



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

Citation: 2015 TMOB 143
Date of Decision: 2015-08-13

IN THE MATTER OF AN OPPOSITION

Score Retail Nederland B.V.	Opponent
and	
Triple 5 Inc.	Applicant
1,503,671 for the trade-mark CHASIN	Application

Introduction

[1] Score Retail Nederland B.V. (the Opponent) opposes registration of the trade-mark CHASIN (the Mark) filed on November 12, 2010 by Triple 5 Inc. (the Applicant) on the basis of proposed use in association with:

Clothing, namely: blouses, skirt sets, namely, skirts and blouses, pant sets, namely, pants and blouses, pants and jackets; shorts sets, namely, shorts and blouses, skirts, pants, shorts, dresses, jackets, blazers, coats, scarves, sweaters, t-shirts, vests, car coats, trench coats, jumpsuits, hats and gloves; knits and knit co-ordinates, namely: sweaters and cardigans, pullovers, knitted dresses, knitted vests, knitted blazers, shirts, camisoles, blouses, leggings, jumpsuits, leotards, shorts and socks; ties, underwear, all purpose sport bags (the Products).

[2] The Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 30(i), 16(3)(a) and 2 (distinctiveness). They all turn on the issue of likelihood of confusion with the

Opponent's trade-mark CHASIN[?]. The grounds of opposition are detailed in Annex A to this decision.

[3] For the reasons explained below, I reject the opposition.

The Record

[4] The application was advertised in the *Trade-marks Journal* on May 25, 2011. The Opponent filed its statement of opposition on October 25, 2011. The Applicant filed and served a counter statement on November 25, 2011 in which it denied each and every ground of opposition pleaded by the Opponent.

[5] The Opponent filed as evidence the affidavits of Ms. Jennifer Leah Stecyk sworn March 23, 2012 and Mr. Johannes Wilhelmus Theodorus Peters sworn March 23, 2012. I noted that the heading on both of these affidavits refer to a different application number than the one assigned to this file. I am assuming that such discrepancy is a typographical error.

[6] The Applicant filed as its evidence the affidavit of Mr. Vinit Soni sworn on April 18, 2013.

[7] Mr. Peters, Ms. Stecyk and Mr. Soni were cross-examined and their transcripts are part of the record.

[8] Only the Applicant filed a written argument and no hearing was held.

The parties' respective burden or onus

[9] The legal onus is on the applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293

(FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary remarks

[10] I wish to point out that, in reaching my decision, I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence filed by the parties.

[11] In the absence of the Opponent's written argument or a hearing during which the Opponent could have developed arguments based on the evidence it filed, it is difficult to predict what could have been those arguments. I will try to associate the evidence filed with the grounds of opposition raised by the Opponent, where applicable.

The Opponent's evidence

The Stecyk affidavit

[12] Ms. Stecyk has been a trade-mark searcher employed by the agent firm acting on behalf of the Opponent when she executed her affidavit.

[13] She filed as exhibit A to her affidavit a print out from the CIPO Online Database of the details of Canadian trade-mark application No. 1,549,139 for the trade-mark CHASIN' in the name of the Opponent.

[14] She states that on March 21 and 23, 2012 she conducted Internet searches using the Google search engine in order to obtain information about the Opponent's trade-mark CHASIN' by entering the term 'Chasin' or "chasin'jeans" in the search field. She filed as exhibit B copies of web pages which were downloaded and printed on those dates from certain websites which she personally visited from among those listed in the results of the Google searches.

[15] She then downloaded and printed on March 23, 2012 web pages from the website *www.jeansonline.com* which she filed as exhibit C. It appears from those pages that an account can be created to order jeans from that website. Some of the fields to create an account have been

filled up, including the name ('Jane Smith') with an address in Toronto, Ontario, Canada. From these extracts, she concludes that clothing in association with the Opponent's trade-mark CHASIN' is promoted and offered for sale in Canada.

