



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 18

Date of Decision: 2020-02-18

IN THE MATTER OF AN OPPOSITION

**Groupe International Travelway Inc./
Travelway Group International Inc.**

Opponent

and

**Bernard Ehret Design
Société à responsabilité limitée**

Applicant

1,672,461 for JUMP Design

Application

[1] Groupe International Travelway Inc./Travelways Group International Inc. (the Opponent) opposes application no. 1,672,461 (the Application) for registration of the trademark JUMP Design (the Mark) filed by Bernard Ehret Design, Société à responsabilité limitée (the Applicant). The Mark consists of the word JUMP in stylized lettering that resembles outlines of geometric shapes, as shown below:

[2] For the reasons that follow, the opposition is successful.

PRELIMINARY REMARKS

[3] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13, (the Act) came into force on June 17, 2019. All references to the Act in these reasons are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition, which refer to the Act as it read immediately before it was amended (see the transitional provisions in section 70 of the Act, which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

THE RECORD

[4] The Application was filed on April 11, 2014. It is based on registration and use of the Mark in France and on proposed use of the Mark in Canada in association with the following goods (the Goods):

Maroquinerie et articles de maroquinerie, nommément, sacs d'alpinistes, bourses, sacs de campeurs, cartables, porte-cartes, portefeuilles, étuis pour clés, coffres de voyage, coffrets destinés à contenir des articles de toilette dits 'vanity case', porte-documents, sacs d'écoliers, sacoches pour porter les enfants, sacoches porte ordinateur, sacoches porte ordinateur à roulettes, filets à provisions, malles, mallettes, mallettes pour documents, porte-monnaie non en métaux précieux, sacs de plage, poignées de valises, poignées de sacs, sacs à provision en cuir et en plastique, sacs à roulettes, sachets et pochettes pour l'emballage en cuir et en imitation du cuir, sacs à dos, sacs à main, sacs de voyage, serviettes, trousse de voyage, valises, valises à roulettes, sacs-housses pour vêtements pour le voyage, sacs de sport en cuir et en imitation du cuir, sacoches porte ordinateur en cuir et en imitation du cuir, mallettes en cuir et en imitation cuir, porte-habits, sacs, nommément, sacs à main, sacs de voyage, sacs pour articles de toilette, sacs à cosmétiques, sacs porte ordinateur, sacs de sport, sacs à dos, porte-chéquier.

[TRANSLATION: Leatherwork and leatherwork items, namely climbing bags, purses, camping bags, school bags, card holders, wallets, key cases, travel chests, vanity cases, portfolios, school bags, slings for carrying infants, computer carrying cases, computer carrying cases on casters, mesh shopping bags, trunks, attaché cases, attaché cases for documents, coin purses not made of precious metals, beach bags, suitcase handles, bag handles, shopping bags made of leather and of plastic, wheeled bags, leather and imitation leather bags and pouches for packaging, backpacks, handbags, travel bags, briefcases, travel kits, suitcases, suitcases with casters, garment bags for travel, sports bags made of leather and imitation leather, computer carrying cases made of leather and imitation leather, attaché cases made of leather and imitation leather, suit bags, bags, namely handbags, travel bags, toiletry bags, cosmetic bags, computer bags, sports bags, backpacks, chequebook holders.]

[5] The Application was advertised in the *Trademarks Journal* on April 6, 2016 for the purposes of opposition.

[6] On June 1, 2016, the Opponent filed a statement of opposition pursuant to section 38 of the Act. The grounds of opposition pleaded are based on sections 30(d) and 30(i) (compliance), 12(1)(d) (registrability), 16(2)(a) and 16(3)(a) (entitlement), and 2 (distinctiveness) of the Act as it read immediately before June 17, 2019.

[7] The opposition is based primarily on the Opponent's allegation that the Mark is confusing with the Opponent's trademark JUMP, registered and used in association with goods that include luggage and bags, as set out below (the Opponent's JUMP Registrations):

Trademark	Registration Number	Registration Date	Goods
JUMP	TMA338,778	March 31, 1988	Luggage, sport bags, totes, toiletry bags, shoe bags, shirt bags, briefcases, portfolios and garment bags.
JUMP	TMA581,305	May 12, 2003	(1)Backpacks and note-pad holders; (2) Snowboards, skateboards, scooters, snowboard equipment bags, ski equipment bags, hand bags, brief bags, travel bags, school bags, wallets, telephone address books, travel wallets, fanny packs, cosmetic bags, computer bags, hand-held computer cases, cellular phone cases, pager cases and eyewear cases.

[8] I note that registration No. TMA581,305 has since been amended (on March 13, 2018) to delete "note-pad holders", "snowboards, skateboards, scooters", "telephone address books", "cellular phone cases, pager cases and eyewear cases" from the goods covered by that registration.

[9] The Applicant filed a counter statement on July 27, 2016, denying each of the grounds of opposition.

[10] The Opponent filed as its evidence the affidavit of Gerry Shadeed, dated November 18, 2016.

[11] The Applicant filed as its evidence (i) the affidavit of Bernard Ehret, dated March 20, 2017; and (ii) a certified copy of the Applicant's registration No. TMA367,800 for the trademark JUMP & Dessin (Oval JUMP Logo), registered for use in association with bags, travel bags and sports bags, bags of all kinds ("*Sacs, sacs de voyage et sacs de sports, sacs et bags en tous genres*").

[12] Neither of the affiants was cross-examined.

