



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 59

Date of Decision: 2019-06-21

IN THE MATTER OF AN OPPOSITION

Hunter Boot Limited

Opponent

and

DK Company A/S

Applicant

**1,747,882 for
DENIM HUNTER & DESIGN**

Application

INTRODUCTION

[1] DK Company A/S (the Applicant) has applied to register the trademark DENIM HUNTER & DESIGN (the Mark), shown below:

DENIM HUNTER

[2] The Mark is applied for in association with the following goods and services, on the basis of proposed use in Canada:

Goods

Leather and imitations of leather, and goods made of these materials namely animal skins, hides; trunks namely leather storage trunks and travelling bags; umbrellas, parasols and walking sticks; whips; belts, suspenders, hats, shoes, dress shoes, sport shoes, casual shoes, sandals, athletic shoes; Clothing namely, shirts, dress shirts, sports shirts, woven or

knitted shirts, ties, bow ties, neckwear namely neckties, sweaters, jackets, sports jackets, dress jackets, parkas, slacks, pants, trousers, jeans, suits, sport coats, overcoats, topcoats, hosiery, swimwear, shorts, dresses, skirts, tops namely crop tops, fleece tops, knit tops and tube tops.

Services

Business management for others; business administration in connection with design, production, sale and marketing of clothing and related goods for others.

[3] Hunter Boot Limited (the Opponent) opposes the application based on various grounds, including that it is confusing with its registered HUNTER trademark.

[4] For the reasons that follow, the application is refused.

THE RECORD

[5] The application for the Mark was filed on September 28, 2015.

[6] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. In the context of opposition proceedings, the date for identifying which version of the Act applies is the date on which the application being opposed was advertised. In the present case, the application was advertised for opposition purposes in the *Trademarks Journal* on May 11, 2016. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[7] The Opponent opposed the application on October 11, 2016, by filing a statement of opposition under section 38 of the Act, as it then was. The grounds of opposition are based on sections 30(e), 30(i), 12(1)(b), 12(1)(d), 16(3) and 2 of the Act as it then was, discussed in turn below.

[8] The Applicant filed a counter statement denying each of the allegations in the statement of opposition.

[9] In support of its opposition, the Opponent filed the following evidence:

- Certified copies of the Opponent's registrations for its trademarks HUNTER (TMA818,090), HUNTER Logo (TMA820,401), and H CREST Design (TMA 894,920);
- Certified copy of the Opponent's application for the trademark HUNTER Design (No. 1,669,127); and
- Affidavit of Kirsten Hardigg, sworn on April 11, 2017.

[10] In support of its application, the Applicant filed the following evidence:

- Affidavit of Jens Poulsen, sworn September 11, 2017;
- Affidavit of Christoph Heinemann, sworn September 12, 2017; and
- Affidavit of Jane Buckingham, sworn August 16, 2017.

[11] None of the affiants were cross-examined on their affidavits. Both parties filed written arguments. An oral hearing was not requested.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Certified copies of the Opponent's Marks

[12] The Opponent filed certified copies of the Opponent's registrations for its trademarks HUNTER (TMA818,090), HUNTER Logo (TMA820,401), and H CREST Design (TMA 894,920) as well as a certified copy of the Opponent's application for the trademark HUNTER Design (No. 1,669,127) (collectively, the Opponent's Marks).

[13] I note that subsequent to the filing of the Opponent's evidence, application No. 1,699,127 was registered on September 27, 2017. However, the Opponent did not amend its statement of opposition to reference this registration.

[14] Particulars of the Opponent's Marks are attached as Schedule A to this decision.

Affidavit of Kirsten Hardigg

[15] In her affidavit, Ms. Hardigg provides an overview of the Opponent's business and details regarding the sales of HUNTER footwear and clothing by the Opponent. Her affidavit can be summarized as follows:

