



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

Citation: 2012 TMOB 265
Date of Decision: 2012-12-11

**IN THE MATTER OF AN OPPOSITION
by Gilmar S.p.A. to application
No. 1,401,742 for the trade-mark
ICEBREAKER REALFLEECE in the
name of Icebreaker Limited**

[1] On July 2, 2008, Icebreaker Limited (the Applicant), filed an application for the trade-mark ICEBREAKER REALFLEECE (the Mark) for use in association with the following wares as amended (the Wares):

- (1) Fabrics, all being made wholly of real woollen fleece.
- (2) Clothing, namely men's underwear, namely boxers, briefs, singlets, short and long sleeve undershirts, leggings, base layers; women's underwear, namely camisoles, boy shorts, bikini briefs, long sleeve tops, hipster briefs, leggings, base layers; shirts (collared, long sleeved and short sleeved), sweaters, hooded tops, tank tops, athletic tops; skirts, dresses; trousers, travel pants, shorts; outdoors coats and jackets; children's tops; accessories, namely gloves, scarves, balaclavas
- (3) Headgear, namely hats, beanies, caps, ski hats
- (4) Footwear, namely socks.

The application has a priority filing date of June 17, 2008 and is based on the Applicant's proposed use of the Mark in Canada and use and registration of the Mark abroad.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 16, 2009.

[3] On November 10, 2009, Gilmar S.p.A. (the Opponent) filed a statement of opposition. The grounds of opposition, as amended November 8, 2010, are the following:

- (a) contrary to section 38(2)(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant never intended to use the Mark in Canada as the Applicant's knowledge of the marketplace and its own marketing plans were such that it knew that use of the Mark in Canada would never be commenced;
- (b) contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares given the Opponent's use and registration of the trade-mark ICEBERG and its use and application for the trade-mark ICE ICEBERG Design;
- (c) the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with registration No. TMA345,589 for ICEBERG owned by the Opponent;
- (d) the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(a) and 16(3)(a) of the Act since at the date of filing and priority filing date the Mark was confusing with the Opponent's trade-marks ICEBERG and ICE ICEBERG Design;
- (e) the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(b) and 16(3)(b) of the Act since at the date of filing and priority filing date the Mark was confusing with application No. 1,358,600 for ICE ICEBERG Design; and
- (f) the Mark is not distinctive of the Applicant.

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

[5] The Opponent's evidence consists of the affidavit of Massimo Marani. The Applicant's evidence consists of certified copies of 27 trade-mark applications and registrations including the component ICE.

[6] The Opponent filed a written argument. A hearing was conducted on August 9, 2012 at which both parties were represented.

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. There is however an initial 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/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) at 424];
- sections 38(2)(c)/16(2) and 16(3) - the filing date of the application; and
- sections 38(2)(d)/ 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition

Section 30 Grounds of Opposition

[9] The Opponent has pleaded that the application is contrary to sections 30(e) and 30(i) of the Act.

[10] There is no evidence that supports the ground of opposition based on section 30(e) of the Act that the Applicant does not intend to use the Mark. Consequently, this ground is dismissed on the basis that the Opponent has not satisfied its initial burden.

[11] The section 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the trade-mark in Canada in association with the Wares because the Applicant had knowledge of the Opponent and its trade-marks. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Section 12(1)(d) Ground

[12] I have exercised the Registrar’s discretion and checked the register to confirm that registration No. TMA345,589 set out below, is extant [*Quaker Oats Co of Canada Ltd/Cie Quaker Oats du Canada Ltee v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

Trade-mark	Wares
ICEBERG	<p>(1) Purses and belts.</p> <p>(2) Knitted vests, waistcoats, shirts, dresses, jackets and jerkins, coats, raincoats; fur jackets and coats, leather and skin jackets and coats, skirts, trousers, jeans, catsuits, shorts, sashes, scarves, foulards, gloves, shawls, handkerchiefs, socks, towels, swimming suits, hats; boots, shoes and slippers.</p>

test for confusion

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. 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 or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

[14] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel US Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states the resemblance between the marks (section 6(5)(e)), will often have the greatest effect on the confusion analysis.

inherent distinctiveness and extent known

[15] The Opponent's trade-mark is inherently distinctive as there is no apparent connection between icebergs and the Opponent's registered wares (the Opponent's Wares).

