

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

**Citation: 2020 TMOB 50**

**Date of Decision: 2020-03-31**

**IN THE MATTER OF AN OPPOSITION**

**TM25 Holding B.V.** **Opponent**

**and**

**Slazengers Limited** **Applicant**

**1,569,795 for RAW** **Application**

[1] TM25 Holding B.V. (the Opponent) opposes an application for registration of the trademark RAW (the Mark) filed by Slazengers Limited (the Applicant).

[2] For the reasons that follow, I refuse the application.

THE RECORD

[3] On March 21, 2012, the Applicant filed an application bearing serial No. 1,569,795 (the Application) for registration of the Mark. The Application is based on use of the Mark in Canada since at least as early as September 2005 in association with the goods “golf balls” and proposed use in association with the goods “golf clubs, golf tees, golf club grips, golf club heads, golf club inserts, golf club shafts, golf irons, golf putters, golf putter covers, golf iron covers, golf tee

markers, grip tapes for golf clubs, golf ball retrievers, golf ball sleeves, golf bags; golf club bags and covers; golf bag covers” (collectively “the Goods”).

[4] The Application was advertised in the *Trademarks Journal* on September 3, 2014 for the purposes of opposition.

[5] On February 3, 2016, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to 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 provide that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before that date).

[6] The grounds of opposition pleaded are based on sections 30(b), 30(e) and 30(i) (compliance); 16(1)(a) and 16(3)(a) (entitlement); 2 (distinctiveness); and 12(1)(d) (registrability) of the Act as it read immediately before June 17, 2019. The Applicant filed a counter statement on June 8, 2016, denying each of the grounds of opposition.

[7] Only the Opponent filed evidence, which consists of certified copies of seven trademark registrations and one trademark application owned by the Opponent (respectively the “Opponent’s Registrations” and “Opponent’s Application”). The particulars thereof are set out at Schedule A hereto. Only the Opponent filed written arguments and a hearing was not requested.

#### EVIDENTIARY BURDEN

[8] The legal onus is on the applicant to show that the application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent 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]. The legal onus being on the applicant means that if a

determinate conclusion cannot be reached once all the evidence is in then the issue must be decided against the applicant.

#### GROUND OF OPPOSITION SUMMARILY DISMISSED

[9] The grounds of opposition raised under sections 30(b), 30(e), 30(i), 16(1)(a), 16(3)(a), and 2 of the Act are summarily dismissed for the reasons that follow.

#### **Compliance with section 30(b) of the Act**

[10] The Opponent pleads that the Application does not conform to the requirements of section 30(b) in that the Applicant had not used the Mark in association with the Goods “golf balls” continuously or at all since September 2005, the date of first use claimed. However, there is no evidence in the record to support such an allegation. I also note that the Opponent makes no submissions with respect to this ground in its written argument. Accordingly, the ground of opposition based on section 30(b) of the Act is dismissed, as the Opponent has failed to meet its evidential burden.

#### **Compliance with section 30(e) of the Act**

[11] The Opponent pleads that the Application does not conform to the requirements of section 30(e) of the Act because the Applicant could not have intended and did not have a *bona fide* intention to use the Mark in Canada in association with the Goods other than “golf balls”. More specifically, the Opponent pleads that, as of the Application’s filing date, the Applicant must be deemed to have been aware of the Opponent’s and/or its predecessor in title’s prior rights in (i) the trademarks covered by the Opponent’s Registrations and (ii) the Opponent’s trademark RAW, which had been used and made known in Canada in association with the goods set out in the Opponent’s Application, and that the Mark is confusing with these trademarks.

[12] However, even if the Applicant had been aware of these trademarks, the mere existence of an allegedly confusing trademark does not preclude an applicant from having a *bone fide* intention to use the trademark it is applying to register, in association with the specific goods or services set out in its application. I would also note that the Opponent has not filed any other

evidence or made any submissions in its written argument in support of this pleading. Accordingly, the ground of opposition based on section 30(e) of the Act is dismissed as well.

