

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

Citation: 2015 TMOB 110
Date of Decision: 2015-06-18

**IN THE MATTER OF AN OPPOSITION by
McGregor Industries Inc. to application
No. 1,561,670 for the trade-mark RUN
HAPPY in the name of Brooks Sports Inc.**

[1] McGregor Industries Inc. (the Opponent) opposes registration of the trade-mark RUN HAPPY (the Mark) that is the subject of application No. 1,561,670 by Brooks Sports Inc. (the Applicant).

[2] The application was filed on January 27, 2012 and covers the following goods, as revised by the Applicant during the examination of the application:

Shoes, socks, athletic footwear, shirts, pants, jackets, hats, caps, shorts, tights, jogging suits, gloves, warm up suits, headbands, T-shirts, unitards, wind resistant jackets, waterproof jackets and pants, track suits, tank tops, visors. (the Goods)

[3] The application is based on use of the Mark in Canada since at least as early as January 31, 2000 and use and registration of the Mark in the United States of America.

[4] The Opponent has opposed the application for the Mark under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), based upon various grounds revolving around the likelihood of confusion between the Mark and essentially one or more of the Opponent's "HAPPY FOOT" trade-marks, which have been previously used and registered or applied for registration in Canada by the Opponent in association with, among other goods, socks. The opposition is also based on the ground that the application for the Mark does not comply with the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in Canada in

association with one or more of the Goods set out in the application, including socks and tights, since the date of first use claimed. The detailed list of the grounds of opposition, as pleaded by the Opponent, is attached hereto under Schedule “A”. The detailed list of the trade-mark registrations and application relied upon by the Opponent is also attached hereto under Schedules “B” and “C” respectively.

[5] I find the determinative issue in this proceeding is whether the Mark is confusing with the Opponent’s registered trade-mark HAPPY FOOT.

[6] For the reasons explained below, I find that the application ought to be refused in part.

The Record

[7] The statement of opposition was filed by the Opponent on June 17, 2013. The Applicant filed and served a counter statement on July 29, 2013 denying each of the grounds of opposition set out in the statement of opposition.

[8] As its evidence, the Opponent filed an affidavit of its CEO Earl Lipson, sworn November 27, 2013 (the Lipson affidavit). Mr. Lipson was not cross-examined on his affidavit.

[9] The Applicant elected not to file evidence.

[10] Both parties filed written arguments and were represented at a hearing held on May 26, 2015.

The parties’ respective burden or onus

[11] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Analysis

Ground of opposition based on non-conformity of the application under section 30(b) of the Act

[12] As indicated above, the Opponent has pleaded that the application for the Mark does not comply with the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in Canada in association with one or more of the Goods set out in the application, including socks and tights, since the date of first use claimed, namely January 31, 2000.

[13] The relevant date for considering the circumstances in regard to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. The Opponent can meet its initial burden under section 30(b) by reference not only to its own evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, the Opponent may only successfully rely upon the Applicant's evidence to meet its initial burden if the Opponent shows that the Applicant's evidence puts into issue the claims set forth in the Applicant's application [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at paras 30-38 (CanLII)].

[14] The Opponent relies on the Lipson affidavit and accompanying Exhibit "H" to show that the Applicant has not used the Mark as applied for in Canada since the claimed date of first use, at least in connection with "socks" and "tights".

[15] More particularly, the Opponent relies on the following statements contained in the Lipson affidavit, which it submits, have not been challenged by cross-examination:

13. In the subject application, it is asserted that the [Mark] has been used in Canada in connection with all of the [Goods] since at least as early as January 31, 2000. The Opponent, which uses a large sales force spread out across Canada, and I myself are very familiar with the activities of other socks manufacturers, distributors and vendors in the hosiery field in Canada. If the Applicant had used [the Mark] in the normal course of trade in Canada as it claims, it is likely that such usage in connection with "socks" and

“tights” would have come to my attention, either directly or indirectly via the Opponent’s sales force or other personnel. No such usage was ever been brought to my attention – either as of about the year 2000 or any time thereafter.

