

IN THE MATTER OF AN OPPOSITION
by Manifatture Casucci Di Caucci Ugo & C. S.a.s.
to application No. 589,088
for the mark CASUCCI
filed by Casucci Clothes Inc.

On June 17, 1987, the applicant, Casucci Clothes Inc., filed an (incomplete) application to register the mark CASUCCI based on proposed use in Canada in association with various items of clothing and footwear and "jewellery, watches, eye glasses, luggage, men's and women's handbags, perfumes, aftershave, bathing additives." The application was incomplete in that the application filing fee (\$150.00) did not accompany the application. As a result, the application did not receive further processing, or a filing date (see the Registrar's letter dated June 29, 1987) until the application filing fee was received by the Registrar, on August 4, 1987.

The subject application was advertised for opposition purposes on June 15, 1988, after the applicant had overcome an objection at the examination stage. The objection was that the mark was not registrable pursuant to Section 12(1)(a) of the Trade-marks Act because the mark CASUCCI is primarily merely the surname of an individual who is living or who has died within the preceding 30 years.

The opponent, Manifatture Casucci Di Caucci Ugo & C. S.a.s., filed a statement of opposition on October 17, 1988. The opponent is an Italian company having its head office in Teramo, Italy. Included among the grounds of opposition is that the application is not in compliance with Section 29 [now Section 30] because "the applicant, at the filing of the application [that is, August 4, 1987] was already using the TRADE MARK [CASUCCI] in Canada..."

The opponent defaulted in filing evidence pursuant to Rule 43 of the Trade-marks Regulations, but requested leave to file evidence pursuant to Rule 46(1). That evidence consists of the affidavits of Gladys Barbot Desmangles, Charles Even, and Ugo

Caucci. The Board followed its usual practice by giving the applicant an opportunity to comment on the opponent's requests for leave to file evidence. The applicant was advised that if it did not raise any objection, then the opponent's requests for leave to file evidence pursuant to Rule 46(1) would likely be granted: see the Board letters dated July 23 and August 21, 1990 to the agents for the applicant.

The applicant did not respond with any comments or objections. Ordinarily in such circumstances, the opponent's requests would have been granted and the parties would have been so notified. Unfortunately, the Board inadvertently neglected to follow-up on the opponent's requests and did not notify the parties whether leave was granted. Neither party brought this unresolved matter to the Board's attention prior to the oral hearing. In the circumstances, I granted the opponent leave to file its evidence at the oral hearing. As the applicant had already received copies of the evidence in issue when the opponent made its requests, nothing further was required from the opponent.

The applicant's evidence consists of the affidavit of Giovanni Pezzulo, President of the applicant company. It appears that exhibits M, N, and O, referred to in his affidavit, were not filed with the Board or served on the opponent.

Only the opponent filed a written argument and only the opponent was represented at an oral hearing.

The opponent relies on Mr. Pezzulo's affidavit evidence in support of its ground of opposition that the applicant was in fact using the applied for mark CASUCCI at the date that the application was filed, namely August 4, 1987. Some of the relevant passages from Mr. Pezzulo's affidavit are summarized below:

"Since its incorporation on or about April 30,

1987, Casucci Clothes Inc. has continuously offered for sale, sold and distributed clothing throughout Canada in association with its trade-mark..." (see paragraph 4)

"Some of the wares offered for sale or sold... have inscribed thereon the mark CASUCCI."
(see paragraph 6)

"Each and every ware offered for sale or sold..., upon which the trade-mark was not inscribed, had attached thereto a label on which the trade mark was inscribed."
(see paragraph 7)

Paragraphs 14 and 15 are reproduced in full below:

Mr. Pezzulo also asserts that "during the third week of June, 1987", that is, "a little more than one month after my company...had started using ...its trade mark CASUCCI", he received certain information about the opponent: see paragraphs 22 and 23. The above evidence indicates that the applicant began to use the mark CASUCCI about mid-May, 1987, that is, shortly after the applicant company incorporated, on April 30, 1987.

Paragraph 24 of Mr. Pezzulo's affidavit is reproduced in full below:

I infer from Mr. Pezzulo's evidence that the applicant was using the mark CASUCCI in association with all of the wares described in the subject application since at least as early as mid-May, 1987. That date is prior to the filing date of record for the subject application namely August 4, 1987, and it is also prior to the filing date that would have been accorded to the application, namely June 17, 1987, had the subject application been complete initially.

The opponent submits that the subject application should be refused for non-compliance with Section 30, that is, the application should have been based on use of the mark in Canada, as provided for in Section 30(b), rather than on intended use of the mark (as provided for in Section 30(e)). The opponent relies on Soci t  Nationale Elf Aquitaine v. Spex Design Inc. (1988), 22 C.P.R.(3d) 189 (TMOB), one in a line of cases decided by this Board, which holds that an applicant is not permitted to base its application on intended use once the applicant has commenced use of the mark in Canada: see, in particular, Frisco-Findus S.A. v. Diners Delite Foods Ltd. (1989) 26 C.P.R.(3d) 556 at 558.

I agree with the opponent that I am bound by precedent to find in its favour. The opponent therefore succeeds on the ground of opposition that the application is not in compliance with Section 30. Accordingly, I need not consider the remaining grounds of

opposition.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 29th DAY OF December, 1993.

Myer Herzig,
Member,
Trade-marks Opposition Board