### **Compliance with section 30(i)**

[13] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act because, at the Application's filing date and at any other relevant date, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods, in view of the allegations in the grounds of opposition and the following allegations:

- the Applicant is deemed to have been aware of the Opponent's and/or its predecessor in title's earlier adoption and use of the Opponent's RAW trademarks in Canada;
- use with the Goods was unlawful because, at all material times, the Applicant was aware of the Opponent's and/or its predecessor in title's use and registration of the Opponent's RAW trademarks and knew that any use by the Applicant would be likely to have the effect of depreciating the value attached to the Opponent's Registrations, contrary to section 22 of the Act; and
- use of the Mark in Canada in association with the Goods would violate the Federal legislation set out at section 7 of the Act.

[14] 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. Mere awareness of an allegedly confusing trademark does not preclude an applicant from being satisfied of its own entitlement to use the trademark it is applying to register. 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 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)].

[15] The Opponent makes no submissions in support of this ground of opposition in its written argument and there is no evidence of bad faith on the part of the Applicant.

[16] With respect to the allegation that section 7 of the Act prevents registration of the Mark, the ground is insufficiently pleaded. As the Opponent does not specify which subsection of section 7 is alleged to be violated, the pleading does not provide sufficient material facts to enable the Applicant to reply. Moreover, the Opponent has not provided any evidence to suggest that the Applicant has violated a particular subsection of section 7.

[17] Section 22 of the Act provides that no person shall use a trademark registered by another person “in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto”. Setting aside the issue of whether combining sections 30(i) and 22 can form a valid ground of opposition, I find that the Opponent has not met its initial burden for this ground. Specifically, the Opponent has not adduced any evidence of goodwill in its registered trademarks or any evidence to suggest that use of the Mark is likely to depreciate the value of that goodwill. Even if I were to find that the Mark is confusing with one or more of the Opponent’s trademarks, confusion alone is not sufficient to establish a diminishment of goodwill [for a discussion of goodwill and the elements of section 22 see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at paras 46, 62–68].

[18] Consequently, the section 30(i) ground of opposition is dismissed as well.

### **Entitlement to registration under sections 16(1)(a) and 16(3)(a) of the Act**

[19] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because, at the claimed date of first use, namely September 2005, the Mark applied for in association with “golf balls” was confusing with (i) the trademarks covered by the Opponent’s Registrations TMA794,041, TMA910,242, TMA911,042, and TMA917,927, previously used in Canada by the Opponent and/or its predecessors in title; and (ii) “the various RAW marks used in Canada at common law”.

[20] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark because, as of the Application’s filing date, namely, March 21, 2012, the Mark applied for in association with the Goods other than “golf balls” was confusing with (i) the trademarks covered by the Opponent’s Registrations, previously used in Canada by the Opponent and/or its predecessors in title; (ii) the Opponent’s trademark RAW previously used at common law in

association with the goods listed in the Opponent's Application; and (iii) the Opponent's family of RAW trademarks.

[21] To meet its initial burden under these ground of opposition, an opponent must evidence the previous use of the trademark on which it relies (in accordance with sections 16(1) and (3) of the Act) and also that this trademark had not been abandoned at the date of advertisement of the applicant's application (as stipulated in section 16(5) of the Act). In the present case, the Opponent has not evidenced any use of its trademarks. Although claims of use are made in some of its registrations, the mere filing of a certificate of registration is insufficient to meet the evidential burden [see *Roxx Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. Consequently, I dismiss the grounds of opposition based on section 16 of the Act for the Opponent's failure to meet its initial burden.

#### **Distinctiveness of the Mark under section 2 of the Act**

[22] The Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act because the Mark "will not distinguish as it is not adapted to distinguish the [Goods] from the [goods] and services of others including those of the Opponent in association with which the Opponent, and/or its predecessors in title, has previously registered and/or used in Canada its RAW trade-marks as well as from its family of marks".

[23] In order to succeed under a section 2 ground of opposition, an opponent relying on a trademark must establish that, as of the filing date of the statement of opposition, this 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]. In the present case, the Opponent has not filed any evidence of use or promotion of any of the trademarks on which it relies, nor has it filed evidence to suggest that any of these trademarks had otherwise become known in Canada to any extent. The Opponent has therefore failed to meet its evidential burden under this ground of opposition. Consequently, the ground of opposition based on lack of distinctiveness of the Mark is also dismissed.