- Ms. Hardigg is the Global Director of Sales Operations of Hunter Boot USA, a wholly-owned subsidiary of the Opponent (para 1);
- The Opponent is a Scottish company that was formed in 2007 (para 8);
- Until 2011, the Opponent sold its HUNTER goods in Canada through its former distributor, Man Made Sales Inc.; since 2012, the Opponent has sold its HUNTER goods through its current distributor, Steven Slavin Agencies Inc. (para 10);
- The Opponent's annual sales figures in Canada for its HUNTER goods have ranged from £1.4 million (British pounds) in 2010 to CDN\$12.5 million in 2016 (para 11);
- Canadian retailers of HUNTER goods include Hudson's Bay, Nordstrom and Saks Off Fifth, and have previously included Urban Outfitters, Club Monaco and Intermix (para 12);
- The Opponent operates a Canadian website, *ca.hunterboots.com*, to promote and sell HUNTER goods in Canada; sales through the website have ranged from £2.6 million in 2014 to CDN\$1 million in the first three months of 2017 (para 13);
- Annual Canadian advertising/promotional expenditures by the Opponent associated with HUNTER goods have ranged from CDN\$69,000 in 2012 to CDN\$210,000 in 2016 (para 14);
- The Opponent has used HUNTER marks, the trade name HUNTER, and the trade name "Hunter Boot Canada Inc" in association with the sale of footwear and clothing in Canada, as evidenced by dozens of representative invoices dated between 2009 and 2016 (para 15 and Exhibit D);

- HUNTER goods have been promoted through advertisements in Canada, including through print and website advertisements of various Canadian retailers (para 16 and Exhibit E);
- Since 2014, the Opponent has held “press days” in Canada twice a year to promote its HUNTER goods, where HUNTER goods are displayed and showcased in venues, such as galleries, to invited members of the fashion press (para 17);
- HUNTER marks are displayed on the goods themselves and on invoices when the goods are sold in Canada (para 18 and Exhibit F, which includes excerpts from the Opponent’s 2010 Fall catalogue, 2011 Spring/Summer Trade Guide and Canadian website);
- The Opponent’s HUNTER footwear has gained media and public attention from patronage by the British Royal Family and several well-known international celebrities (paras 19 and 20; Exhibits G and H);

OVERVIEW OF THE APPLICANT’S EVIDENCE

Affidavit of Jens Poulsen

[16] In his affidavit, Mr. Poulsen provides an overview of the Applicant’s business and details regarding the Applicant’s use of its DENIM HUNTER marks in Canada. His affidavit can be summarized as follows:

- Mr. Poulsen is the CEO of the Applicant (para 1);
- The Applicant is “part of a multi brand fashion group and offers a product range comprised of women and men’s clothing, including headgear, bags, belts and accessories”; DENIM HUNTER is one of the applicant’s brands (para 2);
- The Applicant operates a website for its DENIM HUNTER brand at *www.denim-hunter.com*, which is accessible in Canada (para 6 and Exhibit B);
- The DENIM HUNTER brand focuses on women’s jeans, but includes other women’s clothing categories (para 8);

- A DENIM HUNTER mark, reproduced below, is featured on labels and tags of clothing sold by the Applicant (para 8 and Exhibit 8):



- DENIM HUNTER-brand clothing is sold in many countries, including Canada (para 10);
- The DENIM HUNTER word mark appears throughout the Applicant's website (para 11 and Exhibit B);
- As of September 28, 2015 (the filing date of the application), the Applicant had not yet used the Mark in association with any products or services sold in Canada; but the Applicant did have such intention (para 13);
- In 2017, the Applicant commenced use of a DENIM HUNTER trademark in Canada in association with women's jeans, shirts and blouses, through its Canadian licensee, DK Company Canada Inc. (para 14);
- As of 2017, a number of Canadian retailers, including The Hudson's Bay Company, sell DENIM HUNTER-brand jeans (para 15 and Exhibit D);
- Since 2017, wholesales of DENIM HUNTER-brand apparel in Canada has been in excess of CDN\$20,000.
- The Applicant promotes the DENIM HUNTER brand online and on social media (para 19 and Exhibit E);
- The Applicant also promotes the DENIM HUNTER brand through fashion catalogues and newsletters, which are distributed to retailers and end consumers in Canada (para 20 and Exhibit F);

- The DENIM HUNTER brand has been featured at international fashion fairs, including “10-13 September – The Profile Show, Canada”.

