada than the Opponent's mark.

[23] Thus, the overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Applicant.

The length of time the trade-marks have been in use

[24] The Opponent's registration for its FOOT Design trade-mark claims that the mark has been used in Canada since at least as early as September 2000. However, as indicated above, in the absence of evidence supporting such date of first use, a claimed date of first use set forth in a registration cannot give rise to an inference of continuing use.

[25] By comparison, the Applicant's application is based on proposed use of the Mark and the Applicant has filed evidence attesting that use of the Mark in Canada commenced sometime around the spring of 2006 and has been continuous since then.

[26] Thus, this factor favours the Applicant.

The nature of the goods; and the nature of the trade

[27] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this



respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[28] As indicated above, the Applicant's application covers: "Children's, toddlers' and babies' footwear, namely, shoes, sandals and boots" whereas the Opponent's registration covers: "Footwear, namely casual and dress shoes and sandals".

[29] The Applicant submits that there are significant differences to consider in the nature of the parties' goods, and their respective channels of trade.

[30] Considering first the nature of the goods, the Applicant submits that as shown in the exhibits attached to the Jacobs affidavit, specifically the product information found on the Applicant's website, and in the images of the Applicant's Goods, the Applicant sells a highly unique product. The Applicant contends that its footwear is more stylish than the typical footwear that is available to children and infants. Another unique feature of the Applicant's footwear is that all of the materials used in the production are rigorously tested for toxins such as lead and formaldehyde.

[31] The Applicant submits that by contrast, the Opponent sells shoes for adults that are designed for comfort and support. The Applicant relies in this regard on its response dated July 14, 2011 filed with the Registrar during the examination of the present application, which was submitted as evidence by the Opponent as part of the file history attached to the Bédard affidavit. In that response, the Applicant had attached a copy of excerpts printed from the Opponent's website, located at *www.phoenixfootwear.com* for the examiner's review.

[32] Turning to the channels of trade, the Applicant submits that its footwear is sold in boutiques that feature modern, high-end trendy clothing and footwear for children and infants. As well, a consumer may purchase the Applicant's footwear from its website, which, the Applicant points out, clearly does not feature any products that are designed for adults.

[33] The Applicant submits that in its response to the examiner dated July 14, 2011, when it accessed the Opponent's website, it was unable to locate any stores in Canada that sold the Opponent's SOFT WALK shoes, which is the word mark that accompanies the FOOT Design

trade-mark on the Opponent's website. However, the Applicant concedes that it may be assumed that typically a consumer would purchase the Opponent's footwear from its website. Still, the Applicant submits that the Opponent's website features only adult comfort shoes.

[34] I disagree with the Applicant's position.

[35] As stressed by the Opponent, it is not necessary that the parties operate in the same general field or industry or that their respective goods be of the same type or quality for there to be a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur "whether or not the goods or services are of the same general class".

[36] As also stressed by the Opponent, there is a clear overlap between the parties' goods. They both consist of footwear. Furthermore, the Opponent's registration is not restricted to adult footwear.

[37] Likewise, there is a clear overlap between the parties' channels of trade. While the Applicant submits that its footwear is retailed only at boutiques that specialize in clothing and footwear for children and infants, there is no such restriction in the Applicant's statement of goods. In other words, nothing prevents the Applicant from selling its goods at the same locations or through similar channels of trade as those of the Opponent. This is particularly true in my view in the footwear industry where many companies make children and adult footwear under the same brands, and they are sold at the same locations.

[38] Furthermore, there is no reason to conclude that the parties' goods would not be directed to the same type of clientele. Although intended for children, toddlers and babies, the Applicant's footwear is to be purchased by the accompanying adult.

[39] To sum up, the overall consideration of the nature of the parties' goods and their corresponding trades favours the Opponent.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[40] The Applicant submits that there are significant differences in appearance and impression

conveyed by the parties' marks.

[41] The Applicant submits that the predominant impression that is immediately conveyed by the Mark is a fanciful depiction of the letter "S". It submits that any other observations would occur only after further contemplation. As well, the Applicant submits that the letter "S" appears to be underlined by a series of dots. It submits that in association with the Applicant's Goods, the "S" design conveys a connection to the word SOLES, which word the Applicant has adopted in its trade-name, as well as its family of marks LITTLE SOLES, LITTLE SOLES & Design (registration No. TMA800,322) and BABY SOLES (registration No. TMA775,055), all of which the Applicant claims to have used extensively in Canada in association with its products. I will return to that family of marks when assessing the additional surrounding circumstances.

[42] The Applicant submits that in direct contrast, visually a footprint is the only resemblance that the Opponent's trade-mark immediately bears. It submits that while the Opponent's trade-mark does appear stylized, the mark is aligned in such a manner as to easily convey the image of a footprint. In association with footwear, the style of the mark creates the impression of a comfortable, relaxed and natural fit. The Applicant submits that any other significance to the design would require further contemplation of the trade-mark.

