IN THE MATTER OF OPPOSITIONS by Les Boutiques Verri Uomo Canada Inc. to application Nos. 552,545 and 552,553 for the trade-marks VERRI UOMO and VERRI UOMO Design filed by Leomar S.r.l.

On November 14, 1985, the applicant, Leomar S.r.l., filed applications to register the trade-marks VERRI UOMO and VERRI UOMO Design (a representation of which appears below) both based upon use of the trade-marks in Canada since July 1982 in association with "Clothing, namely: sweaters, suits, pullovers, shirts, coats, ties, belts, shoes and slippers".

The opponent, Les Boutiques Verri Uomo Canada Inc., filed statements of opposition in respect of each application on July 3, 1986. In each statement of opposition, the opponent alleged that the applicant's application is not in compliance with Section 29(i) (now Section 30(i)) of the Trade-marks Act in that the applicant had not used its trade-mark since the claimed date of first use asserted in its application. In respect of this ground, the opponent further alleged that if the trade-mark had been used in Canada since July of 1982 in association with the wares covered in the application, such use was by Vercelli S.R.L. and not by the applicant. Next, the opponent claimed that the applicant is not the person entitled to registration of its trade-mark in that, as of the filing date of its application, the applicant's trade-mark was confusing with the opponent's trade-mark VERRI UOMO which had been previously used since October 17, 1984 in association with the services relating to the sale of clothing and accessories for men. In respect of this ground, the opponent submitted that the applicant had not used the trade-mark since July 1982 and therefore was not entitled to rely upon use of its trade-mark prior to that of the opponent. Next, in each of the oppositions, the opponent asserted that the applicant's trade-mark is not distinctive in that it is confusing and was confusing as of the applicant's filing date with the mark VERRI UOMO as previously used by the opponent since October 17, 1984 in association with services relating to the sale of clothing. Further, the opponent alleged that the applicant is not the person entitled to registration in that, as of the filing date of the applicant's application, the applicant's trade-mark was confusing with the opponent's trade-name VERRI UOMO which had previously been used in Canada

since September 26, 1984 in association with the sale and marketing of men's clothing. Finally, the opponent in each of its statements of opposition alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's corporate name which had been previously used in Canada since September 26, 1984 in relation to the sale and marketing of clothing.

The applicant served and filed a counter statement in each opposition proceeding in which it asserted that its applications were in compliance with Section 29 (now Section 30) of the Trade-marks Act, that the applicant is the person entitled to registration of its trade-marks VERRI UOMO and VERRI UOMO Design, and that the applicant's trade-marks are distinctive of its wares.

The opponent filed as its evidence in each case the affidavit of Fred Jalal who was cross-examined on his affidavit, the transcript of the cross-examination forming part of the record in each opposition. The applicant failed to file any evidence pursuant to Rule 44 of the Trade-marks Regulations and the applicant's request for leave to submit evidence pursuant to Rule 46(1) of the Trade-marks Regulations was refused by the Opposition Board.

Neither party submitted written argument and while both parties were represented at an oral hearing, the agent for the opponent made no substantive submissions concerning any of the issues in the opposition proceedings.

With respect to the ground of opposition based on Section 30 of the Trade-marks Act, the legal burden is on the applicant to show that its application complies with Section 30 of the Act. However, in so far as the opponent relies upon allegations of fact in support of its ground of opposition, there is an evidentiary burden on the opponent to prove those allegations (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 517). Additionally, the material date in respect of this ground of opposition is as of the filing date of the application.

No evidence has been adduced by the opponent that the applicant has not used the trade-marks VERRI UOMO or VERRI UOMO & Design in Canada since July 1982. Further, no evidence has been adduced by the opponent that any use of the applicant's trade-marks in Canada was by Vercelli S.R.L. and not by the applicant. Accordingly, the opponent's Section 30 ground of opposition in each of the opposition proceedings has been rejected.

Each of the opponent's Section 16 grounds of opposition relating to the applicant's

entitlement to registration is based on its allegation that the applicant has not used its trade-marks in Canada since July 1982. As noted, the opponent's Section 30 ground of opposition which challenged that applicant's claimed date of first use has been rejected. Further, as the opponent has neither alleged nor established a date of use of its trade-mark or trade-name VERRI UOMO or its corporate name in Canada prior to July 1982, the opponent's grounds of opposition relating to the applicant's entitlement to registration have also been rejected.

The only remaining ground of opposition relied upon by the opponent in each proceeding is that the applicant's trade-marks VERRI UOMO and VERRI UOMO Design are not distinctive in that they were confusing as of the applicant's filing date with the mark VERRI UOMO previously used in Canada since September 26, 1984 in relation to the sale and marketing of men's clothing, namely, coats, jackets, sweaters, shirts, ties, pants, suits and smocks. With respect to the issue of distinctiveness, the opponent's use of its mark need not be a trade-mark or trade-name use. Further, the material date for assessing the issue of distinctiveness is as of the date of the opponent's opposition (June 26, 1986). While the opponent alleged that the applicant's trade-mark was not distinctive as of the filing date of the applicant's application, there is no indication in the applicant's counter statement nor was there any submission made by it at the oral hearing that it was relying on the determination of the issue of distinctivenesss as of its filing date. Accordingly, I am prepared to overlook this technical deficiency in the opponent's ground of opposition and will consider the issue of distinctiveness as of the date of opposition although it would appear from the evidence of record that the same conclusion would be reached if the filing date were to be taken as the material date in respect of this ground of opposition.

With respect to the distinctiveness issue, the legal burden is on the applicant to establish that its trade-marks are distinctive although there is an initial evidentiary burden on the opponent to prove the allegations being relied upon by it in respect of this ground. In this regard, the opponent has submitted the Jalal affidavit while the applicant has relied upon the transcript of Mr. Jalal's cross-examination to support its position that Mr. Jalal's affidavit should be rejected in its entirety in that Mr. Jalal was not properly sworn when he executed his affidavit and further that Mr. Jalal was evasive in his answers to the questions put to him during his cross-examination.

I must say it is difficult at times to assess with certainty whether a deponent is being evasive on cross-examination from a review of a transcript or whether, as appears to be the case in the present instance, there was a certain degree of animosity existing between the deponent and counsel for the applicant, combined with a very apparent lack of comprehension of the questions being asked

by counsel for the applicant and a problem in communicating in the English language by Mr. Jalal. I also had a sense of an attempt on the part of counsel for the applicant to either confuse or intimidate Mr. Jalal, particularly when pursuing a line of questions concerning the manner in which Mr. Jalal was sworn when he executed his affidavit.

From the transcript of the Jalal cross-examination, I am satisfied however that Mr. Jalal was not particularly convincing in respect of his responses concerning the adoption by the opponent of the mark VERRI UOMO. Nevertheless, the opponent was incorporated under the Canada Business Corporations Act on September 26, 1984 and the opponent carried on business under the name VERRI UOMO in Montreal of selling men's clothing at the retail level commencing in October of 1984. From October of 1984 to November of 1985 (applicant's filing date), sales of men's clothing in the opponent's store were in excess of $450,000. and, according to Mr. Jalal, the opponent's sales were accompanied by invoices bearing the trade-name VERRI UOMO as well as its corporate name. Further, the wares sold by the opponent included labels bearing the name VERRI UOMO.

Having regard to the opponent's evidence, I have concluded that the applicant's trade-marks VERRI UOMO and VERRI UOMO Design were not distinctive of the applicant's wares as of either the filing date of the applicant's application or as of the date of opposition.

In view of the above, I refuse the applicant's applications pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL QUEBEC THIS 30th DAY OF MARCH 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.