



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

**Citation: 2014 TMOB 143**  
**Date of Decision: 2014-07-14**

**IN THE MATTER OF AN OPPOSITION  
by William Adams to application  
No. 1,459,682 for the trade-mark I AM &  
Design in the name of Sven Bullaert**

[1] William Adams opposes registration of the trade-mark I AM & Design (the Mark), shown below, applied for registration under serial No. 1,459,682 in association with, among others, purses, wallets and goods made of leather and imitations of leather, clothing, footwear and headgear. The full statement of wares of the application is reproduced in annex.



[2] The application was filed by Sven Bullaert (the Applicant) on November 19, 2009. It is based on registration of the Mark in the Benelux Office for IP and use of the Mark in Belgium.

[3] The statement of opposition was filed by William Adams (the Opponent) on February 28, 2012. There were five grounds of opposition alleged in the originally filed statement of opposition. However, further to an interlocutory ruling issued on June 21, 2012, there are four grounds of opposition that remain to be decided.

[4] The first two grounds of opposition are premised on allegations that the application does not comply with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The two others grounds of opposition are premised on allegations of confusion between the Mark and the

Opponent's trade-mark I AM alleged to have been used and made known in Canada by the Opponent in association with, among others, the same wares than those associated with the Mark.

[5] In support of his opposition, the Opponent filed his own affidavit and an affidavit of Paul Alexander Bost.

[6] The Applicant did not conduct cross-examination and elected not to file evidence in support of his application.

[7] Only the Opponent filed a written argument and was represented at the hearing.

[8] Despite the Applicant's apparent lack of interest in this proceeding, for the reasons that follow, I find that the opposition ought to be rejected.

#### Legal Onus and Evidential Burden

[9] The legal onus is on the Applicant to show that the 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 his 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), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

#### Analysis of the Issues

[10] There are four issues that arise from the grounds of opposition, namely:

1. Did the Applicant specifically define in ordinary commercial terms all of the wares identified in the application?

2. Did the Applicant use the Mark in Belgium as of the filing date of the application?
3. Was the Applicant the person entitled to the registration of the Mark as of the filing date of the application?
4. Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?

[11] I will analyze each of these issues in turn.

*Did the Applicant specifically define in ordinary commercial terms all of the wares identified in the application?*

[12] This issue arises from the ground of opposition alleging that the application does not comply with section 30 of the Act because the statement of wares contained in the application does not describe specific wares as required by the Act. While the pleading does not specify which subsection of section 30 is relied on, it is apparent that it is section 30(a) of the Act.

[13] The material date for considering a ground of opposition based upon non-compliance with section 30 of the Act is the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. However, in a case where the statement of wares was amended during prosecution of the application, as in this case, the date of the amended application could be considered as the material date to assess the section 30(a) ground of opposition [see *Eaton Williams (Millbank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB) at 77].

[14] There are two issues to be determined under a section 30(a) ground of opposition, namely, whether the statement of wares is in ordinary commercial terms and whether it adequately identifies the specific wares or services [see *Whirlpool SA v Eurotherm Holdings Limited*, 2010 TMOB 171 (CanLII) at para 39]. Further, an opponent's initial evidential burden under section 30(a) is a light one and may be met simply through sufficient argument [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104].

[15] The Opponent did make submissions in his written argument about this ground of opposition, but only for the wares “leather and imitations of leather, and goods made of these (*sic*) materials namely *animal skins* ...” (my emphasis). More particularly, the Opponent submits that “animal skins” are not leather, imitations of leather or goods made of leather or imitations of leather. They are the outer covering of animals. Thus the wares “animal skins” are not a subset of “leather and imitations of leather, and goods made of these (*sic*) materials” as stated in the application. Accordingly, the statement of wares does not refer to the wares in ordinary commercial terms.

[16] For the reasons that follow, the Opponent did not convince me that the description of wares “leather and imitations of leather, and goods made of these (*sic*) materials namely animal skins...” does not comply with section 30(a) of the Act.

[17] In assessing the Opponent’s submissions, I have referred myself to the *Wares and Services Manual* of the Canadian Intellectual Property Office (the Manual). In that regard, I note that the Registrar has referred to the Manual to assess a section 30(a) ground of opposition in opposition proceedings [see, for example, *Royal Scenic Holidays Ltd. v. Scenic Holidays (Vancouver) Ltd.*, 2010 TMOB 36 (CanLII)]. The Manual contains a representative listing of acceptable wares. Also, listings found in the Manual can be used to indicate by analogy the kind of specification that will be acceptable for wares not covered by the Manual.