Affidavit of Christoph Heinemann

[17] Mr. Heinemann is a law clerk employed by the Applicant’s trademark agent. In August and September 2017, Mr. Heinemann conducted various Internet searches related to the proceeding. His search results are attached to his affidavit, including the following:

- Exhibit A: printouts from the Applicant’s website, *www.dkcompany.dk*;
- Exhibit C: printouts from the Applicant’s DENIM HUNTER website, *www.denim-hunter.com*;
- Exhibit E: printouts from entries for “denim” and “hunter” from the *Merriam-Webster* dictionary website, *www.merriam-webster.com*;
- Exhibit F: printouts of search results for “Denim Hunter” from The Hudson’s Bay Company’s website, *www.thebay.com*.

Affidavit of Jane Buckingham

[18] Ms. Buckingham is a trademark searcher employed by the Applicant’s trademark agent (para 1). On August 14, 2017, Ms. Buckingham conducted a search of the Canadian Trademarks Register via a third-party database using the following search criteria:

All active Canadian trademark applications and registrations which contain the element *HUNTER*, alone or in combination with other word or design elements, in association with wares and services including and relating to clothing, apparel, headgear, and footwear. (para 3)

[19] The search results and a summary table are attached to her affidavit as Exhibit A.

ONUS

[20] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, the Opponent must first adduce

sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Cos*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD) at para 11].

MATERIAL DATES

[21] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30 with respect to non-compliance with section 30 – the filing date of the application, namely, September 28, 2015 [*Georgia-Pacific Corp v Scott Paper Ltd*, 1984 CarswellNat 1107, 3 CPR (3d) 469 (TMOB) at para 16];
- sections 38(2)(b)/12(1)(b) with respect to clearly descriptive or deceptively misdescriptive – the filing date of the application [*General Housewares Corp v Fiesta Barbeques Ltd*, 2003 FC 1021, 28 CPR (4th) 60 at para 26];
- sections 38(2)(b)/12(1)(d) with respect to confusion with a registered trademark – the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA) at para 18];
- sections 38(2)(c)/16(3) with respect to entitlement – the filing date of the application [section 16(3) of the Act];
- sections 38(2)(d)/2 with respect to non-distinctiveness – the filing date of the opposition, namely, October 11, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

ANALYSIS

Section 30(e) – Intends to Use Statement

[22] The Opponent pleads that the application does not comply with the requirements of section 30(e) of the Act, in that the Applicant did not, as of the filing date of the application, intend to use the Mark in Canada in association with the applied-for goods and services.

[23] In this case, since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trademark in Canada, it formally complies with section 30(e) of the Act, as it then was. Therefore, the issue is whether or not the Applicant substantially complied with section 30(e), *i.e.*, was the Applicant's statement that it intended to use the Mark true [*Home Quarters Warehouse, Inc v Home Depot, USA, Inc*, 1997 CarswellNat 2870, 76 CPR (3d) 219 (TMOB) at para 7; *Jacobs Suchard Ltd v Trebor Bassett Ltd*, 1996 CarswellNat 3039, 69 CPR (3d) 569 (TMOB) at para 7].

[24] In this respect, the Opponent further pleads that the Applicant could not have intended to use the Mark in Canada because:

- The Applicant must be deemed to have been aware of the Opponent's earlier adoption and use in Canada and elsewhere of the Opponent's Marks and therefore could not have had a *bona fide* intention to use the Mark which is confusing with the Opponent's family of HUNTER trademarks;
- The Applicant did not intend to use the Mark in association with all of the applied-for goods and services, but rather only in association with one or some of the applied-for goods and/or services;
- The Applicant could not have had a *bona fide* intention to use the Mark in association with one or some of the goods and services as of the filing date since it had already used the Mark in association with those goods and services.

[25] The Opponent led no evidence in support of this ground. However, an opponent may 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 *Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at paras 30-38].

[26] In its written argument, the Opponent notes that the Applicant's evidence shows that, in 2017, the Applicant commenced use of DENIM HUNTER trademarks in association with some of the applied-for goods in Canada; however, the Opponent argues that, as the DENIM HUNTER marks were not the applied-for Mark, this indicates that the Applicant had no intention

to use the Mark as applied for (Opponent's Written Argument, paragraph 117, referencing the Poulsen Affidavit, paragraph 14, Exhibits A to F).