REGISTRABILITY OF THE MARK UNDER SECTION 12(1)(D) OF THE ACT

[24] The determinative issue in this proceeding is whether the Mark is registrable under section 12(1)(d) of the Act. The Opponent pleads that it is not, by reason of it being confusing with the trademarks covered by the Opponent's Registrations.

[25] The relevant date for the analysis of this 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)].

[26] The Opponent's initial burden with respect to this ground is met if one or more of the registrations relied upon are 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 all of the Opponent's Registrations are extant. I note that the registered goods and services have now been grouped according to the Nice classification system, which has resulted in a minor restatement of some of the goods (and the deletion of "rugs" from one of the registrations), but these adjustments do not affect my analysis.

[27] 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 any of the trademarks in the Opponent's Registrations.

**The test for confusion**

[28] 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, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[29] 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, supra*, 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.

[30] 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].

[31] In my opinion, comparing the Mark and the Opponent's registered trademarks G-RAW Design (TMA820,689), RAW SHOES (TMA770,144) and RAW FOOTWEAR (TMA770,308) will effectively decide the section 12(1)(d) ground of opposition. If confusion is not likely between the Mark and one of these three registered trademarks, then it will not be likely between the Mark and any of the other registered trademarks pleaded by the Opponent. I will therefore focus my discussion on these three registrations.

### **Degree of resemblance between the trademarks**

[32] 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. 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]. In this respect, the first portion of a trademark is generally considered to be the most important for the purpose of distinction [see *Conde Nast Publications*



*Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, the trademarks should not be dissected or subjected to a microscopic analysis, but rather looked at in their totality and assessed for their effect on the average consumer as a whole [*Veuve Clicquot, supra*; *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD)].

[33] The Mark consists of the single word RAW, whereas the Opponent's trademark G-RAW Design consists of a large stylized G design with the word RAW underneath it, as shown below:



[34] The design element of the Opponent's trademark consists of a solid half-capsule shape with a thin horizontal cutout creating the effect of a stylized letter "G". The horizontal cutout is the shape of the number "1" turned 90° to the left.

[35] While the word RAW is the sole element of the Mark, the Opponent's G-RAW Design is dominated by the large G design. This design is the first and, in my view, the most striking feature of the Opponent's trademark. Although it is a relatively simple design, I find that the arrangement of positive and negative space to suggest both the letter G and the number 1 simultaneously is a unique feature that stimulates some visual interest. I therefore find there to be a significant visual difference between the Opponent's G-RAW Design and the Mark. Nevertheless, the fact that the Opponent's G-RAW Design and the Mark both feature the word RAW as their sole word element results in there being an important point of similarity between the two trademarks.

[36] To the extent that the G design would be recognized as the letter G and sounded, there may also be a phonetic difference between the trademarks: the Mark would simply be sounded as "RAW" while the Opponent's design mark might be sounded as "G RAW". However, given the highly stylized nature of the letter G in this design, I consider it equally if not more likely that the design element would *not* be sounded.

[37] With respect to ideas suggested, I find that the Mark does not have any particularly obvious meaning in the context of the Goods—which are golf equipment—although it might suggest the idea of raw talent for the sport, or perhaps allude to the level of refinement in the styling of some of the goods or in the materials of which they are made. As for the G-RAW Design, I find that it does not have any readily apparent meaning in the context of its associated goods either, although the number “1” within it could perhaps lend it a slight laudatory connotation and, to the extent that it is used in association with sports wear, athletic footwear, and golf footwear, it too might suggest the idea of “raw” athletic talent or of a certain styling or choice of materials. With respect to the golf footwear, I note that the G in the design could stand for “golf”; however, I find this G to be stylized to the point where it may not be recognized as a letter of the alphabet on first impression.

[38] On balance, although the G-RAW Design features a significant design element, this trademark and the Mark share the same word element. I also find that the two trademarks are most likely to be sounded identically and that any differences in ideas suggested would appear to be minor. The result is a fair degree of resemblance overall.