[13] Both parties filed written arguments and were represented at an oral hearing.

EVIDENTIARY BURDEN

[14] The legal onus is on the applicant to show that its application complies with the provisions of the Act. However, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Compliance with section 30(d)

[15] The Opponent pleads that the Application does not conform to the requirements of section 30(d) because, contrary to the statement contained in the Application, the Applicant could not and cannot properly claim that the Mark is the subject in or for another country of the Union of a registration by the Applicant and that the Mark has been used in France in association with the Goods. However, there is no evidence in the record to support either of these allegations. I also note that the Opponent did not address this ground of opposition either in its written argument or at the hearing. Accordingly, the ground of opposition based on section 30(d) of the Act is dismissed, as the Opponent has failed to meet its evidential burden.

Compliance with section 30(i)

[16] The Opponent also pleads that the Application does not conform to the requirements of section 30(i) of the Act, because contrary to the statement contained in the Application, the Applicant could not and cannot be satisfied of its entitlement to use the Mark in Canada in association with the Goods. Specifically, the Opponent pleads that the Applicant must have been or must be aware that the Mark is confusing with the Opponent's JUMP trademark, previously used and registered in Canada in association with the goods listed in paragraph 7, above.

[17] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use its trademark in Canada in association with the goods and services described in the application. Awareness of an allegedly confusing trademark does not preclude an applicant from making the required statement, since the applicant may nevertheless be satisfied of its own entitlement to use the trademark it is applying to register, in association with the goods and services in its application. Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged, or where federal legislation arguably prevents the registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[18] In the present case, there are no allegations of that nature in the statement of opposition and there is no evidence in the record to that effect. Again, the Opponent made no submissions with respect to this ground of opposition, either in its written argument or at the hearing. Consequently, this ground of opposition is dismissed as well, as the Opponent has failed to meet its initial burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[19] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act, because it is confusing with the Opponent's JUMP Registrations, described above.

[20] The relevant date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[21] The Opponent's initial burden with respect to this ground is met if at least one of the registrations relied upon is in good standing at the date the Registrar's decision. The Registrar has discretion to check the Register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that both of the Opponent's JUMP Registrations are extant, although, as noted above, registration No. TMA581, 305 was amended on March 13, 2018, to delete certain goods from the registration.

[22] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's JUMP Registrations.

The test for confusion

[23] The test for confusion is outlined in section 6(2) of the Act, which stipulates 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.

[24] This test does not concern confusion of the marks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source. It is described in the following terms by Justice Binnie in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, at paragraph 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [applicant's mark], at a time when he or she has no more than an imperfect recollection of the [opponent's] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[25] Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trademarks are set out in section 6(5) of the Act: (a) the

inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks 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 trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Degree of resemblance between the trademarks

[26] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks at issue is the most important factor in assessing the likelihood of confusion. One must consider the degree of resemblance between the trademarks from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64]. Even so, each trademark must be considered as a whole [see *Veuve Clicquot, supra*].

[27] In the present case, the Opponent’s trademark is the word JUMP while the Mark is the word JUMP in stylized lettering that resembles outlines of geometric shapes.

[28] The two trademarks are identical phonetically and suggest essentially the same ideas, if any. This aspect of the resemblance test is particularly significant to the extent that an average consumer would tend to identify the trademarks at issue by the word element rather than by a description of the design component [see *e.g. Ferrero SpA v A & V 2000 Inc*, 2017 TMOB 84; and *Nada Fashion Designs Inc v Groupe Boyz Inc*, 2011 TMOB 155]. The marks also resemble one another to a certain degree in appearance, as the dominant feature of the Mark is the word JUMP. Although the letters in the Mark are stylized, the fact remains that the Mark incorporates the Opponent’s trademark JUMP in its entirety. In this respect, I would also note that the registration of a word mark permits an owner to use the mark with any style of lettering, colour or design [*Masterpiece, supra*]. Thus, nothing would prevent the Opponent from depicting its registered JUMP trademark by outlining the letters and/or by forming them with geometric shapes.

[29] Given the degree of resemblance between the parties' trademarks in appearance, sound and ideas suggested, this factor favours the Opponent. Consequently, I must review the other factors to determine if they favour the Applicant in such a way that they would outweigh the degree of resemblance between the marks.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[30] The word JUMP is inherently distinctive with respect to both parties' goods. Although JUMP is an ordinary dictionary word, it does not relate in any obvious way to products in the nature of bags and luggage.

[31] The Applicant submits that the Mark's stylized lettering increases its inherent distinctiveness. In this respect, the Applicant argues that the geometric, stylized shapes forming the letters give the Mark a striking effect that does not exist in the Opponent's JUMP trademark.

[32] However, it has been held that design features such as fanciful scripts or other embellishments that are intrinsic to the letters in a trademark, and cannot be dissociated from the letters themselves, generally add little to the inherent distinctiveness of a trademark [see *Canadian Jewish Review Ltd v The Registrar of Trade-marks* (1961), 37 CPR 89 (Ex Ct); and *John Labatt Ltd v Canada (Registrar of Trade Marks)* (1984), 79 CPR (2d) 110 (FCTD)].

[33] Accordingly, I find that the Mark possesses only a slightly higher degree of inherent distinctiveness than the Opponent's JUMP trademark.

[34] However, the degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW, supra*]. Both parties filed evidence in this respect.