[16] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of Mr. Marani, Chief Financial Officer of the Opponent, provides the following information about the use and promotion of the Opponent's ICEBERG trade-mark with the Opponent's Wares in Canada:

- The Opponent has sold the Opponent's Wares in association with the ICEBERG trade-mark since 1982 in Canada (para 8). The ICEBERG trade-mark is directly marked on the Opponent's Wares or on labels attached to these wares (Exhibits D and E).
- Mr. Marani provides pictures of the following ICEBERG wares sold in Canada: jackets, sweaters, long sleeved t-shirts, tank tops, jeans, t-shirts, sandals, sneakers, belts, fashion scarves, umbrellas, and winter scarves (Exhibit E).
- The ICEBERG brand has been featured in numerous catalogues from 2003-2010 distributed to distributors, retail stores and consumers in Canada (para 11; Exhibit H).
- The Opponent operates and has operated the *iceberg.com* and *icebergjeans.com* websites since 1997 which feature the ICEBERG trade-mark (para 15; Exhibit M).

- The ICEBERG brand has been advertised and/or featured in magazines from 2007 onwards including in *Harper's Bazaar* (March 2008; March 2009); *WWD* (February 2010); *Marie Claire* (June 2007; September 2007); *Interview* (March 2007, April 2007); *Redbook* (April 2007); and *US Weekly* (May 2007) (para 9; Exhibit F). I have not had regard to the references predating 2007 since the material date for this ground of opposition is the date of my decision. I take judicial notice of the fact that the publications *Harper's Bazaar*, *Marie Claire* and *US Weekly* have some circulation in Canada [see, for example, *Timberland Co v Wrangler Apparel Corp* (2005), 46 CPR (4th) 201 (TMOB) at 207]. I have not had regard to the information for the 2004 Canadian circulations from the Audit Bureau of Circulations (Exhibit G) since this evidence is hearsay and no information has been provided to its necessity and reliability.
- Sales of the Opponent's Wares in Canada in association with the ICEBERG trade-mark for the years 2005-2008 are set out below in EUR as provided by Mr. Marani:

2005	66,000
2006	139,000
2007	96,000
2008	206,000

- Invoices from 2007 onwards provided by Mr. Marani show sales to the following retailers in Canada: Emma (Montreal, Quebec); Via Cavour (Toronto, Ontario) and Verso Milano Sport (Montreal, Quebec).

Given the evidence above, it appears that the Opponent's ICEBERG trade-mark is known to some extent in Canada.

[17] The Mark has a similar degree of inherent distinctiveness as the Opponent's trade-mark since the Wares do not directly relate to icebreakers. I further note that the component REALFLEECE does not add any inherent distinctiveness of the Mark as it is suggestive, if not descriptive, of a character or quality of the Wares. As the Applicant has not shown any use of its Mark, this factor favours the Opponent.

length of time in use

[18] The length of time that each trade-mark has been in use favours the Opponent who has evidenced use of the ICEBERG trade-mark in Canada since at least as early as 1982 (see para 8; Exhibits E and P). There is no evidence that the Mark is in use in Canada.

nature of the wares, services or business; nature of trade

[19] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB) at 98-99].

[20] I find that with the exception of "fabrics, all being made wholly of real woolen fleece", the Wares overlap with the Opponent's Wares. Furthermore, as neither party includes a restriction in the channel of trade both party's goods could conceivably all be sold at the same stores. Therefore, this factor favours the Opponent with respect to the Wares with the exception of "fabrics, all being made wholly of real woolen fleece."

degree of resemblance between the trade-marks

[21] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court in *Masterpiece* [at para 64] advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[22] In this case, I find that the aspects of each trade-mark which are particularly striking or unique are the words ICEBERG and ICEBREAKER. While ICEBERG and ICEBREAKER have some degree of resemblance in appearance and sound due to their beginning components (ICE), the different endings in each of these words distinguish the marks. Furthermore, the fact that ICE is not an independent component of either mark means that the word ICE would not necessarily be perceived independently by consumers.

