

IN THE MATTER OF AN OPPOSITION by Guess?, Inc. to
application No. 663,688 for the trade-mark Triangle Design filed by
France Roy

On August 7, 1990, France Roy filed an application to register the trade-mark Triangle Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "bijouterie".

The opponent, Guess?, Inc., filed a statement of opposition on August 9, 1991 in which it alleged that the applicant's trade-mark is not registrable and not distinctive, that the applicant's application is not in compliance with Section 30(i) of the Trade-marks Act, and that the applicant is not the person entitled to its registration, in view of the registration and prior user by the opponent of its registered trade-marks: GUESS? & Triangle Design, registration No. 336,133; GUESS? & Triangle Design, registration No. 348,382; and GUESS? & Triangle Design, registration No. 373,753. Further, the opponent alleged that the applicant is not the person entitled to registration and that the applicant's trade-mark is not distinctive in view of the opponent's previously filed application for the trade-mark GUESS? & Triangle Design, application No. 659,001. According to the opponent, the applicant's trade-mark Triangle Design is confusing with its registered trade-marks and pending trade-mark application covering the trade-marks GUESS? & Triangle Design.

The applicant filed a counter statement in which she effectively denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of Antonio R. Sarabia II and Fay Haakman while the applicant failed to file any evidence in this opposition.

Both parties filed a written argument and, while the opponent requested an oral hearing, it subsequently withdrew that request.

The opponent filed certified copies of the trade-mark registrations identified in its statement of opposition as exhibits to the Haakman affidavit. Each of the registrations is for the identical

trade-mark GUESS? & Triangle Design, a representation of which is set out below, and the wares covered in the opponent's registrations include various articles of men's, women's and children's clothing, sunglasses, clocks, leather handbags, jewellery, namely bracelets and earrings, and watches. Additionally, application No. 659,001 had matured to registration on January 31, 1992 and Ms. Haakman has annexed a certified copy of registration No. 393,519 to her affidavit. From the representation of the trade-mark in application No. 659,001 set out below, it is noted that this mark is almost identical to the opponent's registered trade-marks and the wares set forth in the opponent's application include wearing apparel and sports bags, tote bags, hand bags and travel bags.

Registration No. 336,133
Registration No. 348,382
Registration No. 373,753

Application No. 659,001

The opponent's grounds of opposition all turn on the issue of confusion between the applicant's trade-mark Triangle Design and the opponent's registered trade-marks GUESS? & Triangle Design and its pending trade-mark application for the mark GUESS? & Triangle Design. With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)). The material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (August 7, 1990) and the date of opposition (August 9, 1991).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's trade-marks GUESS? & Triangle Design and the applicant's trade-mark Triangle Design are all inherently distinctive.

No evidence has been filed by the applicant and her trade-mark must be considered as not having been used or become known to any extent in Canada as of the material dates in this opposition. On the other hand, the Sarabia affidavit establishes that the opponent's trade-marks GUESS? & Triangle Design have become known in Canada in association with wearing apparel and watches with sales of clothing and watches exceeding \$11,000,000 and \$1,000,000 respectively as of the date of the Sarabia affidavit. As well, Mr. Sarabia indicates that the opponent's GUESS? & Design watches are sold in over 3,000 retail stores in Canada and, in paragraph 27 of his affidavit, the affiant has provided a list of department stores, clothing stores, gift stores and jewellery stores through which the opponent's watches are sold in Canada. Further, Mr. Sarabia attests to sales of the opponent's GUESS? & Triangle Design sunglasses in Canada although he is silent as to the volume or dollar value of sales of the opponent's sunglasses in this country. As a result, both the extent to which the trade-marks at issue have become known and the length of time that the marks have been in use favour the opponent in this opposition.

The applicant's "bijouterie" is closely related to the opponent's watches and appears to be overlapping with the opponent's "jewellery, namely bracelets and earrings" covered by registration No. 373,753. The opponent's watches are sold through jewellery stores in Canada and I would expect that the applicant's "bijouterie" would or could also be sold through the same retail outlets as the opponent's wares.

The only remaining criterion for consideration under Section 6(5) of the Act is the degree of resemblance between the trade-marks at issue in appearance, sounding and ideas suggested. In this regard, the trade-marks at issue bear no similarity in sounding and do not suggest any particular idea in common. However, the trade-marks are somewhat similar in appearance in that both include identical equilateral triangle designs.

In her written argument, the applicant submitted that she conducted a trade-mark search prior to filing her application and found that there were a number of trade-marks which include equilateral triangles. However, no evidence of the state of the register was filed by the applicant in support of these assertions. In this regard, the Registrar can only have regard to evidence submitted by way of affidavit or statutory declaration in deciding the outcome of an opposition proceeding. Further, the

applicant stated in her argument that she discussed her proposed trade-mark application with a member of the Trade-marks Office staff prior to preparing and filing her application. While Office staff attempt to assist persons who wish to prepare and file their own trade-mark applications, they cannot assure such applicants that their applications will not be opposed once they has been examined and advertised for opposition purposes in the Trade-marks Journal.

In view of the legal complexity of opposition proceedings, it is advisable that a party involved in an opposition be represented by a registered trade-mark agent. Further, in view of the adversarial nature of such proceedings, the Opposition Board must treat both parties equally, regardless of whether they are represented by a trade-mark agent or not. As a result, the Board cannot overlook deficiencies in the handling of a case by an unrepresented party as to do so would be to give preferential treatment to one of the parties to the opposition.

Having regard to the above and, in particular, to the degree of resemblance between the trade-marks at issue in appearance and the overlapping in the wares and channels of trade of the parties, I have concluded that the applicant has failed to meet the legal burden on her of establishing that there would be no reasonable likelihood of confusion between the trade-marks Triangle Design and GUESS? & Triangle Design. As a result, the applicant's trade-mark Triangle Design is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

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

DATED AT HULL, QUEBEC THIS __31st__ DAY OF _August_, 1994.

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