



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

Citation: 2015 TMOB 23
Date of Decision: 2015-01-30

**IN THE MATTER OF AN OPPOSITION
by Marc and Michele Bohbot, carrying on
business in partnership and Fashion
Brands Holding Corporation to
application No. 1,295,515 for the trade-
mark BIZOUX BIZOUX & Design in the
name of 1655453 Ontario Inc. dba
BIZOUX BIZOUX**

Introduction

[1] Marc and Michele Bohbot, carrying on business in partnership and Fashion Brands Holding Corporation (the Opponent) oppose the registration of the trade-mark BIZOUX BIZOUX & Design shown below (the Mark), which is the subject of application No. 1,295,515.



The application was filed by 1655453 Ontario Inc. dba BIZOUX BIZOUX (the Applicant) on March 21, 2006, and is based upon use since 2005 in association with the following goods, as revised: Wash cloths, blankets, quilts, bunting bags, towels, pillows.

[2] The application has been opposed primarily on the basis that there is a reasonable likelihood of confusion between the Mark and the Opponent's previous use of its mark BISOU-BISOU, registration No. TMA503,518 in association with various clothing articles.. The Opponent also alleges under section 30(b) of the *Trade-Marks Act*, RSC 1985 c. T-13 (the Act) that the Applicant has not used the Mark since the date claimed.

[3] For the reasons that follow, I reject the opposition.

The Record

[4] The Mark is described in the application as a two-dimensional label containing only the words and design elements shown in the drawing. Colour is also claimed as a feature of the mark and is described as follows:

In compliance with Section 28(1) of the Regulations, the colour is described as follows :
Background : The background is a grid comprised of 16 equally sized boxes with alternating colours arranged in a linear format such that the first linear array of boxes alternates between yellow and green; and whereas the second linear array of boxes alternate between pink and blue; and whereas the third and fourth linear arrays contain the same colour scheme as the first and second linear array, respectively, however in a reciprocal format within each linear array. Lettering and Other Design Elements: The first and third linear arrays contain the word BIZOUX in blue lettering using the Comic Sans MS font. The second and fourth linear arrays contain objects representing a cruciform structure (cruciform) and a representation of a stylized heart figure (heart) in alternating sequence such that in the second linear array the cruciforms are blue and the hearts are pink and in the fourth linear array the cruciforms are pink and the hearts are blue.

[5] The application for the Mark was advertised on November 16, 2011. The Opponent filed a statement of opposition on April 16, 2012, based on the following grounds of opposition set out under section 38 of the Act: non-compliance with section 30(b), non-registrability under section 12(1)(d), non-entitlement under section 16(1) and non-distinctiveness under section 38(2)(d) and section 2. As noted above, the Opponent relies on its previous use of its BISOU-BISOU trade-mark, registration No. TMA503,518. The Applicant filed and served a counter statement.

[6] On June 12, 2012, the Applicant filed the affidavit of Martine Guay. As this evidence was filed prematurely, it was not made of record (see Board letter dated September 10, 2012).

[7] In support of its opposition, the Opponent filed the affidavits of Lee Ewing, Marc Bahbot, Jason B. Dinelle and a certified copy of registration No. TMA503,518. None of the Opponent's affiants were cross-examined.

[8] As its evidence, the Applicant filed various materials entitled "Counter Statement to Opposition". I will rule on the admissibility of this evidence below.

[9] Neither party filed a written argument. A hearing was not held.

Preliminary Issues

Admissibility of Applicant's evidence

[10] The materials filed by the Applicant as its evidence may be described as follows. Pages 1-7 of the Applicant's document are entitled "Counter Statement to Opposition" and consist of written arguments from the Applicant regarding the Opponent's evidence filed on January 14, 2013. This "Counter Statement to Opposition" is then followed directly by a page signed by Ms. Martine Guay and a commissioner of oaths. The final page of the Applicant's document prior to the Exhibits is entitled "Affidavit". While this document does make reference to the affiant "making oath", this page is not signed nor commissioned. It describes the contents of the exhibits that are attached (all of which have been dated and commissioned).

[11] From my review of the materials filed in their entirety, I am prepared to infer that the page which was signed by Ms. Guay and commissioned by a notary public was intended to follow the page entitled "Affidavit" as opposed to succeed it. The page entitled "Affidavit" shows that Ms. Guay was making oath and, as owner of the Applicant, had knowledge of the matters set out in it. The exhibits that were described in the body of the "Affidavit" are also correctly identified and properly commissioned. I am therefore satisfied that the page entitled "Affidavit" whereby Ms. Guay identifies herself and states that she is making an oath, the page containing the signatures of Ms. Guay and her notary public, and the exhibits attached as Exhibits A through I are admissible and together comprise the affidavit of Ms. Guay.