[23] With respect to the ideas between the marks, the marks suggest different, albeit somewhat related ideas. I find that the ICEBERG trade-mark suggests an iceberg, or a large floating mass of ice, broken off from a glacier, while the Mark suggests fleece sold under the brand ICEBREAKER which suggests a ship built for breaking a channel through ice [definitions are taken from *The Canadian Oxford Dictionary*, 2nd ed; see *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 for authority to take judicial notice of dictionary definitions]. At the hearing, the Applicant submitted that the Mark suggests products which break the ice or cold, however, given that ICEBREAKER is a defined word and there is no evidence that the Wares are used to break the cold, I do not find that the Mark would suggest this to consumers.

[24] The degree of resemblance between the marks in appearance, sound and ideas suggested favours the Applicant.

other surrounding circumstances

(i) state of the register evidence

[25] The Opponent argues that ICE is the most important component because it is the first portion or first syllable of a mark which is the more important for the purposes of distinction: see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD) at 188. The Applicant submits that the significance of any resemblance between the parties' marks owing to the component ICE is mitigated by the state of the register evidence. The relevant marks submitted by the Applicant are application Nos. 1,346,200 for CRASHED ICE; and 1,426,712 for GIRLS KICK ICE; and registration Nos. TMA783,659 for ICE SKIN; TMA449,507 for CENTRE ICE; TMA498,175 for CENTRE ICE; TMA504,140 for ICE ISLAND; TMA546,762 for ICE-TECH; TMA677,542 for FIRE + ICE; TMA583,920 for NORTHERN ICE; TMA571,579 for CHINO ICE JEANS Design; TMA594,528 for NORTHERN ICE Design; TMA570,679 for COLD AS ICE; and TMA492,212 for ICE FLANNEL, all for use in association with various clothing wares.

I find the remaining applications and registrations submitted by the Applicant and set out below to not be relevant for the following reasons:

- Application Nos. 1,151,905 for BLACK ICE NAKED; 1,151,906 for BLACK ICE; 1,467,96 for ICE LOCK Design; 1,260,615 for ICE CAPADES; and 1,187,561 for ICE CREAM – these applications are not based on use [*Kraft Canada Inc v Happy Planet Foods Inc*; 2005 CarswellNat 2772 (TMOB) at para 21];
- Application No. 1,238,361 for ICE CREAM design – this application is not pending;
- Registration No. TMA590,959 for WESTMOUNT CENTRE ICE – the wares are different in nature from the Wares and the Opponent’s Wares [*Camiceria Pancaldi & B Srl Ltee v Cravatte Di Pancaldi Srl*; 2007 CanLII 80816 (TMOB) at para 38];
- Registration Nos. TMA322,543; TMA336,019; TMA570,860 and TMA751,298 for ICEBREAKER – these registrations are owned by the Applicant and, therefore, are not to be included as state of the register evidence [*Allergan Inc v Lancôme Parfums & Beauté & Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB) at 169]; and
- Registration Nos. TMA778,397 for ICE PIRATES Design; TMA530,865 for THE ICE GARDENS Design; and TMA514,989 for AUTHENTIC CENTER ICE COLLECTION Design – ICE is not a dominant component of these trade-marks [see, for example, *RPM, A Partnership v American Biltrite Intellectual Properties, Inc* (2011), 92 CPR (4th) 329 (TMOB) at para 44].

[26] The Opponent argues that the Applicant’s evidence is insufficient to allow for inferences to be made about the state of the marketplace and points to various decisions of the Registrar including: *Air Miles International Trading BV v Sea Miles LLC* 2009 CanLII 90465 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD at 209). While I agree with the Opponent that the state of the register evidence is insufficient to find that ICE prefixed marks have been commonly adopted, I am prepared to find that the evidence presented results in the inference that the Opponent does not have a monopoly over the use of the component ICE in the clothing marketplace. As such, this factor slightly favours the Applicant.

(ii) other marks owned by the Applicant

[27] The Applicant has introduced evidence that it has previously registered the following ICEBREAKER trade-marks:

Registration No.	Wares and Services
TMA322,543	Fabrics
TMA336,019	Ladies', men's, boys', girls', and children's outerwear, namely, coats, jackets, parkas, skiwear, rainwear, snowsuits and snowpants.
TMA570,860	Clothing namely jerseys and thermal underwear. Clothing namely sweaters, vests, shirts, T-shirts, underwear; jackets, socks, hats, gloves, scarves, mittens.
TMA751,298	A number of retailing, wholesaling, procurement, trading, distribution and home shopping services...