The Peters Affidavit and his cross-examination

[16] Mr. Peters is the Director of Score Group B.V. During his cross-examination he explained that the Opponent is a wholly owned subsidiary of Score Group B.V.

[17] He states that the Opponent is located in the Netherlands and has since at least as early as 1981 been engaged in the retail sale of clothing and fashion accessories, with a particular focus on jeans. He alleges that the Opponent owns a number of clothing brands but also distributes clothing and accessories sold under brands of third parties.

[18] Mr. Peters further states that the trade-mark CHASIN' was adopted and first used by the Opponent at least as early as 1998 and has been in continuous use since that date in association with jeans, pants, jackets, sweaters, shirts, t-shirts, knitwear, sweatshirts, hoodies, belts, hats, underwear and shoes. The Opponent's trade-mark CHASIN' has also been used in association with retail store services and online retail sales for more than 10 years. He filed, as exhibit A, a listing showing the details of the Opponent's registrations and applications for the trade-mark CHASIN' throughout the world. I note that Canadian application No.1,549,139 referred to in Ms. Stecyk's affidavit is listed in exhibit A.

[19] Mr. Peters alleges that the trade-mark CHASIN' is and has been used by the Opponent by being prominently displayed on garments and fashion accessories and/or on patches, labels and hang tags affixed to garments and fashion accessories. He filed as exhibit B to his affidavit, print outs and copies of photographs which illustrate the manner in which the trade-mark CHASIN' has been used over the preceding ten years by the Opponent in association with clothing and fashion accessories (CHASIN' products).

[20] Mr. Peters also filed, as exhibit C to his affidavit, print outs and copies of photographs which illustrate the manner in which the trade-mark CHASIN' has been used over the preceding ten years by the Opponent in association with retail store services featuring sales of clothing and

fashion accessories and in association with online retail sales of those products. He states that the Opponent currently operates CHASIN' retail stores in various locations throughout Germany, the Netherlands and Belgium. He adds that CHASIN' products are available in thirty-five (35) store locations. I note that there is no reference to stores located in Canada.

[21] Mr. Peters alleges that commencing in 1998 and continuing to the present, CHASIN' products have been promoted and offered for sale by the Opponent on the website *www.score.nl*. In August 2008, the Opponent created a separate web site *www.chasin.com* for the promotion of CHASIN' products. Then, in December 2011, an online store dedicated solely to sales of CHASIN' products was added to the website *www.chasin.com*.

[22] Mr. Peters asserts that sales of CHASIN' products are not limited to CHASIN' retail stores or to the websites *www.score.nl* and *www.chasin.com*. The Opponent also distributes its CHASIN' products through other channels and CHASIN' products are and have been available since well prior to November 2010 from other sources including through the website *www.jeansonline.com* which site ships to Canada and the United States.

[23] Mr. Peters then states that revenues generated by the sale of the Opponent's CHASIN' products have been increasing steadily since 2008 and as of March 2012 exceeded € 48.306.261. He has provided the details of those revenues broken down by year from 2008 to 2011. However there is no reference to Canadian sales. He also provides the approximate total advertising figures dedicated to the promotion and advertising of the Opponent's CHASIN' products, broken down by year for the same period, which total approximately € 5 million; but again there is no reference to Canada.

[24] Mr. Peters then goes on to state that significant exposure and information is dedicated to CHASIN' Products on the Opponent's websites located at *www.score.nl* and *www.chasin.com*. He filed as exhibit D to his affidavit copies of pages displaying the trade-mark CHASIN' downloaded and printed from these websites. He also filed as exhibit E to his affidavit a copy of the Opponent's CHASIN brand manual which contains information and sample promotional materials relating to the CHASIN' brand.

[25] Mr. Peters further states that CHASIN' products have also been heavily advertised and promoted by means of live fashion shows, television commercials and on the Internet via Facebook as well as on numerous third party websites including YouTube.