14. In addition, I have reviewed the [A]pplicant’s website insofar as it relates to the RUN HAPPY designation. In particular, attached hereto as Exhibit “H” are printouts of various pages from such website. Pages 1 and 2 of Exhibit “H” are printouts of what appears to be the main page [...] describing the [A]pplicant’s RUN HAPPY program. It is apparent that the RUN HAPPY designation is used primarily in connection with an information service provided to runners relating to various topics of interest. A search of the website for the search terms “run happy socks” and “run happy tights” discloses no hits [...].

[16] The Applicant for its part reminds me that it is under no duty to document its date of first use unless the Opponent provides evidence to raise doubt concerning such claim of first use. It submits that the quality of that evidence is important.

[17] In the present case, the Applicant asserts that Mr. Lipson’s knowledge of the market is largely based on hearsay as he is in part relying on the Opponent’s sales force rather than first-hand knowledge. The Applicant further asserts that the excerpts from its website relied upon by the Opponent under Exhibit “H” are far from contradicting its claimed date of first use of the Mark. The Applicant draws my attention to pages numbered by hand nos. 7, 12, 17, and 19, which all display the rubric “Run Happy” on the menu bar of the pages pertaining to “Men/Apparel/Socks”, “Women/Apparel/Socks”, “Men/Apparel/Tights & Pants”, and “Women/Apparel/Tights & Pants” respectively.

[18] I am in general agreement with the Applicant.

[19] While I mindful of the fact that it is difficult for an opponent to produce evidence to show that there was no use of an applicant’s trade-mark as of the Applicant’s claimed date of first use, I am not satisfied that the Opponent has met its evidentiary burden in the present case.

[20] Mr. Lipson’s knowledge of the market has hearsay flaws, not to mention that there is no evidence that the parties’ respective goods were intended to be sold through the very same

establishments at the relevant time, or any time thereafter. This may explain why the Opponent's sales force never came across the Applicant's Goods. Also, the excerpts from the Applicant's website all postdate the relevant date for considering this ground of opposition.

[21] In view of the foregoing, the section 30(b) ground of opposition is dismissed for the Opponent having failed to meet its evidentiary burden thereof.

Ground of opposition based on non-registrability of the Mark under section 12(1)(d) of the Act

[22] As indicated in Schedule "A" hereto, the Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-marks HAPPY FOOT (UCA18614), HAPPYFOOT & Design (TMA219501), and MCGREGOR HAPPY FOOT & Design (TMA773396), the particulars of which are attached in Schedule "B" hereto.

[23] I have exercised the Registrar's discretion to confirm that each of these registrations is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[24] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-marks.

[25] Unless indicated otherwise, I will focus my analysis on registration No. UCA18614 for the word mark HAPPY FOOT, which presents the Opponent's strongest case. If the Opponent is not successful with this cited mark, it would not achieve a more favourable result with the other cited marks.

The test for confusion

[26] Section 6(2) of the Act provides that:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[27] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source.

[28] The test for confusion is one of first impression and imperfect recollection. As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); 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].

Consideration of the section 6(5) factors

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

[30] I assess the inherent distinctiveness of the parties' marks as about the same and moderate.

[31] The strength of a trade-mark may be increased by means of it becoming known through

promotion or use.

[32] There is no evidence that the Applicant's Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent in Canada.

[33] In contrast, the Lipson affidavit evidences that the Opponent's trade-mark HAPPY FOOT has been used and become known to a significant extent in Canada, as per my review below of the salient points of this affidavit.

The Lipson affidavit

[34] Since at least as early as 1937, the Opponent and its predecessor entities have continuously manufactured (or recently have had manufactured on their behalf) and sold to retailers for re-sale to the consuming public in Canada footwear or legwear – namely hosiery, in particular high quality knitted socks – in association with its HAPPY FOOT mark and the Opponent continues to do so at the present [para 4 of the affidavit].

[35] The HAPPY FOOT mark has been and continues to be prominently borne on labels which are affixed to the goods at the time of transfer in the normal course of trade in Canada. Numerous representative specimens of labels used by the Opponent and its predecessors over the years from at least about the 1950s to the present are included in Exhibits "C-1" to "C-7" [para 5 of the affidavit].

