

**IN THE MATTER OF AN OPPOSITION  
by Associated Brands Inc. to application  
no. 174,488(01) for the trade-mark CHIFFON  
filed by Scott Paper Limited**

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On August 6, 1998, the applicant filed an extension to wares application in respect of registration no. UCA 11280 for the trade-mark CHIFFON covering the wares “toilet paper.” The mark CHIFFON was registered on November 9, 1938 and has been renewed periodically since then. The subject extension to wares application seeks to add “paper towels,” based on use of the mark in association with paper towels since at least as early as September 30, 1997.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 25, 1998 and was opposed by Associated Brands Inc. on April 26, 1999. The grounds of opposition are pleaded succinctly and are reproduced in full below:

- (a) The Applicant’s trade mark application does not comply with the provisions of Section 30(I) of the *Trade-marks Act*. The Applicant could not be satisfied that it had applied to register a trade mark, in view of the descriptiveness of the word CHIFFON.
- (b) The Applicant’s trade mark is not registrable, pursuant to Section 12(1)(b) of the *Trade-marks Act* in that the word CHIFFON is clearly descriptive or deceptively misdescriptive of the wares, namely paper towels.

- (c) The Applicant's trade-mark is not registrable, pursuant to Section 12(1)(c) of the *Trade-marks Act* in that the word CHIFFON is the name, in French, for the wares. In *Harrop's English/French Dictionary*, the word "CHIFFON" is translated as "a rag, duster or dust cloth".
- (d) The Applicant's trade-mark is not distinctive, and is not adapted to distinguish the wares of the Applicant from the wares and services of others. The word CHIFFON is incapable as functioning as a trade-mark in view of its clear descriptiveness. The word CHIFFON is widely used, in French, to describe wares similar or identical to those set-out in the application.
- (e) In the alternative, the Applicant is not the person entitled to registration, since the trade mark CHIFFON is confusing with the Opponent's trade mark CHIFFONS J, previously used in Canada by the Opponent and its predecessor-in-title, on hospital, industrial and domestic towels.
- (f) The Applicant's trade mark is not registrable, pursuant to Section 12(1)(d) of the *Trade Marks Act*, in that the trade mark CHIFFON is confusing with the registered trade mark CHIFFONS J, No. 151,933, owned by the Opponent for hospital, industrial and domestic towels.
- (g) The Applicant's trade mark is not distinctive, and is not adapted to distinguish the wares of the Applicant from the wares of the others, including the Opponent and its predecessors, who have previously used the trade mark CHIFFONS J.

A copy of the statement of opposition was forwarded by the Registrar to the applicant on June 8, 1999. The applicant responded by filing and serving a counter statement. The opponent's evidence consists of the affidavits of John R. Foster, Jonathan Friedman, and Jeanette Lee. The above mentioned individuals were cross-examined on their affidavit evidence. The transcripts of cross-examination, together with answers to undertakings, form part of the evidence of record. The applicant's evidence consists of the affidavits of Mary P. Noonan and K. Anne Marshall. Both parties submitted a written argument, however, only the opponent was represented at an oral hearing.

The first ground of opposition pursuant to Section 30(i) of the *Trade-marks Act* should have pleaded that the applied for mark is "clearly descriptive" of the applicant's wares, as there is no prohibition in the *Act* against descriptive marks. In any event, even if the first ground had been pleaded correctly, then it would not stand as an independent ground but would depend on a favourable finding for the opponent with respect to the second ground of opposition.

Concerning the third ground of opposition, the weight of the evidence leads me to conclude that the French word generally used in Canada for paper towels is "essuie-tout" rather than the French word "chiffon." Thus, the allegation that the French word "chiffon" is the name of the applicant's wares is rejected.

The remaining grounds of opposition are all closely related to the issue raised under the second ground of opposition pursuant to Section 12(1)(b), that is, whether the applied for mark is clearly descriptive or deceptively

misdescriptive of the wares paper towels. Dictionary definitions for the French and English word “chiffon,” as provided in the evidence and collected below, indicate that the English meaning of the word “chiffon” is a thin, delicate fabric while the French meaning of the word “chiffon” is a dusting or wiping rag (although the word has other meanings depending on context).

Further, the table included in paragraph 6 of the Lee affidavit, shown below, provides examples of how the word chiffon is used in the French language to indicate a cleaning or wiping cloth:

The material time to consider the issues arising under Section 12(1)(b) is the date of filing of the application, that is, August 6, 1998: see the Board decision in *Zorti Investments Inc. v. Party City Corporation* (application no. 766,534; decided January 12, 2004; yet unreported). The issue as to whether the applicant's mark CHIFFON is clearly descriptive of the character or quality

of paper towels must be considered from the point of view of the everyday purchaser of the wares. The word "clearly" is not synonymous with "accurately" but rather "easy to understand, self-evident or plain". The mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression: see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-28 and *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186. Further, the character or quality of a ware includes its effect or function: see Chairman Partington's review of jurisprudence regarding Section 12(1)(b) in *Sharp Kabushiki v. Dahlberg Electronics, Inc.* (1983) 80 C.P.R.(2d) 47 at 55:

More recently, Mahoney J. in *Thomson Research Associates Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 205, considered an appeal from a decision of the Registrar of Trade Marks refusing to allow registration for the trade mark ULTRA FRESH for bacteriostats and fungistats. At p. 208 of the published decision, the learned trial judge commented as follows:

I agree with the respondent that "ultra fresh" is clearly descriptive. It is not descriptive of the bacteriostats and fungistats themselves but it does clearly describe, or deceptively misdescribe, the condition of the product, e.g., the underwear, after treatment with those bacteriostats and fungistats.

