



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

**Citation: 2012 TMOB 168**  
**Date of Decision: 2012-08-30**

**IN THE MATTER OF OPPOSITIONS**  
**by Groupe Bikini Village inc. to**  
**application Nos. 1,376,728 and 1,378,458**  
**for the trade-marks BIKINI BAY and**  
**BIKINI BAY Design in the name of**  
**Bikini Bay Co. Ltd.**

[1] On December 19, 2007, Bikini Bay Co. Ltd. (the Applicant) filed application No. 1,376,728 to register the trade-mark BIKINI BAY based upon use of the trade-mark in Canada since at least as early as March 1, 2001. The statement of wares and services of the application, as revised on August 25, 2008, reads:

Wares: (1) ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups; (2) fashion accessories namely, goggles, sun glasses, beach bags, swim caps, beach towels; (3) clothing accessories, namely hats, baseball caps.

Services: (1) operation of retail stores for the sale of ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups, fashion accessories, namely, goggles, sun glasses, beach bags, swim caps and beach towels; (2) manufacturing of ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups, fashion accessories, namely, goggles, sun glasses, beach bags, swim caps and beach towels; (3) importing and distribution of ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups, fashion accessories, namely, goggles, sun glasses, beach bags, swim caps and beach towels.

[2] The Applicant has disclaimed the right to the exclusive use of the word BIKINI apart from the trade-mark.

[3] On January 9, 2008, the Applicant filed application No. 1,378,458 to register the trade-mark BIKINI BAY Design, shown below, based upon use of the trade-mark in Canada since at least as early as March 1, 2001.



[4] The statement of wares of application No. 1,378,458, as revised on August 25, 2008, is the same as that of application No. 1,376,728, but the statement of services is slightly different; it reads: “(1) operation of retail stores for the sale of swimwear, beach wear, fashion and clothing accessories; (2) manufacturing of swim wear (*sic*), beach wear, fashion and clothing accessories; (3) importing and distribution of swim wear (*sic*), beach wear, fashion and clothing accessories.”

[5] The applications were advertised for opposition purposes in the *Trade-marks Journal* of October 1, 2008 (No. 1,378,458) and October 22, 2008 (No. 1,376,728).

[6] On December 1, 2008, Groupe Bikini Village inc. (the Opponent) filed a statement of opposition against application No. 1,378,458. On December 22, 2008, the Opponent filed a statement of opposition against application No. 1,376,728. The grounds of opposition in each statement of opposition, which are to be read in conjunction with Schedules “A” and “B” thereto, are essentially the same. They allege, in summary, that:

- the application does not conform to the requirements of sections 30(b) and (i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act);
- the trade-mark is not registrable pursuant to section 12(1)(d) of the Act since it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
The logo for Bikini Village features a palm tree on the left and the words "Bikini Village" in a stylized font on the right.	TMA319,349
BIKINI VILLAGE	TMA648,662
OCEAN BIKINI VILLAGE	TMA679,246



TMA679,247

- the Applicant is not the person entitled to registration of the trade-mark pursuant to section 16(1)(a) of the Act in view of confusion with the trade-marks BIKINI VILLAGE and BIKINI VILLAGE & Design (TMA319,349) previously used by the Opponent or its predecessors-in-title;
- the Applicant is not the person entitled to registration of the trade-mark pursuant to section 16(1)(b) of the Act in view of confusion with the trade-mark BIKINI VILLAGE & Design (TMA319,349) in respect of which an application had been previously filed;
- the Applicant is not the person entitled to registration of the trade-mark pursuant to section 16(1)(c) of the Act in view of confusion with the trade-names BIKINI VILLAGE and OCEAN BIKINI VILLAGE previously used by the Opponent or its predecessors-in-title; and
- the Mark is not distinctive pursuant to section 2 of the Act.

[7] The Applicant filed and served a counter statement on January 20, 2009 for application No. 1,378,458 and on February 10, 2009 for application No. 1,376,728, in which it denied the Opponent's allegations. On February 10, 2009, the Applicant also filed an amended counter statement for application No. 1,378,458. Upon review of the file, I have noted that the letter sent on behalf of the Registrar on February 24, 2009 mistakenly confirms the acceptance of an amended application, as it is apparent that the letter was intended as a grant of leave to file the amended counter statement of February 10, 2009 pursuant to section 44 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations).

