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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 172

Date of Decision: 2021-08-03

IN THE MATTER OF AN OPPOSITION

Majora Inc.

Opponent

and

Alliance Apparel Group, Inc.

Applicant

1,777,470 for MAJORELLE

Application

INTRODUCTION

[1] Majora Inc. (the Opponent) opposes registration of the trademark MAJORELLE (the Mark) filed by Alliance Apparel Group, Inc. (the Applicant).

[2] The application filed on April 14, 2016 is based on proposed use of the Mark in Canada. It claims the priority of a corresponding application filed on October 16, 2015 in the United States. The statement of goods and services of the application, as amended on April 10, 2017, reads as follows:

Goods: Clothing, namely, crop tops, fleece tops, halter tops, hooded tops, knit tops, tube tops, woven tops, pajama bottoms, swimming suit bottoms, jeans, pants, trousers, capris, leggings, shorts, overalls, shortalls, skirts, dresses, t-shirts, tank tops, rompers, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, underwear, lingerie, panties, bras, undergarments, bralettes, swimwear and jumpsuits (the Goods).

Services: Retail stores services and online retail store services for clothing (the Services).

[3] The application was advertised in the *Trademarks Journal* of August 16, 2017.

[4] The grounds of opposition all turn on the issue of confusion with the Opponent's trademarks MAJORA (registration No. TMA757,311) and MAJORA SKINNIES (application No. 1,654,370).

[5] It should be noted that the *Trademarks Act*, RSC 1985, c T-13 (the Act) was amended on June 17, 2019. Accordingly, all references in this decision are to the Act as amended, except for references to the grounds of opposition which refer to the Act as it read before it was amended. [See 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 prior to that date.]

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

THE RECORD

[7] The Opponent filed its statement of opposition on October 16, 2017.

[8] The Applicant filed and served its counter statement on February 5, 2018 denying all the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Daniella M. Geraci-Samlal. She provides a printout from the Canadian Trademarks Database for registration No. TMA757,311 for the trademark MAJORA.

[10] The Applicant did not file any evidence.

[11] Neither party filed written representations. Both parties were represented at a hearing.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence,

then the issue must be decided against the Applicant. 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS

Grounds of opposition summarily dismissed

[13] At the hearing, the Opponent conceded that it did not provide evidence to support either of the non-entitlement grounds of opposition respectively alleging confusion with the Opponent's previously used trademarks MAJORA and MAJORA SKINNIES, nor the ground of opposition alleging non-distinctiveness of the Mark.

[14] Accordingly, the section 16(3)(a) grounds of opposition and the non-distinctiveness ground opposition are dismissed for the Opponent's failure to meet its initial evidential burden.

[15] I will now consider the two remaining grounds of opposition.

Registrability ground of opposition – Section 12(1)(d) of the Act

[16] The ground of opposition alleges that the Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's registration No. TMA757,311 for the trademark MARJORA for a variety of goods, including ladies', men's and children's clothing, intimate apparel, and ladies' accessories, and for retail department store services.

[17] The material date to assess the ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[18] I have exercised the Registrar's discretion to confirm that the Opponent's alleged registration is in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As of the date of my decision, the Opponent's trademark MAJORA is registered in association with the goods and services identified in Schedule A to my decision.

[19] I note that registration No. TMA757,311 for the trademark MAJORA is the subject of a parallel proceeding under section 45 of the Act, initiated by the Applicant. The Registrar's decision in the section 45 proceeding was issued on June 30, 2021 [see *Alliance Apparel Group, Inc v Majora Inc*, 2021 TMOB 138]. The Registrar concluded that registration No. TMA757,311 should be amended to include only the following goods: "Ladies' and men's clothing, namely: jackets, pants, t-shirts, tank tops, sweaters, pullovers, ladies [sic] accessories, namely: jewellery."

[20] The time limited by the Act to appeal from the Registrar's decision has not expired and thus the June 30, 2021 decision has not taken effect. Consequently, for the purposes of this opposition proceeding, I consider the Opponent's registration No. TMA757,311 as it currently stands in association with the full statement of goods and services, rather than the amended version set out in the Registrar's decision of June 30, 2021.

