



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 91
Date of Decision: 2013-05-15

**IN THE MATTER OF AN OPPOSITION
by Archalous Jakmakjian Keverian to
application No. 1,439,560 for the trade-
mark FRATELLI DIAMANTE in the
name of Diamco Holdings Inc. / Gestion
Diamco Inc.**

I. Background

[1] Diamco Holdings Inc. / Gestion Diamco Inc. (the Applicant) applied for registration of the trade-mark FRATELLI DIAMANTE (the Mark) based upon proposed use in Canada. The statement of wares of the application of record, as amended on June 29, 2010, reads: (1) men's clothing, namely, dress shirts; (2) jewellery, namely, cufflinks.

[2] Archalous Jakmakjian Keverian (the Opponent) brought an opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the grounds that: (i) the application does not conform to the requirements of section 30(i) of the Act; (ii) the Mark is not registrable in view of confusion with the Opponent's registered trade-mark DUE FRATELLI; (iii) the Applicant is not the person entitled to registration of the Mark in view of confusion with the Opponent's previously used trade-mark and trade-name DUE FRATELLI; and (iv) the Mark is not distinctive within the meaning of section 2 of the Act.

[3] The Opponent filed evidence, which solely consists of a certified copy of registration No. TMA413,734 for the trade-mark DUE FRATELLI. The Applicant elected to file no evidence. Also, neither party filed a written argument.

[4] Finally, the hearing originally scheduled at the request of the Applicant was cancelled by the Registrar as the Applicant withdrew its request to be heard. In response to a letter sent by the Registrar further to the cancellation of the hearing, the Applicant confirmed maintaining an interest in the application for the Mark. That being said, it remains that the Applicant did not provide evidence or submissions in support of its application. Therefore, even though the Applicant may maintain an interest in the application, it has shown an apparent lack of interest in responding to the opposition.

II. Relevant Dates

[5] The material date for considering the conformity of the application to the requirements of section 30 of the Act is the filing date of the application, namely May 28, 2009 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[6] The material date for considering the registrability of the Mark under section 12(1)(d) of the Act is the date of this decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[7] The material date for considering the Applicant's entitlement to the registration of the Mark under sections 16(3)(a) and 16(3)(c) of the Act is also the filing date of the application.

[8] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition, namely March 23, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

III. The Issues

[9] The issues to be resolved in this opposition are:

1. Could the Applicant have been satisfied of its entitlement to use the Mark in Canada when it filed the application?
2. Is the Mark registrable at the date of this decision?
3. Was the Applicant the person entitled to registration of the Mark at the filing date of the application?

4. Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

IV. Onus on the Parties

[10] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the Applicant bears the legal burden or onus to establish, on a balance of probabilities, that the Mark is registrable [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

V. Analysis of the Issues

V.1 Could the Applicant have been satisfied of its entitlement to use the Mark in Canada?

[11] This issue arises from the two-prong ground of opposition alleging that the application does not conform to the requirements of section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the wares identified in the application. In support of the ground of opposition, the Opponent alleges, in summary, that: (i) the Applicant was well aware of the Opponent's trade-mark and trade-name DUE FRATELLI and of their continued use; and (ii) the use of the Mark is contrary to the provisions of section 22 of the Act.

[12] For the reasons that follow, I dismiss the ground of opposition in its entirety and so decide this issue in favour of the Applicant.

[13] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

[14] In addition, neither the Registrar, nor the Federal Court has ruled on the validity of a section 30(i) ground of opposition based on the violation of section 22 of the Act [*Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FC) at paras 38-42]. Even if I had found this to be a valid ground of opposition, the Opponent has failed to file any evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 of the Act [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC)].

V.2 Is the Mark registrable at the date of this decision?

[15] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(d) of the Act in view of confusion with the Opponent's trade-mark DUE FRATELLI of registration No. TMA413,734.

[16] For the reasons that follow, I accept the ground of opposition and so decide this issue in favour of the Opponent.

[17] Having exercised the Registrar's discretion, I confirm that registration No. TMA413,734 is extant and so the Opponent's evidentiary burden has been met. Thus, the question becomes whether the Applicant has met its legal onus to show that the Mark is not reasonably likely to cause confusion with the Opponent's trade-mark DUE FRATELLI (the Opponent's Mark) registered in association with the following wares:

articles made from leather and imitation of leather, namely luggage, travelling bags, handbags, briefcases, suitcases, pocketbooks, purses, agenda books, ties cases, card cases, wallets, picture frames, small bags suitable for holding toiletries and related items, clothing for men, women and children, namely ties and belts.

[18] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[19] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the

inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[20] I now turn to the assessment of the surrounding circumstances.

Section 6(5)(a): the inherent distinctiveness of the trade-marks and the extent to which they have become known

[21] I conclude that the section 6(5)(a) factor slightly favours the Opponent, but only to the extent that the inherent distinctiveness of the marks are concerned.