[8] In support of each opposition, and pursuant to section 41 of the Regulations, the Opponent filed affidavits of Lise Lahaise, Director of Operations of the Opponent, dated May 26, 2009 (the 2009 Lahaise affidavit) and Jocelyne Genest, a paralegal employed by the Opponent's trade-marks agent, dated May 27, 2009. The Opponent filed a second affidavit of

Lise Lahaise dated May 4, 2010 (the 2010 Lahaise affidavit) in each opposition as reply evidence pursuant to section 43 of the Regulations. The Opponent's affiants were not cross-examined by the Applicant.

[9] In support of each application, and pursuant to section 42 of the Regulations, the Applicant filed affidavits of Boris Kisliuk, President of the Applicant, dated September 18, 2009 (the 2009 Kisliuk affidavit) and Stacey Pompeo, a law clerk employed by the Applicant's trademarks agent, dated September 23, 2009. Pursuant to section 44 of the Regulations, the Applicant filed a second affidavit of Boris Kisliuk dated September 9, 2010 (the 2010 Kisliuk affidavit) and an affidavit of Consuelo Burstin, website designer/project manager with Burstin Marketing Group Inc., dated August 23, 2010 as further evidence in support of each application. The Applicant's affiants were not cross-examined by the Opponent.

[10] Both the Applicant and the Opponent filed a written argument for each opposition proceeding. As briefly detailed below, an issue arising from the circumstances surrounding the filing of the Applicant's written arguments was the subject of a preliminary discussion at the oral hearing conducted for both opposition proceedings and where both parties were represented.

[11] When summarizing the record for each opposition at the beginning of the oral hearing, I remarked that the Applicant had filed a written argument only for application No. 1,378,458. The Applicant submitted that it had filed a written argument for each application and that its written arguments were essentially identical. Upon my further review of the files, I noted that the written argument for application No. 1,376,728 had been mistakenly put on the file for application No. 1,378,458 for reasons unknown to me. Under these circumstances, before carrying on with the oral hearing, I gave the Opponent the opportunity to review the Applicant's written argument for application No. 1,376,728. The Opponent indicated that it was satisfied that the written argument was essentially identical to the Applicant's written argument for application No. 1,378,458 and the Opponent agreed to proceed with the oral hearing.

#### Onus and Material Dates

[12] 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- sections 38(2)(a)/30(b) and 30(i) - the filing date of the application [see *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 [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1)(a), (b) and (c) - the claimed date of first use; and
- sections 38(2)(d)/2 - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

#### Analysis of the Grounds of Opposition

[14] From the outset, I am summarily dismissing the sections 30(i) and 16(1)(b) grounds of opposition raised against each application for the following reasons:

- where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. These are not such a case; and
- the section 16(1)(b) ground of opposition based upon the Opponent's previously filed application for the trade-mark BIKINI VILLAGE & Design has been improperly pleaded. The alleged application had already proceeded to registration No. TMA319,349 at the advertisement date of each trade-mark [see *Governor and Co of Adventurers of England trading into Hudson's Bay v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB)].

[15] As the parties' respective evidence and submissions in each proceeding are the same and there is no significant difference between the two proceedings, I will consider both applications together in analyzing the remaining grounds of opposition. I will refer to the Applicant's trademarks collectively as the BIKINI BAY Marks and distinguish them where I consider it necessary to do so. Also, I will use the singular form in my consideration of an affidavit as a reference to the essentially identical affidavits filed by the affiant in each proceeding. I will not afford weight to the opinion of an affiant that goes to the questions of fact and law to be determined by the Registrar in the present proceedings.

[16] As I will analyze the remaining grounds of opposition, although not necessarily in their order of pleading, in regard to the relevant evidence of record I shall first make preliminary comments on the Opponent's reply evidence and the Applicant's further evidence.