[21] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

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

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has 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 enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54.] I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, at para 49, where the Supreme

Court of Canada states that the section 6(5)(e) factor, the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[24] I now turn to the consideration of the section 6(5) factors.

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

[25] The Applicant argues that the Opponent's trademark MAJORA has a low degree of inherent distinctiveness because the word major lauds the importance of goods and services. The Applicant submits that because the word major is a laudatory expression, the range of protection to be given to the Opponent's trademark should be limited; other traders should not be prevented from adopting a trademark comprising the laudatory word major.

[26] The Opponent disputes the Applicant's position as to the laudatory connotation attaching to its trademark MAJORA. It submits that the trademark is inherently distinctive since it is neither descriptive nor suggestive of the Opponent's goods and services. Further, the Opponent submits that the degree of inherent distinctiveness of its trademark MAJORA is higher than that of the Mark whose suffix ELLE is suggestive of women's clothing and accessories.

[27] In the present case, there is no evidence that the word major is a common component of trademarks or has been used descriptively in the clothing industry or in the field of retail sales services such that its impact on consumers would diminish. In addition, I disagree with the Applicant's position that the inherent distinctiveness of the Opponent's trademark is diminished owing to the laudatory connotation attaching to the word major. Rather, I agree with the Opponent that the trademark MAJORA, when considered in its entirety, is neither suggestive nor descriptive of the Opponent's goods and services.

[28] In the end, I consider both trademarks to be inherently distinctive. However, I assess the trademark MAJORA to have a relatively higher degree of inherent distinctiveness than that of the Mark whose suffix ELLE is suggestive of women's clothing and accessories.

[29] A trademark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its mark. Further, the mere existence of the Opponent's registration can establish no more than minimal use and cannot

give rise to an inference of significant and continuous use in association with the registered goods and services [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. As such, I am unable to determine the extent to which the Opponent's trademark MAJORA has become known in Canada.

[30] In view of the above, I conclude that the section 6(5)(a) factor favours the Opponent, but only to the extent that the trademark MAJORA possesses a relatively higher degree of inherent distinctiveness than the Mark.

length of time the trademarks have been in use

[31] As discussed above, the mere existence of the Opponent's registration cannot give rise to an inference of continuous use of the trademark in Canada.

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

the nature of the goods, business and trade

[33] When considering sections 6(5)(c) and (d) of the Act, the statements of goods and services as defined in the application for the Mark and in the Opponent's registration govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[34] While the Opponent's trademark is registered for a variety of goods, it suffices to consider the following registered goods to conclude that there are similarities, identity or overlap with the Goods in the application:

Ladies [*sic*], mens [*sic*] and childrens [*sic*] clothing, namely: suits, jackets, skirts, pants, dresses, coats, blouses, t-shirts, halter tops, tank tops, sweaters, sweater jackets, pullovers, cardigans, sweatsuits, swimwear, jeans; intimate apparel, namely: lingerie, pantyhose, hosiery, sleepwear, nightgowns, pajamas, robes, underwear, foundations, bras, camisoles

[35] In addition, there is a relationship between the above-identified registered goods and the Services in the application as they involve the retail sale of clothing. Furthermore, it is a well-known fact that a wide range of consumer goods are offered for sale in a department store. Thus, there is also a potential for overlap between the Services and the Opponent's registered services.

[36] Neither party filed evidence concerning the nature of the trade associated with its trademark. Further, neither the application nor the registration restricts the channels of trade. Therefore, for the purposes of assessing confusion, I find it reasonable to conclude that there is a potential for overlap between the parties' channels of trade.

[37] Accordingly, the sections 6(5)(c) and 6(5)(d) factors favour the Opponent.

the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested

[38] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side-by-side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[39] Given its position as to the laudatory connotation attaching to the trademark MAJORA because the word major is synonymous with important, the Applicant argues that the differences between the trademarks are sufficient to distinguish them. In that regard, the Applicant argues that there are differences between the trademarks when sounded owing to their suffix. It also argues that there are differences between the trademarks when viewed because the Mark is longer than the Opponent's trademark. Finally, the Applicant argues that the Opponent cannot claim a monopoly into the idea suggested by the laudatory word major.

[40] The Opponent disputes the Applicant's contention and submits that the degree of resemblance supports a finding in its favour. I agree.

