

NO CONFUSION BETWEEN "ARROW" AND "AEROPEAK BY DE UNGAVA" TRADE-MARKS, FEDERAL COURT RULES IN TRADE-MARK OPPOSITION CASE

Barry Gamache*
LEGER ROBIC RICHARD, LLP
Lawyers, Patent & Trademark Agents
Centre CDP Capital
1001 Square-Victoria – Bloc E – 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel. (514) 987 6242 – Fax (514) 845 7874
info@robic.com - www.robic.ca

A recent decision of Canada's Federal Court confirmed an earlier Opposition Board decision that there was no likelihood of confusion between a new, proposed trade-mark, AEROPEAK BY DE UNGAVA, for clothing and the long-standing ARROW trade-mark for shirts. (*Cluett, Peabody Canada Inc. v. Effigi Inc.*, 2005 FC 400 (March 23, 2005, de Montigny J.)).

On December 4, 1998, Effigi Inc. ("Effigi") filed a trade-mark application to register the proposed used trade-mark AEROPEAK BY DE UNGAVA in association with clothing. In January 2001, Cluett, Peabody Canada Inc. ("Cluett, Peabody") opposed the application, alleging confusion between Effigi's applied for trade-mark and its own family of trade-marks which incorporate the word "Arrow", used and registered for shirts and other articles of clothing.

Before the Opposition Board, Cluett Peabody filed evidence of its various registrations for ARROW-type trade-marks for clothing without, however, submitting any evidence of use of those trade-marks. This lack of evidence regarding Cluett Peabody's activities in association with its trade-marks did not stop the Board from considering the length of time Cluett Peabody's trade-marks had been in use: One of the registrations for the trade-mark ARROW mentioned that it had been used in Canada since at least as early as 1902. The Board accepted this statement in the registration as evidence of use of the trade-mark, since section 54 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 provides that a copy of any entry in the register purporting to be certified to be true by the Registrar (which was the case here) is evidence of the facts set out therein. The Board also noted that the parties' wares and respective

© CIPS, 2005.

* Barry Gamache, lawyer, is a member of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the April 2005 issue of the WIPR. Publication 142.174.

trade were similar. However, the Board made a crucial finding concerning the degree of resemblance between the trade-marks: In the Board's view, the parties' trade-marks could be distinguished visually; furthermore, they both suggested different ideas while the word "arrow" and the "aero" component in Effigi's mark could be pronounced differently. Under the circumstances, the Board concluded that Effigi had discharged its onus of establishing that there would be no likelihood of confusion between the parties' marks and rejected the opposition.

Cluett, Peabody appealed the Board's decision before the Federal Court. As permitted by Section 56 of the *Trade-marks Act*, it submitted fresh evidence before the Court: Evidence of use was presented detailing the extensive use of the ARROW trade-marks in Canada going as far back as 1902; the evidence also revealed that Cluett, Peabody displayed prominently its trade-marks on the wares it sells. Additionally, evidence was filed purporting to show that both the words "arrow" and "aero" have the same pronunciation, according to various dictionaries available in Canada.

The Court reviewed Cluett Peabody's new evidence but concluded that it would not have lead to conclusions of fact different from those of the Opposition Board: Despite clear evidence of use of the ARROW trade-marks, which was lacking before the Board, the Court concluded that the latter was ready to acknowledge such use going back to 1902 in light of Section 54 of the *Trade-marks Act*. Moreover, the evidence regarding the pronunciation of the words "arrow" and "aero" also revealed that when "aero" is used as a prefix, at the beginning of a word (such as is the case, for example, in "aerobalistics", "aerobatics" and "aerobic"), it can be pronounced in different ways, which was essentially the Board 's conclusion.

What was crucial for both the Court and the Board was that the parties' trade-marks did not resemble each other in any way, *when taken as a whole*. The Court referred to the guiding principle enunciated by the Federal Court of Appeal in *Christian Dior, S.A. v. Dion Neckware Ltd.*, (2002) 3 F.C. 405 where the Court indicated that confusion between trade-marks must be assessed by considering the marks in their totality: "While I appreciate that the first portion of a trade-mark is the most relevant for purposes of distinction (see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.T.D.), *per* Denault J., at page 370), marks are nevertheless to be considered in their totality and the effect or idea of the whole is to be compared even when words in the marks are disclaimed. (See *Standard Coil Products Can. Ltd. v. Standard Radio Corp.*, (1971) F.C. 106; *affd* (1976) 2 F.C. iv (C.A.); *Sealy Sleep Products Ltd. v. Simpson's-Sears Ltd.*, (1956-60) Ex. C.R. 441, approved by the Supreme Court of Canada in *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, (1965) S.C.R. 734.)"

Under the circumstances, the Court concluded that the Board's decision was both reasonable and correct in law. The Court's decision is a reminder that trade-marks must never be dissected when analyzing the issue of confusion; they must be analyzed in their totality.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

