

**IN THE MATTER OF AN OPPOSITION by Garbo Creations  
Inc. to application No. 708,840 for the trade-mark GRETA  
GARBO Design filed by Harriet Brown & Company Inc.**

On July 14, 1992, the applicant, Harriet Brown & Company Inc., filed an application to register the trade-mark GRETA GARBO Design, a representation of which appears below, based on proposed use of the trade-mark in Canada in association with:

Cosmetics and toiletries, namely perfume, toilet water, eau de cologne; soaps and cleansers for the face and body for use in bath and shower; bath beads, milks, powders, lotions, mousses, oils, creams and gels; lotions, mousses, oils, creams and gels for cosmetic and massage purposes; make-up and make-up remover; deodorant lotions, creams, sprays and powders; powders for cosmetic purposes; masks and exfoliative lotions, mousses, oils, creams, ointments and gels; shaving and depilatory lotions, mousses, oils, creams and gels; shampoos, cream rinses, hair lotions, mousses, oils, creams, gels, sculpting liquids and sprays; nail polishes, creams, oils, lotions, abrasives and cleansers; suntanning, sunblocking and after-sun lotions, mousses, oils, creams and gels and sprays; eyeglasses and accessories, namely, eyeglasses, sunglasses and reading glasses, eyeglass, sunglass and reading glass frames, eyeglass, sunglass and reading glass cases, cords, ribbons, chains and accessory items.



The present application was advertised for the purposes of opposition in the *Trade-marks Journal* dated June 2, 1993 and the opponent, Garbo Creations Inc., filed a statement of opposition on July 20, 1993. A copy of the statement of opposition was forwarded to the applicant on August 20, 1993 and the applicant served and filed a counter statement on September 20, 1993. The opponent subsequently requested and was granted leave pursuant to Rule 42 [now Rule 40] of the *Trade-marks Regulations* to amend its statement of opposition. As well, the applicant requested and was granted leave pursuant to Rule 42 [now Rule 40] of the *Trade-marks Regulations* to amend its counter statement.

The opponent filed as its evidence the affidavit of Gary N. Grundman, dated April 20, 1994, while the applicant submitted as its evidence a certified copy of the Trade-marks Office file relating to application No. 569,040 for the opponent's trade-mark GARBO Design, which matured to

registration No. 339,759 on April 29, 1988. The opponent submitted as evidence in reply a second affidavit of Gary N. Grundman, dated June 19, 1995. However, the second Grundman affidavit is not strictly confined to matter in reply to the applicant's evidence as required by Rule 43 of the *Trade-marks Regulations* and therefore is not proper reply evidence in this proceeding. I have therefore ignored the second Grundman affidavit for the purposes of determining the outcome of this opposition.

The first ground of opposition is based on Paragraph 16(3)(a) of the *Trade-marks Act*, the opponent asserting that the applicant is not the person entitled to registration of the trade-mark GRETA GARBO Design in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-marks GARBO and GARBO Design which had previously been used and made known in Canada by the opponent since September 15, 1984. While the opponent has not identified the wares or services in association with which it has previously used or made known its trade-marks in Canada, I have assumed that the wares relied upon in respect of the first ground are the same wares as those identified in the fourth ground of opposition, namely, jewellery and costume jewellery.

In his first affidavit, Gary N. Grundman, President of the opponent, states that his company, which is the owner of registration No. 339,759 for the trade-mark GARBO Design, has sold semi-precious and costume jewellery through agents all across Canada in association with its GARBO Design trade-mark since September 1984. According to Mr. Grundman, these agents sell the opponent's jewellery to 2,100 customers with more than 3,000 separate locations, the customers being women's fashion, accessory and apparel stores, chain and department stores, namely, The Bay, Eaton's, Sears, Zellers, and a small number of jewellery stores. While Mr. Grundman provides evidence that sales of the opponent's wares exceeded five million dollars per annum as of the date of the affidavit [April 20, 1994], no indication is provided by Mr. Grundman as to the volume or dollar value of sales of the opponent's wares between 1984 and the date of his affidavit [April 20, 1994]. Further, while Mr. Grundman identifies in paragraph 6 of his affidavit the annual advertising and promotion expenditures of the opponent, he does not indicate that those expenditures are in relation to the GARBO and GARBO Design trade-marks.

Even though the Grundman affidavit leaves much to be desired in terms of its completeness, it does in my view establish that the opponent used the trade-mark GARBO Design in Canada prior to the applicant's filing date [July 14, 1992] in association with semi-precious and costume jewellery and, further, that it had not abandoned its trade-mark as of the date of advertisement of the present application in the *Trade-marks Journal* [June 2, 1993]. As a result, the opponent has met its initial burden under Subsections 16(5) and 17(1) of the *Trade-marks Act* in relation to the Paragraph 16(3)(a) ground. Thus, this ground remains to be decided on the issue of confusion between the applicant's trade-mark GRETA GARBO Design as applied to the wares covered in the present application and the opponent's trade-mark GARBO Design as applied to semi-precious and costume jewellery.