[27] However, as noted above, the relevant date for considering the circumstances with respect to this ground of opposition is the filing date of the application, in this case, September 28, 2015. Furthermore, in his affidavit, Mr. Poulsen confirms that, as of the relevant date, the Owner had an intention to use the Mark in Canada and had not yet used the Mark in association with the applied-for goods and services (Poulsen Affidavit, paragraph 13). Mr. Poulsen was not cross-examined on such statements. Absent further evidence or admissions in cross-examination, I am not prepared to infer, based merely on some evidenced use of related trademarks by the Applicant after the relevant date, that the Applicant's statement made pursuant to section 30(e) of the Act was untrue.

[28] In this respect, I further note that mere awareness of prior rights alleged by an opponent does not preclude an applicant from truthfully making the statement required by section 30(e) of the Act.

[29] Accordingly, the section 30(e) ground of opposition is rejected as the Opponent has not met its evidential burden.

Section 30(i) – Entitled to Use Statement

[30] The Opponent pleads that the Applicant could not have been satisfied it was entitled to use the Mark in Canada, having regard to, *inter alia*, the Opponent's family of HUNTER trademarks previously used in Canada.

[31] Section 30(i) of the Act, as it then was, merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application. Where this statement has been provided, 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 [*Sapodilla Co Ltd v Bristol Myers Co*, 1974 CarswellNat 476, 15 CPR (2d) 152 (TMOB) at paras 8-10]. Mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an

applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197 at para 10].

[32] The application for the Mark contains the statement required under section 30(i) of the Act as it then was and there is no evidence that this is an exceptional case. Accordingly, this ground of opposition is rejected.

Sections 12(1)(b) – Clearly Descriptive or Deceptively Misdescriptive

[33] The Opponent pleads that the Mark is not registrable because it is clearly descriptive or deceptively misdescriptive of all of the applied-for goods and services. In this respect, it pleads that denim is a type of fabric and, as such, the trademark clearly describes or deceptively misdescribes a character or quality of the applied-for goods and services.

[34] As noted above, the material date for this ground is the filing date of the application. While the legal burden is upon an applicant to show that its trademark is registrable, there is an initial evidential burden upon an opponent in respect of this ground to adduce sufficient admissible evidence which, if believed, would support the truth of its allegation that the applied-for trademark is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's goods and services [section 12(1)(b) of the Act].

[35] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)*, 1990 CarswellNat 834, 34 CPR (3d) 154 (FCTD) at para 14; *e-Funds Ltd v Toronto Dominion Bank*, 2007 CarswellNat 2283, 61 CPR (4th) 475 (TMOB) at para 15].

[36] The issue as to whether a trademark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated goods and services. Character means a feature, trait or characteristic of the goods and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada v American Home Products Corp*, 1968 CarswellNat 9, 55 CPR 29 (Can Ex Ct) at para 22]. The trademark must not be carefully analyzed but must be considered in its entirety as a matter of immediate impression [*Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)*, 1978 CarswellNat 699, 40 CPR

(2d) 25 (FCTD) at para 7]. In other words, the trademark must not be considered in isolation, but rather in its full context in conjunction with the subject goods and services [*Ontario Teachers' Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60 at para 29]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA c Canada (Procureur général)*, 2003 FCT 715, 29 CPR (4th) 497 (FCTD) at para 11].

[37] For a trademark to be considered deceptively misdescriptive, the trademark must mislead the public as to the character or quality of the goods and services. The trademark must be found to be descriptive so as to suggest the goods or services are or contain something that is not the case. The purpose of the prohibition with respect to deceptively misdescriptive trademarks is to prevent the public from being misled [*Atlantic Promotions Inc v Canada (Registrar of Trade Marks)*, 1984 CarswellNat 831, 2 CPR (3d) 183 (FCTD) at para 18; and *Provenzano v Canada (Registrar of Trademarks)*, 1977 CarswellNat 676, 37 CPR (2d) 189 (FCTD) at paras 2-4].

[38] The Opponent's evidence with respect to this ground is limited to paragraph 22 of Ms. Hardigg's affidavit:

In my experience working in the fashion industry, I have come to expect that any goods branded as DENIM would be primarily composed of the fabric denim. I would expect many of the goods covered by the [DENIM HUNTER & Design] application, though, would not be comprised primarily of the fabric denim.

[39] This assertion is not otherwise supported by the Opponent's evidence.

