



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

**Citation: 2017 TMOB 3
Date of Decision: 2017-01-12**

IN THE MATTER OF AN OPPOSITION

Valhalla Pure Outfitters Inc.	Opponent
and	
Pure Licensing Limited	Applicant
1,571,627 for PURE & CIRCULAR Design	Application

Introduction

[1] Valhalla Pure Outfitters Inc. (the Opponent) opposes registration of the trade-mark PURE & CIRCULAR Design (the Mark), shown below, applied for registration under serial No. 1,571,627 in the name of Pure Licensing Limited (the Applicant).



[2] The Mark has been applied for registration in association with clothing goods and wholesale and retail sales of clothing goods, as more fully described below. The determinative

issue in this proceeding is whether the Mark is confusing with four trade-marks comprising the term PURE and registered by the Opponent in association with garments and camping equipment as well as the operation of retail outlets selling garments, camping and sporting equipment and accessories, as more fully described below.

[3] For the reasons that follow, I find that the application ought to be refused.

The Record

[4] The application was filed on April 3, 2012 on the basis of proposed use of the Mark in Canada. The statement of goods and services of the application, last amended on July 16, 2013, reads as follows:

Goods: Yoga wear; exercise wear; sports wear (*sic*); T-shirts; pants; sweat pants; sweat shirts; shorts; tank tops; tights; bathing suits; beachwear; belts; bibs; underwear; sweaters; Halloween costumes; dresses; gloves; hats; caps; hosiery; infant wear; jackets; mittens; pajamas; shirts; sleepers; socks; vests; jerseys; scarves; neckties; robes; night shirts; night gowns; head bands; wrist bands; skirts; coats; leotards; leg warmers; stockings; panty hose; rainwear (the Goods).



Services: Online wholesale and retail services of clothing, headgear, yoga wear, exercise wear, sportswear, T-shirts, pants, sweat pants, sweat shirts, shorts, tank tops, tights, bathing suits, beachwear, belts, bibs, underwear, sweaters, Halloween costumes, dresses, gloves, hats, caps, hosiery, infant wear, jackets, mittens, pajamas, shirts, sleepers, socks, vests, jerseys, scarves, neckties, robes, night shirts, night gowns, head bands, wrist bands, skirts, coats, leotards, leg warmers, stockings, panty hose, rainwear; retail store sales of clothing, headgear, yoga wear, exercise wear, sportswear, T-shirts, pants, sweat pants, sweat shirts, shorts, tank tops, tights, bathing suits, beachwear, belts, bibs, underwear, sweaters, Halloween costumes, dresses, gloves, hats, caps, hosiery, infant wear, jackets, mittens, pajamas, shirts, sleepers, socks, vests, jerseys, scarves, neckties, robes, night shirts, night gowns, head bands, wrist bands, skirts, coats, leotards, leg warmers, stockings, panty hose, rainwear (the Services).

[5] The application was advertised in the *Trade-marks Journal* of December 25, 2013.

[6] The statement of opposition was filed on February 7, 2014.

[7] Generally speaking, the grounds of opposition raised under section 38(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) allege that: (i) the application does not comply with the requirements of section 30 of the Act; (ii) the Mark is not registrable under section 12(1)(d) of

the Act; (iii) the Applicant is not the person entitled to registration under section 16(3)(a) of the Act; and (iv) the Mark is not distinctive under section 2 of the Act. Most of the grounds of opposition are premised on allegations of confusion between the Mark and the following four registered trade-marks of the Opponent (collectively referred to in the statement of opposition as the PURE trade-marks):

<u>Trade-mark</u>	<u>Registration No.</u>
PURE OUTSIDE	TMA836,193
PURE OUTDOORS	TMA836,186
	TMA836,188
	TMA401,341

[8] Unless indicated otherwise, I will also subsequently refer to the Opponent’s alleged trade-marks collectively as the PURE trade-marks.

[9] Each of the PURE trade-marks is registered in association with:

Goods: Garments, namely, T-shirts, sweatshirts, sweatpants, shorts, slacks, tights, cycle shorts, sweaters, fleece tops and bottoms, underwear tops and bottoms, thermal underwear tops and bottoms, shell jackets, shell pants, insulated jackets, insulated pants, insulated hats, raincoats, waterproof pants, cotton pants, stretch pants, denim pants, denim shirts, denim jackets, skipants, skijackets, golf shirts, golf hats, socks; camping equipment, namely, sleeping bags, backpacks, tents, hiking boots (the Opponent’s Goods).