[36] The Opponent's socks sold under the HAPPY FOOT mark are and have been sold across Canada through conventional clothing retail outlets such as large national department stores (e.g. The Bay and Sears Canada and formerly Eaton's, Simpsons and Woodward's), major national chain stores (e.g. Walmart, Canadian Tire, Mark's Work Warehouse and Target Stores, and formerly K-Mart, Woolco, Zellers and Bi-Way) and junior department stores (e.g. Stedman's, MacLeod's and Field's and formerly Saan), as well as hundreds of independent retail stores [para 6 of the affidavit].

[37] The Opponent's sales of its goods sold in association with its HAPPY FOOT mark have been substantial and significant across Canada – since about 1970, in excess of a million pairs of socks each year representing millions of dollars in retail sales annually [para 7 of the affidavit].

[38] The Opponent has spent significant sums advertising and promoting socks under its HAPPY FOOT mark in Canada, both in national advertising campaigns, in coop advertising and other forms of advertising and promotion. Numerous representative specimens of typical advertisements and promotional materials used over the years, including many used before the year 2000, are included in Exhibit “D”. Each year since at least about 1970, at least many tens of thousands of dollars have been spent annually on such advertising and promotion [para 8 of the affidavit].

[39] Over the years, including before 2000, many of the retail outlets referred to above have had point of sale displays which prominently feature the HAPPY FOOT mark. Often this has taken the form of the trade-mark HAPPY FOOT appearing at the top of a fixturing rack. A photograph of a point of sale display and specimens as recently used at Canadian Tire for the Opponent’s licensed children’s products is included in Exhibit “E”. Some images of point of sale materials used in the past, including before the year 2000, are included in Exhibit “D” [para 9 of the affidavit].

[40] The Opponent also advertises and promotes its HAPPY FOOT products on its website at *www.mcgregorsocks.com*. Print-outs of screen shots from such website are included in Exhibit “F”. Some of the Opponent’s customers also promote and sell the Opponent’s HAPPY FOOT products on-line; some print-outs thereof are included in Exhibit “G” [para 13 of the affidavit].

[41] To sum up, I am satisfied from my review of the Lipson affidavit that the Opponent’s HAPPY FOOT trade-mark has become known to a very significant extent in Canada in association with socks. I wish to add in this respect that I am not affording weight to Mr. Lipson’s statement made in paragraph 12 of his affidavit, according to whom the above described sales and promotion have made the Opponent’s HAPPY FOOT socks “perhaps the best known socks in Canada, both to retailers and consumer alike.” Indeed, such statement constitutes personal opinion, which is not supported by evidence of the Opponent’s market share or some sort of independent consumer survey.

[42] The overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, thus favours the Opponent.

The length of time the trade-marks have been in use

[43] As indicated above, the Opponent's HAPPY FOOT mark has been used in Canada for decades, whereas there is no evidence that the Applicant's Mark has been used.

[44] Accordingly, this factor also favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[45] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration referred to by the Opponent [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)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[46] I agree with the Opponent that some of the Applicant's applied-for goods, namely "socks" and "tights" (and also "athletic footwear"), either directly overlap, or are similar to the Opponent's registered goods as described in Schedule B. In the absence of evidence to the contrary, there is no reason to believe that their corresponding channels of trade could not also overlap.

[47] However, with respect to the remaining goods listed in the Applicant's application, I disagree with the Opponent's position that they could be considered a natural extension of the Opponent's registered goods in the present case. The Opponent's HAPPY FOOT mark is registered with a very limited range of goods. The same holds true with respect to the other two registrations relied upon by the Opponent in support of its section 12(1)(d) ground of opposition. The evidence of use submitted by the Opponent further shows that use of the HAPPY FOOT mark has been restricted for decades to this limited range of goods only. Besides, I note that

while the Opponent’s application for the trade-mark THE HAPPYFOOT SOCK COMPANY referred to in Schedules “A” and “C” hereto, originally covered a wide variety of clothing, jewellery and accessories, it matured to registration on August 14, 2013 in association with the limited goods “clothing, namely: socks” following the filing of a declaration of use on August 2, 2013 [see paras 2 and 3 of the Lipson affidavit together with Exhibits “A” and “B” referred to therein]. To sum up, there is no evidence to support the position that the Opponent would expand its current range of products to other types of clothing goods, such as the remaining goods listed in the Applicant’s application.