#### Preliminary Comments

##### *Opponent's reply evidence*

[17] The Applicant did not make any submissions with respect to the admissibility of the 2010 Lahaise affidavit as evidence pursuant to section 43 of the Regulations. Nonetheless, I am of the view that I have the authority to consider this issue on my own, especially given the legislative requirement that such evidence be strictly confined to matters in reply to evidence filed pursuant to section 42 of the Regulations.

[18] The 2010 Lahaise affidavit should not serve to fill in voids in the Opponent's evidence. However, the test is not simply whether the evidence could have been included in the evidence of the Opponent. The test is whether the evidence properly responds to issues raised in the evidence filed by the Applicant pursuant to section 42 of the Regulations, namely the 2009 Kisliuk affidavit and the Pompeo affidavit, and is responsive to unanticipated matters. That being said, I conclude from the Opponent's submissions that the 2010 Lahaise affidavit does not purport to respond to the Pompeo affidavit, which merely introduces into evidence Certificates of Authenticity of the original and amended applications for each of the BIKINI BAY Marks. In any event, I find that the 2010 Lahaise affidavit does not respond to the Pompeo affidavit.

[19] In deciding whether the 2010 Lahaise affidavit properly responds to the 2009 Kisliuk affidavit, I am not affording any significance to the affiant's statement that her affidavit is filed as the Opponent's reply evidence [para. 7]. Incidentally, such statement is seemingly contradicted by the affiant's statement that the affidavit follows her first affidavit [para. 6]. I would add that this latter statement arguably lends support to a finding that the evidence introduced by the 2010 Lahaise affidavit or part thereof could easily have been filed as part of the Opponent's evidence pursuant to section 41 or with leave from the Registrar pursuant to section 44 of the Regulations.

[20] Since I am not affording weight to affiant's opinions that go to the questions of fact and law to be determined in the present proceedings, it is a moot point to decide whether the statements at paragraphs 22, 31, 39, 48 and 49 of the 2010 Lahaise affidavit constitute proper reply evidence. For ease of reference, I am discussing hereafter the remainder of the evidence by dividing it in three categories, as in the 2010 Lahaise affidavit, namely: the nature of the wares and services [paras. 10 to 21]; the nature of the trade [paras. 23 to 38]; and the notoriety of the Opponent's trade-marks [paras. 40 to 47].

[21] I find that the evidence concerning the nature of the wares and services does not reply to any new facts contained in the 2009 Kisliuk affidavit and could easily have been filed as part of the Opponent's evidence. The same is true of a portion of the evidence concerning the nature of the trade [paras. 23 to 30] and of the evidence which purports to show the notoriety of the Opponent's trade-marks as a result of advertisement. However, I find that the evidence concerning the nature of the trade from paragraphs 32 to 38 of the 2010 Lahaise affidavit, which purports to show instances of confusion, may qualify as proper reply evidence given the essence of Mr. Kisliuk's testimony as to the absence of instances of confusion [paras. 17 and 28 of the 2009 Kisliuk affidavit].

[22] In view of the above, when analysing the grounds of opposition, I will not have regard to the evidence introduced by the 2010 Lahaise affidavit concerning the nature of the wares and services, the notoriety of the Opponent's trade-marks, and to a portion of the evidence concerning the nature of the trade. I will only have regard to paragraphs 32 to 38 of the 2010 Lahaise affidavit as proper evidence pursuant to section 43 of the Regulations.

*Applicant's further evidence*

[23] It is apparent that the 2010 Kisliuk affidavit and the Burstin affidavit filed by the Applicant as evidence pursuant to section 44 of the Regulations purport to reply to portions of the 2010 Lahaise affidavit that I am disregarding. Thus, both affidavits become of no significance and will not be discussed.

Registrability pursuant to Section 12(1)(d) of the Act

[24] The Opponent has provided a Certificate of Authenticity of each registration alleged in support of the ground of opposition [Exhibit "JG-1" to the Genest affidavit]. Having exercised the Registrar's discretion, I confirm that each alleged registration is extant as of today's date and so the Opponent's initial burden under section 12(1)(d) of the Act has been met. The question becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the BIKINI BAY Marks and any of the Opponent's registered trade-marks.

