

IN THE MATTER OF AN OPPOSITION
by Fendi Paola e Sorelle s.a.s.
to application No. 578,695 for
the trade-mark FENZI & Design
filed by Wiltomar Fashion Group Inc.

On February 23, 1987, the applicant, Wiltomar Fashion Group Inc., filed an application to register the trade-mark FENZI & Design (illustrated below) for the "operation of a retail clothing store" based on use in Canada since April 16, 1986. The application was advertised for opposition purposes on August 12, 1987.

The opponent, Fendi Paola e Sorelle s.a.s., a limited partnership consisting of Carla Fendi and Alda Fendi, general partners, and Paola Fendi, Anna Fendi and Franca Fendi, limited partners, filed a statement of opposition on September 9, 1987, a copy of which was forwarded to the applicant on September 30, 1987. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark FENDI registered under No. 314,842 for the following wares:

(1) luggage, trunks, travel bags, sacks, ruck-sacks, hand and shoulder bags, briefcases, attache cases, wallets, purses, key cases, passport cases, document cases, driving license cases, card cases, paper cases, beauty cases, shirt cases, diary covers, book covers, desk accessories namely desk pads, pen holders and paper holders; umbrellas, parasols

(2) fur coats, fur stoles, fur pieces, raincoats, coats, jackets, trousers, dresses, hosiery, shirts, blouses, headwear, scarves, foulards, gloves, ties, neckwear, handkerchiefs, socks, stockings, lingerie; footwear namely boots, shoes and slippers; belts, swimwear, nightgowns and pyjamas; bed sheets, pillow covers, bed covers, table cloths, napkins, towels, clothing linings, textile piece goods; soaps, tooth paste, creams, perfumery, essential oils, cologne, toilet water, body lotions and hair lotions

(3) cigarette cases, cases for eye glasses and sunglasses, coats, jackets, trousers, dresses, shirts, blouses and scarves.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Roger Paul Britton. The applicant filed the affidavits of Geoff Hill, Gary Laforet, Mary Raichinis, Patrick Sweeney, Lorraine King and William Nasralla. In his affidavit, Mr. Nasralla makes reference to a number of exhibits. However, there is no record of those exhibits having been received by the Opposition Board. Only the applicant filed a written argument and no oral hearing was conducted.

The material time for considering the circumstances respecting the opponent's ground of opposition based on Section 12(1)(d) of the Act is as of the filing of the

opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks of the parties. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

In view of the names of the various partners comprising the opponent, it is apparent that FENDI is a surname. However, there is no evidence indicating that it is a common surname, particularly in Canada. Thus, the opponent's mark FENDI is inherently distinctive although it is not inherently strong. There is no evidence of use of the opponent's mark and I must therefore conclude that it had not become known in Canada as of the material time.

The applicant admits that FENZI is a surname (see paragraph 24 of the Nasralla affidavit). However, there is no evidence indicating that it is a common surname in Canada or that Canadians would necessarily recognize it as a surname. Thus, the applicant's mark FENZI & Design is inherently distinctive although it, too, is not inherently strong. The Nasralla affidavit evidences fairly extensive use of the applicant's mark in the Toronto area for the one and a half year period preceding the filing of the present opposition. Thus, I can conclude that the applicant's mark had become known to some extent in the Toronto area as of the material time.

The length of time the marks have been in use is not a significant circumstance in the present case. The applicant's services of the operation of a retail clothing store are similar to the clothing wares listed in the opponent's registration since those wares would normally be sold through such an outlet. The potential overlap between the trades of the parties is further emphasized by the applicant's own evidence. Mr. Nasralla states that the applicant sells various clothing items bearing the applied for trade-mark through its retail outlets.

As for Section 6(5) (e) of the Act, I find there is a fairly high degree of visual and phonetic resemblance between the marks of the parties. The applicant's mark consists essentially of a stylized version of the word FENZI which differs by only one letter from the opponent's registered mark FENDI. To the extent that the marks would be perceived as coined words, neither suggests any particular idea.

The applicant has submitted that the contemporaneous coexistence of the two marks at issue in Italy without confusion is a relevant additional circumstance. Such a circumstance might be of some relevance but the applicant has failed to evidence coextensive use of the two marks in Italy.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. As noted above, the onus or legal burden is on the applicant. What that means is that if after all of the evidence has been considered a determinate conclusion cannot be reached, the issue must be decided against the applicant. In view of the similarities between the wares, services, trades and marks of

the parties, I find that a determinate conclusion respecting the issue of confusion cannot be reached. The issue must therefore be decided against the applicant and the ground of opposition based on Section 12(1)(d) of the Act is successful. The remaining grounds need not therefore be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF December, 1990.

David J. Martin,
Member,
Trade Marks Opposition Board.