[39] With respect to the Opponent’s word marks RAW SHOES and RAW FOOTWEAR (the Opponent’s Word Marks), I consider the word RAW to be their most striking element. Although the addition of the term SHOES or FOOTWEAR results in a visual and phonetic difference from the Mark, these additional terms are clearly descriptive of shoe and footwear goods. Thus the Applicant has adopted the most distinctive component of the Opponent’s Word Marks, and this results in there being a fair degree of resemblance between them and the Mark.

[40] Having found that the parties’ marks share a fair degree of resemblance, I must now assess whether any of the other factors are sufficient to shift the balance of probabilities in the Applicant’s favour. The remaining section 6(5) factors will therefore be of particular importance in the remainder of the analysis.

### **Inherent distinctiveness and the extent to which the trademarks have become known**

[41] Although RAW is an ordinary dictionary word, I find the Mark to be inherently distinctive, as it has no clear meaning in relation to golf equipment.

[42] I consider the Opponent's G-RAW Design trademark to be more inherently distinctive, in view of the dominant design feature combining a stylized G with a sideways number "1". Conversely, I find that the trademarks RAW SHOES and RAW FOOTWEAR are less inherently distinctive, because they clearly identify the Opponent's goods as being footwear.

[43] Distinctiveness can be enhanced through use and promotion [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. However, in the present case, there is no evidence of the extent to which any of the parties' trademarks have been used or promoted, or otherwise brought to the attention of Canadian consumers in a way that might enhance the marks' distinctiveness. The Opponent's G-RAW Design registration claims use in Canada; however, in the absence of evidence of use, it has been held that the Registrar can only infer a *de minimis* use of a registered trademark from the certificate of registration [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. *De minimis* use does not support a conclusion that the trademark has been used continuously from the dates claimed or that it has become known to any significant extent.

[44] Overall, this factor favours the Opponent in the case of G-RAW Design and the Applicant in the case of RAW SHOES and RAW FOOTWEAR, but only slightly in each case.

#### **Length of time the trademarks have been in use**

[45] Since the Registrar can at best infer only a *de minimis* use from a certificate of registration and since neither party filed any evidence of use of its trademark or trademarks, this factor does not favour either party.

#### **Nature of the parties' goods, services and trades**

[46] When considering the nature of the goods and services and the nature of the parties' trades, 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, supra*; 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, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[47] In the present case, the Application covers golf balls, golf clubs, golf tees, golf bags, and related equipment, whereas the Opponent's registrations cover clothing, footwear, headgear, leather goods and fashion accessories, as well as retail services therefor and related franchising services.

[48] The Opponent takes the position that the parties' respective goods are "identical or very closely related" since they are "sports related goods and, more specifically, goods for use in the sport of golf". The Opponent further submits that there is "no reason to expect the Applicant to sell its goods in a venue other than that utilized or intended to be utilized by the Opponent" and that "since there is no restriction regarding the nature of the business contained in the Applicant's statement of goods that might differentiate the respective businesses, it must be held that these overlap."

[49] More particularly, the Opponent invites the Registrar to take judicial notice of "the fact that clothing, footwear, headgear and sporting goods are sold in many of the same stores in Canada". The Opponent also notes that its services include retail services for leather goods and that the Goods "golf club grips", "golf club bags", "golf bags" and "golf bag covers" can all be made of leather. In addition, the Opponent seeks to draw an analogy between the present case and the case in *Salamon Sa v Tricot Exclusive Inc* (2001), 14 CPR 4th 520 (FCTD), where an application covering various clothing goods was refused on the basis of a likelihood of confusion with the opponent's trademarks used in association with ski equipment and clothing for ski and other sports.

[50] I would first note that the situation in *Salamon* can be distinguished from the present case, in that both parties' goods in *Salamon* included clothing and the opponent's trademark was held to be well known in Canada, with use dating back to 1957. In the present case, there is no

evidence of the Opponent's trademarks' reputation and no direct overlap in the parties' goods on the face of the Application and registrations at issue. At best, there is a possible connection between the parties' goods and trades in that the following goods listed in the Opponent's registrations may be used as accessories or apparel when playing golf or other sports:

G-RAW Design: Clothing, namely, warm-up suits, outdoor wear, sports wear, track suits.  
Footwear, namely, athletic, exercise, golf, outdoor.  
Leatherware, made of leather, namely, gloves.  
Imitation leather and goods made of these material, namely bags and wallets.  
Umbrellas.