[43] I disagree with the Applicant's position.

[44] As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[45] As is the case with the Opponent's trade-mark FOOT Design, the Mark is to be assessed in its entirety in the context of footwear. The Mark consists only of the S (Design) and not any additional matter. It is the Mark itself which must be considered when assessing the degree of resemblance, not the Mark and additional matter in connection with which it may or may not be used. That being so, I find that the Mark is more likely to be perceived as a stylised footprint,

rather than as the letter “S” underlined by a series of dots. Thus, both marks convey, as a matter of first impression, the idea of a footprint.

[46] As both marks consist of design marks, the degree of resemblance between them in sound is difficult to assess in that neither of them is likely to be sounded.

[47] The main difference between the parties’ marks is their positioning. The Mark stands vertical while the Opponent’s trade-mark FOOT Design is laying down horizontal. However, as stressed by the Opponent, when the Mark is turned sideways, as this might appear on a pair of shoes as expressly illustrated in some of the photographs under Exhibits C, I and J to the Jacobs affidavit (or when the Opponent’s FOOT Design trade-mark is turned down, as this might also appear on a pair of shoes), the degree of resemblance in appearance between the parties’ marks becomes greater [see by analogy *Levi Strauss & Co v Benetton Group SpA* 1997 CanLII 15757].

[48] To sum up, I find there is a very high degree of resemblance between the parties’ marks in appearance and in ideas suggested by them.

#### Additional surrounding circumstances

##### State of the register evidence

[49] The Applicant relies on the state of the register evidence that was referred to in its response dated July 14, 2011 filed with the Registrar during the examination of the present application, a copy of which is included in the file history attached to the Bédard affidavit.

[50] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[51] In the present case, the Applicant submits that the state of the register evidence shows that the image of a footprint is a commonly adopted component of trade-marks that are advertised, allowed or registered in association with goods related to footwear.

[52] More particularly, the Applicant refers me to a table listing two pending applications and ten registrations of trade-marks made up of the image of a footprint, which was included in its response to the examiner. This table is reproduced in its entirety in Schedule A to this decision.

[53] At the hearing, despite the objection raised in its above-mentioned letter dated April 9, 2014, the Opponent did not object to the state of the register evidence as having been improperly introduced into evidence. The Opponent only objected to the weight to be given to that evidence, taking the view that the number of pertinent trade-marks referred to by the Applicant was not significant enough and that none of them was as close to the Mark as the Opponent's. That being said, the fact remains in my view that this state of the register evidence is deficient in that it provides incomplete particulars of the trade-marks located. No copies of the applications and registrations in question are provided, leaving one to rely on the veracity of the Applicant's table regarding these third party applications and registrations. Furthermore, the table does not provide the complete statement of goods, there is no indication as to who the owners of the various marks are (it may be that a number of marks located are owned by the same entity), and there is no indication of the current status of the applications and registrations located (some may be abandoned or expunged) [see *Quebec Maple Products Inc v Stafford Foods Ltd* (1988) 20 CPR (3d) 404 (TMOB)]. The Registrar generally declines to exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications identified in a statement of opposition are extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[54] In view of the foregoing, I am not prepared to have regard to the state of the register evidence in this case. Even if I were to consider this evidence, it likely would not have impacted the outcome of my decision, as I note that none of the marks listed in Schedule A so nearly resembles the Opponent's FOOT Design mark as does the Mark.

Prior registration secured by the Applicant

[55] The Applicant submits that it is already the owner of the trade-mark LITTLE SOLES LOGO (shown below) registered under No. TMA800,322 in association with the following goods and services: “footwear, namely, shoes, sandals and boots; distributor services, namely, distributing footwear for others”, the particulars of which are attached as Exhibit L to the Jacobs affidavit:



[56] However, it is well established by the jurisprudence that although section 19 of the Act gives the owner of a registration the exclusive right to the use of that mark with respect to the goods and services covered by the registration, it does not necessarily follow that the registered owner is given an automatic right to obtain any further registrations no matter how closely related they may be to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB) at 115].

Foreign registrations for the Mark

[57] At the hearing, the Applicant submitted that it is the owner of a U.S. trade-mark registration as well as a Community trade-mark registration for the Mark. However, as conceded by the Applicant, none of these foreign registrations has been introduced into evidence in this case. Furthermore, there is also no evidence that the parties’ marks coexist on these foreign registers. In any event, the fact that the parties’ marks may coexist on foreign trade-marks registers is not binding upon the Registrar [see *Quantum Instruments Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB)].

Coexistence of the parties’ marks without confusion

[58] The Applicant submits that the parties’ marks have coexisted without confusion for a

period of eight years or so.