[26] During his cross-examination he stated that:

- The Opponent had in 1981 one store located in the Netherlands.
- The Opponent operates 150 stores in 2012: some under SCORE and some under CHASIN'.
- None of the companies under the Score Group of companies operates retail stores in Canada.
- Score Retail Nederland first used the trade-mark CHASIN' in 1998.
- He could not answer the question about documents evidencing sales by Jeans on Line (a distributor) of jeans bearing the trade-mark CHASIN' in Canada.
- The Opponent has not advertised on radio, television, newspapers or magazines in Canada but states that it advertised its brand CHASIN' on the Internet which could be viewed in Canada.
- The pictures filed as exhibit C to his affidavit do not represent a store located in Canada as there are no stores in Canada operated by the Opponent under the trade-mark CHASIN'.
- The items illustrated on the various pages filed as exhibit D were offered for sale in the Fall 2011 or 2012.
- The language of the text on the pages filed as exhibit D is Dutch.
- Exhibit E is the Opponent's CHASIN' bible and it is written in Dutch. It is for internal use.
- The live fashion shows referred to in paragraph 11 to his affidavit were held in Amsterdam and Arnhem, the Netherlands.
- The television commercials mentioned in paragraph 12 to his affidavit were aired in European countries.

- The goodwill and reputation of the Opponent's CHASIN' trade-mark in Canada comes from the fact that several people wanted to import the brand but he does not know the names of these persons and when such demands were made.
- He did not verify beforehand his statement about the fact that Jeans on Line did ship products in Canada.

The Applicant's evidence

Mr. Soni's affidavit and cross-examination

[27] Mr. Soni is the Applicant's managing director and chief operating officer. He has been employed by the Applicant since 2001. He explains in general terms the Applicant's business which he describes as a family run business wherein his father is the President, and in which his mother, a brother and a sister are all actively involved in the business. He states that the Applicant has manufactured for it, and imports, clothing which it distributes at wholesale in Canada and elsewhere in association with a series of trade-marks it owns.

[28] Mr. Soni explains that each and every garment that the Applicant has manufactured for it, or that it imports into Canada, has a trade-mark label, content label, and hag-tags attached to the garment by the manufacturer or supplier, as the case may be, pursuant to the Applicant's instructions and directives.

[29] Mr. Soni explains that in the Spring/Summer of 2010 the Applicant decided to adopt a new trade-mark for a line of clothing that it was then in the process of styling and developing. He states that a trade-mark search was effected in order to determine if the proposed trade-mark CHASIN was available. He also states that a summary survey of the Canadian marketplace was done, which showed no evidence of use in Canada of the trade-mark CHASIN. As such, instructions were given to proceed with the filing of the present application.

[30] During his cross-examination, Mr. Soni did explain in what circumstances the Mark was chosen and provided the details of what he qualified 'a summary survey of the Canadian marketplace'.

[31] Mr. Soni goes on to state that, once the application was filed, the Applicant began visiting retailers across Canada offering for sale the line of clothing bearing the Mark. He confirms, after verifying with the Applicant's representatives, who visited or otherwise had contact with Canadian retailers, that none of them had encountered anyone who mentioned, in any manner whatsoever, any other 'Chasin' products.

[32] Mr. Soni asserts that, since November 12, 2010, the Applicant has commenced selling the Products in association with the Mark throughout Canada and has continuously done so.

[33] He attached, as exhibit 1 to his affidavit, examples of the type of CHASIN labels and hang-tags that would be affixed to each and every garment being offered for sale by the Applicant in association with the Mark as well as a randomly selected invoice dated December 22, 2011 received for these labels and hang-tags.

[34] Mr. Soni states that the Products bearing the Mark sold by the Applicant to its customers is shipped to them in boxes bearing the Mark. He filed as exhibit 2 to his affidavit, a photo of a sample box used by the Applicant to ship its CHASIN clothing to retail customers.

[35] Mr. Soni filed as exhibit 3 to his affidavit randomly selected purchase orders issued by the Applicant to MHR FASHION LIMITED, a manufacturer of Dhaka, Bangladesh as well as a series of documents evidencing that these garments are destined for one of the Applicant's retail customers.