Services: Operation of retail outlets selling garments, camping equipment and accessories, sporting equipment and accessories (the Opponent’s Services).

[10] The Applicant filed a counter statement denying each and every allegation in the statement of opposition.

[11] The Opponent filed certified copies of its trade-mark registrations as its evidence in chief, and an affidavit of Amanda Hughes as its reply evidence.

[12] The Applicant's evidence consists of a statutory declaration of Yeung Wing Tai Charlie (I understand that Yeung is the surname of the witness), and an affidavit of April Smith.

[13] None of the affiants was cross-examined.

[14] Each party filed a written argument. Only the Applicant was represented at the hearing, where it corrected a typographical error in its written argument (the word "Opponent" in the second line of paragraph 40 should have read "Applicant").

Material Dates

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

- sections 38(2)(a)/30 of the Act - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(b)/12(1)(d) of the Act – 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(3)(a) of the Act – the filing date of the application [section 16(3) of the Act]; and
- sections 38(2)(d)/2 of the Act (non-distinctiveness) – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

Legal Onus and Evidential Burden

[16] The legal onus is on the Applicant to show, on a balance of probabilities, 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 initial

evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

Evidence

[17] I will provide below an overview of the parties' evidence along with preliminary remarks.

Opponent's Evidence in Chief

[18] As indicated before, the Opponent's evidence in chief is restricted to certified copies of its registrations for the PURE trade-marks.

[19] Accordingly, the Opponent's pleading that it owns a family of trade-marks is not born out by the evidence. Suffice it to say that in order to rely on a family of marks, an opponent must prove use in Canada of each mark of the alleged family [see *McDonald's Corp v Yogi Yogurt* (1982), 66 CPR (2d) 101 (FCTD)].

Applicant's Evidence

Statutory declaration of Yeung Wing Tai Charlie, dated December 24, 2014

[20] Mr. Yeung identifies himself as the Financial Controller of Pure Group, which he says consists of Pure International Holdings (BV) Ltd., and its wholly-owned subsidiaries the Applicant and Pure Retail Ltd.

[21] Mr. Yeung furnishes evidence with respect to registrations and applications owned worldwide by the Applicant for "trade-marks that contain the word PURE" [Exhibits "B" to "H"]. Except for the Canadian registration for the trade-mark PURE YOGA & Design, I will

not further discuss this part of Mr. Yeung's evidence because it is not relevant in assessing the grounds of opposition at issue.

[22] Mr. Yeung explains that the clothing associated with the Mark is manufactured in China and Taiwan under the control of the Applicant; the Mark is applied on labels and tags attached to the items of clothing. Photographs of clothing items and one actual clothing item are furnished as specimens of use of the Mark [Exhibit "I"]. Also furnished as exhibits to his declaration are copies of the Fall/Winter 2014 catalogue for clothing sold under the Mark, and the Order Form used by buyers for the Fall/Winter 2014 collection of clothing sold under the Mark [Exhibits "J" and "K"].

[23] I accept that the specimens provided as Exhibit "I" show the Mark as applied for registration. In this regard, I disagree with the Opponent's written representations that "when a circular design is used, the CIRCLE DESIGN differs from that of the applied for mark". I would add that since the Opponent was not represented at the hearing, I could not obtain clarification for the basis of its contention. That being said, Mr. Yeung makes no reference to the use of the Mark in Canada, nor does he furnish any evidence to show Canadian sales of clothing in association with the Mark. This was acknowledged by the Applicant at the hearing.

[24] Lastly, Mr. Yeung files pages from the website *www.be-pure.com* which he states is "operated for Pure Retail Ltd" [Exhibit "L"]. These pages are provided to show online advertising of the clothing associated with the Mark as well as the addresses of retail stores operated by Pure Retail Ltd., in Asia. Mr. Yeung states that the Mark appears on the website with the permission of the Applicant.

