



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

Citation: 2012 TMOB 7
Date of Decision: 2012-01-18

**IN THE MATTER OF AN OPPOSITION
by Stella Cadente S.A.R.L. to application
No. 1,308,568 for the trade-mark MISS
ME in the name of Sweet People Apparel,
Inc.**

[1] On June 27, 2006, Sweet People Apparel, Inc. (the Applicant) filed an application to register the trade-mark MISS ME (the Mark). The application was filed on the basis of use in Canada by the Applicant's predecessor-in-title Stella Cho since at least 2001 in association with:

Clothing for women and girls, namely, jeans, pants, shorts, jackets, vests, skirts, dresses, T-shirts, blouses, camisoles, cardigans, sweaters, and belts (the Wares).

The right to the exclusive use of the word MISS has been disclaimed apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 10, 2007.

[3] On March 12, 2007, Stella Cadente S.A.R.L. (the Opponent) filed a statement of opposition pleading the following grounds:

- (a) The Opponent bases its opposition on the ground set forth in Section 38(2)(a) [of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act)], namely that the application does not comply with the requirements of Section 30 because the Applicant's trade-mark has not been used in the normal course of trade in Canada in association with all the wares identified in the application no. 1,308,568 since the alleged date of first use namely, 2001, or at all.

- (b) The Opponent further bases its opposition on the ground set forth in Section 38(2)(a) namely that the application does not comply with the requirements of Section 30 in that the Applicant did not either itself or through a licensee use the trade-mark in the normal course of trade in Canada in association with all the wares identified in the application no. 1,308,568 since the alleged date of first use namely 2001, or at all.
- (c) The Opponent further bases its opposition on the ground set forth in Section 38(2)(a) namely that the application does not comply with the requirements of Section 30 in that Stella Cho is not the Applicant's predecessor-in-title.
- (d) In view of the allegations in paragraphs (a), (b) and (c), the Opponent also bases its opposition on the ground set forth in Section 38(2)(d) of the Act, namely that the trade-mark claimed in application no. 1,308,568 is not distinctive of the Applicant's products identified in the application.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of Zeina Waked and a certified copy of the incorporation documents of 9160-5519 Quebec Inc. In support of its application, the Applicant filed an affidavit of Eric Choi and certified copies of registration Nos. TMA687,210; TMA687,211 and TMA687,323. No cross-examinations were conducted.

[6] Only the Applicant filed a written argument. A hearing was not held.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc.*

v. Stargate Connections Inc. (2004), 34 C.P.R. (4th) 317 (F.C.).

Section 30(b) Grounds of Opposition

[9] The Opponent's first three grounds of opposition each appear to allege a contravention of s. 30(b) of the Act. I will begin by addressing the first and third grounds of opposition.

First Ground of Opposition: No Use of the Mark Since Date Alleged

[10] The first ground of opposition alleges that the Mark has not been in use since 2001, the date claimed in the application.

[11] The Opponent filed an affidavit of Zeina Waked, a paralegal employed by its trade-mark agent. Ms. Waked attaches a press release dated fall 2007 for the MISS ME brand (Exhibit ZW-1) which:

- states that in fall, 2005 Miss Me “goes international with the signing of distributor agreements in Canada...”; and
- identifies the Canadian distributor as 9160-5519 Quebec Inc. (“9160-5519 Quebec”).

While the press release is hearsay, it satisfies the requirements of necessity and reliability and is admissible. It was necessary for the affiant to obtain evidence of the use of the MISS ME brand and it is reliable as the evidence of the Applicant addresses information in it [*Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. The Opponent also filed a certified copy of the incorporation documents for 9160-5519 Quebec confirming this entity was incorporated on September 9, 2005. The Opponent's evidence that MISS ME signed up a Canadian distributor in 2005 raises a question about the accuracy of the claimed date of first use in Canada and is sufficient to meet the Opponent's light initial burden [*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89].

[12] The Applicant filed an affidavit of its President, Eric Choi, who attests that the Applicant and its predecessors-in-title sold MISS ME marked clothing and clothing accessories for women and girls directly to Canadian retailers from 2001 until 2006 when the Applicant granted Canadian distribution rights to 9160-5519 (para. 14). Mr. Choi states that \$137,000 USD of

MISS ME clothing was sold to Canadian retailers in 2001 (para. 18). Mr. Choi provides samples of labels, hang tags and invoices supporting use of the Mark in Canada from 2001 through 2008 by Miss Me (Exhibits EC-2 and EC-8). The invoices specifically reference the following types of clothing: jeans, pants, skirts, dresses, cardigans and sweaters. I note that if the Opponent perceived any ambiguities in Mr. Choi's evidence with respect to the use of the Mark in association with each of the Wares it could have cross-examined him.