[12] I am not satisfied, however, that the document entitled “Counter Statement to Opposition” is proper evidence. There is no indication that it is the sworn testimony of any particular person as is required by the *Canada Evidence Act*, RSC 1985, c C-5. This document is therefore inadmissible and has not been made of record.

Section 45 Proceedings

[13] At the request of the Applicant, the Registrar of Trade-marks issued a notice under section 45 of the Act on August 8, 2012 to the Opponent regarding its registration No. TMA503,518 for the trade-mark BISOU-BISOU. On October 29, 2014, the Registrar (acting through Hearing Officer Bene) issued a decision deleting all of the goods of the Opponent’s registration with the exception of pants [*655453 Ontario Inc. dba Bizoux Bizoux v Fashion Brand Holdings Corporation* 2014 TMOB 231]. The amended statement of goods for registration No. TMA503,518 therefore now reads “Clothing, namely, pants”.

Onus and Material Dates

[14] The Opponent bears an evidentiary burden to show that the grounds of opposition are supported before the Applicant’s legal onus to prove its claim for a trade-mark is engaged [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)]. Although this evidentiary burden is light, the Opponent must still present sufficient evidence from which it can reasonably be concluded that the facts alleged to support a ground of opposition exist [*Cyprus (Commerce and Industry) v International Cheese Council of Canada*, 2011 FCA 201 at para 26, 93 CPR (4th) 255, citing *Labatt*, at para 13].

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

- Section 38(2)(a)/Section 30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];

- Section 38(2)(c)/Section 16(1)(a) – the Applicant’s date of first use;
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Analysis of Grounds of Opposition

Non-compliance – Section 30(b)

[16] The Opponent’s initial evidential burden under section 30(b) can be met by reference not only to the Opponent’s evidence but also to the Applicant’s evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230]. However, while the Opponent may rely upon the Applicant’s evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant’s evidence is clearly inconsistent with the Applicant’s claim as set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), affirmed 11 CPR (4th) 489 (FCTD)]. If the Opponent shows a clear discrepancy in the evidence regarding the Applicant’s claimed date of first use, then the onus would be on the Applicant to positively support the dates it has claimed.

[17] In the present case, the Opponent did not file any supporting evidence or make any submissions with respect to this ground of opposition. This ground of opposition can therefore be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof.

Non-entitlement – Section 16(1)(a)

[18] The Opponent’s section 16(1)(a) ground of opposition is pleaded as follows:

Pursuant to paragraph 38(2)(c) of the Trade-marks Act, the applicant is not the person entitled to registration of the trade-mark in view of paragraph 16(1) of the Trade-marks Act since at the alleged date of first use it was confusing with the opponent’s trade-marks BISOU-BISOU and BISOU BISOU which were previously used in Canada by Marc and Michele Bohbot, carrying on business in partnership.

[19] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the alleged date of first use of the Mark in Canada, either of the Opponent's trade-marks had been previously used and had not been abandoned as of the date of advertisement of the Applicant's application in the *Trade-marks Journal*, that is November 16, 2011 [section 16(5) of the Act]. In order to determine if the Opponent has met this burden, I will now review the relevant parts of the Opponent's evidence.

[20] Mr. Bohbot identifies himself as the Chief Executive Officer of the Opponent. He is also the owner and controlling principal of the related company Vintage Brand, which manufactures and distributes clothing, footwear and fashion accessories under license from the Opponent.

[21] Mr. Bohbot attests that the Opponent's trade-mark has been sold in association with clothing in Canada since at least as early as 1990, and that such clothing bore the trade-mark in the form of labels and hang tags affixed at the time of purchase. Attached as Exhibit A to his affidavit is a copy of a representative label displaying the trade-mark. Mr. Bohbot further states that since 1992 the Opponent and its predecessor-in-title have sold BISOU-BISOU clothing in Canada via the retail store Winners. Attached as Exhibit B to his affidavit are representative invoices, all from 2012, for the sale of BISOU-BISOU jeans from the Owner's distributor and licensee, Vintage Brand, to Winners in Canada.

[22] Mr. Bohbot further states that from 2003 – 2011, J.C. Penney Corporation, Inc. (J.C. Penney) manufactured and sold BISOU-BISOU clothing in Canada, under license from the Opponent and its predecessors. Under the terms of the license, the Opponent provided the clothing designs and fashion direction to J.C. Penney. The Opponent also maintained direct and indirect control over the character and quality of the clothing manufactured and sold by J.C. Penney which bore the trade-mark BISOU-BISOU. The quantity of sales of BISOU-BISOU clothing in Canada by J.C. Penney is discussed in Mr. Ewing's affidavit, which I will review below.

