

**IN THE MATTER OF AN OPPOSITION by
Midore Imports of Canada Inc./Les Importations Midore du Canada Inc. to
application No. 1,000,019
for the trade-mark SCAVIA Design
filed by FMS Trading S.R.L.**

On December 16, 1998, the applicant, FMS Trading S.R.L., filed an application to register the trade-mark SCAVIA Design. The trade-mark is shown below:

The application is based both on proposed use of the trade-mark in Canada and on use and registration abroad in association with watches, stop watches, pendulum clocks, wrist watches, pocket watches, table clocks, costume jewellery, jewellery, precious stones. The application has a convention priority filing date of September 9, 1998.

The application was advertised for opposition purposes in the Trade-marks Journal of November 1, 2000. The opponent, Midore Imports of Canada Inc./Les Importations Midore du Canada Inc., filed a statement of opposition on November 28, 2000. The applicant filed and served a counter statement in which it denied the opponent's allegations.

The opponent filed as its evidence a certified copy of registration TMA 500,115 and the affidavit of Michael Negreanu.

The opponent is the owner of registration TMA 500,115 for the trade-mark SCANDIA for use in association with watches and clocks. Mr. Negreanu is the President of the opponent. He attests that the opponent has been selling watches in association with the trade-mark SCANDIA in Canada since August 1997, with minimum sales having been \$100,000 on an annual basis since that date. The trade-mark SCANDIA appears on the face of the opponent's watches as well as on their boxes. SCANDIA watches are sold through The Bay department stores and Mr. Negreanu has provided various invoices evidencing this. He has also provided some representative advertisements for SCANDIA watches and states that expenses incurred in promoting SCANDIA watches exceed \$5000 per annum.

The applicant chose to not file any evidence. Each party filed a written argument. An oral hearing was not held.

The applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*. However, 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 each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at p. 298].

The opponent has pleaded several grounds of opposition pursuant to paragraph 38(2)(a) of the *Act*. However, it has not filed any evidence that supports the underlying allegations. Accordingly, these grounds of opposition fail on account of the opponent not having met its initial burden.

The opponent has also pleaded grounds of opposition pursuant to paragraphs 38(2)(b), (c) and (d) of the *Act*. All of these grounds are based on a likelihood of confusion between the applied for mark and the opponent's SCANDIA mark. The material date with respect to each ground of opposition is as follows: paragraph 12(1)(d) - 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 (F.C.A.)]; section 16 - the convention priority filing date; non-distinctiveness - the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

With respect to the section 16 grounds of opposition, the opponent must evidence use of its trade-mark prior to the applicant's priority filing date and establish non-abandonment of its mark as of the date of advertisement of the applicant's application [subsections 16(5) and 17(1), *Trade-marks Act*]. This the opponent has done.

With respect to the grounds of opposition based on non-distinctiveness, the opponent need only show that as of November 28, 2000 its trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all

the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

As far as I know, both SCAVIA and SCANDIA are invented words, although it is possible that they may be words in a foreign language. A consideration of the inherent distinctiveness of each mark favours neither party.

A consideration of the extent to which each mark has become known favours the opponent.

The length of time each mark has been used also favours the opponent.

Both parties' marks are associated with watches. I consider the various other horological instruments listed in the application to be closely related to watches. As watches are often considered to be jewellery, I find that there is a close relationship between watches and costume jewellery and jewellery. I do not consider there to be a close relationship between watches and precious stones.

Only the opponent has identified its channels of trade, namely department store sales. I will assume

that the applicant's wares would travel through channels of trade typically associated with its wares, such as jewellery stores and department stores.

The trade-marks SCANDIA and SCAVIA Design have a fairly high degree of resemblance in appearance and sound. One might also say that they resemble each other with respect to the idea suggested as well since both suggest either no meaning or a foreign meaning. "Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction." [*K-Tel International Ltd. v. Interwood Marketing Ltd.* (1997), 77 C.P.R. (3d) 523 (F.C.T.D.) at 527]

The issue is whether a consumer who has a general and not precise recollection of the opponent's mark, will, upon seeing the applicant's mark, be likely to think that the two products share a common source. In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined. I find that a consideration of all the surrounding circumstances leads me to conclude that the applicant has not satisfied the onus on it to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the mark SCANDIA as applied to watches and the mark SCAVIA Design as applied to watches, stop watches, pendulum clocks, wrist watches, pocket watches, table clocks, costume jewellery, and jewellery. My conclusion is based primarily on the resemblance between the parties' marks and wares. However I consider the wares "precious stones" to be sufficiently different from watches to make confusion unlikely between the marks with respect to such wares. As a result, the opposition succeeds with respect to all the wares except "precious stones" pursuant to the grounds of opposition pleaded under paragraphs 38(2)(b), (c) and (d), specifically paragraphs 2(a), 3(a) and 4(a) of the statement of opposition.

Paragraph 3(b) of the statement of opposition does not plead a proper ground of opposition. The grounds of opposition pleaded under paragraphs 4(b) and (c) are dismissed because there is no evidence supporting the allegations pleaded therein.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the *Act* in so far as “precious stones” are concerned and refuse the application with respect to the remaining wares. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 12th DAY OF JANUARY 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**