RAW SHOES/  
RAW FOOTWEAR: Clothing, namely athletic, exercise, golf wear, gym, ski-wear, sports.  
Footwear, namely, athletic, exercise, fishing, golf.  
Umbrellas.

[51] Of these registered goods of the Opponent, the only ones that appear to be specifically tailored to golf are the "golf" footwear and (for the word marks) also the "golf wear" clothing. However, the Opponent's registrations do not specify whether the clothing and footwear in question are sporting goods or merely leisure wear made in a specific style. There is no evidence on the nature of the parties' respective goods, services, businesses or trades to assist in resolving this ambiguity. In this respect, I do not consider the Opponent's suggestion that clothing, footwear, headgear and sporting goods are sold in "many of the same stores" in Canada to be the kind of notorious fact or easily verifiable information of which I can take judicial notice.

[52] On the face of the Application, the Goods appear to be specialized equipment for a particular sport, whereas on the face of the Opponent's registrations, its goods and services appear to be oriented towards a full range of general apparel—from casual wear to business attire to formal wear—as well as "fashion items" and "fashion accessories". For example, the Applicant's various bags, covers and sleeves appear to be specialized equipment for protecting or transporting golfing gear; the Opponent's bags appear to be in the nature of fashion items, such as handbags, and bags for travelers. Furthermore, on a plain reading of the Opponent's Registrations, there is no indication that the retail services set out in these registrations are for specialized golfing equipment in the nature of golf club grips, golf club bags, golf bags or golf

bag covers or that this equipment is likely to be sold as part of the Opponent's registered retail services.

[53] Nevertheless, the Opponent's registrations are not restricted to fashion items. Moreover, even if the Goods differ in nature from the majority of the goods and services covered by the Opponent's registrations, the Goods are at least related to "footwear, namely, ... golf" and "golf wear" to the extent that specialized golf shoes or golfing apparel can be considered a type of golfing gear.

[54] The onus is on the Applicant to establish that confusion is unlikely. In the present case, the Applicant has not filed any evidence on the nature of its golfing equipment as compared to golf footwear or golf clothing, or on there being any differences in the parties' probable channels of trade. In the absence of any evidence on these points, I am unable to conclude from the wording of the Application and the Opponent's registrations that the Opponent's "golf" footwear and "golf wear" are not similar in nature to the Applicant's golfing equipment or that these two lines of goods are not likely to be sold in the same channels of trade.

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

**Additional surrounding circumstances:**

The Opponent's alleged family of marks

[56] The Opponent submits that there is an additional surrounding circumstance that must be considered in the present case, namely, that the Opponent owns a family of RAW marks.

[57] The concept of a "family" of marks refers to a series of trademarks having a common characteristic, all 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)].

[58] However, a party seeking to rely on a family of trademarks must establish that it is using the trademarks in 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 Opponent has not furnished evidence of use of any of the trademarks within the alleged family.

[59] Accordingly, this factor does not assist the Opponent.

#### Extension of the Opponent's brand

[60] The Opponent submits that, “as in many product areas, it is common for the owner of a mark to use associated marks to brand either the same or related goods” and that there is therefore “a strong likelihood that a prospective purchaser would believe that the golf equipment sold under the RAW mark would simply be an extension of the same brand of golf footwear offered by the Opponent” [my emphasis].

[61] However, I am not prepared to accept that consumers would likely view the trademark RAW applied to golfing equipment as an extension of the Opponent's brand. I would be prepared to accept that a fashion brand might be extended from footwear to clothing, handbags or the like. However, in the absence of evidence on the specific nature of the Opponent's footwear business—including with respect to “golf” footwear—and on the nexus between such a line of business and the Goods, I am not prepared to make any inferences favourable to the Opponent in this regard. In any event, there is no evidence of the *extent* of the Opponent's use of any of its trademarks in association with any of its registered goods or services, either before or after the Applicant's claimed date of first use. In the circumstances, I am not prepared to conclude that a prospective purchaser encountering the trademark RAW on golf equipment would be likely to believe that it is an extension of the Opponent's footwear, clothing and accessories brand, rather than recognizing it as the Applicant's golf ball brand.

