

IN THE MATTER OF AN OPPOSITION by ROC International, une société à responsabilité limitée to application No. 618,200 for the trade-mark ROCCO filed by Rocbel Holdings Inc.

On November 1, 1988, Rocbel Holdings Inc. filed an application to register the trade-mark ROCCO based upon proposed use of the trade-mark in Canada in association with "shampoo, conditioners, facial and body creams and treatments, foaming bath oils, soap, talc, hair spray, hair styling gel, styling mousse, hair setting lotion, spritzers, perfumes, colognes and scents, nail polish, nail hardener, nail wrap kits, manicure kits, nail files, lipstick, foundation, blusher, eye shadow, mascara, eye pencils, lip pencils, cosmetic kits, perfumed bath powder, perfumed bath beads and perfumed bath foam".

The opponent, ROC International, une société à responsabilité limitée, filed a statement of opposition on November 14, 1989 in which it alleged that the applicant's application is not in compliance with Section 30 of the Trade-marks Act. In particular, the opponent alleged that the applicant had used its trade-mark in Canada prior to filing its proposed use application or, in the alternative, that the applicant did not intend or had abandoned its intention to use its trade-mark in Canada. Further, the opponent alleged that the applicant could not have been satisfied that it was entitled to use the trade-mark ROCCO in Canada.

As its next grounds, the opponent alleged that the applicant's trade-mark is not registrable in that: (a) it is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years; (b) it is confusing with the registered trade-mark ROC, registration No. 149,570, contrary to Section 12(1)(d) of the Trade-marks Act; and (c) it is a mark the adoption of which is prohibited by Section 9(1)(k) of the Trade-marks Act in that it is matter that may falsely suggest a connection with a living individual.

The opponent also challenged the applicant's entitlement to registration under Section 16 of the Trade-marks Act, the opponent alleging that the applicant is not the person entitled to registration in that the applicant's trade-mark ROCCO is confusing with the opponent's ROC trade-marks and the opponent's trade-names ROC, ROC INTERNATIONAL, LABORATOIRES ROC and ROC LABORATOIRE which had previously been used and made known in Canada by the opponent and its predecessors-in-title in association with wares, services and the business relating to cosmetics and perfumery products, as well as treatment products and related accessories.

As its final ground, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant filed a counter statement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence a certified copy of registration No. 149,570 for the trade-mark ROC & Design, together with the affidavits of Charles Even and Jacques Dagenais-Pérusse while the applicant filed the affidavit of Nicola M. Hunt. As evidence in reply, the opponent submitted the affidavit of Brigitte Dufour.

Both parties filed 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 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of its Section 30 grounds of opposition (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330). To meet the evidential burden upon it, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. However, no evidence was submitted by the opponent in support of its allegations that the applicant had used its trade-mark in Canada prior to filing its proposed use application or, in the alternative, that the applicant did not intend or had abandoned its intention to use its trade-mark in Canada. Likewise, no evidence has been furnished 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 ROCCO in Canada. As a result, the opponent has failed to meet the evidential burden upon it in respect of the Section 30 grounds of opposition which I have therefore rejected.

With respect to the opponent's ground of opposition based on Section 12(1)(a) of the Trade-marks Act, the legal burden is upon the applicant to establish that its trade-mark ROCCO is registrable. The Even affidavit establishes that Rocco is the surname of a number of people residing in Canada while the Hunt affidavit establishes that the word "rocco" in the Italian language means, inter alia, "(chess) rook, castle", as well as possessing a given name significance. As a result, ROCCO is not merely the surname of an individual and it is therefore necessary to consider whether the applicant's trade-mark is primarily merely a surname.

The Even affidavit sets forth a number of telephone listings located by the affiant both in Canada and the United States under the surname Rocco. The total number of listings located by Mr. Even included fewer than 100 from more than 21 telephone directories for various Canadian cities.

In all but four of the directories, there were three or fewer entries for persons having the surname Rocco with the majority of the listings appearing in the Toronto (24), Montreal and region (17) and the Niagara Region (21) directories. Thus, the opponent's evidence establishes that the applicant's trade-mark ROCCO is a relatively rare surname throughout most of Canada although some minor recognition of the name may be inferred based on the telephone listings in the Toronto-Niagara regions of Ontario, as well as in the Montreal area. No other evidence has been adduced by the opponent which would point to the recognition of Rocco as a surname in Canada. As a result, the opponent has failed to establish that either a majority of Canadians or even a majority of Canadians in a significant area of Canada would recognize Rocco as a surname (see Nationwide Manufacturing Ltd. v. Robert Morse Appliances Ltd., 27 C.P.R. (3d) 112; and Juneau v. Chutes Corp., 11 C.P.R. (3d) 260).

No evidence has been adduced by the applicant in an attempt to establish how many Canadians would recognize the word "rocco" as meaning rook or castle in the Italian language. However, I am prepared to take judicial notice of the fact that there are a number of Canadians who are fluent in the Italian language. Nevertheless, in the absence of evidence in this opposition, I am not prepared to infer that the number of Italian-speaking Canadians who would recognize the word "rocco" as meaning rook or castle in the game of chess would be significant.

Apart from the meaning of the word "rocco" in the Italian language, the applicant adduced evidence that the word "Rocco" also has a given name significance. In this regard, I would note that exhibit CE-1 to the Even affidavit identifies Rocco Donald Belvedere as being the first director of the applicant, further confirming the given name significance of the word "Rocco".