Opponent's evidence of use and promotion

[35] The evidence with respect to use and promotion of the Opponent's JUMP trademark in Canada consists of the affidavit of its Vice-President and Secretary-Treasurer, Gerry Shadeed, who has been an officer of the Opponent and actively involved in its day-to-day operations since

1977. Mr. Shadeed states that the Opponent is a Canadian federal business corporation based in Montreal. He explains that, since 1976, the Opponent and its predecessor in title have carried on the business of importing various merchandise into Canada—including a wide range of bags—and of distributing such merchandise under various brand names and trademarks throughout Canada.

[36] Mr. Shadeed attests that, at least since the issuance of the Opponent’s JUMP Registrations, the Opponent has been distributing goods of the type covered by these registrations to retailers in Canada for retail sale to consumers. He attaches photographs of such goods displaying the Opponent’s JUMP trademark as Exhibits O-2 to O-8 to his affidavit. The depicted products are identified with item numbers and include various types of bags and luggage, in the nature of backpacks, school bags, binder and note-pad holders, portfolios, brief bags or cases, computer bags, sport bags, duffle bags, wheeled duffle bags, carry-on or tote bags, garment bags, toiletry and cosmetic bags, travel wallets, travel bags, hand bags, shoe bags, and fanny packs with a cell phone pocket case.

[37] The trademark JUMP is prominently displayed on the depicted goods in various ways, for example, embroidered or screen printed directly on the good; embroidered on a label that is either permanently affixed to the front or side of the good or otherwise attached to the good; or embossed on the zipper pulls of the good. The stylization and arrangement of the letters in the word JUMP varies. Some examples are reproduced below:



outline of lowercase lettering



lowercase lettering with a red dot on the J and as the stem of the P



variation wherein a red dot also links the U and M, which overlap to form a horizontal section sign (§)



solid uppercase lettering



solid uppercase lettering forming a square, with JU above MP



variation of the square wherein U and M are in a contrasting colour



variation of the square wherein each letter is a different colour



solid uppercase
lettering with serifs



curvy solid uppercase lettering



outline of curvy
uppercase lettering

[38] Although the word JUMP might be recognized less readily when it is presented in one of the square arrangements, or when the letters U and M overlap, I am satisfied that the trademark JUMP remains recognizable in each of the designs reproduced above.

[39] As Exhibit O-9 to his affidavit, Mr. Shadeed attaches several specimens of artwork for hang-tags displaying the Opponent's JUMP trademark. He explains that such hang-tags are attached to the Opponent's goods at the point of their sale to retail customers in Canada. The specimens provided appear to be for goods in the nature of backpacks, school bags and portfolios, and feature the JUMP trademark with stylizations similar to some of the ones reproduced above. Some of the artwork is dated, with dates ranging from 2003 to 2014.

[40] As Exhibit O-10 to his affidavit, Mr. Shadeed attaches a sampling of the Opponent's invoices (with prices redacted) for each of the years 2004–2016. The exhibit includes scores of invoices addressed to over 30 retailers located across Canada and covers goods with item numbers matching nearly all of the products represented in Exhibits O-2 to O-8.

[41] I note that no evidence of marketing or promotional materials has been provided. Nonetheless, the evidence includes images of the Opponent's JUMP trademark displayed on the exterior of various bag and luggage goods and invoices showing annual sales of such goods to numerous Canadian retailers from 2004 to 2016. I am therefore satisfied that the Opponent's JUMP trademark has been used continuously in Canada since at least 2004 and has thus become known in Canada to a fair extent.

Applicant's evidence of use and promotion

[42] The Applicant's evidence with respect to use and promotion of the Mark in Canada consists of the affidavit of its President and Chief Executive Officer (*“Président Directeur*

Général”), Bernard Ehret. Mr. Ehret states that the Applicant began operating in August 1998, specialising in the creation and manufacture of “*sacs et bagages*” (bags and luggage). I note that Mr. Ehret does not specify where the Applicant was operating at that time and makes no specific reference to Canada in this respect.

[43] Mr. Ehret states that he has been employed by the Applicant since 1999, but was previously (since 1969) the general manager (“*directeur général*”) of the company La Société Alsacienne de Maroquinerie (Société Alsacienne), a designer and manufacturer of sports bags located in France. It is important to note that Mr. Ehret does not explain the relationship, if any, between the Applicant and Société Alsacienne.

[44] Mr. Ehret states that he created the trademark “JUMP” in 1979, at which point the Applicant started to market its goods in Europe—and gradually in other countries such as Canada and the United States—under the Mark and the Oval JUMP Logo. An image of the Oval JUMP Logo is reproduced below:



[45] The Oval JUMP Logo contains the following additions to the Mark:

- Dark, solid fill within each of the letters of the word JUMP (as opposed to the letters being merely outlined, as they appear in the Mark);
- Stripes—horizontal or diagonal—across a different part of each letter;
- The words “DESIGN BERNARD EHRET” in small lettering beneath the word “JUMP”;
- The word “PARIS” in small lettering hanging vertically from the letter P in “JUMP”;
- A thick, dark, oval frame with a stitched border surrounding all of the word elements.

[46] Going forward, I will refer to the word JUMP with this dark fill and striping as the “Striped JUMP” and I will refer to the Mark, the Oval JUMP Logo and the Striped JUMP collectively as “the Applicant’s JUMP Trademarks”.