[25] I find that comparing the BIKINI BAY Marks with the Opponent's word mark BIKINI VILLAGE (No. TMA648,662) registered in association with the wares "ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups, warmers, dancing shoes and exercise outfits; printed publications, namely magazines, calenders, and posters " and the services "operation of retail stores for the sale of the above-mentioned wares" will effectively decide the outcome of the registrability ground of opposition, especially since any relevant evidence of use of the design mark BIKINI VILLAGE (TMA319,349) may serve as evidence of use of the word mark. In other words, if confusion is not likely between the BIKINI BAY Marks and the Opponent's registered word mark BIKINI VILLAGE then it would not be likely between the BIKINI BAY Marks and any of the three other registered trade-marks alleged by the Opponent.

[26] 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.



[27] In applying the test for confusion, I 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 the trade-marks have 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (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.]

[28] At this time, I wish to address the Applicant's submissions based on the disclaimer to the right to the exclusive use of the word BIKINI in the Opponent's registration. Suffice it to say that when dealing with a section 12(1)(d) ground of opposition, a disclaimer in either the application or the registration is of little, if any, consequence [see *Canadian Tire Corp v Hunter Douglas Inc* (2010), 81 CPR (4th) 304 (TMOB) at para 36].

[29] Recently, in *Masterpiece* the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[30] Thus, I now turn to the assessment of the likelihood of confusion between the BIKINI BAY Marks and the Opponent's registered word mark BIKINI VILLAGE having regard to the surrounding circumstances of this case, starting with the degree of resemblance between the marks.

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

[31] 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* advised 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 [see *Masterpiece* at para 64].

[32] Ordinarily it is the first portion of a mark that is the most important for the purpose of distinguishing between marks. When the first or dominant portion of a mark is a common descriptive word, its importance diminishes [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD); *Vancouver Sushiman Ltd v Sushiboy Foods Co* (2002), 22 CPR (4th) 107 (TMOB)].

[33] In the instant cases, the word BIKINI may be considered as the dominant first portion of each of the marks in issue. However, since the word BIKINI is descriptive, there would be a tendency to discount the importance of the prefix in the parties' marks and by corollary to focus more on their other components. I recognize that the word BAY when viewed or sounded does not resemble the word VILLAGE. Nonetheless, I am not prepared to conclude that the word BAY is particularly "striking" as an element of the BIKINI BAY Marks since in the context of swimwear, it evokes "a body of water where the coastline curves inwards" [see *The Canadian Oxford Dictionary*].

[34] The Applicant's written argument does not particularly address the idea suggested by the marks. In oral argument, the Applicant submitted that the word VILLAGE is not tied to water. The Opponent submits that the idea suggested is similar because both the words VILLAGE and BAY suggest the idea of a geographical area. I find that the Opponent's submission has merit.

[35] In the end, I find that there is a fair degree of resemblance between the trade-marks at issue.

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

[36] I assess the inherent distinctiveness of the BIKINI BAY Marks and the trade-mark BIKINI VILLAGE as about the same in the context of the wares and services at issue. The trade-marks are each composed of dictionary words, one of which describes a two-piece bathing suit for women. In my opinion, the features of the Applicant's design mark do not significantly increase its inherent distinctiveness. Besides the fact that the words "bikini bay" are predominant, the palm trees are evocative of tropical beaches.

[37] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. Thus, I shall now consider the evidence with respect to the extent to which the trade-marks have become known in Canada.

[38] In turning to the Opponent's evidence filed by way of the 2009 Lahaise affidavit, I first remark that my subsequent use of the terms "the BIKINI VILLAGE Marks" reflects the affiant's collective reference to all the trade-marks listed at Schedule "A" of each statement of opposition. Likewise, my subsequent use of the terms "Wares and Services" reflects the affiant's collective reference to the wares and services identified in the Opponent's registrations and application for the BIKINI VILLAGE Marks.

