

IN THE MATTER OF AN OPPOSITION by The Dial Corp. and Greyhound Lines of Canada Ltd. to application No. 577,294, for the trade-mark CLASSIC NOUVEAU & Design filed by Fiorucci S.p.A.

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The applicant, Fiorucci S.p.A. filed an application with the Trade-Marks Office on January 30, 1987, based on a priority filing date of November 4, 1986, to register the trade-mark CLASSIC NOUVEAU & Design, depicted below, based upon use and registration in Italy in association with the following wares: leather and imitations of leather and articles made from these materials; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks, whips and harness; clothing, namely T-shirts, sweatshirts, cardigans, caps, panty hose, scarves, gloves, jackets, costumes, tailleurs, overalls, jerseys, vests, skirts, sweaters, jeans, pants, shorts, jackets, raincoats, coats, shirts, waistcoats, bath-gowns, bathing suits, underpants, hats, socks, stockings, ties, belts, braces, boots, shoes and slippers.

The application was advertised for opposition purposes in the Trade-Marks Journal of February 19, 1992, and the opponents, The Dial Corp. and Greyhound Lines of Canada Ltd., filed a statement of opposition on July 8, 1992 .

The first ground of opposition is that the applied for mark is not registrable pursuant to s.12(1)(d) of the Trade-Marks Act, R.S.C. 1985 c. T-13 (hereinafter the Act) as it is confusing with one or more of the following registered trade-marks of The Dial Corp.:

<b>TRADE-MARK</b>	<b>REGN. NO.</b>	<b>SERVICES/WARES</b>
GREYHOUND RACING DOG & Design	104,057	transportation by motor bus of passengers, mail, express and newspapers

GREYHOUND RACING DOG & Design	160,076	(1)packing, storage and truck transportation of the goods of others;(2) the pickup, transport and delivery of parcel express packages
GREYHOUND RACING DOG & Design	207,690	data processing by computer, leasing computer time, and equipment leasing
GREYHOUND RACING DOG & Design	221,522	consulting services for businesses, namely engineering and designing services; and employment agency and temporary staffing services
GREYHOUND RACING DOG & Design	237,508	toy vehicles

The second ground of opposition is that the applicant is not entitled, pursuant to s.38(2)(c) and s.16 of the Act, to register the applied for mark because at the date of filing, the applicant's trade-mark was confusing with the opponents' trade-marks consisting of the representation of a running greyhound dog (hereinafter greyhound racing dog) which had been previously used in Canada. As its third ground of opposition, the opponents contend that the applied for mark does not distinguish the wares or services of the applicant, pursuant to s.38(2)(d) of the Act, from the wares and services of others, including those of the opponents. The opponents allege as their fourth ground of opposition that the application does not comply with the requirements of s.30 of the Act in that: i) the statement of wares does not state in ordinary commercial terms the specific wares in association with which the applicant's mark has been used; and ii) the applicant has not used its trade-mark in Italy in respect of each of the wares claimed as of the filing date of January 30, 1987.

The applicant filed and served a counterstatement on November 17, 1992, in which it denied the allegations asserted by the opponents in their statement of opposition. As their evidence, the opponents filed the affidavit of John Munro, executive vice-president of Greyhound Lines of Canada Ltd. (a subsidiary of The Dial Corp. and recorded as a registered user of the racing greyhound design prior to the abolition of the registered user system). The

opponents also filed the affidavits of L. Gene Lemon, Vice-President and General Counsel of The Dial Corp. and Helen M. Bisson, legal secretary employed by the opponents' agents, Messrs. Smart and Biggar. The Lemon affidavit attaches and incorporates by reference another affidavit sworn by Mr. Lemon which had been prepared for a related opposition proceeding. The applicant's evidence consists of the affidavit of Robert Sterling, trade-mark agent. As evidence in reply, the opponents filed the affidavit of Andrea Billingham, trade-mark searcher for the agents of the opponents. Both the opponents and the applicant filed written arguments and both were represented at an oral hearing.

With respect to the s.30 grounds of opposition, there is a legal burden on the applicant to establish that its application was in compliance with s.30 of the Act as of the applicant's filing date (see the opposition decision in Style-Kraft Sportswear Ltd. v. One Step Beyond Ltd. (1993), 51 C.P.R. (3d) 271, and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) (hereinafter John Labatt)). However, to the extent that the opponents rely on allegations of fact in support of the ground of opposition, there is an initial evidential burden on the opponents to prove those allegations. To meet the evidential burden upon them in relation to a particular issue, the opponents must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist (see John Labatt, supra, at 298).

In the present case, there is nothing in the evidence to suggest that the applicant's wares would be described differently in the trade. Further, the opponents have not adduced any evidence to show that the applicant had not used its trade-mark in Italy in respect of each of the wares described in the application. Consequently, I am not satisfied that the opponents have met the evidential burden upon them in respect of the s.30 grounds, and I reject these grounds of opposition.