[47] I note that Mr. Ehret does not explain the apparent inconsistency between his statement that the Applicant began marketing JUMP goods in 1979 and his statement that the Applicant only began operating in 1998. It would appear from the above history that, when Mr. Ehret created the JUMP trademark in 1979, he did so as the general manager of Société Alsacienne, a third party entity. Mr. Ehret does not explain the chain of title for the Mark; nor does he specify when the marketing of goods under the Applicant’s JUMP Trademarks in Europe expanded to include marketing in Canada.

[48] In any event, Mr. Ehret does state that the Applicant distributes and markets its JUMP products in Canada and elsewhere through various channels and authorised distributors. He explains that the Applicant sells the products to authorized distributors, who in turn market them to Canadian purchasers through retail stores, online boutiques and department stores. Mr. Ehret notes that the products are also marketed through the Applicant’s web site at *www.jump.fr* and the Applicant’s participation at trade shows. In support of his assertions, he attaches the following exhibits to his affidavit:

- Exhibit BE-1 contains photographs of four JUMP products that Mr. Ehret attests are currently sold in Canada: a shoulder bag, a drawstring bag, a duffle bag and a wheeled suitcase, each identified on the photographs by a reference number. Each bag features a triangular label on which the Mark is displayed in a slight arc (above a swordfish design). Also attached to each bag is a hang-tag featuring the Mark (above a swordfish design) and, among other elements, a variation of the Oval JUMP Logo wherein the frame is merely a thin line. Images of the label and hang-tag are reproduced below:



product label



hang-tag

- Exhibit BE-2 contains four photographs of exterior and interior store displays, which Mr. Ehret attests show the Applicant's JUMP products in an Urban Traveller boutique in Toronto. The bags and luggage in the store displays resemble the items depicted at Exhibit B-1, but the branding is not visible, and there is no indication of when the photographs were taken.
- Exhibit BE-2 also contains copies of various documents that Mr. Ehret describes as purchase orders from the Applicant's authorized distributors for JUMP products in Canada, invoices and shipping confirmations, as follows:
 - A copy of a September 25, 1984 invoice for leather and linen JUMP bags, addressed to an agency in Ontario. However, due to the poor quality of the photocopy, the top portion has been truncated and therefore it is impossible to confirm that the logo appearing on top is the Striped JUMP. Moreover, owing to the faintness of the copy, it is not possible to make out the source of the invoice; however, given that "Soc Gén Als de" is visible below the visible portion of Striped JUMP and "SOCIÉTÉ ALSACIENNE DE" is visible above the address provided on the invoice, I find it reasonable to infer that the invoice is from Société Alsacienne.
 - A copy of a July 15, 2014 invoice from Société Alsacienne to Clear Image Marketing and PR in Ontario (Clear Image) for various bags and luggage made in Vietnam, for example, briefcases, suitcases, backpacks, wheeled bags, toiletry cases, etc. The invoice header displays the Mark (slightly arced, above a swordfish design) along with the notation "LUGGAGE TOTE & BAGS".
 - Purchase orders from Clear Image for similar goods, dated April 30, 2014 and May 7, 2014, respectively.
 - A packing list and waybill for shipments to Clear Image, dated July 4, 2014 and August 1, 2014, respectively. The packing list displays the Mark above a French address in the upper right corner; the waybill also identifies "JUMP" as the shipper.

- Documentation of various transactions in Asia, namely, a May 20, 2014 sales confirmation from Kodex Travelware Company in Taiwan (Kodex Travelware) regarding the May purchase order from Clear Image; a September 17, 2014 booking confirmation from a Vietnamese shipping company for a shipment to Toronto; an October 17, 2014 fund transfer from Clear Image to Kodex Travelware in respect of this purchase order; and a November 18, 2014 invoice from the Applicant to Kodex Travelware for royalties in respect of the purchase order. None of these documents display the Mark; however, I note that the invoice from the Applicant includes three items whose reference numbers match products depicted at Exhibit BE-1. I also note that the same address is given for the Applicant, the shipper “JUMP”, and Société Alsacienne on the various invoices, packing list and waybill in Exhibit BE-2.
- Exhibit BE-3 contains extracts from the Applicant’s website at *www.jump.fr*, which appear to have been printed in March 2017, although some of the webpages have a 2014 copyright notice. The Mark is displayed slightly arced in the header (above a swordfish design and the year 1979) and in the footer. The Mark is also displayed (above the word “PARIS” in small, plain lettering) at the top of what appears to be the home page, along with the notation “BERNARD EHRET DESIGN® LUGGAGE TOTES & BAGS SINCE 1979”. The furnished webpages advertise various types of luggage and bags. A wheeled suitcase resembling the one at Exhibit BE-1 is depicted, although its branding is not visible. The webpages also provide ordering and shipping information; however, there is no indication that Canadians have viewed the website or ordered products from it, or that the Applicant offers delivery to Canada.
- Exhibit BE-4 contains four photographs that Mr. Ehret attests show the Applicant’s stand at the Luggage, Leathergoods, Handbags and Accessories Association of Canada trade show held in Toronto from September 18 to 20, 2016. Various bags resembling those depicted at Exhibit B-1 are displayed in the photographs. Again, the branding on the bags themselves is not visible; however, the Mark (above the smaller “PARIS”) features prominently on the various display stands. Additionally, the Oval JUMP Logo is displayed on either side of the backdrop stand for the overall display.

[49] In its written argument, the Applicant contends that its JUMP trademarks have been the subject of extensive advertising and promotion in Canada for at least three decades, with the Oval JUMP Logo having been used in Canada since 1984.

