

**IN THE MATTER OF AN OPPOSITION by Christian Dior, S.A.  
to application No. 700,373 for the trade-mark DION  
COLLECTION & Design filed by Dion Neckwear Ltd.**

On March 6, 1992, Dion Neckwear Ltd. filed an application to register the trade-mark DION COLLECTION & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as August 1, 1989 in association with: “Neckties, scarves and ascots”, as well as being based upon proposed use of the trade-mark in Canada in association with “shirts, sweaters, blouses, trousers, suits, socks, underwear, t-shirts, wallets, umbrellas, belts, watches, and glasses”. The applicant disclaimed the right to the exclusive use of the word COLLECTION apart from its trade-mark.

The applicant's application was advertised for opposition purposes in the *Trade-marks Journal* of February 24, 1993 and the opponent, Christian Dior, S.A., filed a statement of opposition on March 24, 1993 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 association with the wares covered in the application in that, as of the filing date of its application, the applicant should have known that its mark was confusing with the following registered trade-marks of the opponent:

<b><u>Trade-mark</u></b>	<b><u>Registration No.</u></b>
DIOR	203,924
CHRISTIAN DIOR	203,925
CHRISTIAN DIOR MONSIEUR	190,518

CHRISTIAN DIOR	203,926
CHRISTIAN DIOR	203,927
DIOR	203,928
DIOR & Design	323,994
DIOR 2 Design	356,392
CHRISTIAN DIOR & Design	362,646
CHRISTIAN DIOR	UCA50698
CHRISTIAN DIOR	UCA43937
DIOR	UCA50697

(b) The applicant's trade-mark is not registrable in that it is primarily merely the surname of an individual who is living or has died within the preceding thirty years;

(c) 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>
DIOR	203,924
CHRISTIAN DIOR	203,925
CHRISTIAN DIOR MONSIEUR	190,518
CHRISTIAN DIOR	203,926
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CHRISTIAN DIOR & Design	362,646
CHRISTIAN DIOR	UCA50698
CHRISTIAN DIOR	UCA43937
DIOR	UCA50697

(d) The applicant is not the person entitled to registration of the trade-mark DION COLLECTION & Design in that, as of the claimed date of first use of August 1, 1989, the applicant's trade-mark as applied to 'Neckties, scarves and ascots' was confusing with the trade-marks of the opponent identified in the third ground which had previously been used in Canada by the opponent and its predecessors-in-title;

(e) The applicant is not the person entitled to registration of the trade-mark in that, as of the applicant's filing date, the applicant's trade-mark as applied to 'shirts, sweaters, blouses, trousers, suits, socks, underwear, t-shirts, wallets, umbrellas, belts, watches, and glasses' was confusing with the trade-marks of the opponent identified in the third ground which had previously been used in Canada by the opponent and its predecessors-in-title;

(f) 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 affidavits of Stuart Nifoussi and Peter Tsihlias. As evidence in reply, the opponent submitted a second affidavit of Fabienne Havet.

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 DION COLLECTION & 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 had 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 DION COLLECTION & 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].

As its second ground, the opponent alleged that the applicant's trade-mark DION COLLECTION & Design is not registrable in that it is primarily merely the surname of an individual who is living or has died within the preceding thirty years, contrary to Section 12(1)(a) of the *Trade-marks Act*. However, even were I to conclude that the word DION is primarily merely a surname, which in my view it is in view of the evidence furnished by the opponent by way of the Joakim affidavit, I consider there to be sufficient subject matter in the applicant's trade-mark apart from the word DION to 'warrant registration as a trade mark' [see *John Labatt Ltd. v. The Registrar of Trade Marks*, 79 C.P.R. (2d) 110, at p. 115; and *Davidoff Commercio E Industroa Ltda. v. Davidoff Extension S.A.*, 24 C.P.R. (3d) 230, at p. 234]. I have therefore dismissed this ground of opposition.

In passing, I would note that the agent for the opponent requested at the oral hearing that I take judicial notice of the fame of Céline Dion in support of the opponent's position that Dion would

be recognized as a surname in Canada. While I would not normally take judicial notice of such a matter, the agent for the applicant supported the opponent's submission at the hearing. Moreover, the applicant's agent submitted that I should likewise take judicial notice of the fame of Deion Sanders, a professional football and baseball player in the United States of America, as supporting the applicant's position that Dion has other than a surname significance. However, the spelling of Deion Sanders' name differs from the surname portion of the applicant's mark and therefore does not support the applicant's submission.