The remaining grounds of opposition under s.12(1)(d), non-entitlement and non-distinctiveness are all contingent upon a finding of confusion between the applicant's trade-mark CLASSIC NOUVEAU & Design and The Dial Corp.'s greyhound racing dog trade-marks. The applicant submits that since the affidavit of Helen M. Bisson comprises certified copies of several of The Dial Corp.'s registered trade-marks which were not referenced in the opponents' statement of opposition, it must be disregarded by the Registrar. Counsel for the opponents submitted that out of The Dial Corp.'s family of racing greyhound trade-marks, only the five registered marks pleaded in the statement of opposition would be relied on under the s. 12(1)(d)

ground. In any event, I consider The Dial Corp.'s trade-marks registered under Nos. 104,057 (for transportation by motor bus of passengers, mail, express and newspapers) and 160,076 (for (1) packing, storage & truck transportation of the goods of others; and (2) the pickup, transport and delivery of parcel express packages) [hereinafter "transportation and courier services"] shown below, to be the most relevant of all of The Dial Corp.'s marks.

Thus, a consideration of confusion will be made under s.12(1)(d) between these marks and the applicant's mark.

The material date to consider the issue of confusion with a registered trade-mark pursuant to s. 12(1)(d) of the Act is the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)). Further, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in s.6(2) of the Act, consideration is to be given to all of the surrounding circumstances, including the following specifically set forth in s.6(5) of the Act: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. I will review the evidence in light of these criteria, and any other surrounding circumstances.

With respect to the inherent distinctiveness of the trade-mark, the applicant submits that The Dial Corp.'s greyhound racing dog suggests speed and is therefore suggestive of a quality of The Dial Corp.'s transportation and courier services. I agree that the greyhound racing dog is at least somewhat suggestive of speed. On the other hand, I do not consider the applicant's mark to possess any apparent significance in relation to the clothing and other wares covered in its application. Therefore, I conclude that the applicant's mark possesses a greater degree of inherent distinctiveness than The Dial Corp.'s mark.

The extent to which the trade-marks have become known in Canada favours the opponents. A review of the Lemon affidavit suggests that the “image of a running dog” is a trade-mark known world wide. What is more relevant with respect to s.6(5)(a) however is that the Munro affidavit evidences fairly extensive use of the racing greyhound design mark in Canada in association with passenger and charter coach transportation, related tourism businesses and package courier service. Mr. Munro explains that his company is Canada’s largest intercity coach corporation operating over 400 motor coaches and servicing over 1000 communities across Canada. Further, at paragraph 6 he states that the total number of passengers transported as reported to regulatory authorities by his company has been in excess of 5 million for each of the past 20 years. On the other hand, since the applicant’s mark is based on use and registration in Italy, I must conclude that the applicant’s mark has not become known in Canada.

The length of time the marks have been in use also favours the opponents. In his affidavit, Mr. Munro states at paragraph 7 that his company has used “the running dog trade-mark” extensively in Canada in association with the activities of his company since about 1930. At paragraph 4 of his affidavit, Mr. Munro asserts that total revenues for his company excluding subsidiary companies was in excess of 170 million dollars in 1991 and that most of these revenues were the result of activities his company carried out in association with the greyhound racing dog trade-mark. To corroborate this assertion, he attaches as Exhibits A1-A7 of his affidavit annual reports of his company’s activities for the years 1991, 1990, 1989, 1988, 1984, 1981 and 1980. As for the applicant’s mark, use of it has not been shown in Canada.

Regarding the wares, services and trades of the parties, it is the applicant’s statement of wares and the opponent’s statement of services in registration No. 245,033 that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the applicant rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see page 3 of the unreported decision of the Federal Court of Appeal in McDonald’s Corporation v. Coffee Hut Stores Ltd. (Court No. A-278-94; June 5, 1996).

In the present case, the applicant’s application covers various specialized wearing apparel items as well as ordinary clothing items. The Dial Corp.’s most relevant registrations, on the

other hand, cover transportation and courier services. In my view, the specialized wearing apparel items as well as ordinary clothing items of the applicant are significantly different from The Dial Corp.'s transportation and courier services. Consequently, I conclude that there would be little if any overlap in the trades of the parties.

At the oral hearing, the agent for the opponents contended that there is a connection between the wares, services, and trades of the parties because Greyhound Lines of Canada Ltd. has used the trade-mark in association with clothing items. However, The Dial Corp. can not rely on the alleged use of the mark in association with clothing by Greyhound Lines of Canada Ltd. because The Dial Corp. has not shown that Greyhound Lines of Canada Ltd. was licensed to use the greyhound racing dog in association with such wares. Furthermore, use of the mark by Greyhound Lines of Canada Ltd. in association with clothing is of no relevance to the s.12(1)(d) ground because clothing is not covered by The Dial Corp.'s registrations. Since this issue may be relevant under s.16 and non-distinctiveness, it will be considered later under those grounds.