[39] According to Ms. Lahaise's statements, the Opponent was founded in 1978 [para. 8]. In 1983, the name of the STUDIO CARMEN boutique, located in Montreal, was changed to BIKINI VILLAGE to become the first link in a chain of successful boutiques specializing in swimwear [para. 10]. In 1989, there were 25 BIKINI VILLAGE boutiques in operation in the Provinces of Quebec and Ontario [para. 11]. In 2009, the Opponent's operations had grown to 59 boutiques operated under the banners BIKINI VILLAGE and OCEAN BIKINI VILLAGE, (collectively referred to by the affiant as the BIKINI VILLAGE boutiques); there were 55 boutiques operated under the banner BIKINI VILLAGE in Quebec, Ontario, Nova Scotia and New Brunswick, and 4 boutiques operated under the banner OCEAN BIKINI VILLAGE in Quebec [paras. 12 to 16, Exhibit "LL-2"]. The BIKINI VILLAGE boutiques carry a wide range of swimwear, beach accessories and cruise clothing associated with the BIKINI VILLAGE Marks and with the most popular brands in the industry [para. 18].

[40] In order to show the manner of use of the BIKINI VILLAGE Marks in association with the Wares and Services as well as in advertising since at least as early as November 1983, the following are appended as exhibits to the affidavit: a sampling of extracts from the magazine *Maillots/Swimwear* published between 1985 and 1999 and from the magazine *Tropic* published since 2006 by the Opponent; a sampling of advertisements produced between 2004 and 2009, including ads published in various Canadian periodicals and newspapers; an email promotion of 2005; a pamphlet distributed in the BIKINI VILLAGE boutiques to show customers how to use a sarong; excerpts of the Opponent's website; stationery; copies of photographs showing the fronts of a BIKINI VILLAGE boutique in 1987 and of a BIKINI VILLAGE boutique in operation at the date of the affidavit; a plastic bag; a sampling of new releases; a sampling of images of some of the Wares; and a gift card [paras. 24 to 38, Exhibits "LL-4" to "LL-16"].

[41] According to the yearly breakdown provided in the affidavit, between 2004 and 2008 the Opponent spent a total amount of \$4.2 million for the promotion and advertisement of the Wares and Services associated with the BIKINI VILLAGE Marks through the BIKINI VILLAGE boutiques, the Internet and printed media; it estimated spending \$500,000 in 2009 [para. 40].

[42] According to the yearly breakdown provided in the affidavit, the Opponent's sales figures for the years 2004 to 2008 totaled approximately \$191 million [para. 41]. As I understand the evidence, these figures relate to the sales of swimwear, beach accessories and cruise clothing associated with the BIKINI VILLAGE Marks as well as with the other brands of swimwear, beach accessories and cruise clothing available in the BIKINI VILLAGE boutiques. In other words, there is no information concerning the sales figures of swimwear, beach accessories and cruise clothing associated with the BIKINI VILLAGE Marks relative to the sales figures of such wares associated with the other brands available in the BIKINI VILLAGE boutiques.

[43] Now turning to the Applicant's evidence filed by way of the 2009 Kisliuk affidavit, I first remark that according to its heading, the terms "Bikini Bay" are used throughout the affidavit as a reference to the Applicant. However, based on a fair reading of the affidavit, it seems that those terms are also being used by the affiant to refer to the name of its stores or its brand of swimwear. In any event, any ambiguities resulting from the use of the terms "Bikini Bay" by the affiant will be resolved against the Applicant [see *Conde Nast, supra*].

[44] According to Mr. Kisliuk's statements, the name "Bikini Bay" was chosen by his mother for the opening of a store focusing exclusively upon swimwear and swim fashions. Mr. Kisliuk's mother opened "her first 'Bikini Bay' store" in Toronto along with himself and his father in April of 1993; another store was opened in Richmond Hill in June of 1993 [paras. 5 and 6]. The logo created in 1993 "that incorporated the business name and also gave a tropical vacation sense to the viewer" was placed outside the first store [para. 7, Exhibit "A"]. The Applicant was incorporated on November 21, 1995 [para. 8].