The third 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 DION COLLECTION & 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 DION COLLECTION & Design, when considered in its entirety, possesses little inherent distinctiveness in that the word DION would be perceived by the average consumer, and particularly those in the province of Quebec, as possessing a surname significance while the word COLLECTION is descriptive as applied to the applicant's wares and has been disclaimed by it apart from its trade-mark. Moreover, the design features add relatively little inherent distinctiveness to the applicant's mark. The opponent's trade-marks DIOR, CHRISTIAN DIOR, CHRISTIAN DIOR MONSIEUR and CHRISTIAN DIOR Design possess little inherent distinctiveness in view of the surname and name significances associated with these marks. Further, the opponent's trade-marks

DIOR & Design and CHRISTIAN DIOR & Design possess some minor degree of inherent distinctiveness by virtue of the design features which comprise elements of these marks.

The first Havet affidavit establishes that the opponent's trade-mark CHRISTIAN DIOR has become relatively well known in Canada in association with men's clothing and accessories. However, the opponent's evidence does not establish that the opponent's trade-mark DIOR has acquired the same measure of notoriety in the marketplace in Canada although it has become known to some extent in this country in association with socks, ties and belts by virtue of its use as a trade-mark per se, as well as being an element of the trade-mark CHRISTIAN DIOR. However, I agree with the applicant's submission that the opponent's use of its mark DIOR is secondary to its use of its trade-mark CHRISTIAN DIOR.

In his affidavit, Peter Tsihlias, President of the applicant, attests to \$2,420,000 in sales of men's accessories in Canada in association with its trade-mark DION COLLECTION & Design from March of 1989 to May of 1993. According to the Tsihlias affidavit, the applicant has sold approximately 125,000 units of its wares to retail stores throughout Canada in association with its trade-mark. Accordingly, I find that the extent to which the applicant's trade-mark DION COLLECTION & Design and the opponent's trade-marks CHRISTIAN DIOR have become known and the length of use of these marks favour the opponent. On the other hand, the extent to which the applicant's mark and the opponent's DIOR trade-marks have become known does not support either party's position although the length of use of these marks does weigh somewhat in the opponent's favour.

The wares covered in the present application and the opponent's registration Nos. 203,924, 203,928 and UCA50697 for the trade-mark DIOR and 356,392 for the trade-mark DIOR 2 & Design overlap. Furthermore, paragraph 8 of the second Havet affidavit points to the wares of both parties being sold to the public through such retail outlets as The Bay and Eaton's, as well as several retail stores which Mr. Havet has specifically identified which appear to specialize in men's clothing and accessories. The applicant has argued that its wares are expensive items and that the average consumer of its wares would therefore exhibit care in their purchase, thus minimizing the likelihood

of confusion between the trade-marks at issue. However, there is no restriction in the applicant's application which limits the nature of its wares to expensive neckties, scarves, ascots and the like and, in any event, the evidence in this opposition does not convince me that the average consumer would necessarily exercise that much more care in the purchase of such wares.

The applicant's trade-mark DION COLLECTION & Design is similar in appearance to the opponent's DIOR trade-marks although the marks bear somewhat less similarity in sounding. Further, while both marks suggest the surname of an individual as their primary significance, neither party is entitled to a monopoly in respect of such an idea. On the other hand, there is little resemblance either in appearance or in sounding between the applicant's mark and the opponent's CHRISTIAN DIOR trade-marks when considered in their entirety as a matter of immediate impression.

As 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 marketplace and, indeed, in the same retail outlets specializing in men's clothing and accessories. However, the opponent need not establish that there have been instances of actual confusion between the trade-marks at issue in order for there to be a reasonable likelihood of confusion between the trade-marks of the parties. Furthermore, the opponent has only used its DIOR trade-marks to a limited extent in the marketplace and, when it has used its DIOR marks, such use has generally been secondary to its use of its primary trade-mark CHRISTIAN DIOR. This may in part explain the absence of evidence of instances of actual confusion even though the wares of the parties are being sold to consumers through a number of retail outlets in common.

In view of the above, and even bearing in mind the inherent weakness of the opponent's DIOR trade-marks, I am still left in doubt as to whether there would be a reasonable likelihood of confusion between the applicant's trade-mark DION COLLECTION & Design and the opponent's registered trade-marks DIOR in view of the degree of visual similarity between the trade-marks as

applied to overlapping wares travelling through the same channels of trade. I have concluded, therefore, that the applicant has failed to meet the legal burden upon it in respect of the issue of

confusion in relation to the Section 12(1)(d) ground of opposition.

I refuse the applicant's application pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 4<sup>th</sup> DAY OF SEPTEMBER, 1996.

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