[40] The Opponent further submits the following at paragraphs 113-114 of its written argument:

113. The Applicant's Mark, [DENIM HUNTER & Design], must be considered to suggest that the goods for which the Applicant sought registration are made of or contain denim. As denim is a specific type of fabric common to clothing, the term DENIM relates to the composition of the goods, and falsely and erroneously describes a material composition of the goods.

114. Many of the Applicant's goods do not comprise denim but rather are made of another type of fabric. Accordingly, the [Mark] must be considered to be deceptively misdescriptive of the majority of the goods in association with which it is allegedly intended to be used.

[41] In view of the Opponent's submissions, in this case, the question is whether the applied-for Mark is deceptively misdescriptive.

[42] In its written argument, the Applicant submits that the Opponent has not provided any evidence that the applied-for Mark is clearly descriptive or deceptively misdescriptive of the applied-for goods and services and, as such, has not met its initial evidential burden (para 55).

[43] In any event, the Applicant submits that the Mark is not objectionable pursuant to section 12(1)(b) of the Act. In this respect, it submits that:

- the Mark is a unique coined trademark;
- it does not unambiguously say anything about the inherent nature or make-up of the applied-for goods and services;
- it does not have a readily understood meaning; and
- the combination of the words DENIM HUNTER is not part of the common vocabulary and is therefore a novel linguistic construction. (para 57)

[44] Indeed, when considering the trademark as a whole, and the definitions of "denim" and "hunter" provided by the Applicant (Heinemann Affidavit, Exhibit E), I find that the term DENIM HUNTER suggests "one who hunts wearing denim" or "one who searches for denim". As such, the Mark is not *clearly* descriptive of the applied-for goods and services; furthermore, I do not consider that the average consumer would be deceived if the goods sold in association with the Mark were not made of denim material. It follows that the Mark is also not deceptively misdescriptive of the applied-for services, being "business management for others" and "business administration in connection with design, production, sale and marketing of clothing and related goods for others", even if such services are offered in relation to non-denim goods.

[45] Accordingly, the section 12(1)(b) ground of opposition is rejected.

Section 12(1)(d) – Confusing with a Registered Trademark

[46] The Opponent pleads that the Mark is not registrable because it is confusing with registration Nos. TMA818,090 (HUNTER), TMA820,401 (HUNTER Logo) and TMA894,920 (H CREST DESIGN) (particulars set out in the attached Schedule A). I have exercised my discretion and have checked the Register to confirm that these registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As noted above, the material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA) at para 18].

Test to determine confusion

[47] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[48] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[49] The criteria in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[50] In this case, I will focus my analysis on the Opponent’s registrations for HUNTER and HUNTER Logo (the HUNTER Marks), as these two marks have greater resemblance to the applied-for Mark than the H CREST DESIGN mark; aside from the letter “H”, I do not find any resemblance between the Mark and the H CREST DESIGN mark, including with respect to their design elements.

[51] The HUNTER Logo trademark appears below:



Distinctiveness – Inherent Distinctiveness and the Extent Known

[52] With respect to their inherent distinctiveness, the Mark and the Applicant’s HUNTER Marks all share the component HUNTER, which may be perceived as the ordinary dictionary word or as a surname. As the Applicant submits, the word HUNTER is somewhat suggestive of the intended uses for some of the Opponent’s goods (such as waterproof footwear and rubber boots), used in hunting and “outdoor pursuits” [Applicant’s Written Argument, para 66].

[53] With respect to the Mark, while above I found that the Mark as a whole was not clearly descriptive, I consider the DENIM element to have a low level of inherent distinctiveness in association with the applied-for clothing-related goods and services. Furthermore, the design element is relatively small in relation to the words DENIM and HUNTER.

[54] With respect to the extent the marks have become known in Canada, the Opponent has evidenced use of its HUNTER Marks in Canada since 2006, with sales exceeding CDN\$77 million. Although the Applicant submits that this is “essentially restricted to use in association with ‘Wellington-style outdoor rubber boots’” (Applicant’s Written Argument, para 69), Ms. Hardigg’s affidavit includes evidence that the HUNTER Marks have been used in Canada since at least 2010 in association with jackets, socks, bags and umbrellas (Exhibit F).