I do not think that the various authorities, of which GWG Ltd., supra, is an example, dealing with the distinction between trade marks merely suggestive of a characteristic of the wares and those clearly descriptive of them are pertinent. "Ultra clean" does not merely suggest a characteristic of the bacteriostats and fungistats at all; it clearly suggests the principal, if not only, effect of their application to other wares, in other words, their function.

There seems to be no material distinction to be made between this situation and the use of the trade mark OFF in association with insect repellent. In considering the registrability of that trade mark, the *Supreme Court of Canada* held, *S. C. Johnson & Son, Ltd. et al. v. Marketing Int'l Ltd.* (1979), 44 C.P.R. (2d) 16 at p. 25, 105 D.L.R. (3d) 423, [1980] 1 S.C.R. 99:

"With respect, I have to say that the learned trial Judge was in error in the view he took of the plaintiffs' use of the word "off ". He failed to consider the essential factor that this was an elliptical use of the word in association with an insect repellent and therefore, in that context, it was descriptive of the wares or of their effect."

"Off " was found, in the circumstances to be an ellipse of "bug off ". Since neither "off " nor "bug off " could be descriptive of the character or quality of an insect repellent, a chemical mixture, giving each operative word a narrow literal meaning, while both terms were found to be clearly descriptive of its effect, I take that decision as authority that the character or quality of a ware includes its function.

Given the dictionary meanings of the word "sharp" as applied to the sensory functions and having regard to the applicant's trade mark SHARP as applied to hearing aids, it is readily apparent that the applicant's trade mark as a matter of immediate impression is clearly descriptive of the function or result that the applicant's hearing aid is liable to produce, that being that the user will have sharp hearing. As a result, I find the applicant's trade mark SHARP to be clearly descriptive of the character of hearing aids and therefore objectionable under para. 12(1)(b) of the *Trade Marks Act*.

In the *Thomson Research* case, above, the mark ULTRA FRESH was found to clearly describe the function of the wares, that is, to remove bacteria and fungus. In the *S. C. Johnson* case, above, the mark OFF! was found to be an elliptical reference to “bug off” and therefore clearly descriptive of the function of insect repellent, that is, to ward off insects. In the *Sharp Kabushiki* case, above, the mark SHARP was found to be clearly descriptive of the result produced by hearing aids, that is, to provide sharp hearing.

In the instant case, I conclude that an everyday purchaser of paper towels, being either bilingual or French speaking, would readily understand that the word “chiffon” used in association with the applicant’s wares indicates that the wares function as a wiping or dusting cloth. Accordingly, I find that the applied for mark CHIFFON is (i) clearly descriptive of the applicant’s wares if the applicant’s paper towels have cloth characteristics or (ii) deceptively misdescriptive of the applicant’s wares if the subject paper towels do not have cloth characteristics. In this regard, no evidence has been filed concerning the characteristics of the applicant’s paper towels. In either case (i) or (ii) above, the opponent succeeds under the second ground of opposition.

The first branch of the fourth ground of opposition alleging non-distinctiveness must also succeed under the above finding as the opponent has not relied on acquired

distinctiveness pursuant to Section 12(2) of the *Trade-marks Act* as a defence to the ground of opposition based on Section 12(1)(b). No evidence has been adduced to support the second branch of the fourth ground, which is therefore unsuccessful.

The remaining grounds of opposition turn on the issue of confusion between the applied for mark CHIFFON for paper towels and the opponent's mark CHIFFONS J for hospital, industrial and domestic towels. Given my above finding in favour of the opponent under Section 12(1)(b), it is not necessary to determine the issue of confusion between the applied for mark and the opponent's mark. However, in the event that I am wrong in my conclusion that the applied for mark is clearly descriptive or deceptively misdescriptive, I will consider the issue of confusion assuming that the mark CHIFFON is merely descriptive or highly suggestive and therefore registrable under Section 12(1)(b).

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark CHIFFON and the opponent's mark CHIFFONS J. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection considering the marks in their entireties. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the Act: the inherent distinctiveness of the 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; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not

necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

As noted earlier, if the applied for mark CHIFFON is not clearly descriptive or deceptively misdescriptive, then I find that the mark is descriptive or at least highly suggestive of the purpose or function of the applicant's wares. Similarly, the opponent's mark CHIFFONS J is at least highly suggestive of the opponent's wares owing to the component CHIFFONS. Further, the letter J comprising the second component of the opponent's mark possesses a low degree of inherent distinctiveness: see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 at 167 (F.C.T.D. In other words, the marks in issue are inherently weak marks. I also note that the opponent's registration for its mark CHIFFONS J disclaims the component CHIFFONS. This underscores the view that the component J is the crucial distinguishing feature of the opponent's mark.

The opponent's mark CHIFFONS J would have acquired some reputation at all material times, through sales and advertising under the mark, while there is no evidence that the applied for mark acquired any reputation at any material time. The opponent has been using its mark since 1965, well before the applicant's entry into the marketplace. The parties' wares are similar and the evidence suggests that it is not uncommon for the opponent's wares and paper towels to be sold in fairly close proximity in retail outlets. There is a fairly high degree of resemblance between the parties' marks visually, aurally and in ideas suggested owing to the component CHIFFON present in both marks.

In the above circumstances, I find that the governing principle to assess the issue of confusion is that small differences may be accepted to distinguish one weak mark from



another weak mark: see *GSW Ltd.*, above. Accordingly, and keeping in mind in particular that it is the component J that is the crucial distinguishing feature of the opponent's mark, I find that the parties' marks would not be confusing at any material time.

In view of my previous finding regarding the second ground of opposition, the subject application is refused.

DATED AT GATINEAU, QUEBEC, THIS 1st DAY OF NOVEMBER , 2004.

Myer Herzig,  
Member,  
Trade-marks Opposition Board