In my view, the opponent's evidence does not support the conclusion that the number of Canadians who would recognize the word "Rocco" as a surname would be greater than the number of Canadians who would identify the word "rocco" as being either a given name or a word in the Italian language meaning rook or castle in the game of chess. Accordingly, I have concluded that the applicant's trade-mark ROCCO is not primarily merely a surname and have therefore rejected the Section 12(1)(a) ground of opposition.

The opponent's next ground of opposition is based on Section 9(1)(k) of the Trade-marks Act which 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;

With respect to this ground of opposition, the legal burden is on the applicant to establish that its trade-mark is registrable and is therefore not a mark the adoption of which is prohibited by Sections 9 or 10 of the Trade-marks Act. However, while the legal burden is on the applicant, there is an initial evidential burden on the opponent to adduce sufficient evidence to persuade the trier of fact that the alleged facts are true (see John Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293, at pg. 298). In the present case, no evidence has been adduced by the opponent which might indicate that the applicant's trade-mark ROCCO falsely suggests a connection with any particular living individual. As a result, I have dismissed this ground.

The opponent's final ground of opposition relating to the registrability of the applicant's trade-mark ROCCO is based on Section 12(1)(d) of the Trade-marks Act, the opponent alleging that the applicant's trade-mark is confusing with its registered trade-mark ROC & Design, a representation of which appears below, registration No. 149,570. With respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

Registration No. 149,570

In assessing whether there would be a reasonable likelihood of confusion between the applicant's trade-mark ROCCO as applied to the wares covered in the applicant's application and the opponent's registered trade-mark ROC & Design as applied to "lotions, crèmes et poudres pour la peau, crayons pour les yeux, crèmes antisolaires, vernis à ongles, dissolvants de vernis à ongles, maquillages, laite de beauté, rouges à lèvres, savons de toilette, shampooing", the Registrar must

have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish 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 ROCCO possesses both a surname and given name significance and, being an inherently weak mark, possesses relatively little inherent distinctiveness. The opponent's trade-mark ROC & Design includes a mortar and pestle design element which suggests an association between the opponent's wares and retail outlets distributing pharmaceutical products. On the other hand, the element ROC does not convey any meaning in relation to the opponent's wares. As a result, the opponent's trade-mark ROC & Design, when considered in its entirety, possesses more inherent distinctiveness than does the applicant's mark ROCCO.

Both the extent to which the trade-marks have become known and the length of use of the trade-marks ROCCO and ROC & Design weigh in the opponent's favour in this opposition. In this regard, the opponent has relied upon the affidavit of Jacques Dagenais-Pérusse, Director General of Prestilux Inc., the exclusive distributor of the opponent in Canada. In his affidavit, Mr. Dagenais-Pérusse attests to more than \$8,000,000 in sales of the opponent's wares in Canada in association with the trade-mark ROC from 1985 to 1990 inclusive while the opponent's publicity and promotional expenditures associated with the mark ROC during this time exceeded \$2,000,000. Further, the affiant confirms that the opponent's ROC trade-marks has been used in Canada since 1980. On the other hand, no evidence has been adduced by the applicant that it has commenced use in Canada of its proposed use trade-mark ROCCO in Canada.

Many of the wares covered in the applicant's application are either identical to, or closely related to, the wares covered in the opponent's registration. Further, and in the absence of any evidence to the contrary, I have concluded that the channels of trade associated with these wares could overlap.

The only remaining criterion under Section 6(5) of the Act is the degree of resemblance between the trade-mark ROCCO and ROC & Design in appearance, sounding and in the ideas suggested. When considered in their entireties as a matter of first impression and imperfect recollection, the trade-marks ROCCO and ROC & Design bear some degree of similarity in appearance and an even greater degree of resemblance in sounding while the marks do not suggest any ideas in common. Further, the applicant's trade-mark ROCCO includes the entirety of the main

element ROC of the opponent's trade-mark, as well as being the principal element of the opponent's trade-name.

The applicant has argued that little weight ought to be accorded to the Dufour affidavit in that Ms. Dufour has not sufficiently qualified herself to give expert opinion evidence relating to the phonetic similarities in both official languages between the trade-marks ROCCO and ROC. However, I have reached the same conclusions as Ms. Dufour relating to the sounding of the trade-marks ROCCO and ROC & Design without having regard to her affidavit. As a result, it is unnecessary to consider the issue as to the weight which ought to be accorded the Dufour affidavit.

As a further surrounding circumstance, the applicant submitted evidence of the state of the register by way of the Hunt affidavit. In addition to registrations for the trade-marks ROCHELLE, YVES ROCHER & Design and HENRI ROCHEAU, the affiant located several registrations standing in the name of Parfums Rochas for trade-marks including the element ROCHAS. Additionally, Ms. Hunt provides some evidence of use in the marketplace of the registered trade-marks MADAME ROCHAS, EAU DE ROCHAS and MYSTERE DE ROCHAS. However, none of these marks bear the same degree of resemblance either in appearance or in sounding to the opponent's trade-mark as does the applicant's mark ROCCO. As a result, the applicant's evidence is of limited value in assessing the issue of confusion in this opposition.

Considering that there is some similarity in appearance and an even greater degree of resemblance in sounding between the trade-marks ROCCO and ROC & Design and that the trade-marks at issue are applied to similar wares travelling through the same channels of trade, and bearing in mind that the opponent has established that its trade-mark has become known in Canada while the applicant's mark is based upon proposed use, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

In view of the above, I have not considered the remaining grounds of opposition relied upon by the opponent.

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

DATED AT HULL, QUEBEC, THIS 31st DAY OF January, 1994.

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