[25] I note that the website pages were apparently printed on December 22, 2014. At the hearing, I had an exchange with the Applicant regarding the evidentiary value of the website pages as well as Mr. Yeung's reference to the website being operated "for Pure Retail Ltd." However, there is no need to further discuss my exchange with the Applicant since the latter ultimately acknowledged that it did not provide any data with respect to Canadian visitors to the website.

Affidavit of April Smith, dated January 5, 2015

[26] Ms. Smith, a Legal Administrative Assistant and IP Record Clerk employed by the Applicant's trade-marks agent firm, files materials that she obtained following instructions received on December 22, 2014, namely:

- dictionary definitions for the word "pure" [Exhibits "A" and "B"];
- particulars of the Applicant's registration No. TMA774,910 of August 18, 2010 for the trade-mark PURE YOGA & Design [Exhibit "C"];
- pages from the website *www.be-pure.com* [Exhibit "D"];
- pages from the website *www.gapcanada.ca* that she accessed to "search for Pure Body clothes", as well as the actual "Pure Body' long sleeve V-neck shirt" that she purchased through the website and received from *gapcanada.ca* [Exhibits "E" and "F"]; and
- pages from the website *www.sears.ca* that she accessed "to find and buy PURE NRG ATHLETICS clothing", as well as the actual pair of PURE NRG ATHLETICS shorts that she purchased through the website and received from Sears [Exhibits "G" and "H"].

[27] In my view, Ms. Smith provides no opinions that ought to be excluded from consideration pursuant to *Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada*, 2005 FC 1254, 43 CPR (4th) 21, upheld by 2006 FCA 133, 53 CPR (4th) 286. Accordingly, I find her affidavit to be admissible evidence. However, as I will discuss below, the evidence provided by Ms. Smith does not assist the Applicant in the present case.

Opponent's Reply Evidence

Affidavit of Amanda Hughes dated January 30, 2015.

[28] Ms. Hughes is a Patent and Trade-mark Clerk employed by the Opponent's trade-marks agent firm. She files a notice issued by the Registrar under section 45 of the Act on

January 15, 2015 with respect to the Applicant's registration No. TMA774,910 for the trademark PURE YOGA & Design [Exhibit "A"].

[29] The fact that a section 45 notice issued against registration No. TMA774,910 is ultimately irrelevant to the issue before me. Thus, it is not necessary to discuss whether Ms. Hughes' affidavit qualifies as reply evidence.

[30] By the same token, I would add that its ownership of registration No. TMA779,910 does not give the Applicant the automatic right to the registration of the Mark [see *Mister Coffee Services Inc v Mr Coffee Inc* (1999), 3 CPR (4th) 405 (TMOB) at 416, upheld by 2001 FCT 1218, 16 CPR (4th) 53]. Thus, I will not further discuss registration No. TMA779,910.

Grounds of Opposition Summarily Dismissed

[31] Given the evidence of record, or lack thereof, the grounds of opposition alleging that the application does not comply with the requirements of sections 30(e), 30(h) and 30(i) of the Act, the non-entitlement ground of opposition, and the non-distinctiveness ground of opposition are summarily dismissed for the reasons that follow.

Non-compliance with the Requirements of Section 30 of the Act

[32] The grounds of opposition alleging that the application does not comply with the requirements of sections 30(e), 30(h) and 30(i) are dismissed either because they have been improperly pleaded or because the Opponent has failed to discharge its initial evidential burden.

Section 30(e) of the Act

[33] The Opponent has pleaded that the Applicant does not intend to use the Mark either by itself or through a licensee.

[34] The ground of opposition, as pleaded, does not raise a proper ground of opposition in that the Opponent has not pleaded any material facts in respect thereof. Alternatively, there is no evidence establishing that the Applicant falsely made the statement required by section 30(e) of the Act as of April 3, 2012,

Section 30(h) of the Act

[35] Section 30(h) of the Act requires an applicant to include a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed, unless the application is for a word or words not depicted in a special form. The Opponent has pleaded that the application for the Mark “does not contain an accurate and clear drawing of the trade-mark for which registration is being sought”.

[36] The ground of opposition, as pleaded, does not raise a proper ground of opposition in that the Opponent has not pleaded any material facts in respect thereof. Alternatively, there is no evidence for me to conclude that the application did not contain an accurate representation of the Mark intended to be used in Canada as of April 3, 2012.