[45] Mr. Kisliuk provides the addresses of 14 stores opened in Ontario by his mother or the Applicant between April 1993 and April 2009 [para. 9]. A "scratch and save card" used at the opening of the Toronto outlet store in 1996 is appended to the affidavit [para. 33, Exhibit "L"]. As of April 2009, there were 10 stores operated by the Applicant in Ontario [para. 10]. Mr. Kisliuk files photographs of plastic bags used in each of the stores [para. 33, Exhibits "Q" and "R"].

[46] Mr. Kisliuk states that the Applicant's advertising has focused "upon either traditional print or radio advertising". According to the yearly breakdown provided in the affidavit, the Applicant spent a total amount of \$56,279 on such advertising between 2004 and 2008 [para. 19]. A copy of an advertisement published in the May 7, 2000 edition of the "In Fashion" section of the *Toronto Star* is appended to the affidavit [para. 33, Exhibit "N"].

[47] According to Mr. Kisliuk's statements, apart from print and radio advertising, the Applicant's marketing efforts have focused upon sponsorships, in particular sponsorship of various issues of the *Toronto Sun* swimsuit edition and of the 2007 Miss Canada Globe beauty pageant [para. 20]. The Applicant has also focused upon direct visual marketing which primarily consists in customer giveaways including beach towel bags, which is a beach bag folding into a beach towel, baseball hats and beach bags [paras. 21 and 33, Exhibits "C", "E" and "S"]. The amount spent by the Applicant between 2004 and 2008 for other forms of advertising than print and radio "have been negligible and have amounted to only a few hundred of dollars in each of these years. Rather than spending heavily, [the Applicant's] efforts involved extensive marketing and cross promotion by the staff at the store level" [para. 22]. Mr. Kisliuk files copy of a promotional brochure valid for a 10% discount on clothing purchases; the brochure is given to

participating travel agents who in turn give it to customers upon the booking of a vacation [para. 33, Exhibit “T”].

[48] According to the yearly breakdown provided in the affidavit, the Applicant’s total revenues for its 2004 to 2008 fiscal years (ending August 31<sup>st</sup>) were \$23,152,192 [para. 24]. I note that although it is unclear whether he refers to the Applicant’s fiscal year or the calendar year, Mr. Kisliuk states at paragraph 13: “As at 2008, sales of bikini bay swimwear constituted approximately 30% of the [Applicant’s] total sales in that year.” According to Mr. Kisliuk’s statements, sales of other brands of swimwear, whether the Applicant’s or third party’s brands, constituted approximately 65% of the total sales in 2008, which include 10% of sales of BODY GLOVE brand of swimwear carried by both the Applicant and the Opponent [para. 13]. I will return to the sales of BODY GLOVE swimwear by both parties when discussing the nature of the parties’ wares and trade.

[49] Finally, Mr. Kisliuk files: a copy of a price tag that “was in use by *Bikini Bay* since the opening of its first store in 1992” (my emphasis); the original label for “[the Applicant’s] ‘Bikini Bay’ brand of swimwear” used from 1996, when the brand was introduced, to 2002; the label used since 2002; and the hand tag used since 2004 for “the ‘Bikini Bay’ brand garments” sold in the stores [para. 33, Exhibits “J”, “K”, “O” and “P”].

[50] In my view, both the 2009 Kisliuk affidavit and the 2009 Lahaise affidavit are opened to criticism, especially when considering evidence directed to the circulation or distribution of advertising and promotional material. The introduction of the evidence by collective references to the BIKINI VILLAGE Marks and to the Wares and Services also opens the 2009 Lahaise affidavit to criticism. That being said, I am able to conclude from the evidence that the Opponent’s trade-mark BIKINI VILLAGE has become known in Canada to a significant extent as well as to a larger extent than have the BIKINI BAY Marks.

[51] In the end, I conclude that the acquired distinctiveness of the trade-mark BIKINI VILLAGE is greater than that of the BIKINI BAY Marks. Thus the overall consideration of the first factor favours the Opponent.

*The length of time each trade-mark has been in use*

[52] The BIKINI BAY Marks have been applied for registration based upon use in Canada since March 1, 2001. However, as discussed above, the Applicant's evidence establishes that the BIKINI BAY Marks would have been first used in association with the operation of a retail store for swimwear and swim fashions in April of 1993. Still, such first use could not have been by the Applicant whose date of incorporation is November 21, 1995. At the utmost, one could reasonably conclude from the evidence that the Applicant itself would have first used the BIKINI BAY Marks in 1996 when it opened the Toronto outlet store and introduced the BIKINI BAY brand of swimwear.