[36] Mr. Soni explains that, since the filing of its application, the Applicant has been circulating, to its retail customers, point of sale posters featuring the Mark and he filed, as exhibit 5 to his affidavit, samples of such posters. He also filed, as exhibit 7 to his affidavit, a series of randomly selected documents shown to, or circulated to, retailers throughout Canada to inform these retailers of the type of garments the Applicant offers for sale, and sells, in Canada in association with the Mark.

[37] Mr. Soni goes on to explain that the Applicant distributes a line list for the Products bearing the Mark which indicates the current style number and the colours in which the illustrated garments are available, to enable the retail customers to select the garments they wish

to purchase, in the colours selected and in the sizes needed. He filed as exhibit 6 such line list for the Spring/Summer 2013 season.

[38] Mr. Soni concludes his affidavit by making the following statements:

- Since the filing of the subject application by the Applicant, no one, whether a professional buyer or an ordinary consumer, with whom the Applicant regularly has contact, has ever suggested to have any knowledge of any CHASIN goods that emanate from someone other than the Applicant;
- Both prior to November 12, 2010, the date of the filing of the subject application No. 1,503,671, and since then, representatives of the Applicant have had communications with numerous retailers throughout Canada, and no one has ever even referred to any other source for CHASIN goods;
- None of the many retailers that the Applicant has dealt with both prior to and since November 12, 2010, has ever informed the Applicant that any of their customers have in any way referred to any source of CHASIN goods other than the CHASIN goods emanating from the Applicant.

[39] During his cross-examination Mr. Soni stated that:

- he has not seen, in the Canadian marketplace, the Opponent's mark CHASIN';
- he saw the brand in Amsterdam after the opposition proceeding commenced during a pleasure trip;
- he identified two customers, namely L'Aubainerie and Jean Machine to whom the Products bearing the Mark have been sold in Canada;
- he confirmed that the design of the Mark appearing on exhibit 1 to his affidavit was done by one of the Applicant's designers.

Section 30(i) Ground of Opposition

[40] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the goods and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect. Mr. Soni, during his cross-examination, explained in what particular circumstances the

Mark was chosen and he confirmed that he never saw or made aware of the Opponent's trade-mark CHASIN' being used in Canada prior to the filing of the application. In fact, he confirmed that the first time he saw the Opponent's mark CHASIN' was during a pleasure trip in Amsterdam after the opposition proceeding commenced.

[41] Consequently, in view of the Opponent's failure to meet its initial burden, this ground of opposition is dismissed.

The Entitlement Ground of Opposition (Section 16(3) of the Act)

[42] The relevant date under this ground of opposition is the filing date of the application [see section 16(3) of the Act].

[43] In its statement of opposition the Opponent is alleging that the Applicant is not entitled to registration of the Mark since, at the filing date of the application (November 12, 2010), the Mark was confusing with the Opponent's trade-mark CHASIN' previously used and/or made known in Canada by the Opponent.

[44] For the reasons detailed below I conclude that the Opponent has failed to establish prior use of its mark CHASIN' in Canada or that it was known in Canada at the relevant date.

[45] Nowhere in its evidence does the Opponent make specific reference to Canada. In fact as mentioned above, Mr. Peters during his cross-examination confirmed that the Opponent does not operate retail stores in Canada under the trade-mark CHASIN', nor did it advertise the Mark in Canada in newspapers, magazines, or on television or radio. He does mention that jeans bearing the trade-mark CHASIN' have been sold online in Canada through the website *www.jeansonline.com*. When he was questioned on those sales during his cross-examination he was not personally aware of a single sale having been made in Canada through such website and when asked to provide the details of sales of jeans bearing the trade-mark CHASIN' in Canada through that website he stated that it would be impossible to furnish such information.

[46] As for a potential sale made in Canada to a Jane Smith from Toronto, Ontario and part of the evidence filed by Ms. Stecyk, if any was made, it would have taken place on March 23, 2012,

which is subsequent to the relevant date. Therefore, I cannot consider it for the purpose of this ground of opposition.