[41] Indeed, I consider that there is a high degree of resemblance between the parties' marks in appearance and sound. Both trademarks consist of a one word with MAJOR as its first

component; the marks only differ by their suffix. As discussed before, the Applicant did not convince me that this is a case where the importance of MAJOR as the first component of the trademarks should be disregarded because major is synonymous with important.

[42] I acknowledge that in view of its suffix ELLE, the Mark is suggestive of women's clothing and accessories. However, given that each trademark is a coined word with MAJOR as its first component, when considered as a whole, I find that the trademarks resemble each other to a fair extent in ideas suggested.

[43] Accordingly, the section 6(5)(e) factor favours the Opponent.

conclusion on the likelihood of confusion

[44] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the relatively higher degree of inherent distinctiveness of the trademark MAJORA, the nature of the goods and services, the nature of the trade, and the degree of resemblance between the trademarks, I find that the Applicant has not discharged its legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark MAJORA of registration No. TMA757,311.

[45] Accordingly, the section 12(1)(d) ground of opposition succeeds.

[46] I wish to add that I would have reached the same conclusion if the Registrar's decision to amend the statement of goods of registration No. TMA757,311 had been in effect as of the date of my decision. Suffice it say that the amended statement of goods includes ladies' and men's clothing which I have considered relevant in the assessment of the section 6(5)(c) and (d) factors.

Non-entitlement ground of opposition – Section 16(3)(b) of the Act

[47] The ground of opposition is premised on allegations that the Applicant is not the person entitled to registration of the Mark because at the filing date of the application, the Mark was confusing with the Opponent's trademark MARJORA SKINNIES of application No. 1,654,370

[48] The material date to assess the section 16(3)(b) ground of opposition is the priority filing date claimed in the application for the Mark, namely October 16, 2015.

[49] At the hearing, the Opponent indicated that it would not be making any representations with respect to this ground of opposition because the Opponent did not provide evidence of its alleged application. I asked the Applicant whether it nonetheless wished to make representations concerning the section 16(3)(b) ground of opposition. The Applicant indicated that should the ground of opposition be assessed, its representations under the section 12(1)(d) ground of opposition would remain applicable.

[50] The Registrar has previously held that “an opposition is not simply an ‘inter partes’ proceeding but also involves a consideration of the public interest” [see *Coca-Cola Ltd v Compagnie française de Commerce International COFCI, SA*, (1991), 35 CPR (3d) 406, at 413]. Thus, I have decided to exercise the Registrar’s discretion to check the status of the Opponent’s alleged application No. 1,654,370 [*Quaker Oats Co of Canada, supra*].

[51] I confirm that the Opponent’s application, which has now proceeded to registration, was filed on December 2, 2013 and was still pending at the date of advertisement of the Mark. Thus, the Opponent’s initial evidential burden for this ground of opposition has been met [see section 16(4) of the Act].

[52] The issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that as of October 16, 2015 there was no reasonable likelihood of confusion between the Mark and the Opponent’s trademark MAJORA SKINNIES applied for registration on the basis of proposed use in Canada association with the following goods and services:

Goods: Casual clothing and dress clothing; jeans; pants; footwear, namely, shoes, boots and sandals; headwear, namely, hats, caps and toques.

Services: Retail store services featuring clothing, footwear and headwear.

[53] I turn to the assessment of the section 6(5) factors.

[54] I find that both trademarks are inherently distinctive. Further, I assess their degree of inherent distinctiveness to be about the same because they both have a suggestive connotation in the context of the goods and services listed in the parties’ applications. Indeed, as previously

indicated, the suffix ELLE in the Mark is suggestive of women's clothing and accessories. As for the Opponent's trademark, the word SKINNIES is suggestive of tight-fitting clothing. Accordingly, the section 6(5)(a) factor does not favour either party.

[55] Likewise, absent evidence of actual use of the trademarks, the section 6(5)(b) factor does not favour either party.

[56] Given the statements of goods and services as defined in the parties' applications, the section 6(5)(c) and (d) factors favour the Opponent.