[18] The Manual lists the wares “leather” as acceptable without further specification. The Manual does not list the wares “imitations of leather”, but does list “imitation animal skin fabrics” as acceptable without further specification. In my view, the wares “imitations of leather” are analogous to the wares “imitation animal skin fabrics”. Thus, based on a plain reading of the statement of wares, I find it is reasonable to conclude that the Applicant chose “animal skins” to specify “goods made of these (*sic*) materials” rather than “leather and imitations of leather”.

[19] As I may refer myself to dictionaries, I note that according to the *Canadian Oxford Dictionary*, the first definition attaching to the term “leather” is “material made from the skin of animal by tanning or a similar process”. Since leather can be made from the skin of animal, I see nothing incoherent or inconsistent in specifying goods made of leather and imitations of leather by using the term “animal skins”. I would reach the same conclusion if I were to consider

“animal skins” as specifying the entirety of the wares “leather and imitations of leather, and goods made of these (*sic*) materials” identified in the application for the Mark.

[20] Accordingly, I dismiss the ground of opposition for the Opponent’s failure to meet his evidential burden.

*Did the Applicant use the Mark in Belgium as of the filing date of the application?*

[21] This issue arises from the ground of opposition alleging that the application does not comply with section 30 of the Act because the Mark has not been used in Belgium in association with all of the wares set forth in the application, or at all. While the pleading does not specify which subsection of section 30 is relied on, it is apparent that it is section 30(d) of the Act.

[22] To the extent that an applicant has easier access to the facts, the burden of proof on an opponent with respect to this ground of opposition is less onerous [*105272 Canada Inc v Grands Moulins de Paris, SA* (1990), 31 CPR (3d) 79 (TMOB)].

[23] As evidence in support of this ground of opposition, the Opponent relies on the affidavit of Mr. Bost, sworn on August 22, 2012. More particularly, the Opponent relies on the following statements of Mr. Bost, who resides in the United States and is an associate at the law firm of Sheppard Mullin Richter & Hampton LLP, counsel for the Opponent:

3. I am of information and belief that a search was conducted in Belgium by our European counsel and use of the mark I AM by Sven Bullaert was not found in Belgium in association with all of the wares set forth in Canadian trade mark application serial number 1,459,682.

[24] I disagree with the Opponent that this evidence is sufficient for discharging his initial burden, no matter how light it is.

[25] The statements made by Mr. Bost on the basis of information received from a third party are *prima facie* inadmissible hearsay evidence. Further, I find that the evidence does not satisfy the criteria of necessity and reliability, which determine the weight to be accorded to it [see *Labatt Brewing Company Limited v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. Indeed, Mr. Bost does not explain why the European counsel could not have provided

the evidence. Moreover, Mr. Bost does not explain why the evidence he is attesting to should be considered reliable. There is no information about the “search” conducted by the European counsel, even less information for inferring that it addressed the issue of use of the Mark in Belgium as of November 19, 2009.

[26] Accordingly, the ground of opposition is dismissed for the Opponent’s failure to meet his evidential burden.

*Was the Applicant the person entitled to the registration of the Mark as of the filing date of the application?*

[27] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark in view of confusion with the Opponent’s trade-mark I AM allegedly used and made known in Canada by the Opponent since at least as early as June 2009. Although not specified in the pleading, the ground of opposition is based upon section 16(2)(a) of the Act.

[28] Despite the legal onus resting on the Applicant, the Opponent has the initial burden of establishing that his alleged trade-mark I AM had been used or made known in Canada prior to the filing date of the application for the Mark, i.e. November 19, 2009, and had not been abandoned at the date of advertisement of the application [section 16(5) of the Act].

[29] The Opponent has not made any submissions to the effect that his evidence shows that his trade-mark I AM had been “made known” in Canada prior to November 19, 2009 within the definition of “made known” set out in section 5 of the Act. However, the Opponent contends that his own affidavit, sworn on August 23, 2012, evidences the use of his trade-mark I AM in Canada prior to November 19, 2009 and its non-abandonment. Thus, I shall review the Opponent’s own affidavit.