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

[48] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, “the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], 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”.

[49] As previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998 CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34].

[50] In this regard, while it is true that the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece, supra*, at paragraph 64].

[51] Applying those principles to the present case, I find there is a fair degree of resemblance between the parties’ marks.

[52] Considering the descriptive character of the word FOOT in the context of the Opponent's goods, the dominant element of the trade-mark HAPPY FOOT is the word HAPPY.

[53] The same holds true for the Mark having regard to the descriptive or suggestive connotation of the word RUN in the context of the Applicant's applied-for goods, at least with respect to those that can readily be understood to be intended for physical activity, such as the ones described as "athletic footwear", "jogging suits", "warm up suits", "headbands", and "unitards".

[54] The main idea suggested by both parties' marks is that of happiness or pleasure. As acknowledged by the Applicant in its written argument, the Opponent's HAPPY FOOT mark suggests the idea that a person's foot feels pleasure, presumably when associated with the Opponent's goods, whereas the Applicant's Mark suggests that a person feels, or should feel, pleasure when she or he runs.

[55] I shall add in this regard that I find that it is not necessary to discuss the Opponent's argument according to which, in certain contexts, the word FOOT is a synonym for the word RUN, for example in the phrase "He footed it over to headquarters". The meaning to be ascribed to the word FOOT, in the context of the Opponent's HAPPY FOOT mark, cannot be other than that of a noun, as opposed to a transitive verb.

[56] Finally, the parties' marks are both made of two words and share the same number of syllables.

Additional surrounding circumstance

[57] The Applicant notes as an additional surrounding circumstance that the Opponent has adduced no evidence of any actual confusion.

[58] Transposing the comments of Board Member Tremblay in *Aspen Custom v Chrysler Group LLC*, 2011 TMON 48 (CanLII) at para 70, it has often been said that an opponent does not need to prove instances of confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion.

[59] In any event, since the evidence does not permit me to draw any meaningful conclusion as to the extent and the period of use of the Applicant's Mark, I cannot draw any meaningful conclusion with respect to the absence of actual confusion. Indeed, in the absence of evidence showing that the parties' goods did in fact coexist in the marketplace, the absence of evidence of actual confusion is not surprising.

Conclusion regarding the likelihood of confusion

[60] In view of my analysis above, and except for the goods described below in paragraph 63, I arrive at the conclusion that the Applicant has not discharged the ultimate onus upon it to show that there is no reasonable likelihood of confusion between the Mark in association with the goods "socks", "athletic footwear" and "tights" and the Opponent's registered goods.

[61] In reaching this conclusion, I have had special regard to the following facts: i) by reason of its long and extensive use in association with socks over seven decades in Canada, the Opponent's HAPPY FOOT mark has acquired a very significant reputation; ii) there is a fair degree of resemblance between the parties' marks in appearance and sound and in the ideas suggested by them; and iii) there is a clear overlap between these particular goods of the Applicant and the Opponent's registered goods.

[62] Accordingly, the section 12(1)(d) ground of opposition succeeds, except for the goods described below in paragraph 63.

[63] However, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark in association with the remaining applied-for goods and the Opponent's registered goods, as these goods differ substantially from the Opponent's, and as the reputation of the Opponent's HAPPY FOOT mark has been restricted to the very limited range of goods consisting of socks and there is no reason to believe that this could change:

Shoes, [...] shirts, pants, jackets, hats, caps, shorts, [...], jogging suits, gloves, warm up suits, headbands, T-shirts, unitards, wind resistant jackets, waterproof jackets and pants, track suits, tank tops, visors.

[64] Accordingly, the section 12(1)(d) ground of opposition succeeds partially insofar as it is based on registration No. UCA018614.

[65] As registration No. UCA018614 presented the Opponent's strongest case, I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to the other pleaded registrations.

The non-entitlement grounds of opposition

[66] As indicated in Schedule "A" hereto, the Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark within the meaning of sections 16(1)(a), (2)(a), (2)(b) and (2)(c) of the Act.