[57] When assessing the degree of resemblance between the trademarks, I consider the term MAJORA to be the most striking component of the Opponent's trademark owing to the suggestive connotation attaching to the term SKINNIES. Thus, for similar reasons as those mentioned above, I find that the trademarks resemble each other in appearance, sound and ideas suggested to a fair extent. Indeed, considering the trademarks in their entirety as a matter of first impression, I find that any difference between them owing to the term SKINNIES is outweighed by the resemblance between MAJORA and MAJORELLE. Accordingly, the section 6(5)(e) factor favours the Opponent.

conclusion on the likelihood of confusion

[58] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, including the nature of the goods and services, the nature of the trade, and the degree of resemblance between the trademarks, I find that the Applicant has not discharged its legal onus to prove, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's trademark MAJORA SKINNIES of application No. 1,654,370, as of October 16, 2015.

[59] Accordingly, the section 16(3)(b) ground of opposition succeeds.

DISPOSITION

[60] 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.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Statement of goods and services of registration No. TMA757,311

Goods

(1) Ladies [*sic*], mens [*sic*] and childrens [*sic*] clothing, namely: suits, jackets, skirts, pants, dresses, coats, blouses, t-shirts, halter tops, tank tops, sweaters, sweater jackets, pullovers, cardigans, sweatsuits, swimwear, jeans; intimate apparel, namely: lingerie, pantyhose, hosiery, sleepwear, nightgowns, pajamas, robes, underwear, foundations, bras, camisoles; ladies [*sic*] accessories, namely: hats, gloves, jewellery, socks, hair clips, scarves, handbags, belts; small leather goods, namely: wallets, purses, key chains, briefcases and eyeglass cases; housewares, namely, flatware, cookware, glassware, giftware and table top items, namely: dinnerware made of porcelain, fine or bone china, pottery or stoneware, coffee mugs, café au lait cups, espresso cups, beverage glassware, wine glasses, martini glasses, serving plates and platters, vegetable bowls, salad bowls, butter dishes, cream and sugar sets, sugar bowls, gravy boats, salt and pepper shakers, egg cups, ice cream dishes, onion soup bowls, pitchers, hors d'oeuvre plates, butter warmers, butter cups, tea and coffee pots, eating utensils (namely forks, knives, spoons, chop sticks, seafood forks, lobster tongs, cocktail forks, butter knives), cooking pots, stock pots, pans, skillets, roasting pans, crock pots, casserole dishes, woks, rice cookers, baking sheets, baking pans, muffin tins, pie plates and servers, quiche dishes, soufflé dishes, waffle irons, fondue sets, fondue plates, fondue forks, burners and ignition fuel in liquid or solid form for fondues, ramekins, tureens, colanders, rolling pins, cake plates and servers, milk frothers, paper towel holders, utensil holders, spoon rests, trivets, tongs, peelers, rotary cheese graters, rolling mincers, food slicers, graters, corers, zesters, pizza wheels, spaghetti measurers, cheese plates, grapefruit trimmers, lemon squeeze, pie servers, jar openers, ice cream scoops, kitchen knives, bottle openers, can openers, scissors, candy thermometers, oven thermometers, garlic presses, turners, spatulas, cooking spoons, cooking forks, ladles, spoon rests, skimmers, strainers, corkscrews, spaghetti servers, potato mashers, whisks, measuring cups, measuring spoons, spice racks, canister sets, cookie jars, bread boxes, cutlery trays, jam jars, coaster sets, cheese boards, cutting boards, carving boards, lazy Susans, condiment sets, cookbooks, cookbook holders, wine racks, kitchen clocks, napkin holders, knife blocks, banana holders, nut crackers with picks, salad sets, chip and dip sets, dish racks, fruit bowls; home furnishings, namely: furniture for the kitchen, bedroom, bathroom, living room, dining room, rec room, office and outdoors, bedding, sheets, pillow cases, duvet covers, comforter covers, bed skirts, bedspreads, afghans, decorative pillow covers, pillow shams, pillows, mattress pads, mattress covers, quilts, quilt covers, duvets, hand and bath towels, wash cloths, bath mats and window treatments.

Services

(1) Retail department store services.

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

HEARING DATE 2021-06-02

APPEARANCES

Noelle Engle-Hardy	For the Opponent
Barry Gamache	For the Applicant

AGENTS OF RECORD

All the trademark agents at Smart & Biggar	For the Opponent
All the trademark agents at Robic	For the Applicant