

On January 8, 1992, the applicant, Sacamoto Handbag Imports Inc./Importations de Sac A Main Sacamoto Inc., filed an application to register the trade-mark DC & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least 1987 in association with: 'ladies and men handbags, wallets, luggage and travel bags, briefcases, school bags, umbrellas, writing cases'.

The applicant's application was advertised for opposition purposes in the Trade-marks Journal on September 30, 1992 and the opponent, Christian Dior, S.A., filed a statement of opposition on November 27, 1992 in which it alleged the following grounds of opposition:

(a) The applicant's application does not comply with Section 30(i) of the *Trade-marks Act* in that it is false that the applicant has said that it is satisfied that it is entitled to use the mark in Canada in that, as of the filing date of its application, the applicant should have known of the opponent's or its predecessors' use of the following trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>
CD	190,704
CHRISTIAN DIOR	UCA50698
CHRISTIAN DIOR	203,738
CHRISTIAN DIOR Design	226,743
DIOR & Design	323,994
CHRISTIAN DIOR & Design	362,646

(b) The applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act* in that the applicant's trade-mark is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
CD	190,704
CHRISTIAN DIOR	UCA50698

CHRISTIAN DIOR	203,738
CHRISTIAN DIOR Design	226,743
DIOR & Design	323,994
CHRISTIAN DIOR & Design	362,646

(c) The applicant is not the person entitled to registration of the trade-mark in that, as of the claimed date of first use of 1987, the applicant's trade-mark was confusing with the following trade-marks of the opponent which have previously been used in Canada by the opponent and its predecessors-in-title in association with the wares identified below:

<u>Trade-mark</u>	<u>Wares</u>
CD	Used since 1972 in association with 'articles en cuir et imitation, sacs de voyage, ceintures et bagages pour hommes et femmes'
	Used since 1973 in association with 'sacs à main'
CHRISTIAN DIOR	Used since 1947 in association with 'sacs à main'
CHRISTIAN DIOR	Used since 1974 in association with 'bagages'
CHRISTIAN DIOR Design	Used since 1978 in association with 'bookbinding material, writing articles etc'
DIOR & Design	Used since 1986 in association with 'leather and imitations of leather and articles made from these materials; namely, skins, hides; bags and handbags, trunks, valises, travelling bags and other luggage being or including attache-cases, beauty-cases, vanity-cases, pouches, cases, dressing-cases, travelling toilet cases, make-up cases, wallets and purses, umbrellas and parasols'
CHRISTIAN DIOR & Design	Used since 1983 in association with 'sacs à main'.
	Used since 1986 in association with 'parapluies'

(d) The applicant's trade-mark is not distinctive in that the applicant's trade-mark is confusing with the opponent's trade-marks identified above.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition. The opponent filed as its evidence the affidavits of Fabienne Havet and Faiza Joakim while the applicant submitted as its evidence the affidavit of Jim Tsatsoulis. The opponent filed as reply evidence the affidavits of Maryse Lipari-Simms, Sylvie Brindamour and Akram Saba. Both parties submitted written arguments and both were represented at an oral hearing.

While the legal burden is upon the applicant to show that its application complies with Section 30(i) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. As no evidence has been filed by the opponent in support of its allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark DC & Design in Canada, it has failed to meet the evidential burden upon it in respect of the Section 30 ground. In any event, and even has the applicant been aware of the opponent's trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark DC & Design in Canada on the basis *inter alia* that its mark is not confusing with the trade-marks of the opponent. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at pg. 155].

The second ground of opposition is based on Section 12(1)(d) of the *Trade-marks Act*, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark DC & Design and one, or more, of the registered trade-marks identified in the statement of opposition. With respect to a ground of opposition based on Section 12(1)(d) of the Act, the material date is 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)]. Furthermore, in determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including those which are specifically enumerated

in Section 6(5) of the Act. Additionally, 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 the trade-marks of the parties as of the date of my decision.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark DC & Design, when considered in its entirety, possesses some measure of inherent distinctiveness even though the initials DC add little, if any, inherent distinctiveness to the applicant's mark. In this regard, I would note that trade-marks comprising or dominated by letters or initials are weak marks which, in the absence of evidence of acquired distinctiveness, are only entitled to a narrow ambit of protection. The opponent's trade-mark CD possesses little inherent distinctiveness in that trade-marks comprising initials without additional design elements are inherently weak trade-marks. Further, the opponent's trade-marks CHRISTIAN DIOR and CHRISTIAN DIOR Design possess little inherent distinctiveness in view of the name significance associated with these marks. On the other hand, the opponent's trade-marks DIOR & Design and CHRISTIAN DIOR & Design possess some measure of inherent distinctiveness by virtue of the design features which comprise elements of these marks.