[53] That said, nothing turns on whether the date of first use claimed in the applications for the BIKINI BAY Marks or the one established by the evidence should be considered when assessing the likelihood of confusion under section 12(1)(d) of the Act. Indeed, the Opponent is anyway favoured by this factor as its trade-mark proceeded to registration No. TMA648,662 based on its use in Canada since at least as early as November 1983, which date is supported by the Opponent's evidence.

*The nature of the wares, services or business; and the nature of the trade*

[54] When considering the nature of the parties' wares, services and business and the parties' nature of trade, it is the statement of wares and services in the applications and the statement of wares and services in the registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)].

[55] The Applicant concedes that the general nature of the parties' wares, that is swimwear, is the same. However, it submits that consideration should be made of the exact type of swimwear. More particularly, the Applicant submits that paragraph 10 of the 2010 Lahaise affidavit establishes that the Opponent's wares comprise swimwear for sale to women between the ages of 20 and 45 whereas the Applicant's evidences is that approximately 70% of its wares are sold to older women, children and men. I have to remark that paragraph 10 of the 2010 Lahaise affidavit

is part of the reply evidence that I am disregarding. In any event, I believe that my disregard of such evidence is of no consequence in the assessment of the likelihood of confusion, if only because the statement of wares of the Opponent's registration covers ladies' and men's bathing suits and swimwear. The Applicant also submits that its evidence establishes that it carries wares that overlap with those of the Opponent, but those overlapping wares constituted only approximately 10% of the Applicant's sales. I understand that the BODY GLOVE brand of swimwear carried in both parties' stores is the swimwear for which the Applicant recognizes there is an overlap. With due respect, I fail to understand how the Applicant's ultimate position that there is "only an insignificant overlap" between the parties' wares is of any assistance to its case.

[56] In the end, I conclude to identity, overlap, similarity, or relationship between the Opponent's registered wares "ladies' and mens' (*sic*) bathing suits, swimwear, shorts, cover-ups, warmers, [...] and exercise outfits" and the wares identified in each application. Likewise, I conclude to identity, overlap, similarity or relationship between the Opponent's registered services and the services identified in each application.

[57] The nature of the parties' trade is the same, which is not debated by the Applicant. I would add that the evidence is to the effect that three of the Applicant's stores are located in shopping centres where there is also a store operated by the Opponent and three other of the Applicant's stores are located in close proximity to the Opponent's stores [para. 16 of the 2009 Kisliuk affidavit].

*Surrounding circumstance: state of the market place and of the register*

[58] Mr. Kisliuk states that he conducted a search of the "canada411.com website" and files the list "of nine other swimwear businesses that were found to use the word 'bikini' in their business name" [para. 29, Exhibit "G"]. I am not affording any significance to the affiant's search. Suffice it to say that there is no evidence enabling me to conclude that any of the nine businesses was in activity at the date of the search, which by the way is unknown, or at any time.

[59] Mr. Kisliuk files printouts of two registrations and two applications for trade-marks including the word "bikini" that were disclosed by a search of the Canadian Trade-mark



Database that was conducted at his request [para. 30, Exhibit “H”]. 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)]. Even if I accept that the trade-mark registrations for BIKINI BEACH and SKINBIKINI and the allowed trade-mark application for BIKINI BAR are relevant, three trade-marks are insufficient to make any inference about the state of the marketplace.

*Surrounding circumstance: evidence of actual confusion*

[60] The Opponent’s evidence that purports to show actual instances of confusion is found from paragraphs 32 to 38 of the 2010 Lahaise affidavit accepted as proper response evidence.