Section 30(i) of the Act

[37] The Opponent has pleaded that the Applicant cannot be satisfied that it is entitled to use the Mark in Canada in association with the Goods and Services given the prior use of the Opponent’s PURE trade-marks.

[38] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Mere knowledge of the existence of a trade-mark alleged by an opponent does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the trade-mark [see *Woot, Inc v WootRestaurants Inc Inc*, 2012 TMOB 197]. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant’s statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. This is not such a case.

Non-entitlement Ground of Opposition

[39] The ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act is dismissed for the Opponent’s failure

to meet its initial evidential burden. More particularly, the Opponent has failed to show use of any of its alleged PURE trade-marks in Canada, within the meaning of section 4 of the Act, before April 3, 2012.

Non-distinctiveness Ground of Opposition

[40] The ground of opposition alleging that the Mark is not distinctive under section 2 of the Act is dismissed for the Opponent's failure to meet its initial evidential burden. More particularly, the Opponent has failed to show that any of its alleged PURE trade-marks had become known in Canada as of February 7, 2014 so as to negate the distinctiveness of the Mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

Analysis of the Remaining Ground of Opposition

[41] The ground of opposition that remains to be decided alleges that the Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's registrations for its PURE trade-marks (TMA836,193, TMA836,186, TMA836,188 and TMA401,341).

[42] Having exercised the Registrar's discretion, I confirm that each pleaded registration is extant for the Opponent's Goods and Opponent's Services. Since the Opponent has met its initial evidential burden, the question becomes whether the Applicant has met its legal onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with any of the Opponent's alleged registered trade-marks.

[43] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates 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.

[44] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the

inherent distinctiveness of the trade-marks 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. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

[45] In my view, the Opponent's trade-marks PURE OUTSIDE (TMA836,193) and PURE OUTDOORS (TMA836,186) present its best chances of success as I find them more similar to the Mark than the trade-marks VALHALLA PURE OUTFITTERS & Design (TMA836,188) and VALHALLA PURE & Design (TMA401,341). Accordingly, I will focus my assessment of the surrounding circumstances of this case by comparing the Mark with the trade-marks PURE OUTSIDE and PURE OUTDOORS.

[46] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis by considering that factor. I will do the same.

Section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[47] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks.

[48] The first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)]. At paragraph 64 of the *Masterpiece* decision, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[49] The Applicant describes the Mark as consisting of the stylized word PURE bordered by two opposing and unconnected segments of a circle. I agree with this description. However, I do not consider the “two opposing and unconnected segments” to be particularly striking or unique. They essentially form a geometrical shape akin to a circle. Thus, I find that the word PURE in the Mark is more important for the purposes of distinction.

[50] Similarly, as I do not consider the words OUTSIDE and OUTDOORS in the Opponent’s trade-marks to be particularly striking and unique, I find that their first word PURE is more important for the purposes of distinction.

[51] Accordingly, considering the parties’ trade-marks as a matter of first impression and not of close scrutiny, I conclude to a fair degree of a resemblance in terms of appearance and sound.

[52] In turning to the ideas suggested by the trade-marks, I note that *The Canadian Oxford Paperback Dictionary* defines the word PURE as an adjective; the context in which the word PURE is used will generally dictate its meaning [Exhibit “B” to the Smith affidavit]. The adjective PURE has no clear meaning in association with either the Goods and Services or the Opponent’s Goods and the Opponent’s Services.

[53] Because the word PURE in the Mark sits alone (it does not qualify a word), the idea conveyed by the Mark is pureness.

[54] Even though I do not find the words OUTSIDE and OUTDOORS forming the Opponent’s trade-marks to be particularly striking or unique, when considering the trade-marks as a whole, they convey the idea that the Opponent’s Goods are intended for outdoor use and that the Opponent’s Services relate to goods intended for outdoor use. Nonetheless, as the word PURE in the Opponent’s trade-marks can be viewed as a qualifier of the second word, the two words are linked with each other. Simply put, the word OUTSIDE or OUTDOORS directly refers to the word PURE.

[55] Accordingly, I conclude that the overall consideration of the section 6(5)(e) factor favours the Opponent.