The applicant's agent conceded at the oral hearing that the opponent's trade-mark CHRISTIAN DIOR has become well known in Canada. However, while the Havet affidavit establishes that the opponent's trade-mark CD has become known in Canada in association with travel bags, handbags, wallets, belts and umbrellas, I do not consider that it has acquired the status of a well known trade-mark in this country. The Tsatsoulis affidavit establishes that the applicant's trade-mark DC & Design has also become known in Canada in association with handbags, wallets, luggage and travel bags, briefcases, school bags, umbrellas, writing cases but to a lesser extent than the opponent's trade-mark CD or its other trade-marks. The opponent's evidence further points to the opponent or its licensees having used the trade-mark CD in Canada since 1972 while the applicant's evidence establishes that it commenced using its trade-mark DC & Design in Canada in 1987. Thus, the extent to which the trade-marks at issue have become known and the length of use of the trade-marks of the parties favour the opponent.

The wares of the parties overlap in that the opponent has shown use of its CD and CHRISTIAN DIOR trade-marks in association with travel bags, handbags, wallets, belts and umbrellas and the applicant's application covers handbags, wallets, luggage and travel bags, briefcases, school bags, umbrellas, writing cases. Also, the registration for the trade-mark CD, registration No. 190,704 covers travelling bags, belts, luggage and handbags. Additionally, the channels of trade associated with the wares of the parties would overlap and, in fact, the evidence of record establishes that the wares of the parties have been sold to the same retail outlet in Montreal, namely, The T. Eaton Co. Ltd.

The applicant's trade-mark DC & Design bears some similarity both in appearance and in sounding to the opponent's trade-mark CD although the marks do not suggest any idea in common. Further, the applicant's mark bears no similarity either in appearance, sounding or ideas suggested to the opponent's other trade-marks relied upon in this opposition.

As a further surrounding circumstance in respect of the issue of confusion, the opponent relied upon the Brindamour and Saba affidavits which show that a design element similar to the design element of the applicant's trade-mark has been used by a third party in association with handbags in Canada. Further, the Lipari-Simms affidavit establishes that the opponent has used a somewhat similar design in conjunction with its trade-mark CHRISTIAN DIOR as applied to belts. However, I consider this evidence to be of little relevance in assessing the likelihood of confusion between the applicant's trade-mark DC & Design, when considered in its entirety, and the opponent's trade-mark CD.

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant has noted that no evidence of instances of actual confusion between the trade-marks at issue have been brought to its attention and no such evidence has been adduced by the opponent despite the concurrent use of the marks of the parties in the same area including the same retail outlet in Montreal. However, I am mindful of the fact that the opponent need not establish that there were instances of actual confusion in order for there to be a reasonable likelihood of confusion between the trade-marks at issue. Nevertheless, and even though the applicant has not evidenced significant

sales of its wares in Canada, I consider the absence of evidence of instances of actual confusion to be a relevant surrounding circumstance in this case.

In view of the above, and considering the inherent weakness of the opponent's trade-marks, coupled with the relatively low degree of resemblance between the trade-marks at issue and, in particular, between the applicant's trade-mark DC & Design, when considered in its entirety, and the opponent's trade-mark CD, and bearing in mind the absence of evidence of actual confusion between the trade-marks at issue despite the concurrent use in the same retail outlet of the marks CD and DC & Design as applied to overlapping wares, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark DC & Design and any of the trade-marks relied upon by the opponent, including the opponent's trade-mark CD.

I reject the opponent's opposition in view of the provisions of Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 6th DAY OF MAY, 1996.

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