[62] Accordingly, this factor does not assist the Opponent either.

#### **Conclusion with respect to confusion**

[63] As noted above, the test for confusion under the Act is not concerned with confusion of the trademarks themselves, but rather confusion as to whether the goods and services associated with those trademarks might share a common source. When assessing a ground of opposition

under section 12(1)(d), the question to be asked is whether a casual consumer somewhat in a hurry, with only a general recollection of the opponent's registered trademark applied to goods or services covered by that registration, would be likely to think that the applicant's goods or services might come from the same source. However, the onus is not on the opponent to show that such confusion is likely but rather on the applicant to satisfy the Registrar that there is no likelihood of such confusion.

[64] In the present case, analysis of all the relevant criteria leads me to conclude that the Applicant has failed to demonstrate, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trademarks G-RAW Design, RAW SHOES and RAW FOOTWEAR. I reach this conclusion for each of these registered trademarks, based on my findings that there is a fair degree of resemblance between the Mark and each one of these trademarks owing to the shared inherently distinctive element RAW; that there is no evidence of the Mark being known in Canada in association with golf balls or other Goods; that at least one of the goods in each of the three above-mentioned registrations is related to the Goods; and that the parties' channels of trade could potentially overlap. I must therefore decide against the Applicant and allow the ground of opposition based on section 12(1)(d).

[65] As the Applicant has failed to meet its legal burden, the section 12(1)(d) ground of opposition is successful.

DISPOSITION:

[66] 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.



---




Oksana Osadchuk  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



SCHEDULE A

<b>Registration No. Trademark</b>	<b>Goods</b>	<b>Services</b>	<b>Registration Date (Application Date)</b>
TMA770,144 RAW SHOES	(1) Leather and imitations of leather, and footwear, namely, boots, shoes, sandals made of these materials; traveling trunks and travel bags; umbrellas; clothing, namely athletic, baby, beachwear, business attire, bridal wear, casual, children's, exercise, formal wear, golf wear, gym, infant, loungewear, maternity, outdoor winter, rainwear, ski-wear, sleepwear, sports, undergarments, footwear, namely, athletic, beach, bridal, casual, children's, evening, exercise, fishing, golf, infant, outdoor winter, rain, headwear, namely berets, earmuffs, hats, toques; clothing accessory belts; none of the foregoing wares relate to wrestling, wrestling, wrestling entertainment or wrestlers.	(1) Business management, namely retail services and franchising services, namely, offering technical assistance to others in the establishment and/or operation of retail businesses selling clothing, footwear, jewellery, fashion accessories, leather goods, sunglasses, accessories or related fashion items; business administration; none of the foregoing services relate to wrestling, wrestling entertainment or wrestlers.	June 18, 2010
TMA770,308 RAW FOOTWEAR	(1) Leather and imitations of leather, and footwear, namely, boots, shoes, sandals made of these materials; traveling trunks and travel bags; umbrellas; clothing, namely athletic, baby, beachwear, business attire, bridal wear, casual, children's, exercise, formal wear, golf wear, gym, infant, loungewear, maternity, outdoor winter, rainwear, ski-wear, sleepwear, sports, undergarments, footwear, namely, athletic, beach, bridal, casual, children's, evening, exercise, fishing, golf, infant, outdoor winter, rain, headwear, namely berets, earmuffs, hats, toques; clothing accessory belts; none of the foregoing wares relate to wrestling, wrestling, wrestling entertainment or wrestlers.	(1) Business management, namely retail services and franchising services, namely, offering technical assistance to others in the establishment and/or operation of retail businesses selling clothing, footwear, jewellery, fashion accessories, leather goods, sunglasses, accessories or related fashion items; business administration; except services relating to wrestling, wrestling entertainment and wrestlers; none of the foregoing services relate to wrestling, wrestling entertainment or wrestlers.	June 21, 2010