The non-entitlement grounds of opposition based on sections 16(1)(a) and (2)(a)

[67] An opponent meets its evidentiary burden with respect to a section 16(1)(a) or (2)(a) ground if it shows that as of the date of first use claimed in the applicant's application or the date of filing of the applicant's application, as the case may be, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application. As per my review above of the Lipson affidavit, the Opponent has met its evidentiary burden at least insofar as its HAPPY FOOT mark in association with socks is concerned.

[68] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[69] The non-entitlement grounds of opposition based on sections 16(1)(a) and (2)(a) of the Act therefore succeed partially with respect to the goods "socks", "athletic footwear" and "tights". They are otherwise dismissed with respect to the remaining applied-for goods of the Applicant.

[70] As the Opponent's word mark HAPPY FOOT presented the Opponent's strongest case, I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to the other pleaded marks under section 16(1)(a) and (2)(a) of the Act.

The non-entitlement ground of opposition based on section 16(2)(b)

[71] An opponent meets its evidentiary burden with respect to a section 16(2)(b) ground if it shows that its application was filed prior to the date of filing of the Applicant's application and was pending when the Applicant's application was advertised [section 16(4) of the Act]. The Opponent has met its evidentiary burden.

[72] However, I am satisfied that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark in association with all of the Goods and the Opponent's goods as they were described in the Opponent's pending application as of the relevant date. Indeed, I agree with the Applicant that the differences existing between the Mark and the Opponent's MCGREGOR HAPPY FOOT mark are amply sufficient by themselves to avoid a likelihood of confusion. Suffice it to say that the element MCGREGOR, if not the dominant element of the Opponent's mark MCGREGOR HAPPY FOOT, is at least as equally dominant as the word HAPPY.

[73] The non-entitlement ground of opposition based on sections 16(2)(b) of the Act is therefore dismissed.

The non-entitlement ground of opposition based on section 16(2)(c)

[74] An opponent meets its evidentiary burden with respect to a section 16(2)(c) ground if it shows that as of the date of filing of the applicant's application, its trade-name had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application. I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to its trade-name THE HAPPYFOOT SOCK COMPANY.

[75] Indeed, even if I were to assume that the Opponent has met its evidentiary burden with respect to this ground of opposition, I would still find that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark in association with all of the Goods and the Opponent's trade-name owing to the major differences existing between the Mark and the Opponent's trade-name THE HAPPYFOOT SOCK COMPANY.

[76] The non-entitlement ground of opposition based on sections 16(2)(c) of the Act is therefore dismissed.

The non-distinctiveness ground of opposition

[77] As indicated in Schedule “A” hereto, the Opponent has pleaded that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish, nor is it adapted to distinguish the Goods of the Applicant from the goods of the Opponent.

[78] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case June 17, 2013) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Lipson affidavit, the Opponent has met its evidentiary burden at least insofar as its HAPPY FOOT mark in association with socks is concerned.

[79] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[80] The non-distinctiveness grounds of opposition therefore succeeds partially with respect to the goods “socks”, “athletic footwear” and “tights”. It is otherwise dismissed with respect to the remaining applied-for goods of the Applicant.

[81] As the Opponent’s word mark HAPPY FOOT presented the Opponent’s strongest case, I find it is not necessary to determine whether the Opponent has met its evidentiary burden with respect to the other pleaded marks under the non-distinctiveness ground of opposition.

Disposition

[82] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act for the goods “socks”, “athletic footwear” and “tights”.

[83] However, I reject the opposition under section 38(8) of the Act for the following goods:

Shoes, [...] shirts, pants, jackets, hats, caps, shorts, [...], jogging suits, gloves, warm up suits, headbands, T-shirts, unitards, wind resistant jackets, waterproof jackets and pants, track suits, tank tops, visors.