[23] Mr. Ewing identifies himself as a supply chain specialist at J.C. Penney Corporation Inc. He asserts that J.C. Penney has sold BISOU-BISOU clothing (including jackets, pants, shirts, dresses, t-shirts, skirts, suits, swimwear, handbags, hats, shoes and belts) to Canadians via the J.C. Penney website from 2003-2011. Attached as Exhibit 2 to his affidavit are printouts from the J.C. Penney website showing representative examples of information about BISOU-BISOU clothing which he states was available for purchase by Canadians from 2003-2011. As Exhibit 3 he provides a spreadsheet summarizing the catalog and online sales of BISOU-BISOU clothing sold to customers in Canada by J.C. Penney from 2003-2010. The spreadsheet consists of over 20 pages showing aggregate sales of various items between 2003 and 2010, line by line. While some of the items show a code identifying them as a BISOU-BISOU item, Mr. Ewing fails to identify the particular good that each sale represents. Further, there is no other information that would allow me to connect any of the sales data with the clothing as shown in the webpages attached as Exhibit 2 to his affidavit or any of the clothing items referred to in Mr. Bohbot's affidavit.

[24] Despite the affiants' assertions with respect to a variety of clothing, footwear and accessories, the Opponent has not provided any clear evidence of sales or transfers of the Opponent's clothing to constitute use pursuant to section 4(1) of the Act prior to the material date of 2005. As a result, I dismiss the ground of opposition based on section 16(1)(a) of the Act on the basis that the Opponent has failed to evidence use of the pleaded trade-marks prior to the Applicant's claimed date of first use.

Non-registrability- Section 12(1)(d)

[25] The Opponent also pleads that the Mark is not registrable because it is confusing with its BISOU-BISOU trade-mark. I have exercised my discretion and confirm that the Opponent's registration No. TMA503,518 is in good standing, but only with respect to the goods "clothing, namely pants".

[26] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

test for confusion

[27] Pursuant to section 6(2) of the Act, "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 wares or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the wares or services . . . are of the same general class". Thus, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the present case, the question posed by section 6(2) is whether there would be confusion of the goods provided by the Applicant under its mark BIZOUX BIZOUX & Design as being manufactured, licensed or endorsed by the Opponent who is the owner of the registered mark BISOU-BISOU.

[28] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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.

[29] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [*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)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[30] The word BISOU (or its phonetic equivalent BIZOUX) is the French word for kiss or kisses. While both parties' marks are inherently strong with respect to their associated goods, I consider the Mark to possess a slightly higher degree of inherent distinctiveness than the Opponent's mark because of its colour claim and design component.

[31] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The extent to which each trade-mark has become known is referred to as the acquired distinctiveness of a trade-mark.

[32] In view of the later material date for this ground, I am satisfied from the Opponent's evidence reviewed above that the Opponent has shown use of its mark in Canada in association with jeans since at least as early as 2012.

[33] With respect to advertising, Mr. Bohbot states that the Opponent's clothing is advertised on the website *www.bisoubisou.com* which has had in excess of 7,000 visits from Canadian IP addresses since 2003 (Bohbot, paras. 7 and 8). Attached as Exhibit C to his affidavit are printouts from the website advertising the Opponent's clothing sold in association with its mark. In addition, he states that from 2003-2011, the Opponent's clothing has been advertised and sold to Canadians via the J.C. Penney website at *www.jcpenney.com*. While he attaches representative printouts from the website advertising the Opponent's clothing, he does not provide the number of visits to such website by Canadians.

[34] With respect to the Mark, Ms. Guay identifies herself as the President of the Applicant. She asserts that the Applicant has used all of the applied for goods since at least as early as May, 2005. Attached as Exhibit C to her affidavit dated April 18, 2013 are copies of invoices for the applied for goods sold in Canada between 2005 and 2012. Photographs from the Applicant's website of wash cloths, blankets, quilts, bunting bags, towels and pillows offered for sale in association with the Mark are attached to her affidavit as Exhibit E. Attached as Exhibit F to her affidavit are what she identifies as "representative BIZOUX BIZOUX client's stores and web-

stores featuring/promoting the BIZOUX BIZOUX line of goods.” She notes that each of these stores/clients is individually owned.

[35] In view of the evidence furnished, I conclude that both parties’ marks have become known to some extent in Canada. I do find, however, that the overall consideration of this factor favours the Applicant.

section 6(5)(b) - the length of time each trade-mark has been in use

[36] Although the Opponent has claimed to have used its trade-mark in Canada for a longer period of time than the Applicant, the evidence furnished does not support this assertion. From the evidence furnished I find that this factor favours the Applicant.

sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade

[37] It is the Applicant’s statement of goods as defined in its application versus the Opponent’s registered goods that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd.* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[38] As noted, I did not have the benefit of written arguments from either party in this proceeding. From the evidence furnished, it is clear that the Applicant’s goods are infant care products. Specifically, they are comprised of accessories related to bathing, sleeping and eating. The Opponent’s goods, as revised by the section 45 decision, are clothing, namely pants. The goods are therefore different.

