



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 210

Date of Decision: 2022-10-31

IN THE MATTER OF AN OPPOSITION

Opponent: Citizens of Humanity, LLC

Applicant: Citizens of Earth Inc.

Application: 1,886,865

INTRODUCTION

[1] Citizens of Earth Inc. (the Applicant) has applied to register the trademark CITIZENS OF EARTH (the Mark) in association with a variety of clothing items and bags.

[2] Citizens of Humanity, LLC (the Opponent) opposes registration of that trademark. The opposition is primarily based on allegations that the Mark is confusing with the Opponent's CITIZENS OF HUMANITY trademark, registered in association with similar goods.

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

THE RECORD

[4] The application was filed on March 8, 2018, and advertised for opposition purposes in the *Trademarks Journal* on January 1, 2020. The applied for goods, as amended, are set out in Schedule A attached to this decision.

[5] On February 27, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 (the Act). All references are to the Act as amended June 17, 2019, unless otherwise noted.

[6] The grounds of opposition, as set out in the Opponent's statement of opposition, may be summarized as follows:

- The application does not contain a statement in ordinary commercial terms of the applied for goods;
- The application was filed in bad faith;
- The Mark is confusing with the Opponent's CITIZENS OF HUMANITY trademark;
- The Applicant is not the person entitled to the Mark in view of the previous use and making known of the Opponent's CITIZENS OF HUMANITY trademark and the use or making known of the Opponent's CITIZENS OF HUMANITY trade name;
- The Mark is not distinctive;
- The Applicant was not using or did not propose to use the Mark in Canada; and
- The Applicant was not entitled to use the Mark in Canada in association with the applied for goods.

[7] On July 3, 2020, the Applicant served and filed a counter statement denying each of the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Shelley Barham and certified copies of the following trademark registrations: CITIZENS OF HUMANITY (TMA873,008) and CITIZENS OF HUMANITY (TMA1,102,120).

[9] The Applicant did not file any evidence. The Opponent's affiant was not cross-examined.

[10] Only the Opponent submitted written representations; a hearing was not requested.

EVIDENTIAL BURDEN AND LEGAL ONUS

[11] The Applicant bears the legal onus of showing that its 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 [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD)].

OPPONENT'S EVIDENCE

[12] The Opponent's evidence is comprised of the affidavit of Shelley Barham, Vice President – Women, of the Opponent. Ms. Barham attests to, *inter alia*, the following facts regarding the Opponent:

- The Opponent is headquartered in Los Angeles, California and manufactures and sells high end denim products and other types of apparel. The Opponent's apparel are sold through various national Canadian retailers, including Aritzia, Nordstrom, Hudson's Bay Company, Holt Renfrew, TJX Canada/Winners and various boutique clothing stores throughout Canada. The Opponent's products are also available from the Opponent's website www.citizensofhumanity.com, as well as through various third party websites.

- Since at least as early as 2003, the Opponent has continuously used its trademark in Canada (and elsewhere) in association with the Opponent's goods. In particular, the Opponent's trademark appears on tags found on the inside and sometimes on the outside of apparel that the Opponent sells in Canada including on t-shirts, shirts, jackets, jeans, pants, skirts, tops, overalls and sweatshirts. Representative photographs showing how the Opponent's trademark is displayed on its products is attached to her affidavit as Exhibit A.
- Sales of products marked with the Opponent's trademark in Canada exceeded \$4 million per year from 2007 through 2009 and exceeded \$5 million per year from 2010 through 2019.

SECTION 12(1)(D) GROUND OF OPPOSITION - REGISTRABILITY

[13] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registered trademark, CITIZENS OF HUMANITY, registration No. TMA873,008 registered in association with the goods set out in the attached schedule B.

[14] The material date for considering this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CanLII 11769 (FCA)].

[15] I have exercised my discretion to check the Register and confirm that the Opponent's registration No. TMA873,008 is in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has met its burden with respect to this ground of opposition.

[16] I now have to determine, on a balance of probabilities, if there is a reasonable likelihood of confusion with between this trademark and the Mark.

Meaning of Confusion between Trademarks

[17] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

[18] 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 . . . 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.

[19] Thus, section 6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's goods, sold under the CITIZENS OF EARTH trademark, would believe that those goods were produced or authorized or licensed by the Opponent who sells its goods under the CITIZENS OF HUMANITY trademark.

Test for Confusion

[20] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in sections 6(5)(a) to 6(5)(e) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them.

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

Inherent distinctiveness and extent known

[22] The inherent distinctiveness of a trademark refers to its uniqueness when considered with its associated goods and/or services.

[23] In my view, the trademark CITIZENS OF EARTH, in association with bags and clothing apparel, is somewhat suggestive that the goods are designed for all people of the planet Earth. Similarly, the trademark CITIZENS OF HUMANITY, in association with similar goods, suggests that the goods are designed for all citizens of the human race. I therefore find that the parties' trademarks possess the same degree of inherent distinctiveness.

[24] The acquired distinctiveness of a trademark refers to the extent to which it has become known in Canada. The Opponent's evidence, summarized above, shows that the Opponent's trademark has become known to a considerable extent across Canada.

[25] As there is no evidence of use of the Mark, I cannot conclude that it has become known to any extent in Canada.

[26] In these circumstances, in view that the inherent distinctiveness of the marks is about the same, given that the Opponent's mark has become known to a greater extent in Canada than the Mark, I find that this factor favours the Opponent.

Length of time in use

[27] The Opponent has shown use of its marks since at least as early as 2003, while the Applicant has not shown any use of its Mark. This factor therefore favours the Opponent.