Section 6(5)(a) - the inherent distinctiveness of the trade-marks and the extent to which they have become known

[56] The overall consideration of the section 6(5)(a) of the Act involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[57] The Opponent's trade-marks are not inherently strong. Both are comprised of ordinary dictionary words. Furthermore, as discussed above, there is a suggestive connotation attaching to the trade-marks in the context of the Opponent's Goods and the Opponent's Services, in that each trade-mark suggests that the Opponent's Goods are intended for outdoor use and that the Opponent's Services relate to goods intended for outdoor use.

[58] The Mark is also comprised of an ordinary dictionary word. The Applicant submits that "the stylized lettering and circumferential design" impart the inherent distinctiveness of the Mark. I disagree. For one thing, the stylized script is intrinsic with the word PURE [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex C)]. Furthermore, I do not consider a geometrical shape akin to a circle to be a particularly distinctive feature. That being said, as discussed above, the word PURE has no clear meaning when considering the Goods and Services. Thus, I find that the Mark has a relatively higher degree of inherent distinctiveness than that of the Opponent's trade-marks.

[59] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. However, the evidence introduced by Mr. Yeung does not establish that the Mark has acquired distinctiveness through promotion or use in Canada.

[60] As for the Opponent's trade-marks, the mere existence of the registrations can establish no more than minimal use and cannot give rise to an inference of significant and continuous use in association with the Opponent's Goods and the Opponent's Services [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[61] Accordingly, I conclude that the section 6(5)(a) factor favours the Applicant, but only to the extent that the Mark possesses a relatively higher degree of inherent distinctiveness.

Section 6(5)(b) – the length of time the trade-marks have been in use

[62] The application is based upon proposed use of the Mark and there is no evidence that the Mark has been used to date in Canada.

[63] By comparison, registration No. TMA836,186 claims use of the trade-mark PURE OUTDOORS since at least as early as August 8, 2011 for the Opponent's Services. It also shows that a declaration of use was filed on November 9, 2012 for the Opponent's Goods. Registration No. TMA836,193 shows that the trade-mark PURE OUTSIDE proceeded to registration further to the filing of a declaration of use on November 9, 2012 for the Opponent's Goods and the Opponent's Services. However, as discussed above, the mere existence of the registrations cannot give rise to an inference of continuous use of the Opponent's trade-marks in Canada.

[64] In the absence of evidence of actual use of the trade-marks in Canada, the section 6(5)(b) factor does not favour either party.

Sections 6(5)(c) and (d) – the nature of the goods, services, and trade

[65] It is the statement of goods and services in the application for the Mark and the statement of goods and services in the Opponent's registrations that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[66] It is with the above in mind that I turn to the consideration of both factors, starting with the nature of the goods and services.

[67] The Opponent submits that both parties' goods can be classified generally as men and women's fitness clothing and apparel for the consumer market; both parties additionally offer a number of services related to the retail sales of these goods.

[68] For its part, the Applicant submits that although the parties' goods fall within the general category of clothing, there are significant differences between them. In this regard, the Applicant submits that its Goods are geared to yoga-related activities whereas the Opponent's Goods are

outdoor goods. Notably, the Applicant did not make specific submissions pertaining to the nature of its Services and the Opponent's Services.

[69] I acknowledge that the Applicant's Fall/Winter 2014 catalogue shows clothing geared to yoga-related activities [Exhibit "J" to the Yeung affidavit]. However, the Goods in the application are not restricted to yoga wear. Notably, "yoga wear" is listed separately in the application for the Mark. In other words, the Applicant itself distinguished the "yoga wear" from the other clothing items included in the Goods. In addition, based on a plain reading of the statement of goods in the application, I cannot reasonably conclude that all of the Goods are geared to yoga-related activities. As a matter of fact, it is reasonable to conclude that some of the Goods are exclusively intended for outdoor use (for instance, "coats", "rainwear").

[70] Likewise, I conclude from a plain reading of the statement of goods in the registrations that not all of the Opponent's Goods in the "garments" category are exclusively intended for outdoor use. Moreover, some of the Opponent Goods are identical to some of the Goods.

[71] Ultimately, I conclude that the Goods are either identical or overlap with the Opponent's Goods falling into the "garments" category. Similarly, I conclude that the Services are either identical or overlap with the Opponent's Services described as "operation of retail outlets selling garments...".