[30] The Opponent affirms, among others, that:

- he is professionally known in Canada and throughout the world as will.i.am, which is his stage name;
- he is globally recognized as a performer, musician, entertainer, songwriter, producer, philanthropist and entrepreneur;
- he is the front man of the Grammy-award winning musical group The Black Eyed Peas;
- he first used the trade-mark I AM on clothing in 2000 and he wore clothing bearing the trade-mark in public;
- in early 2009, he decided to launch a men's wear collection "under the i.am clothing label in collaboration with i.am je suis inc., a division of a Montreal-based company known as Manhattan International";
- he first used the trade-mark I AM for clothing in Canada in June 2009 and officially launched the line at the MAGIC trade show in Las Vegas in September 2009;
- he owns the domain name *iamclothing.net*, which hosts a website dedicated to his "i.am clothing label"; and
- he was interviewed on the television programs *Entertainment Tonight Canada* and CTV's *eTalk* regarding his "i.am clothing line in 2009".

[para 2-4 of the affidavit]

[31] The Opponent did not file any documentary exhibits to support his assertions of use of the trade-mark I AM in association with clothing, which was acknowledged by the Opponent's agent at the hearing. However, the Opponent's agent reiterated the submissions found in the Opponent's written argument based on the absence of cross-examination. More particularly, the Opponent submits that his assertions of use of the trade-mark I AM in Canada must be taken as true because they have not been challenged by the Applicant.

[32] An analogous argument was addressed by Member Carrière in *H-D Michigan Inc v The MPH Group Inc.* (2004), 40 CPR (4th) 245 (TMOB). I make mine the following comments of Member Carrière at page 254:

... [A]ccording to the Opponent, if statements are unchallenged by the other party, they should be taken as is. I can't subscribe to such theory. One should not lose track of the fact that the term "use" is a legal term defined in Section 4 of the Act. If the Opponent based its opposition on the ground that the applicant is not the person entitled to registration because, at the time of filing of the application, the trade-mark applied for was confusing with a trade-mark previously used in Canada, as set out in Section 16 of the Act, we must refer to Section 4 of the Act for the meaning of such term. Reference to such Section to determine if there has been proper evidence of "use" of a trade-mark is not uncommon in opposition proceedings. [See for example *Bombardier Ltd. v. British Petroleum Co. Ltd.*, *Bombardier Ltd. v. British Petroleum Co. Ltd.*, (1973), 10 C.P.R. (2d) 21, *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R.(2d) 183 and *Hughes Aircraft Co. v. Fairchild Camera & Instrument Corp.* (1990), 33 C.P.R. (3d) 500]. The Applicant may have decided not to challenge the statements contained in the Opponent's affidavits on the basis that they didn't constitute proper evidence of use as argued in its written submissions.

[33] It was the responsibility of the Opponent to file evidence enabling me to conclude that he had *in fact* used or made known his alleged trade-mark I AM in Canada in association with clothing before November 19, 2009. The Opponent failed to do so.

[34] Accordingly, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.

*Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?*

[35] This issue arises from the ground of opposition alleging non-distinctiveness of the Mark and premised on an allegation of confusion between the Mark and the Opponent's trade-mark I AM.

[36] The Opponent has failed to provide evidence showing that, as of February 28, 2012, his alleged trade-mark had become known to any extent in Canada to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[37] Accordingly, the ground of opposition is dismissed for the Opponent's failure to meet his evidential burden.



Disposition

[38] Having dismissed every ground of opposition, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

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

## **Annex**

### Statement of Wares of Application No. 1,459,682 (as amended on March 31, 2011)

Leather and imitations of leather, and goods made of these (*sic*) materials namely animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; Clothing namely athletic clothing, casual clothing; clothing for men, women and children, namely shirts, t-shirts, belts, jackets, coats, tank tops, vests, blouses, jerseys (clothing), bottoms (clothing), shorts, pants, trousers, boxer shorts, dresses, skirts, ties, scarves, bandanas, night gowns, night shirts, pyamas (*sic*), loungewear, socks, sweaters, sweatshirts, scarves, aprons; footwear namely slippers, sports footwear, infant footwear, casual footwear; headgear namely hats, caps and sun visors.