Registration No. Trademark	Goods	Services	Registration Date (Application Date)
<p>TMA794,041</p> <p>G G-STAR RAW &amp; Design</p> 	<p>(1) Leather and imitations of leather and goods made of leather and imitations of leather, namely bags and pocket wallets; textile and textile goods namely bath linen, bedding, bed clothes, curtains, flags, furniture coverings, handkerchiefs, kitchen linen, table linen and rugs; clothing, namely jeans, trousers, shirts, t-shirts, socks, stockings, jackets, coats, shorts, blouses, sweaters, athletic clothing, baby clothing, casual clothing, children's clothing, formal wear, golf wear, infant clothing, loungewear, outdoor winter clothing, rainwear, sleepwear, sportswear, warm-up suits, ski-wear, swimming wear, undergarments and belts; headgear, namely berets, earmuffs, hats, caps and toques.</p> <p>(2) Trunks and travelling bags; footwear, namely casual footwear.</p>	<p>(1) Advertising, namely retail store services featuring clothing, footwear, headgear, leather ware, accessories; business management, including franchise services.</p>	<p>March 28, 2011</p>
<p>TMA820,689</p> <p>G-RAW Design</p> 	<p>(1) Leatherware, made of leather, namely shirts, jackets, pants, skirts, vests, dresses, coats, gloves, caps, hats, belts, handbags, purses, imitation leather and goods made of these materials, namely bags and wallets; traveling trunks; umbrellas; leather belts (clothing).</p> <p>(2) Clothing, namely, shirts, t-shirts, sweaters, jackets, suits, warm-up suits, shorts, skirts, dresses, jeans, trousers, blouses, beachwear, business attire, casual and formal wear, loungewear, outdoor wear, winter wear, rainwear, sports wear, undergarments, socks, stockings and belts, shawls, pullovers, knits, track suits, coats; footwear, namely, shoes, boots, athletic, casual, evening, exercise, golf, outdoor, winter, sneakers, slippers; headgear, namely, berets, earmuffs, hats, caps.</p>	<p>(1) Retail services for clothing, footwear, headgear, leather goods and fashion accessories; franchising services, namely, offering technical assistance to others, including offering assistance online, in the establishment and operation of retail business selling clothing, footwear, headgear, leather goods, including interior designing and provision of furniture and shelf systems.</p>	<p>March 26, 2012</p>

Registration No. Trademark	Goods	Services	Registration Date (Application Date)
TMA910,242 G-STAR ORIGINALS RAW DENIM & Design 	(1) Pants; shirts; t-shirts; sweats; knits, namely knitted vests, knitted sweaters, knitted shawls and knitted beanies; dresses; skirts; jackets; headwear, namely caps, hats and beanies; handbags. (2) Casual footwear. (3) Belts.		August 4, 2015
TMA911,042 G-STAR RAW Design 	(1) Pants; shirts; t-shirts; sweats; knits, namely knitted vests, knitted sweaters, knitted shawls and knitted beanies; skirts; jackets; headwear, namely caps, hats and beanies; handbags; belts. (2) Underwear. (3) Dresses. (2) Casual footwear.	(1) Retail services for clothing, footwear, headgear, leather fashion accessories. (2) Franchising services, namely, offering technical assistance to others in the establishment and operation of retail businesses selling clothing, footwear, headgear, leather fashion accessories.	August 12, 2015
TMA917,927 G-RAW Design 	(1) Pants; sweats; knits, namely knitted vests, knitted sweaters, knitted shawls and knitted beanies; dresses. (2) Shirts. (3) T-shirts; skirts; headwear, namely caps, hats and beanies; handbags; belts. (4) Jackets. (5) Underwear. (6) Casual footwear.	(1) Retail services for clothing, footwear, headgear, leather fashion accessories. (2) Franchising services, namely, offering technical assistance to others in the establishment and operation of retail businesses selling clothing, footwear, headgear, leather fashion accessories.	October 22, 2015
1,642,571 RAW	(1) Pants; shirts; sweats; knits; dresses; skirts; headwear, namely caps, hats and beanies. (2) T-shirts; jackets; belts. (3) Handbags. (4) Underwear.		(Pending application filed September 6, 2013)

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

---

No Hearing Held

**AGENTS OF RECORD**

Marks & Clerk

FOR THE OPPONENT

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

FOR THE APPLICANT