[72] I now turn to the nature of the trade.

[73] The Opponent submits that both parties are engaged in retail, online and mail order sales to individuals and that the Opponent also makes retail sales to "walk-in" customers in its retail locations.

[74] The Applicant submits that there is no evidence with respect to the Opponent's nature of trade. More particularly, the Applicant submits that there is no evidence showing that the Opponent is engaged in retail, online and mail order sales to individuals and make retail sales to "walk-in" customers in its retail locations. In addition, the Applicant submits that the parties have distinct channels of trade.

[75] I find it somewhat difficult to reconcile the Applicant's position that there is no evidence pertaining to the Opponent's nature of trade with the Applicant's position that the parties have distinct channels of trade, especially since the Applicant did not expand on the latter.

[76] That being said, given the circumstances of this case, one could argue that the parties have distinct channels of trade because their respective trade-marks are also associated with the retail sales of the parties' goods. However, neither the Applicant's application nor the Opponent's registrations contain restrictions regarding the markets for the distribution of the parties' goods.

[77] Finally, I recognize that in the present state of affairs, it appears unlikely that the Applicant's Goods would be carried in the Opponent's retail outlets. However, in attempting to establish confusion, it is not necessary to prove that the parties' goods are sold in the same outlets, as long as the parties are entitled to do so [see *Cartier Men's Shop Ltd v Cartier Inc* (1981) 58 CPR (2d) 68 (FCTD)].

[78] In view of the above, I conclude that the overall consideration of the section 6(5)(c) and (d) factors favours the Opponent.

Additional surrounding circumstance

[79] At the hearing, the Applicant submitted that it has shown through the affidavit of Ms. Smith that trade-marks comprising the term PURE are commonly used in Canada by third parties in association with clothing [Exhibits "E" to "H"]. The Applicant submitted that this is an additional surrounding circumstance that supports a finding of no likelihood of confusion between the trade-marks. I disagree.

[80] Indeed, I do not think it is reasonable to consider the two online purchases made by Ms. Smith as sufficient evidence for me to infer significant third-party use in Canada of trade-marks comprising the term PURE in association with clothing such that the degree of resemblance between the parties' trade-marks is diminished.

Conclusion on the likelihood of confusion

[81] As indicated above, section 6(2) of the Act is not concerned with confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source. In the present case, the question posed is whether a consumer with an imperfect recollection of either of the Opponent's trade-marks who sees the Mark in association with the Applicant's Goods and Services would, as a matter of first impression, think that the Goods and Services emanate from or are sponsored by or approved by the Opponent.

[82] I am aware that comparatively small differences may suffice to distinguish between "weak" marks, that is between marks of low inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. However, the Applicant did not convince me that this is such a case.

[83] Indeed, as discussed above, the degree of resemblance between the Mark and each of the Opponent's trade-marks PURE OUTSIDE and PURE OUTDOORS significantly advances the Opponent's case. This coupled with the identity or overlap between the parties' respective goods and services, and the potential for overlap in the parties' channels of trade favour the Opponent. In my view, the relatively higher degree of inherent distinctiveness of the Mark is not by itself sufficient to shift the balance of probabilities in favour of the Applicant.

[84] In weighing all of the factors enumerated at section 6(5) of the Act and their relative importance, at best for the Applicant, I find the balance of probabilities between finding that there is no reasonable likelihood of confusion, and finding that there is a reasonable likelihood of confusion, to be evenly balanced. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[85] Accordingly, the section 12(1)(d) ground of opposition is successful to the extent that it is based upon the Opponent's registration Nos. TMA836,193 and TMA836,186.

[86] I wish to add that had the Applicant provided evidence that I would have considered sufficient for concluding that there is common third-party use of trade-marks comprising the

word PURE in Canada in association with relevant goods, this may have been sufficient to shift the balance of probabilities in favour of the Applicant.

Disposition

[87] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,571,627 under section 38(8) of the Act.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2016-09-01

APPEARANCES

No one appearing

FOR THE OPPONENT

Essien Udokang

FOR THE APPLICANT

AGENTS OF RECORD

RIDOUT & MAYBEE LLP

FOR THE OPPONENT

BAKER & MCKENZIE LLP

FOR THE APPLICANT