[61] Ms. Lahaise’s testimony is essentially to the effect that she is personally aware of several instances of confusion over the years. However, as rightly submitted by the Applicant, there are no specifics of the number, the frequency or the timing of those cases, except for one. The one documented instance of confusion is an exchange of emails of April 2010 between the Opponent and a customer about yoga clothing that the consumer mistakenly thought having bought at the Opponent’s store in the Upper Canada Mall, one of the shopping centres where both parties operate a store; the yoga clothing had been bought at the Applicant’s store [para. 35, Exhibit “LL-8”].

[62] The Applicant did not object to the admissibility of Exhibit “LL-8” as reliable evidence of an instance of actual confusion. Rather, the Applicant submits at paragraph 34 of its written argument: “[...] this one isolated instance of actual confusion is insufficient to displace the presumption that there is no likelihood of confusion based upon the long-standing concurrent use between the [BIKINI BAY Marks] and the [Opponent’s] trade-marks.”

[63] It has often been said that an opponent needs not to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. Absence of evidence of confusion does not relieve an applicant from its burden of proof. An adverse

inference may be drawn from the lack of evidence of actual confusion where the marks have coexisted for a long period of time [see *Mattel Inc, supra* at page 347]. Whenever a long period of coexistence of the marks without any instances of confusion has been mentioned as a relevant factor, it has not been the determining factor but simply used to support the Registrar's conclusion of the absence of likelihood of confusion.

*Surrounding circumstance: family of trade-marks*

[64] The Opponent advances its family of trade-marks containing the words BIKINI VILLAGE as an additional circumstance enhancing the likelihood of confusion between the trade-marks at issue. However, I deem it not necessary to consider that additional circumstance in order to find in the Opponent's favour.

*Conclusion on the likelihood of confusion*

[65] The legal onus is on the Applicant to show that, as of today's date, its BIKINI BAY Marks are not reasonably likely to cause confusion with the Opponent's trade-mark BIKINI VILLAGE. This means that the Applicant must prove that the absence of confusion is more probable than its existence.

[66] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I conclude that the Applicant did not discharge the legal onus resting upon it. In reaching this conclusion, I have had regard to: the degree of resemblance between the trade-mark BIKINI VILLAGE and each of the BIKINI BAY Marks; the acquired distinctiveness of the trade-mark BIKINI VILLAGE and the length of time it has been in use; the identity, overlap, similarity, or relationship between the wares and services described in each application and some of the Opponent's registered wares and the Opponent's registered services; and the identity in the parties' channels of trade.

[67] Having regard to the foregoing, the registrability ground of opposition based upon registration No. TMA648,662 for the trade-mark BIKINI VILLAGE is successful with respect to each of the applications and so I will not address the remaining registered trade-marks.

### Non-Distinctiveness

[68] The pleaded ground of opposition revolves around the likelihood of confusion between the BIKINI BAY Marks and the trade-marks and trade-names alleged by the Opponent in the statement of opposition. In order to meet its initial burden, the Opponent has to show that one or more of its alleged trade-marks or trade-names had become known sufficiently as of the filing date of the statement of opposition to negate the distinctiveness of the Applicant's trade-mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[69] I am satisfied that the evidence establishes that the Opponent's trade-mark BIKINI VILLAGE had become sufficiently known as of December 1, 2008 to negate the distinctiveness of the trade-mark BIKINI BAY Design. Likewise, the evidence establishes that the Opponent's trade-mark had become sufficiently known as of December 22, 2008 to negate the distinctiveness of the trade-mark BIKINI BAY. Further in view of the evidence of record, assessing each of the section 6(5) factors as of the filing date of the statement of opposition rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of these cases.

[70] To the extent that the non-distinctiveness ground of opposition with respect to each of the applications is based upon the likelihood of confusion between the Applicant's mark and the Opponent's trade-mark BIKINI VILLAGE, I find it is successful for reasons similar to those expressed in regards to the section 12(1)(d) ground of opposition.

### Remaining Grounds of Opposition

[71] As I have already accepted the opposition to each of the applications under two grounds, I will not address the non-entitlement grounds of opposition based upon section 16(1)(a) and (c) of the Act and the ground of opposition based upon non-conformity to section 30(b) of the Act.

Disposition

[72] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application Nos. 1,376,728 and 1,378,548 pursuant to section 38(8) of the Act.

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office