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, but not limited to, the criteria which are specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. As well, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark GRETA GARBO Design and the opponent's trade-mark GARBO Design as of the applicant's filing date, the material date in respect of the Paragraph 16(3)(a) ground of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark GRETA GARBO Design appears to be the representation of the signature of the once famous actress Greta Garbo and, as such, is a weak trade-mark possessing little inherent distinctiveness. Likewise, the opponent's trade-mark GARBO Design possesses a limited degree of inherent distinctiveness in view of the surname significance associated with the word Garbo although it would appear that Garbo is a relatively rare surname and may therefore not necessarily be perceived by the average consumer as possessing a surname significance.

As of the filing date of the present application, the applicant's trade-mark GRETA GARBO Design had not become known to any extent in Canada as a trade-mark applied to the wares covered in the present application. In this regard, I do not consider that the fame associated with the former

actress Greta Garbo translates into a certain measure of reputation associated with the trade-mark GRETA GARBO Design which the applicant intends to use in Canada in association with certain wares. As a result, and despite the deficiencies in the first Grundman affidavit, I have concluded that the extent to which the trade-marks at issue have become known in Canada weighs in the opponent's favour although only to a limited extent. Likewise, the length of use of the trade-marks at issue favours the opponent in that the opponent commenced use of its trade-mark GARBO Design in Canada in September 1984 whereas the applicant has not yet begun using its trade-mark in this country.

With respect to the nature of the wares of the parties, the applicant's cosmetics, toiletries, eyeglasses and accessories differ from the opponent's jewellery. As for the nature of the trade associated with the wares of the parties, Mr. Grundman states that the opponent's wares are sold through women's fashion, accessory and apparel stores, chain and such department stores as The Bay, Eaton's, Sears, Zellers, as well as a small number of jewellery stores. While the applicant failed to adduce any evidence as to the nature of the trade that may be associated with its wares, I would expect that the normal trade channels associated with jewellery on the one hand and those associated with cosmetics, toiletries, eyeglasses and accessories on the other would be quite distinct.

As for the degree of resemblance between the applicant's trade-mark GRETA GARBO Design and the opponent's trade-mark GARBO Design, I find the marks to be similar both in appearance and in sounding. As for the ideas suggested, the applicant's mark identifies Greta Garbo who was a famous actress while the opponent's mark may suggest to some consumers the surname Garbo.

The applicant relied upon the decision of the Supreme Court of Canada in *S.C. Johnson & Son Ltd. v. Marketing International Ltd.* (1979), 44 C.P.R. (2d) 16 in submitting that the opponent is precluded from arguing that the trade-marks at issue are confusing in that the opponent submitted during the prosecution of its application for registration of the trade-mark GARBO Design that the hypothetical Canadian would not likely think of a connection between its trade-mark GARBO Design and the former movie star Greta Garbo, particularly since there is nothing else in the mark

which suggests an association with her. In the *S.C. Johnson & Son Ltd.* case, the plaintiff alleged that there was a likelihood of confusion between its registered trade-mark OFF! and the defendant's mark BUGG OFF. On the other hand, during the prosecution of its application for registration of the trade-mark OFF!, the plaintiff had argued that its trade-mark was not confusing with the then existing registered trade-mark BUGZOFF. The Supreme Court of Canada commented as follows at pages 27-28 of the reported decision:

In the present case, during the prosecution of its application for registration of the trade-mark GARBO Design, the opponent argued that its trade-mark GARBO Design did not offend the provisions of Paragraph 9(1)(k) of the *Trade-marks Act* in view of the name of the actress Greta Garbo. Paragraph 9(1)(k) of the *Act* provides as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

(k) any matter that may falsely suggest a connection with any living individual;

I do not consider the determination that a trade-mark may falsely suggest a connection with a living individual under Paragraph 9(1)(k) includes within its scope a determination that the trade-mark and the name of the individual are confusing, as contemplated by Section 6 of the *Trade-marks Act*. Indeed, at most, the determination under Paragraph 9(1)(k) of the *Act* would indicate that the trade-mark suggests the idea of a connection with a living individual. However, when assessing the likelihood of confusion between trade-marks, regard must be had not only to the ideas suggested by the marks, but also the degree of resemblance in appearance and in sounding between the trade-marks, together with all the other surrounding circumstances. Consequently, I do not consider that the opponent is estopped from arguing that the trade-mark GRETA GARBO Design is confusing with its trade-mark GARBO Design.

Having regard to the above and, in particular, to the fact that the wares and channels of trade of the parties differ, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion. I have therefore rejected the first ground of opposition.

As its second ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark GRETA GARBO Design in view of Paragraph 16(3)(a) of the *Trade-marks Act* in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-names Garbo Creations Inc. and "Garbo" which had previously been used in Canada. As no evidence has been furnished by the opponent relating to its alleged prior use of its trade-names, I have dismissed this ground of opposition.