[50] However, as can be seen from the above, the Applicant’s only evidence of use or promotion of a JUMP trademark in Canada prior to 2014 is a single invoice, dated in 1984, displaying what appears to be the bottom half of a Striped JUMP. Since the top half of the design is cut off, it is impossible to confirm whether this logo is indeed a Striped JUMP or a different logo. Moreover, the 1984 invoice appears to be from Société Alsacienne; since the relationship between that entity and the Applicant has not been explained, it is not possible to determine

whether any trademark use on this invoice inures to the Applicant's benefit. I would also note that the reference numbers on this invoice do not coincide with the reference numbers on the photographs of current products at Exhibit BE-1; it is therefore not clear that the same types of branded bags and luggage were sold in Canada back in 1984. In view of the foregoing, I am not satisfied that the Applicant has used a JUMP trademark in Canada continuously since 1984 and it is impossible to determine to what extent the JUMP trademarks were ever used in Canada from 2004 to 2014.

[51] With respect to subsequent activity in Canada, even if the evidence had shown that Société Alsacienne and Kodex Travelware were predecessors in title and/or authorized distributors of the Applicant, the evidence with respect to sales, at best, shows (i) the Mark displayed on a July 15, 2014 invoice and a July 4, 2014 packing list sent to a single company in Ontario; and (ii) the Mark displayed on the labels and hang-tags of certain bags and luggage sold to that company in 2014, as may be inferred by matching reference numbers from the exhibited product photographs with reference numbers on the 2014 sales documentation.

[52] Otherwise, the evidence merely shows the Mark displayed on a stand at a tradeshow in Toronto in 2016. The images at Exhibit BE-2 of a Toronto boutique selling the Applicant's JUMP products are undated and do not show the products' branding. As for the webpages from the Applicant's online store depicted at Exhibit BE-3, there is no indication that Canadians visited these webpages.

[53] Consequently, the Applicant has established only very limited use and promotion of the Mark, from 2014 to 2016.

Conclusion with respect to section 6(5)(a)

[54] Overall, since it appears from the evidence that the Opponent's JUMP trademark has become known in Canada to a greater extent than the Mark, this factor favours the Opponent.

Length of time the trademarks have been in use

[55] As it appears from the evidence described above, the Opponent has used its JUMP trademark in Canada in association with various bags and luggage since at least 2004.

[56] With respect to the Mark, for the reasons detailed above, I am only prepared to accept that it has been used in Canada since 2014.

[57] The Applicant submits that the 1984 invoice shows use of the Applicant's JUMP Trademarks in Canada since at least as early as September 25, 1984. However, as discussed above, I do not consider the truncated display on this invoice to constitute such use. Even if I were to accept that the 1984 invoice constitutes evidence of use of the Mark, which I do not for the reasons detailed above, there is no other evidence that would enable me to conclude that the Applicant has been using this mark since 1984. I cannot infer a continuous use of the Mark since 1984 from the production of a single invoice dating back to 1984, when the remainder of the evidence dates from 2014 to 2016. Moreover, as discussed above, the 1984 invoice is from a third party whose relationship with the Applicant has not been explained.

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

Nature of the parties' goods and trades

[59] When considering the nature of the goods and services and the nature of the parties' trades under section 12(1)(d) of the Act, it is the statement of goods and services as defined in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must be read with a view to determining the probable type of business or trade intended by the parties, rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[60] From a plain reading of the statements of goods in the Application and in the Opponent's Registrations, it appears that the nature of the parties' goods and trades is largely the same. In addition, the evidence shows that both parties sell similar types of luggage and bags, through similar channels.

[61] The Applicant submits that the parties' goods differ in practice because the Applicant's bags and luggage are expensive and of high quality (as indicated by the prices on the Applicant's webpages at Exhibit BE-3) and are sold in luxury or high end stores, whereas the Opponent's goods are sold at small retailers and department stores such as Canadian Tire, Walmart, Target and Giant Tiger, which are known for everyday, affordable products. In the Applicant's submission, the targeted consumers and channels of trade will therefore be different and consumers will not consider the parties' goods to be of the same category. The Applicant also argues that consumers would not purchase the products after only a cursory evaluation but rather after examining them in depth.

[62] However, the Supreme Court of Canada confirmed in *Masterpiece, supra*, that consumers' first impression remains the focus of the test for confusion, even when the goods are expensive. Moreover, in the present case, neither the statement of goods in the Application nor the statements of goods in the Opponent's JUMP Registrations restricts the channels of trade in the manner described by the Applicant. Nor does the evidence support such a distinction.

[63] In this last respect, Mr. Ehret's evidence is that the Applicant's authorized distributors market the Applicant's JUMP goods to Canadian purchasers through retail stores, online boutiques and department stores. He does not further specify the type of stores or boutiques through which the Goods are marketed, by Clear Image or otherwise. The only indication of where the Applicant's Goods have been sold to Canadian consumers is the set of photographs of the Urban Traveller boutique in Exhibit BE-2, and those images do not support the conclusion that only luxury or high end boutiques are targeted by the Applicant.

[64] With respect to the Opponent's evidenced channels of trade, although the invoices at Exhibit O-10 show sales to the department stores identified in the Applicant's submissions—as well as sales to certain bargain stores—the invoices also show sales to various other retailers or boutiques, for example, Remy Leather Goods, Romani Leather, Cleve's Sporting Goods, Glamour Sacs à Main etc. There is no evidence to suggest that none of the Opponent's invoiced retailers target markets that overlap with those in which the Applicant's Goods are sold.