I do not consider these registrations to be a significant additional circumstance as they do not give the Applicant the automatic right to obtain a further registration no matter how closely the application may be related to them [*American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB) at 576; *Courtyard Restaurant Inc v Marriott Worldwide Corp*; 2006 CanLII 80366 (TMOB)].

(iii) no evidence of actual confusion

[28] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by an opponent [*Christian Dior SA v. Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at para 19]. In the present case, no adverse inference can be drawn as there is no evidence that there has been any use of the Mark. With respect to the Applicant's submissions that the fact that its registrations for the trade-mark ICEBREAKER are based on use and/or had Declarations of Use filed prior to registration, at most this would lead to the inference that there has been *de minimis* use of the ICEBREAKER trade-mark in Canada. Such *de minimis* use does not demonstrate extensive concurrent use sufficient to find an adverse inference as a result of the Opponent not evidencing confusion between the ICEBERG and ICEBREAKER trade-marks.

(iv) failure of the Applicant to file evidence

[29] I do not find that the failure of the Applicant to file evidence concerning its use of the Mark and/or ICEBREAKER marks to constitute a relevant surrounding circumstance. The application for the Mark is filed, in part, based on proposed use. As a result, the Applicant is not under any obligation to use the Mark until it has been allowed [*Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC) at para 58].

conclusion

[30] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees ICEBREAKER REAL FLEECE on the Wares when he or she has no more than an imperfect recollection of the Opponent's ICEBERG trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin Maison Fondée en 1772 v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at para 20].

[31] Having considered all of the surrounding circumstances, I have concluded that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks at issue. While the Opponent has established that its trade-mark is known to some extent in Canada and that most of the Wares overlap with the Opponent's Wares, these factors are not significant enough for me to find a reasonable likelihood of confusion. In most instances, including this case, it is the degree of resemblance between the trade-marks that is the most crucial factor in determining the issue of confusion [*Masterpiece, supra*]. As noted above, any resemblance between the marks in appearance and sound arises due to the fact that they both share the component ICE, however, the marks when considered as a whole are different in appearance, sound and idea suggested. Accordingly, this ground of opposition is rejected.

Section 16 Grounds of Opposition

[32] The Opponent alleges that the Applicant is not the person entitled to registration of the Mark since at the date of filing and priority filing it was confusing with the Opponent's use of the trade-marks ICEBERG and ICE ICEBERG Design and the Opponent's application No. 1,358,600 for ICE ICEBERG Design. The ICE ICEBERG Design trade-mark is set out below:



[33] The Opponent has met its burden with respect to the section 16(3)(a) ground of opposition by demonstrating use of the ICEBERG trade-mark at the priority filing date of the subject application and that it had not abandoned such use at the date of advertisement. I do not find, however, that the evidence shows that the ICE ICEBERG Design trade-mark is used in accordance with section 4(1) of the Act.

[34] The Opponent has also met its burden with respect to the section 16(3)(b) ground of opposition. I have used my discretion to confirm that application No. 1,358,600 was pending as of the priority filing date and date of advertisement of the subject application [*Royal Appliance Manufacturing Co v. Iona Appliances Inc/ Appareils Iona Inc* (1990), 32 CPR (3d) 525 (TMOB), at 529].

[35] For similar reasons to those set out with respect to the section 12(1)(d) ground of opposition, I find that the Mark is not confusing with the Opponent's use of the ICEBERG trade-mark. With respect to the Opponent's application for its ICE ICEBERG Design trade-mark, the Applicant's position that there is no reasonable likelihood of confusion appears to be even stronger with respect to this mark as compared to the ICEBERG mark. As compared to the Opponent's ICE ICEBERG Design trade-mark, the Mark has less of a degree of resemblance due to the fact that the most striking part of this trade-mark is the ICE component in conjunction with the repeating ICE element. In view of the difference between the marks, I find that the Applicant has met its onus with respect to the sections 16(3)(a) and 16(3)(b) grounds of opposition. The section 16 grounds of opposition are therefore rejected.

Distinctiveness Ground of Opposition

[36] Since assessing each of the section 6(5) factors as of November 10, 2009 does not significantly impact my previous analysis of the surrounding circumstances, I am satisfied that the Applicant has discharged its legal onus show that the Mark was not reasonably likely to cause confusion with the Opponent's ICEBERG or ICE ICEBERG Design trade-marks. Accordingly, this ground of opposition is rejected.

Disposition

[37] 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.

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