Pursuant to s.6(5)(e), the Registrar shall have regard to the degree of resemblance between the trade-marks in appearance, sound and ideas suggested. When examining the degree of resemblance between the two marks, the marks should be looked at in their totality and assessed for their effect on the average consumer as a whole. In the present case, the marks are considerably different phonetically. The applicant's mark would be sounded as CLASSIC NOUVEAU and design while The Dial Corp.'s marks would not be sounded because they are design marks. Even if The Dial Corp.'s marks were sounded, they would likely be sounded as "greyhound" or "dog" which is quite different from "CLASSIC NOUVEAU and design". Visually, the marks bear relatively little similarity when considered in their entirety as a matter of immediate impression. Even if the average consumer were to identify what appears to be a design of a racing dog as an element of the applicant's mark, that component is a relatively minor feature of the trade-mark CLASSIC NOUVEAU and design. Finally, I do not find any similarity in the ideas suggested by these marks. Consequently, I do not consider there to be a significant degree of resemblance between the two marks when considered in their entirety.

Counsel for the applicant also submitted that a further surrounding circumstance for the Registrar to consider in the present case is the plurality of dog design marks for a wide variety of services, including clothing, that co-exist on the register, as evidenced by the Sterling affidavit. As its reply evidence, the opponents submitted the affidavit of Andrea Billingham to show that application No. 663,676 had been abandoned and application No. 541,139 was in opposition. Of

the remaining marks, few incorporate a greyhound racing dog design for wares similar to those of the trade-marks in issue and use was not shown for any of them. In the absence of evidence of use, the existence of this limited number of applications and registrations is not sufficient to allow me to infer that any of those marks have been used to any significant extent (see Del Monte v. Welch (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)). Consequently, I am unable to conclude that consumers are used to seeing such marks in the marketplace and would therefore be more likely to discriminate one from another.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Considering the low degree of resemblance between the trade-marks at issue, and the fact that there would be little if any overlap in the trades of the parties, I find that the applied for mark is not confusing with The Dial Corp.'s marks. The first ground of opposition is therefore unsuccessful.

With respect to the ground of opposition pleaded under s.16, Greyhound Lines of Canada Ltd., in its capacity as opponent, can rely on its prior activities with respect to the greyhound racing dog design mark in so far that it can establish use of the trade-marks in association with clothing. The material time with respect to this ground of opposition is the filing date of the applicant's application. In his affidavit, Mr. Munro maintains that the mark has been applied to uniforms worn by employees, "ticket jackets", badges, and clothing items awarded monthly to employees including sweatshirts, T-shirts, hats and sports bags. He also alleges that his company has had a program of selling to employees and others clothing including jackets, T-shirts, and sweaters featuring the trade-marks of his company in association with the running greyhound dog trade-mark for over 10 years. To corroborate his assertion, he attaches as Exhibit N a copy of what appears to be a catalog of such clothing items. Finally, Mr. Munro estimates that several thousand of such clothing articles are distributed and sold annually through this program.

In my view, providing employees with either uniforms or gifts of clothing displaying the mark, or selling clothing internally does not constitute use in the "ordinary course of trade" within the meaning of s.4(1) of the Act. Although Greyhound Lines of Canada Ltd.'s program of selling clothing to "others" clothing may qualify as use for the purposes of s.4(1), I consider this to be a very limited and somewhat unusual trade. From the evidence furnished, it appears as though clothing is merely an ancillary feature of the opponent's transportation and courier services. Consequently, I do not think this program qualifies as use in the ordinary course of trade for clothing.

Even if I were satisfied on a balance of probabilities that use for clothing had been shown, I would not be satisfied that the applied for mark is likely to be confused with The Dial Corp.'s marks. In view of Greyhound Lines of Canada Ltd.'s limited and unusual channel of trade with respect to clothing, I conclude that there would be little if any overlap in the trades of the parties which would contribute to a finding of a likelihood of confusion between the parties' marks. Further, the remaining circumstances existing at the date of filing are not materially different from those I reviewed in assessing the ground of opposition under s.12(1)(d). Consequently, the opponent is not successful under this ground.

With respect to the third ground of opposition, the material time is the filing date of the opposition. Once again, I do not consider the circumstances at the filing date of the opposition to be much different from those I reviewed in assessing confusion under s.12(1)(d) and under s.16. Consequently, this ground of opposition does not succeed.

In view of the reasons stated above, I find that the applied for mark CLASSIC NOUVEAU & Design is not confusing with the opponents' greyhound racing dog design marks within the meaning of s.6 of the Act. Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I reject the opponents' opposition pursuant to s.38(8) of the Act

DATED AT HULL, QUEBEC, THIS 25<sup>th</sup> DAY OF OCTOBER, 1996.

Cindy R. Vandenakker  
Hearing Officer  
Trade-Marks Opposition Board