[65] Thus, in the absence of further evidence with respect to the parties' retailers, there appears to be considerable overlap in the parties' goods and in their channels of trade.

[66] Therefore, the section 6(5)(c) and (d) factors also favour the Opponent.

Additional surrounding circumstances

[67] In its written argument, the Applicant raises several additional surrounding circumstances, as follows.

No instances of actual confusion

[68] The Applicant argues that the parties' trademarks have co-existed for a period of over thirty years without any evidence of instances of confusion.

[69] As conceded by the Applicant, an opponent is under no obligation to submit evidence of instances of actual confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. That said, the Supreme Court of Canada held in *Mattel, supra*, that an adverse inference may nevertheless be drawn from a lack of evidence of actual confusion, where such evidence would readily be available if the allegation of a likelihood of confusion were justified. Thus, although not a determining factor, if the evidence shows extensive concurrent use of both trademarks in the same area over many years, a lack of evidence of actual confusion *may* support a conclusion that confusion is not likely.

[70] However, in the present case, there is very limited evidence of the Mark's use in Canada. The Applicant submitted at the hearing that this should not lead to a negative inference when the evidence of use of the Applicant's JUMP Trademarks in Canada since 1984 is unchallenged by cross-examination. However, even if I were to accept the 1984 invoice from Société Alsacienne as evidence of use of a JUMP trademark by the Applicant's predecessor in title, there is no information on the volume of sales in Canada from 1984 to the present. A low volume of sales could easily explain the absence of evidence of confusion. Furthermore, in the absence of evidence establishing the extent to which the Mark has been used in Canada in markets that overlap with those of the Opponent, it is not possible to assess whether evidence of actual confusion would be readily available to the parties in the present case.

[71] Consequently, I do not consider the absence of evidence of actual confusion in this case to be a relevant factor.

Applicant's prior registration of the Oval JUMP Logo

[72] As noted above, the Applicant's evidence includes a certified copy of its registration No. TMA367,800 for the Oval JUMP Logo (the Applicant's Prior Registration).

[73] The Applicant submits that its registration for this variation of the Mark gives it rights to the Mark that predate any rights the Opponent may have in the Opponent's JUMP Registrations and, more particularly, prior rights in the dominant element of the Oval JUMP Logo, being the word JUMP. In this respect, the Applicant notes that the filing dates for the Opponent's JUMP Registrations (March 26, 1987 for TMA338,778 and March 8, 2001 for TMA581,305) are subsequent to the priority filing date of the Applicant's Prior Registration (March 13, 1987).

[74] The Applicant further submits that it continues to use its Oval JUMP Logo at the same time as the Mark, which makes the link between its JUMP trademarks that much more evident.

[75] However, I do not find the Applicant's Prior Registration to be of assistance in proving that there is no likelihood of confusion between the Mark and the Opponent's JUMP trademark. In this respect, it is well established that section 19 of the Act does not give the owner of a registration an automatic right to obtain a further registration, no matter how closely related it may be to the prior registration [*Groupe Lavo Inc v Procter & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB)].

[76] That being said, *use* of a previously registered trademark in Canada may be a relevant surrounding circumstance that decreases the likelihood of confusion [see *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SPA*, 2016 FC 895; and *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD), rev'g *sub nom Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB)]. However, in the present case, the Applicant's evidence shows, at best, only very limited display of the Oval JUMP Logo in Canada. The evidence is insufficient to establish that the Oval JUMP Logo is so well known in Canada that the ordinary Canadian consumer might recognize the Mark as a modernized, visually simplified version of the Oval JUMP Logo. Moreover, it is the Mark itself that must be considered when assessing its registrability, not the combination of the Mark and any additional matter with which it may be used. Therefore, the fact that the Mark

might be recognized as a variation of the Oval JUMP Logo when both trademarks are displayed together does not assist the Applicant's case.

[77] In any event, given the significant differences between the Oval JUMP Logo and the Mark, any use of this registered trademark by the Applicant would not be a particularly relevant surrounding circumstance in the case before me. The question I must answer is whether the Mark is registrable on its own—as applied for—and not whether it would be registrable with the additional word and design elements present in the Oval JUMP Logo.

Applicant's prior registration not cited against applications to register the Opponent's JUMP trademark

[78] The Applicant argues that the Registrar did not cite the Applicant's Oval JUMP Logo as a confusingly similar trademark—and thus an obstacle to registration—during examination of the applications for the Opponent's JUMP Registrations. The Opponent's applications were filed after the priority filing date of the Applicant's Prior Registration. The Applicant also argues that the Registrar did not notify the Applicant of the advertisement of the Opponent's applications, as section 37(3) of the Act would have required, had the Registrar been in doubt as to whether there was a likelihood of confusion between the parties' trademarks. The Applicant submits that, by not raising the issue of confusion between the Opponent's JUMP trademark and the Applicant's Oval JUMP Logo, the Registrar must have been satisfied that there was no likelihood of confusion between the parties' respective JUMP marks.

[79] At the hearing, the Opponent responded by arguing that the Applicant had initiated an opposition against registration of the Opponent's JUMP trademark, but withdrew it a few months later.

[80] I would first note that the file history for the Opponent's JUMP Registrations is not in evidence.