[55] The Applicant’s evidence shows that it has used its DENIM HUNTER mark in Canada only since 2017. Such sales have not been as significant, and even those would appear to be

limited to being in association with the word mark and a variation of the Mark, shown above, not the applied-for Mark itself.

[56] In summary, while the Mark may have somewhat greater inherent distinctiveness than the Opponent's HUNTER Marks, the evidence supports a finding that the HUNTER Marks have become known to a much greater extent than the Mark in Canada. Therefore, this factor favours the Opponent.

Length of Time in Use

[57] This factor favours the Opponent, as its HUNTER Marks have been in use in Canada since at least 2006, whereas the Applicant has not evidenced use of the Mark in Canada. Again, the minimal evidence of use by the Applicant is of the word mark DENIM HUNTER or a design variant, not the Mark as applied for.

Nature of Goods, Services or Business

[58] In its written arguments, the Applicant attempts to distinguish its goods and services from those of the Opponent, emphasizing that the Opponent's goods and services relate primarily to "waterproof footwear and rubber boots and other related items intended for wearing during rain or similar [weather] conditions". In contrast, it submits that the Applicant's goods and services "relate to fashion apparel and accessories such as jeans, blouses, t-shirts, skirts, dresses, knits and cardigans".

[59] However, when considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements of goods and services in the subject application and registrations that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA) at paras 24-25].

[60] In this case, the parties' goods either directly overlap (*e.g.*, footwear and coats/jackets) or are otherwise closely related goods (*e.g.*, fashion accessories such as bags, belts and umbrellas) that would likely be sold in the same types of stores and targeting the same type of consumers.

[61] With respect to the applied-for services, the parties are generally in the same trade and the lack of clarity regarding the extent of the Applicant’s “business management” services – *e.g.*, whether it is related or unrelated to its evidenced trade in the clothing industry – goes against the Applicant meeting its burden.

[62] Accordingly, this factor favours the Opponent.

Nature of the Trade

[63] There are no restrictions regarding the channels of trade in the respective statements of goods and services and, in any event, the evidence shows that both the Opponent’s goods and the Applicant’s goods are sold in identical channels of trade, being through Hudson’s Bay in Canada [see, for example, Hardigg Affidavit, paras 12 and 16; Poulsen Affidavit, para 15].

[64] As such, this factor favours the Opponent.

Degree of Resemblance

[65] As mentioned above, the degree of resemblance between the parties’ marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties’ goods, or services, and the parties’ channels of trade, are the same or overlapping, as in this case [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155 at paras 26-30].

[66] Although the first portion of the Mark is DENIM, I find there to be significant resemblance between the Mark and the Opponent’s HUNTER and HUNTER logo trademarks in appearance and when sounded. In this respect, the Mark incorporates the Opponent’s HUNTER mark in its entirety.

[67] Ordinarily it is the first portion of a mark that is the most important for the purpose of distinguishing between marks [*Conde Nast Publications Inc v Union des Editions Modernes*, 1979 CarswellNat 785, 46 CPR (2d) 183 at para 34 (FCTD)]. However, when the first portion of a mark is a common descriptive word, its importance diminishes *Vancouver Sushiman Ltd v Sushiboy Foods Co*, 2002 CarswellNat 4233, 22 CPR (4th) 107 (TMOB) at para 26]. In the

present case, the addition of DENIM does not meaningfully diminish the resemblance between the Mark and the Opponent's HUNTER Marks, as DENIM is suggestive of the goods at issue. Indeed, the Applicant submits that "it is common for the owner of a mark to use associated marks to brand either the same or related goods". Accordingly, the Applicant argues that "there is a strong likelihood that a prospective purchaser would believe that clothing sold under [the Mark] would simply be, for example, another line of clothing offered by the Opponent, such as, a range made of denim" (para 91).

[68] Accordingly, this important factor favours the Opponent.

Surrounding Circumstances: State of the Register

[69] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431, 41 CPR (3d) 432 (TMOB) at para 10; and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178, 44 CPR (3d) 205 (FCTD) at paras 7-10]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124, 43 CPR (3d) 349 (FCA)].