[13] In his affidavit, Mr. Choi attests that Stella Cho launched the Mark and clothing line in 2001 (para. 5) and sets out the chain of title of the Mark. Specifically, Mr. Choi provides a copy of the fictitious business name statement issued to Stella Cho which references use of MISS ME as a business name in California as of January 22, 2001 and an assignment of this business name and the Mark to Bright Future Apparel, Inc. dated July 16, 2001 (Exhibit EC-1). Mr. Choi further attaches a copy of the assignment of this business name and the Mark from Bright Future Apparel Inc. to the Applicant on December 28, 2003 (Exhibit EC-1). Also attached are the fictitious business name statements for MISS ME in the name of Bright Future Apparel, Inc. and Sweet Pea Apparel, Inc. (Exhibit EC-1). Neither of these assignments is limited to a particular jurisdiction.

[14] The Applicant's evidence is sufficient to meet the legal burden on it to demonstrate that the Mark has been in use since 2001 in association with the Wares in Canada. Accordingly, this ground of opposition is dismissed.

Third Ground of Opposition: Stella Cho is not the Predecessor-in-Title of the Applicant

[15] The third ground of opposition alleges that the application does not comply with s. 30 of the Act as Stella Cho is not the Applicant's predecessor-in-title.

[16] As pleaded this ground of opposition cannot support refusal of the application since Stella Cho is a predecessor of the Applicant. It does not matter that the application was assigned to Bright Future Apparel Inc. prior to being assigned to the Applicant as the term predecessor simply means "one who precedes another in an office or position" [*Black's Law Dictionary*, 9th ed. (2009)] and Stella Cho preceded the Applicant as owner of the Mark.

Second Ground of Opposition: Applicant did not use the Mark

[17] The second ground of opposition differs from the first only in that the Opponent has alleged that it is the Applicant who has not used the Mark since 2001. The application names Stella Cho as a predecessor-in-title and the evidence of the Applicant supports that Ms. Cho used the Mark in Canada in 2001.

[18] The Federal Court has directed that an opposition is to be assessed in view of the grounds of opposition as pleaded. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded. In paras. 27- 29 of the *Massif Inc. v. Station Touristique Massif du Sud (1993) Inc.* (2011), 95 C.P.R. (4th) 249 (F.C.) decision, the Federal Court explains:

It is settled law that the Board is not authorized to allow an opposition on the basis of a ground that has not been raised by the opposing party. In *Imperial Developments Ltd. v. Imperial Oil Ltd.*, 26 A.C.W.S. (2d) 155, 79 C.P.R. (2d) 12 (Justice Muldoon), the Court stated that an organization such as the Registrar of Trade-Marks is a creature of statute and that it has no inherent or extrinsic jurisdiction in its constituting legislation. The Court also stated that the Registrar called on to dispose of an opposition could not base its decision on a ground that had not been stated in the statement of opposition.

More recently, in *Procter & Gamble Inc. v. Colgate-Palmolive Canada Inc.*, 2010 FC 231, 364 F.T.R. 288, at paragraph 26, 81 C.P.R. (4th) 343, Justice Boivin also adopted this jurisprudential principle:

... The Respondent submits it is settled law that there is no jurisdiction to deal with an issue not found in a Statement of Opposition and this Court does not have jurisdiction to entertain issues that were not raised before the Board (*McDonald's Corp. v. Coffee Hut Stores Ltd.*, (1994), 76 F.T.R. 281, 55 C.P.R. (3d) 463, aff'd (1996) 199 N.R. 106, 68 C.P.R. (3d) 168 (F.C.A.)). I agree with the Respondent....

I agree with these principles. In this case, even if the Board refused the application for registration on the basis of a failure to meet the requirements of paragraph 30(b) of the Act and the respondent's opposition had also been based on the failure to respect this paragraph, the respondent's opposition referred to a "failure" that is different from that on which the Board based its decision.

[19] This ground of opposition is dismissed as Stella Cho is named as a predecessor-in-title and the evidence of the Applicant supports that Ms. Cho used the Mark in Canada in 2001. As

such it matters not that the Applicant did not use the Mark in 2001. If the Opponent had pleaded that the application was in breach of s. 30(b) because it did not name each of the Applicant's predecessors-in-title, I would have found in its favour as the Applicant had not named Bright Future Apparel Inc. in its application [R.W.S. *Hoists & Cranes Inc. v. Richards-Wilcox Canada Inc.* (2004), 41 C.P.R. (4th) 258 at 265; *Ritz Hotel Ltd. v. Shen Manufacturing Co.* (1992), 47 C.P.R. (3d) 106 (T.M.O.B.) at 112]. I note that nothing would have prevented the Opponent from requesting leave to amend its statement of opposition after being served with the Applicant's evidence detailing the chain of title.

Section 2 Ground of Opposition

[20] The Opponent has also pleaded that the Mark is not distinctive due to the facts alleged with respect to the s. 30(b) grounds of opposition. Neither the Opponent's, nor the Applicant's evidence supports this ground of opposition. The evidence filed by the parties does not support the Opponent's allegation that any entity, other than the Applicant, was using the Mark as of the relevant date, March 12, 2007, the filing date of the statement of opposition. Furthermore, there is no evidence of those other than the Applicant and/or its predecessors-in-title using the Mark. Therefore, the Opponent has failed to meet its evidentiary burden for this ground of opposition. Accordingly, this ground of opposition is dismissed.

Disposition

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

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