[39] With respect to the parties’ channels of trade, the Applicant’s evidence shows that since 2005 the Applicant has sold its goods both on-line and through distributors who in turn sell to specialized retail boutique stores which cater to members of the public interested in acquiring gift products and infant apparel. The Opponent’s goods, on the other hand, are sold through large discount retail stores like Winners, and on-line through J.C. Penney, a large department store in the U.S.

[40] In considering this issue, I had regard to the following comments made recently by the Federal Court in the decision *Jacques Vert Group Limited v YM Inc* 2014 FC 1242:

The fact that the goods sold by each party are sold in different types of stores and marketed to a different type of customer is a significant factor (see: *Mattel* at para 86), since a consumer who is familiar with clothing sold in an “URBAN PLANET” store would not likely be confused by more expensive articles of clothing sold in a “PLANET” boutique in a Bay department store. Moreover, there is no evidence that these channels of trade are likely to mix at any time in the near future. As the Federal Court of Appeal observed in *Alticor Inc v Nutravite Pharmaceuticals Inc*, 2005 FCA 269 at para 37, 257 DLR (4th) 60:

It has been held that assessing the future sales operations of a company should not include speculation about possible new ventures. (See *Joseph E. Seagram & Sons Ltd. v. Registrar of Trade Marks* (1990), 33 C.P.R. (3d) 454, at p. 46, (F.C.T.D.); *Cochrane-Dunlop Hardware Ltd. v. Capital Diversified Industries Ltd.* (1976), 30 C.P.R. (2d), 176 at p. 188 (Ont. C.A.). The actual channels of trade are a preferable basis of projections as to the future likelihood of confusion. [Emphasis added]

I am mindful that the present or actual use of a mark should not be considered to the exclusion of potential future uses within a registration. After all, “what is at issue is what the registration would authorize the [applicant] to do, not what the [applicant] happens to be doing at the moment” (*Mattel* at para 53; *Masterpiece* at para 53). There is no guarantee that “PLANET” goods will always be sold exclusively or only in boutiques in the Bay or that the Respondent will always sell inexpensive goods in its “URBAN PLANET” stores. However, there is no evidence before the Court to suggest that the existing channels of trade will change and, hence, this fact supports the Applicant’s application.

[41] Applying this reasoning to the present case, the fact that the goods sold by each party are sold in different types of stores and marketed to a different type of customer is a significant factor. In this regard, a consumer who is familiar with adult clothing sold in a J.C. Penney Department store would not likely be confused by baby accessories sold in a gift boutique. Moreover, while I am also mindful that the present or actual use of a mark should not be considered to the exclusion of potential future uses within a registration, there is no evidence that the parties’ channels of trade are likely to mix at any time in the near future.

section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[42] In assessing the degree of resemblance between the parties' marks they must not be dissected and must be considered as a whole and as a matter of first impression by the average person [see *Masterpiece, supra*].

[43] The marks are identical when sounded. However, in view of the unique design and colour claim of the Mark, its unique spelling and the hyphen which appears between the two words of the Opponent's mark, the Mark is different from the Opponent's mark in appearance. While the ideas suggested by the marks are similar to the average bilingual consumer in that both marks suggest kisses, the pastel colour claim and design of the Mark suggests baby kisses while the Opponent's mark suggests kisses in general. I therefore only find there to be some degree of resemblance between the marks when considered as a whole.

conclusion

[44] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees BIZOUX BIZOUX & Design on the Applicant's wash cloths, blankets, quilts, bunting bags, towels and pillows at a time when he or she has no more than an imperfect recollection of the Opponent's BISOU-BISOU trade-mark used in association with pants, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*]. In view of my findings above, and in particular the differences between the parties' goods and channels of trade, it seems to me that such a consumer would not, as a matter of first impression, be likely to believe that the goods associated with BISOU-BISOU and BIZOUX BIZOUX & Design were manufactured, licensed or performed by the Opponent. While the marks may be identical phonetically, I find that when the parties' marks are considered as a whole, in association with different goods and channels of trade, this shifts the balance of probabilities in favour of the Applicant. I therefore reject the section 12(1)(d) ground of opposition.

Non-distinctive – Section 38(2)(d) and section 2

[45] With respect to the non-distinctiveness ground, it is arguable whether the Opponent has in fact met its evidential burden of showing that its mark, by the filing date of the statement of opposition, had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the Mark [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Even assuming the Opponent's evidential burden had been met, in my view, the differences in material dates would not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are not likely to be confused would have also applied to this ground of opposition which would not have succeeded in any event.

Disposition

[46] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office