[70] The Applicant submits that "the Register is replete with examples of third parties using the word HUNTER" (para 96), referencing the Buckingham Affidavit which references 50 Canadian trademark applications and registrations containing the element HUNTER in association with clothing, apparel, headgear, and footwear. While many of these marks can be discounted as not being registered trademarks, the Applicant draws attention in particular to registrations for the trademarks HUNTER'S BAY, THE CROCODILE HUNTER, GHOST HUNTERS, MOUNTAIN HUNTER and BARGAIN HUNTER (Applicant's Written Arguments, para 103).

[71] However, I agree with the Opponent that, in the absence of evidence of third-party use, there are too few relevant registered trademarks to draw any inference regarding the state of the Canadian marketplace. In any event, given the low inherent distinctiveness of the DENIM element, I find the resemblance between the Mark and the HUNTER Marks to be greater than

the resemblance between any of the third-party registrations noted above and the HUNTER Marks.

Conclusion

[72] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for goods and services. I reach this conclusion due to the resemblance between the trademarks, especially in view of the overlap in the nature of the parties' goods, services, businesses and trades.

[73] Accordingly, the section 12(1)(d) ground of opposition is successful with respect to all of the applied-for goods and services.

Section 16 - Entitlement

[74] The Opponent pleads, *inter alia*, that the Mark is not registrable because it is confusing with application No. 1,669,127 for the HUNTER Design trademark, previously filed in Canada by the Opponent (particulars set out in the attached Schedule A). As noted above, the material date with respect to this ground of opposition is the filing date of the Applicant's application.

[75] The Opponent meets its burden as its application for the HUNTER Design trademark was filed on March 20, 2014 (prior to the Mark's application date of September 28, 2015) and was pending as of the application for the Mark's advertisement date.

[76] Essentially, the same considerations as above apply to the issue of confusion – in particular the resemblance between the parties' marks – and the same result follows. In fact, I note that the Opponent's application includes a broader scope of goods and services such that there is greater overlap between the nature of the Applicant's goods and services and those of the Opponent.

[77] Accordingly, the section 16(3)(b) ground of opposition is successful.

Remaining Grounds of Opposition

[78] In view of the above, as the Opponent is successful on the bases of two grounds of opposition, it is unnecessary to consider the remaining grounds of opposition, which included further grounds based on section 16 of the Act (entitlement) as well as section 2 of the Act (non-distinctiveness).




DISPOSITION

[79] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Schedule A: Opponent's Marks

Trademark	Registration No. & Reg. Date	Goods and Services
HUNTER	TMA818,090 2012-02-22	Goods: (1) Waterproof boots and rubber boots. (2) Clothing and waterproof clothing, namely hats, coats, welly socks, waterproof clogs, headgear namely hats; footwear, namely, boots and shoes; parts of boots and shoes, fittings for boots and shoes, waterproof headgear, namely hats.
	TMA894,920 23-Jan-2015	Goods: (1) Boots and shoes (2) Socks, boots.
	TMA820,401 2012-03-21	<p>Goods: (1) Waterproof footwear. (2) Waterproof footwear; shoe, boot and footwear polishes; boot cream, boot wax; shoe cream, shoe wax; umbrellas; travel bags; travelling bags; boot and footwear bags; cleaning preparations for shoes, boots and footwear; boot and shoe jacks; cloths for cleaning boots and shoes; articles for cleaning purposes, namely, cleaning cloths for shoes and boots; bags and pouches adapted to carry boots and shoes; boots; liners for boots; headgear namely hats and beanies; clothing accessories namely gloves and outdoor gloves, scarves; galoshes; garters; coats, jackets, raincoats, overcoats, trench coats and socks.</p> <p>Services: Retail services namely the sale of shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear, umbrellas, travel bags, travelling bags, boot and footwear bags, bags and pouches adapted to carry boots and shoes, boot and shoe jacks, cloths for cleaning boots and shoes, boots, liners for boots, headgear, namely hats and beanies, clothing accessories namely gloves and outdoor gloves, scarves, galoshes, garters, waterproof footwear, coats, jackets, raincoats, overcoats, trench coats and socks.</p>
	TMA981,604 (Application No. 1,669,127)	Goods: (1) Wellington boots; waterproof boots; waterproof shoes and waterproof sandals.