The third ground is based on Paragraph 16(3)(b) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark GRETA GARBO Design in view of its previously filed application for registration of the trade-mark GARBO. However, the opponent's trade-mark GARBO Design was registered April 29, 1988 and therefore the opponent's application for registration of this mark was not pending as of the date of advertisement of the present application [June 2, 1993]. Accordingly, the opponent is precluded by Subsection 16(4) of the *Trade-marks Act* from relying upon this application as a ground of opposition under Paragraph 16(3)(b) of the *Act*. As a result, this ground of opposition is also unsuccessful.

As its fourth ground, the opponent pleaded that the applicant's trade-mark GRETA GARBO Design is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that it is confusing with its registered trade-mark GARBO Design, registration No. 339,759, covering "Jewellery, precious and semi-precious and cosmetic jewellery". While the material date for considering this ground is 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 (F.C.A.)], I do not consider that the later material date has any impact on the assessment of the criteria under Subsection 6(5) which was made in relation to the first ground. Consequently, I find that the applicant has met the legal burden upon it in respect of the issue of confusion between its trade-mark

GRETA GARBO Design and the registered trade-mark GARBO Design. I have therefore rejected this ground of opposition.

The opponent also alleged that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the trade-mark GRETA GARBO Design is confusing with its registered trade-mark T.G.I.F. BY GARBO, registration No. 411,363. While the opponent has not filed a copy of this registration as evidence, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registration relied upon by the opponent [see *Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410]. In doing so, I noted that registration No. 411,363 for the trade-mark T.G.I.F. BY GARBO is still in force and covers wares identified as "Jewellery, costume jewellery and fashion accessories, namely handbags, belts and hair ornaments".

As noted above, in assessing the likelihood of confusion between these trade-marks as of the date of my decision, the Registrar must have regard to all the surrounding circumstances, including those enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark GRETA GARBO Design appears to be the representation of the signature of the once famous actress Greta Garbo and, as such, is a weak trade-mark possessing little inherent distinctiveness. The opponent's trade-mark T.G.I.F. BY GARBO possesses a fair degree of inherent distinctiveness when considered in its entirety even though the word GARBO possesses a surname significance. However, it would appear that Garbo is a relatively rare surname and may therefore not necessarily be perceived by the average consumer as possessing a surname significance.

As of the date of decision, the applicant's trade-mark GRETA GARBO Design had not become known to any extent in Canada as a trade-mark applied to the wares covered in the present

application. In this regard, I do not consider that the fame associated with the former actress Greta Garbo translates into a certain measure of reputation associated with the trade-mark GRETA GARBO Design which the applicant intends to use in Canada in association with certain wares. Further, no admissible evidence has been furnished by the opponent relating to its use of the trade-mark T.G.I.F. BY GARBO and I must assume that the mark has not become known to any extent in Canada. Thus, the extent to which the trade-marks at issue have become known and the length of use of the trade-marks at issue does not favour either party.

With respect to the nature of the wares of the parties, the applicant's cosmetics, toiletries, eyeglasses and accessories differ from the opponent's jewellery, costume jewellery, handbags, belts and hair ornaments. As for the nature of the trade associated with the wares of the parties, Mr. Grundman states that the opponent's wares are sold through women's fashion, accessory and apparel stores, chain and such department stores as The Bay, Eaton's, Sears, Zellers, as well as a small number of jewellery stores. While the applicant failed to adduce any evidence as to the nature of the trade that may be associated with its wares, I would expect that the normal trade channels associated with jewellery, handbags, belts and hair ornaments on the one hand and those associated with cosmetics, toiletries, eyeglasses and accessories on the other would be quite distinct.

As for the degree of resemblance between the applicant's trade-mark GRETA GARBO Design and the opponent's trade-mark T.G.I.F. BY GARBO, I find that the marks bear a limited degree of similarity both in appearance and in sounding when considered in their entireties. As for the ideas suggested, the applicant's mark identifies the former actress Greta Garbo whereas the opponent's mark may vaguely suggest to some consumers an association with an individual having the surname Garbo.

Having regard to the above and, in particular, to the fact that the wares and channels of trade of the parties differ and that there is a limited degree of resemblance between the trade-mark GRETA GARBO Design and T.G.I.F. BY GARBO, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion. I have therefore rejected the fourth ground of opposition.



The final ground relates to the alleged non-distinctiveness of the applicant's mark, the opponent relying upon the allegations of confusion between the trade-marks at issue in support of this ground. However, having concluded that the trade-mark GRETA GARBO Design is not confusing with the opponent's trade-marks, I likewise reject this ground of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 10<sup>th</sup> DAY OF SEPTEMBER, 1997.

G.W. Partington  
Chairman  
Trade-marks Opposition Board