Nature of Goods and Channels of Trade

[28] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services as defined in the registrations relied upon by the Opponent and the statement of services in the application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*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)]. However, as each statement must be read with a view to determining the probable type of business intended, evidence of the parties' actual trades is useful [*Triangle Tyre Co, Ltd v Gestion André Touchette inc*, 2019 FC 220; *McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA); *McDonald's Corp v Silcorp Ltd* (1989), 55 CPR (2d) 207 (FCTD), aff'd (1992), 41 CPR (3d) 67 (FCA)].

[29] In the present case the Applicant's goods are either identical to or overlap with the Opponent's goods. In the absence of evidence to the contrary, I must also assume that the parties' channels of trade would overlap.

[30] This factor therefore favours the Opponent.

Degree of resemblance

[31] The preferable approach when assessing the degree of resemblance between two marks is to consider whether there is an aspect of the mark that is particularly striking or unique [see *Masterpiece*, *supra*, at para 64]. In my view, the most striking or unique aspect of the Opponent's CITIZENS OF HUMANITY trademark is the mark as a whole, which in the context of clothing is likely to be understood as clothing for everyone.

[32] Similarly, I find the most striking or unique aspect of the Mark to be the CITIZENS OF EARTH mark as a whole. While there may be differences between the various meanings of the word HUMANITY vs. the meanings of the word EARTH, I still find that in the context of clothing, the ideas suggested by the marks are similar, *i.e.*, clothing for everyone. As the Mark also begins with the same two words as the Opponent's mark, I also find there to be a considerable degree of resemblance between the marks in appearance and sound.

[33] I therefore find that this factor also favours the Opponent.

Conclusion regarding confusion

[34] Ultimately, the test to be applied is whether a casual Canadian consumer, having an imperfect recollection of the Opponent's trademark CITIZENS OF HUMANITY in association with clothing apparel and bags, when they see the trademark CITIZENS OF EARTH in association with the Goods, would think the products come from the same source.

[35] Having considered all of the surrounding circumstances contemplated by section 6(5) of the Act, and given that each of the relevant factors favours the Opponent as discussed above, I conclude that the Applicant has not met its legal burden of establishing on a balance of probabilities that confusion is not likely between the Mark and the Opponent's trademark. The section 12(1)(d) ground of opposition is therefore successful.

SECTION 2 GROUND OF OPPOSITION - DISTINCTIVENESS

[36] The material date for the section 2 ground of opposition is the date of filing the statement of opposition, namely, February 27, 2020.

[37] In order to meet its initial evidential burden under this ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant goods and/or services so as to negate the distinctiveness of the applied for trademark [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[38] In my view, the Opponent's evidence of its use of the trademark CITIZENS OF HUMANITY in Canada since 2003, set out above, is sufficient for the Opponent to meet its evidential burden for the section 2 ground of opposition. The Opponent having met its evidential burden, I find that this ground of opposition is successful based on the same analysis of confusion as set out above with respect to the section 12(1)(d) ground of opposition. Specifically, I find that the Applicant has not met its legal burden to demonstrate that there is no likelihood of confusion between the Mark and the

Opponent's trademark, and thus has not met its legal burden to demonstrate that the Mark is distinctive of the Applicant pursuant to section 2 of the Act as of the material date.

[39] Consequently, the section 2 ground of opposition is also successful.

REMAINING GROUND OF OPPOSITION

[40] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

DISPOSITION

[41] In view of the above, 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.

Cindy Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A – CITIZENS OF EARTH - APPLICATION No. 1,886,865

Goods

(1) Bags adapted for carrying vinyl records; ski goggles, ski glasses.

(2) Bags, namely, sports holdalls, travel bags, handbags, duffle bags, shoulder bags, luggage, backpacks, bags and holdalls for sports clothing, bags and holdalls for sports equipment, travelling school bags, satchels, flight bags, breast pump bags, shoe bags; gymnastic and sporting articles, namely, sports bags; holdalls, cases and bags, namely, garment bags for travel, key cases, wallet, suitcases, overnight cases, trunks for travelling, valises, purses, rucksacks, waist bags.

(3) Clothing, namely, swimwear, robes, blouses, shorts, camisoles, capes, cardigans, sweaters, pullovers, tank tops, jumpers, culottes, dress shirts, coats, sports coats, jackets, sports jackets, waistcoats, suits, trouser suits, skirt suits, coveralls, dresses, dusters, gloves, ear muffs, mittens, jeans, jogging suits, tracksuits, jumpsuits, warm-up suits, kerchiefs, leotards, neckerchiefs, neckties, nightgowns, pyjamas, raincoats, scarves, shirts, snow suits, T-shirts, polo shirts, sweatshirts, sweat pants, sweat suits, tennis wear tops, tennis wear shorts, trousers, underwear, headbands, sweatbands, stockings, socks, hosiery; medical uniforms; headwear, namely, hats, caps; ski boots.

(4) Sporting articles namely, sports gloves, snow skis, ski covers, bindings, release mechanisms for skis.

SCHEDULE B – CITIZENS OF HUMANITY – REGISTRATION No. TMA873,008

Goods

- (1) Tote bags; bags, namely carry bags.
- (2) Apparel, namely coats, coveralls, overalls, shirts, shorts, and sweaters.
- (3) Jeans, pants, skirts, jackets, vests, tops, t-shirts, shorts, bottoms and sweat shirts.
- (4) Apparel, namely jeans, pants, skirts, jackets, vests, tops, t-shirts and sweat shirts.
- (5) Apparel, namely, bottoms, camisoles, cardigans, dresses, dungarees, jerseys, overalls, scarves, shirts, shorts, tank tops and trousers.

Appearances and Agents of Record

No hearing held.

AGENTS OF RECORD

For the Opponent: Paula Clancy

For the Applicant: Chantal St. Denis