[22] Each trade-mark is inherently distinctive in the context of the wares at issue. However, I find that the Mark possesses a lower degree of inherent distinctiveness, particularly in the context of jewellery. Indeed, it seems reasonable to conclude that the component “diamante” would be perceived as the word “diamanté”, which is an adjective meaning, “*garni de diamants*” (translation: set with diamonds), in French, and “decorated with powdered crystal, sequins, or another sparkling substance”, in English [see *Le Petit Robert*, éd 2011; and *The Canadian Oxford Dictionary*, online version].

[23] There is no evidence to conclude that the Mark has become known in Canada through promotion or use. Likewise, there is no evidence about the use or promotion of the Opponent’s Mark in Canada. Also, the mere existence of the Opponent’s registration can establish no more than minimal use and cannot give rise to an inference of significant and continuous use of the Opponent’s Mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

Section 6(5)(b): the length of time each trade-mark has been in use

[24] The section 6(5)(b) factor is of no significance in the circumstances of this case. The Mark has been applied for registration on the basis of proposed use and there is no evidence that it has been used in Canada since the filing of the application. Registration No. TMA413,734 shows that a declaration of use of the Opponent's Mark was filed on May 6, 1993. However, as discussed above, the use of the Opponent's Mark is assumed to be only minimal.

Sections 6(5)(c) and (d): the nature of the wares, services or business; and the nature of the trade

[25] It is the statement of wares in the application for the Mark and the statement of wares in the alleged registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[26] The overall consideration of the sections 6(5)(c) and (d) factors favours the Opponent.

[27] I find that the wares "men's clothing, namely, dress shirts" associated with the Mark overlap with the wares "[...] clothing for men, women and children, namely ties and belts" associated with the Opponent's Mark. Further, I find that there is a close relationship between these registered wares and the wares "jewellery, namely, cufflinks" associated with the Mark. Indeed, even though jewellery specifically differs from clothing, cufflinks are closely related to, if not overlapping with, clothing items. The very fact that the Applicant itself is seeking registration of the Mark with "men's clothing, namely, dress shirts" and "jewellery, namely, cufflinks" supports my finding.

[28] To the extent that I conclude that the wares associated with the marks in issue are overlapping or related, for the purposes of considering confusion, I conclude to potential for overlap in the channels of trade for these wares.

Section 6(5)(e): the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[29] The degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see *Masterpiece, supra*, at para 49]. I find that it favours the Opponent.

[30] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts; rather, marks must be considered in their entirety. While the Supreme Court in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction, it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[31] There is a fair degree of resemblance between the Mark and the Opponent's Mark in appearance, sound and between the ideas suggested by them.

[32] Each mark is formed by two components and "FRATELLI" is the most striking or unique component of each of them in that it is the most distinctive. I acknowledge that the words "DIAMANTE" and "DUE" have distinct meanings. However, considering the Mark in its entirety, it remains that the word "DIAMANTE" refers to the element "FRATELLI". The same is true for the word "DUE" in the Opponent's Mark. Thus, any differences between the marks as a result of the meaning of the words "DIAMANTE" and "DUE" are not significant enough to outweigh the similarity between them owing to their common element FRATELLI.

Conclusion on the likelihood of confusion

[33] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Given the degree of resemblance between the marks, the overlap or relationship between the nature of the wares and the potential for overlap between the nature of the trade, I am not satisfied that the Applicant has discharged its legal onus to establish that there is no reasonable likelihood of confusion between the Mark and the Opponent's Mark in association with "[...] clothing for men, women and children, namely ties and belts".

V.3 Was the Applicant the person entitled to registration of the Mark at the filing date of the application?

[34] This issue arises from the grounds of opposition alleging that the Applicant is not the person entitled to registration of the Mark under sections 16(3)(a) and (c) of the Act in view of confusion with the trade-mark and trade-name DUE FRATELLI alleged to have been previously used in Canada by the Opponent.

[35] I dismiss both grounds of opposition for the Opponent's failure to meet her initial evidentiary burden.

[36] The Opponent has failed to show that her trade-mark DUE FRATELLI had been used in Canada prior to May 28, 2009. The certified copy of registration No. TMA413,734 is not sufficient for the Opponent meeting her evidentiary burden under the non-entitlement ground of opposition [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. Likewise, the Opponent has failed to show that the trade-name DUE FRATELLI had been used in Canada prior to May 28, 2009.

V.4 Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

[37] This issue arises from the ground of opposition alleging that the Mark does not distinguish and is not adapted to distinguish the wares of the Applicant from the wares in association with which the Opponent has used her trade-mark DUE FRATELLI.

[38] I dismiss the ground of opposition for the Opponent's failure to meet her initial evidentiary burden.

[39] The Opponent has failed to show that her trade-mark DUE FRATELLI had become sufficiently known in Canada, as of March 23, 2011, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Here also, the certified copy of registration No. TMA413,734 is not sufficient for the Opponent meeting her evidentiary burden.

VI. Disposition

[40] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office