[59] In the *Dion Neckwear* case cited above, the Court commented as follows on the issue of coexistence:

[TRANSLATION] In regard to the insufficiency of elements of evidence presented by the opponent concerning concrete cases of confusion, the registrar was of the opinion that an opponent did not have to submit this type of evidence. This is true in theory, but when the applicant has presented certain elements of evidence that could make it possible to conclude in the absence of risk of confusion, the opponent runs a significant risk if, in relying on the burden of proof incumbent on the applicant, it presumes that it does not have to submit evidence on the subject of confusion. Although the issue that has to be resolved is that of knowing whether there exists “a risk of confusion” and not an “actual confusion,” or “concrete cases of confusion,” the absence of “actual confusion” is a factor to which the courts grant significance when ruling on the “risk of confusion.” A negative inference can be drawn when the evidence shows that the simultaneous use of two marks is significant and that the opponent has submitted no element of evidence tending to show the existence of a confusion. (See the decision *Pink Panther [Beauty Corp. v. United Artists Corp., [1998], 80 C.P.R. (3d) 247 (FCA)]*; *Multiplicant Inc. v. Petit Bateau Valton S.A. (1994), 55 C.P.R. (3d) 372 (C.F. 1st. inst.)*; *Bally Schuhfabriken AG/Bally’s Shoe Factories Ltd. v. Big Blue Jeans Ltd. (1992), 41 C.P.R. (3d) 205 (C.F. 1st. inst.)*; *Monsport Inc. v. Vêtements de Sport Bonnie (1978) Ltée (1988), 22 C.P.R. (3d) 356 (C.F. 1st. inst.)*).

[60] I note that the Jacobs affidavit is silent as to whether any actual instances of confusion would have been brought to the attention of the Applicant. In any event, since the evidence does not permit me to draw any meaningful conclusion as to the extent and the period of use of the Opponent’s trade-mark FOOT Design, I cannot draw any meaningful conclusion with respect to the absence of actual confusion. Indeed, in the absence of evidence showing that the parties’ goods did in fact coexist in the marketplace, the absence of evidence of actual confusion is not surprising.

#### Family of trade-marks

[61] As indicated above, the Applicant has made reference to its family of trade-marks LITTLE SOLES, LITTLE SOLES LOGO and BABY SOLES.

[62] However, there can be no presumption of the existence of a family of trade-marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family [see *Techniquip Ltd v*

*Canadian Olympic Assn* (1998), CanLII 7573 (FC); and *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[63] In the present case, the Opponent has evidenced use of the registered trade-mark LITTLE SOLES LOGO. It has not with respect to the trade-mark BABY SOLES. Furthermore, use of the word marks LITTLE SOLES and BABY SOLES is not relevant to the issue of use of a family of trade-marks made up of a “S” design identical to that of the Mark.

Conclusion regarding the likelihood of confusion

[64] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[65] The issue is whether an individual having an imperfect recollection of the Opponent’s trade-mark FOOT Design as associated with the Opponent’s registered goods, would, as a matter of first impression and imperfect recollection, conclude that the Applicant’s Goods share a common source. I find that such a consumer would come to such a conclusion.

[66] Indeed, in view of the overlap between the parties’ goods and trades, I am not satisfied that the Applicant has sufficiently distinguished its Mark from that of the Opponent. As indicated above, when the Mark is turned sideways, as it might appear on a pair of shoes as expressly illustrated in some of the exhibits attached to the Jacobs affidavit (or when the Opponent’s FOOT Design trade-mark is turned down, as it might also appear on a pair of shoes), the degree of resemblance in appearance between the parties’ marks becomes greater. I find that the overall consideration of the section 6(5)(a) and (b) factors and additional surrounding circumstances discussed above is not sufficient to outweigh my finding made above under the section 6(5)(c), (d) and (e) factors.

[67] Accordingly, the section 12(1)(d) ground of opposition succeeds.












Disposition




[68] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

---

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

Schedule A

<u>Trademark</u>	<u>App/Reg. No</u>	<u>Summary of relevant wares</u>
	1,392,510	Footwear
<u>Trademark</u>	<u>App/Reg. No</u>	<u>Summary of relevant wares</u>
	1,461,324	Footwear
	TMA719,262	Footwear
	TMA554,056	Footwear
	TMA457,799	Shoe insoles
	TMA400,224	Footwear
	TMA614,715	Footwear
	TMA799,157	Footwear
	TMA514,014	Shoes

<u>Trademark</u>	<u>App/Reg. No</u>	<u>Summary of relevant wares</u>
 <p>The trademark consists of the word "spa" in a lowercase, sans-serif font, followed by "soles" in a smaller, lowercase, sans-serif font. To the right of "soles" are three small, dark, teardrop-shaped marks arranged in a slight curve.</p>	TMA780,094	Shoes
 <p>The trademark features a stylized, hand-drawn illustration of a foot with the word "alt" written across the arch and "bequien" written along the side. To the right of the foot are five small, dark, teardrop-shaped marks arranged in a vertical line.</p>	TMA562,423	Footwear
 <p>The trademark is a grayscale, textured footprint, showing the distinct patterns of the forefoot, midfoot, and heel.</p>	TMA763,087	Footwear