[81] Additionally, it has often been said that this Board is not in a position to explain examiners' findings. Examiners do not have before them the evidence that is filed by the parties in an opposition proceeding, and the onus is different at the examination stage [see *Simmons IP Inc v Park Avenue Furniture Corp* (1994), 56 CPR (3d) 284 (TMOB); and *Proctor & Gamble*

Inc v Morlee Corp (1993), 48 CPR (3d) 377 (TMOB)]. During examination, the Registrar needs to be satisfied that the trademark is *not* registrable to refuse the application under section 37 of the Act. Conversely, in an opposition proceeding under section 38 of the Act, the application must be refused unless the Registrar is satisfied, on a balance of probabilities, that the trademark *is* registrable [see *Joseph E Seagram & Sons, supra*; *Christian Dior, supra*].

[82] In any event, a decision with respect to the likelihood of confusion between the Opponent's JUMP trademark and the Oval JUMP Logo would not assist in determining the likelihood of confusion between the Opponent's JUMP trademark and the Mark. Regardless of any previous positions taken by the parties or the Registrar in respect of trademarks related to the Mark, I must come to a determination as to confusion in the case before me that is in accordance with the Act and the relevant jurisprudence and that has regard to the particular facts of the present case [see *Molson Breweries v Labatt Brewing Co* (1996), 68 CPR (3d) 202 (FCTD)].

[83] In this respect, the additional wording and the overall impression of the Oval JUMP Logo serve to distinguish it from the Opponent's JUMP trademark. The word JUMP has been fully integrated with the words DESIGN BERNARD EHRET PARIS and a stitched oval frame: the design feature of the word PARIS hanging vertically from the P in JUMP down to the end of the words DESIGN BERNARD EHRAT serves to link all of the word elements in this logo, as does the stitched oval frame.

[84] In its written argument, the Applicant cites a number of cases in which the Registrar held that the addition of a descriptive element to a trademark constitutes only a minor deviation. In this respect, the Applicant submits that the words DESIGN BERNARD EHRET PARIS merely name the designer and place of origin of the Goods. However, I do not consider the phrase "DESIGN BERNARD EHRET" to be merely descriptive of the Goods; rather, it serves to distinguish their source.

[85] The Applicant also cites a section of the *Trademarks Examination Manual*—a reference guide for trademark applicants and agents on how examiners will interpret and apply the relevant legislation—for the proposition that one must compare the visual impressions created by the word and design portions of a combination trademark to determine which feature is more influential or prominent and that the word element will be deemed dominant if the design

element does not stimulate visual interest. However, the cited section of the manual provides guidance on the specific question of whether a trademark having both word and design elements may be considered clearly descriptive when sounded. In any event, in my view, the striping pattern in the Oval JUMP Logo stimulates a fair degree of visual interest and the words DESIGN BERNARD EHRET PARIS also contribute to the overall impression created by the Oval JUMP Logo.

[86] In view of the foregoing, I do not consider any events during prosecution of the applications for the Opponent’s JUMP Registrations—involving the Oval JUMP Logo or otherwise—to be a surrounding circumstance that assists the Applicant in the present case.

The Applicant’s JUMP Trademarks constitute a family of marks

[87] The Applicant submits that the Mark is a mere variation of the Oval JUMP Logo, with which it forms a family of marks.

[88] The concept of a “family” of marks refers to a *series* of trademarks having common characteristics, registered and used by the same owner. I accept that, where a party owns a family of marks, there is an increased likelihood of consumers assuming that a new trademark sharing that characteristic is simply another member of the family [*Air Miles International Trading BV v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB)]. However, a party seeking to rely on a family of trademarks must establish that it is using more than one or two trademarks within the alleged family [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Clos St-Denis Inc v Verger du Minot Inc*, 2014 FC 997]. Accordingly, the concept of a family of marks does not apply to the present case, where the Applicant essentially seeks to add the Mark to a family consisting of only one prior trademark. Moreover, the Applicant’s evidence with respect to use of that prior trademark is limited.

[89] Indeed, the only evidence of the Oval JUMP Logo in Canada is the set of photographs showing its display on a Toronto trade show stand in 2016. Without evidence that goods were sold from the stand, this display of the Oval JUMP Logo does not constitute evidence of use of that trademark in association with goods within the meaning of the Act. Furthermore, although there is evidence that a *variation* of the Oval JUMP Logo was displayed on hang-tags for

products sold to an Ontario company in 2014, those sales appear to have been made by two third party entities—Société Alsacienne and Kodex Travelware—whose relationship to the Applicant has not been explained.

[90] Accordingly, this factor does not assist the Applicant.

State of the register and state of the marketplace

[91] Finally, the Applicant submits that consumers are used to seeing trademarks incorporating the word JUMP and to distinguishing between them, such that the scope of protection accorded to the Opponent's JUMP trademark should be limited.

[92] In this respect, in its written argument, the Applicant argues that a search of the trademarks register reveals hundreds of trademarks containing the word JUMP owned by different parties, including over 20 such trademarks for use in association with “bags”. In particular, the Applicant identifies three registrations and one allowed application: iJump (1,689,560); JUMPON Design (TMA913,087); JUMPON (TMA913,088); PUDDLE JUMP BAGS & Design (TMA945,797); and JUMP START Design (TMA608,879). The Applicant invites the Registrar to exercise its discretion to consult the Register in this respect and to take judicial notice of the existence of these trademarks.