	2017-09-27	<p>(2) Boots.</p> <p>(3) Waterproof clogs; liners for boots and shoes; socks for use with Wellington boots and waterproof boots; galoshes.</p> <p>(4) Umbrellas; bags and pouches adapted to carry boots and shoes; flip-flops; gloves; scarves; garters; raincoats, waterproof anoraks, waterproof ponchos, waterproof cagoules, waterproof capes and waterproof trousers and waterproof hats; socks; hats.</p> <p>(5) Shoe, boot and footwear polishes; boot cream, boot wax; shoe cream, shoe wax; cleaning preparations for shoes, boots and footwear.</p> <p>(6) Shoes; shoes of rubber, leather and other materials namely plastic, vinyl, canvas and fabric.</p> <p>(7) Sandals; rain jackets; jackets.</p> <p>(8) Backpacks; rucksacks; boot and footwear bags; bags and pouches; insoles for boots and shoes; inner soles; mittens.</p> <p>(9) Cleaning, polishing, scouring and abrasive preparations.</p> <p>(10) Umbrellas; bags and pouches adapted to carry boots and shoes; backpacks; rucksacks; boot and footwear bags; bags and pouches; travelling bags; luggage; travel bags; holdalls; handbags; gun slings and cartridge bags; Wellington boots; waterproof boots; waterproof shoes and waterproof sandals; boots; shoes; shoes of rubber, leather and other materials namely plastic, vinyl, canvas and fabric; sandals; flip-flops; waterproof clogs; insoles for boots and shoes; inner soles; liners for boots and shoes; socks for use with Wellington boots and waterproof boots; gloves; mittens; scarves; garters; raincoats, waterproof anoraks, waterproof ponchos, waterproof cagoules, waterproof capes and waterproof trousers and waterproof hats; rain jackets; jackets; socks; hats; galoshes; outerclothing; outerwear; coats; overcoats; raincoats.</p> <p>(11) Leather and imitations of leather; wallets; purses; gilets; protective cases for mobile telephones.</p> <p>Services:</p> <p>(1) On-line retail services connected with the sale of shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear; on-line retail services connected with the sale of waterproof boots, boots,</p>
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		<p>shoes, liners for boots and shoes, socks for use with Wellington boots and waterproof boots, umbrellas, bags.</p> <p>(2) Wholesale services connected with the sale of wellington boots, waterproof boots, waterproof footwear.</p> <p>(3) Wholesale services connected with the sale of boots.</p> <p>(4) Wholesale services connected with the sale of waterproof clogs, liners for boots and shoes, socks for use with Wellington boots and waterproof boots, galoshes.</p> <p>(5) Wholesale services connected with the sale of umbrellas, bags and pouches adapted to carry boots and shoes, flip-flops, gloves, scarves, garters, waterproof clothing, socks, hats.</p> <p>(6) Wholesale services connected with the sale of shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear; wholesale services connected with the sale of backpacks, rucksacks, boot and footwear bags, bags and pouches, insoles for boots and shoes, inner soles, mittens.</p> <p>(7) Wholesale services connected with the sale of shoes, shoes of rubber, leather and other materials.</p> <p>(8) Wholesale services connected with the sale of sandals, rain jackets, jackets.</p> <p>(9) Retail, wholesale and on-line retail and wholesale services connected with the sale of cases for mobile telephones, leather and imitations of leather, wallets, purses, gilets.</p> <p>(10) Retail, wholesale and on-line retail and wholesale services connected with the sale of shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear; retail, wholesale and on-line retail and wholesale services connected with the sale of travelling bags, umbrellas, luggage, travel bags, holdalls, handbags, backpacks, rucksacks, gun slings and cartridge bags, boot and footwear bags, bags and pouches, bags and pouches adapted to carry boots and shoes, hip flasks, flasks, vacuum flasks, boot and shoe jacks, cloths for cleaning boots and shoes, boots, Wellington boots, waterproof boots, waterproof footwear, galoshes, waterproof clogs, shoes, shoes of rubber, leather or other materials,</p>
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		sandals, flip-flops, inner soles, insoles for boots and shoes, liners for boots and shoes, socks for use with Wellington boots and waterproof boots, socks, hats, gloves, mittens, scarves, garters, waterproof clothing, outerclothing, outerwear, jackets, coats, overcoats, raincoats.
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**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Grant W. Lynds (Marks & Clerk)

For the Opponent

Gowling WLG (Canada) LLP

For the Applicant