[See *Produits Menager Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"


Grounds of opposition as pleaded by the Opponent

- a) The application does not conform to the requirements of section 30. In particular, without limitation, the Applicant has not used the [Mark] in Canada in connection with one or more of the [Goods] set out in the application (including without limitation socks and tights) since the stated date of first use (namely January 31, 2000), contrary to the provisions of section 30(b);
- b) The [Mark] is not registrable in view of the provisions of section 12(1)(d). In particular, the [Mark] is not registrable because it is confusing with the Opponent's registered trade-marks no. UCA18614 for the word mark HAPPY FOOT, no. TMA219501 for the mark HAPPYFOOT & Design and no. TMA773396 for the MCGREGOR HAPPY FOOT & Design. Copies of said registrations are included [...] hereto;
- c) The Applicant is not the person entitled to registration of the [Mark] in view of the provisions of section 16(1)(a), because at the date of the Applicant's alleged first use (namely January 31, 2000), the [Mark] was then and is now confusing with the Opponent's trade-marks HAPPY FOOT and HAPPYFOOT (herein "HAPPY FOOT Marks) previously used in Canada by the Opponent and its predecessors in connection with clothing including legwear and footwear such as socks, tights and hosiery. The Opponent's HAPPY FOOT Marks have never been abandoned, either as of the date of advertisement of the subject application or ever;
- d) The Applicant is not the person entitled to registration of the [Mark] in view of the provisions of section 16(2)(a), because at the date of filing of the application (namely January 27, 2012), the [Mark] was then and is now confusing with the Opponent's HAPPY FOOT Marks and the trade-mark MCGREGOR HAPPY FOOT, all previously used in Canada by the Opponent and its predecessors in connection with clothing including legwear and footwear such as socks, tights and hosiery. None of Opponent's said marks have ever been abandoned, either as of the date of advertisement of the subject application or ever;
- e) The Applicant is not the person entitled to registration of the [Mark] in view of the provisions of section 16(2)(b), because at the date of filing of the application (namely January 27, 2012), the [Mark] was then and is now confusing with the Opponent's trade-mark application no. 1408591 for the trade-mark THE HAPPYFOOT SOCK COMPANY ("Opponent's Pending Application") previously filed in Canada by the Opponent in connection with a wide variety of clothing, jewellery and accessories, as specified in detail therein. A copy of said application is included [...] hereto. The Opponent's Pending Application was pending as of the date of advertisement of the subject application and remains pending;
- f) The Applicant is not the person entitled to registration of the [Mark] in view of the provisions of section 16(2)(c), because at the date of filing of the application (namely

January 27, 2012), the [Mark] was then and is now confusing with the Opponent's trade-name THE HAPPYFOOT SOCK COMPANY ("Opponent's Trade-Name") previously used in Canada by the Opponent in connection with the operation of a business relating to the manufacture and sale of clothing including legwear and footwear such as socks, tights and other hosiery. The Opponent's Trade-Name has never been abandoned, either as of the date of advertisement of the subject application or ever;

- g) The [Mark] is not distinctive within the meaning of section 2. In particular, the [Mark] does not actually distinguish, and is not adapted to distinguish, the [Goods] in association with which it is alleged to have been used by the Applicant from those of others – namely the clothing and other wares of the Opponent when sold or offered for sale under one or more of its HAPPY FOOT Marks and its marks MCGREGOR HAPPY FOOT and THE HAPPYFOOT SOCKS COMPANY or as part of a business operated by the Opponent under the Opponent's Trade-Name.

Schedule "B"

Trade-mark	Reg. No.	Reg. date	Goods/Claim(s)
HAPPY FOOT	UCA018614	1943-11-09	Knitted footwear Date of first use in Canada January 2, 1937
HappyFoot	TMA219501	1977-03-18	Hosiery Used in Canada since at least as early as 1971
	TMA773396	2010-07-30	(1) Clothing, namely: legwear, namely hosiery and socks. (2) Clothing, namely: legwear, namely leggings, tights. Used in CANADA since at least as early as September 2006 on goods (1). Declaration of Use filed July 7, 2010 on goods (2).

Schedule "C"

Trade-mark	Appl'n. No.	Appl'n. date	Goods/Claim(s)* *As of the advertisement date of the Applicant's application for the Mark
THE HAPPYFOOT SOCK COMPANY	1408591	2013-08-14	(1) Clothing, namely: legwear, namely hosiery, socks, leggings, tights, pantyhose, stockings, gaiters; loungewear and sleepwear [...]; underwear, lingerie, intimate apparel for women; pants, jeans, shorts; shirts including [...]; sweaters, cardigans; dresses [etc.]; (2) Jewelry, including [...] (3) Fashion accessories, namely [...] Proposed use in Canada