[93] As I mentioned at the hearing, I am not prepared to take judicial notice of the trademarks referenced by the Applicant. If a party intends to rely on extracts of the register to argue the state of the register, those extracts should be filed as part of its evidence. The Registrar will exercise its discretion to consult the register only in very limited situations involving public interest, such as to verify whether an opponent is the owner of an extant registration or pending application alleged in its statement of opposition [see *Quaker Oats, supra*]. However there is no public interest in the Registrar seeking to assist an applicant to register its trademark by consulting the register and thereby doing what the applicant ought to have done through the filing of evidence [see *John Labatt Limited v WCW Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 (TMOB)].

[94] In any event, none of the specific trademarks on which the Applicant seeks to rely has for its word element the word JUMP on its own; rather, the word element consist of either a coined

word (iJUMP; JUMPON) or contains additional words (PUDDLE JUMP BAGS; JUMP START). Thus none of the referenced trademarks resemble the Opponent's JUMP trademark to the same extent as the Mark does. Their probative value would therefore be limited.

[95] Furthermore, in three recent decisions [*McDowell v Laverana GmbH & Co. KG*, 2017 FC 327; *McDowell v The Body Shop International PLC*, 2017 FC 581; and *Canada Bread Company, Limited v Dr. Smood APS*, 2019 FC 306], the Federal Court ruled that, unless a large number of trademarks is identified on the register, use of the trademarks cited must be established. Where a large number of relevant trademarks is identified, the Registrar can infer that the element they all have in common is used in the marketplace; where the number of trademarks identified is small, evidence of such use needs to be furnished. In the present case, the Applicant has referenced only five trademarks and provided no evidence of their use.

[96] Accordingly, the state of the register is not a significant surrounding circumstance in the present case.

Conclusion with respect to confusion

[97] Given that the analysis of each relevant factor listed in section 6(5) of the Act favours the Opponent, and that none of the surrounding circumstances, alone or in combination, are sufficient to shift the balance in the Applicant's favour, the Applicant has failed to demonstrate, on a balance of probabilities, that the Mark is not confusing with the Opponent's JUMP Registrations.

[98] Consequently, this ground of opposition is maintained.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[99] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act, because the Mark is not distinctive and does not distinguish the Goods and is not adapted so to distinguish the Goods from the goods of the Opponent.

[100] The relevant date for this ground of opposition is the date of filing the statement of opposition [see *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130

(FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)]. In this case, that date is June 1, 2016.

[101] To succeed under this ground, an opponent relying on its own trademark must establish that, as of the date the statement of opposition was filed, its trademark had become sufficiently known to negate the distinctiveness of the applicant's mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657; *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. In this respect, the opponent has the initial burden to show that its trademark or trade name (i) was known in Canada to some extent at least, *i.e.* that it had a reputation in association with the relevant goods or services that was "substantial, significant or sufficient", or (ii) was well known in a specific area of Canada [*Bojangles, supra*]. The word "reputation" here connotes more than mere knowledge: the trademark must be known to consumers, as an indicator of source [*Scott Paper Ltd v Georgia-Pacific Consumer Products LP* (2010), 83 CPR (4th) 273 (FC); *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305; *Domaines Pinnacle Inc v Les Vergers de la Colline Inc*, 2014 TMOB 110, *aff'd* 2016 FC 188].

[102] Once the opponent's initial burden is met, the applicant has a legal onus to show, on a balance of probabilities, that its own trademark was adapted to distinguish or actually distinguished its goods and services from those of the opponent [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)]. In this respect, the applicant must establish that its trademark was not likely to create confusion with the opponent's trademark at the relevant date [see *Muffin Houses, ibid*].

[103] Having reviewed the evidence summarized under the section 12(1)(d) ground of opposition, I am satisfied that the Opponent's JUMP trademark had become sufficiently known in Canada in association with bags and luggage at the relevant date of June 1, 2016. This conclusion is supported by evidence of substantial sales of such goods, branded with the Opponent's JUMP trademark, across Canada from 2004 to 2016.

[104] The burden therefore shifts to the Applicant, who has to show that, despite the reputation of the Opponent's JUMP trademark, the Mark could still serve to distinguish the Goods from the goods of the Opponent.

[105] Again, the issue revolves around the likelihood of confusion between the Mark and the Opponent's JUMP trademark. The difference in the relevant date does not have a significant impact on this analysis in the present case. Therefore, for the reasons discussed under the section 12(1)(d) ground of opposition, I am also not satisfied that the Mark was adapted to distinguish the Applicant's goods from those of the Opponent when the statement of opposition was filed on June 1, 2016.

[106] Accordingly, the ground of opposition based on non-distinctiveness is also successful.

GROUND OF OPPOSITION BASED ON ENTITLEMENT UNDER SECTIONS 16(2)(A) AND 16(3)(A)

[107] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark in respect of the Goods because, on the date when the Application was filed, the Mark was confusing with the Opponent's JUMP trademark, previously used in Canada by the Opponent in association with the goods set out at paragraph 7 above. However, as the Opponent has already succeeded under two separate grounds, there is no need to address the grounds of opposition based on sections 16(2)(a) and 16(3)(a) of the Act.

DISPOSITION:

[108] In view of all 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.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-11-28

APPEARANCES

Mark Hanna

FOR THE OPPONENT

Robert Brouillette

FOR THE APPLICANT

AGENTS OF RECORD

Hanna Glasz & Sher

FOR THE OPPONENT

Brouillette Legal Inc.

FOR THE APPLICANT