[47] As for the promotional material attached to Mr. Peters' affidavit (exhibit C), it is mostly written in a foreign language, identified by him during his cross-examination as Dutch. Moreover we have no information on the number of Canadians who would have seen the material filed, which mainly comes from various websites.

[48] Finally Ms. Stecyk did some Internet searches on March 21 and 23, 2012 which are after the relevant date. Therefore the results of those searches are of little assistance to the Opponent.

[49] As for the possibility that the Opponent's trade-mark CHASIN' may have been made known in Canada at the relevant date, I refer to the definition of 'made known in Canada' contained in section 5 of the Act, which reads:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

- (a) the goods are distributed in association with it in Canada, or
- (b) the goods or services are advertised in association with it in
 - o (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or
 - o (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

[50] So, in order to fall within that definition, the Opponent had to establish the following:

- 1) Its goods or services were distributed in Canada in association with its trade-mark CHASIN (which is not the case); or
- 2) Its goods or services were advertised in association with its trade-mark CHASIN in:
 - a) any printed publication circulated in Canada (which is not the case); or
 - b) radio broadcasts ordinarily received in Canada (which is not the case); and

3) It has become well known in Canada by reason of the distribution and advertising (which is not the case).

[51] None of those conditions have been met.

[52] In all, I conclude that the Opponent has failed to meet its initial burden to prove that on November 12, 2010 the Opponent has used in Canada the trade-mark CHASIN' or that it was known to Canadians at that time.

[53] Consequently I dismiss this ground of opposition.

Distinctiveness Ground of Opposition

[54] This ground of opposition must be assessed as of the filing date of the statement of opposition (October 25, 2011) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FC)].

[55] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 the Federal Court did an exhaustive analysis of *Motel 6 Inc v No 6 Motel Limited*, [1982]1 FC 638 et *E & J Gallo Winery v Andres Wines Ltd* [1976] 2 FC 3 and concluded that:

- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada.

[56] I have reviewed, under the previous ground of opposition, the Opponent's evidence to determine if it has used the trade-mark CHASIN' in Canada or if it has become known to any extent in Canada. The later relevant date does not have any significant impact on the analysis made previously. I consider that the Opponent has failed to demonstrate that its trade-mark CHASIN' was known in Canada to some extent or that it was well known in a specific area of Canada as of October 25, 2011.

[57] Under these circumstances I dismiss this ground of opposition as the Opponent failed to meet its initial burden.

Disposition

[58] 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.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Agents of Record

Method Law Professional Corporation

For the Opponent

Harold W. Ashenmil

For the Applicant

Annex a

The grounds of opposition raised by the Opponent are:

1. The application does not comply with the requirements of section 30(i) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada because it knew, or ought to have known, of the existence of the Opponent's rights in and to the trade-mark CHASIN' and that its use of the Mark in association with the Products would falsely suggest a connection with the Opponent and/or would direct public attention to the Applicant's Products or business in such a way as to cause or be likely to cause confusion in Canada between the Applicant's products, services or business and the products, services or business of the Opponent;
2. Under the provisions of section 38(2)(c) of the Act, the Applicant is not the person entitled to the registration of the Mark in that at the filing date of the application the Mark was confusing with the trade-mark CHASIN' which has been previously used in Canada and/or made known in Canada by the Opponent in association with a wide range of products and services and has not been abandoned by the Opponent;
3. Pursuant to the provisions of section 38(2)(d) of the Act, the Mark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish the products of the Applicant from the Opponent's products and services in view of the prior use, promotion and making known by the Opponent in Canada and elsewhere of the trade-mark CHASIN' in association with products and services and also by virtue of longstanding operation by the Opponent of the website *www.chasin.com*. The Opponent has since at least as early as 2000 via its website provided information about clothing and fashion and offered retail store services in the field of clothing, footwear, jeans, fashion accessories and leather goods.