

IN THE MATTER OF AN OPPOSITION
by Domenico Dolce and Stefano Gabbana,
Doing Business as Dolce & Gabbana,
To Application Serial No. 861,905 in the name of
Identification Sport Inc. for the Trade-mark
D&G DAVID & GOLIATH & Design

On November 19, 1997, Identification Sport Inc. (“the applicant”) filed an application (“the application”) to register the trade-mark D& G DAVID + GOLIATH & Design, a representation of which appears below:



The application was based on use in Canada since February 1, 1997 in association with the following wares:

“sports clothing, namely: pants, jackets and vests, namely: lined and unlined jackets, jackets made of nylon and/or other fibres, lined and unlined pants, pants made of nylon and/or other fibres, lined and unlined anoraks, anoraks made of nylon and/or other fibres, sweaters, polos and T-shirts”.

The application was advertised for opposition purposes in the December 2, 1998 issue of the Canadian Trade-marks Journal.

On April 30, 1999, Domenico Dolce and Stefano Gabbana, doing business as Dolce & Gabbana (“the opponents”), filed a Statement of Opposition to the application. The Statement of Opposition was forwarded to the applicant on May 25, 1999. On September 8, 2000, the opponents requested leave pursuant to Rule 40 of the *Trade-marks Regulations* to file an amended Statement of Opposition. The applicant raised no objection and the opponents were granted leave to file the amended Statement of Opposition on November 30, 2000.

The first ground of opposition contained in the amended Statement of Opposition is that the application does not comply with the requirements of Section 30(i) of the *Trade-marks Act* (“the Act”) since the applicant’s statement that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares described in the application is inaccurate. In this respect, the opponents allege that the applicant cannot have been satisfied that it was entitled to use its trade-mark in Canada in association with the wares listed in the application in view of the opponents’ prior use of their registered and common law trade-marks and trade name.

The second ground of opposition is that the application does not comply with the requirements of section 30(b) of the Act in that the applicant did not use the trade-mark in association with any or all of the wares listed in the application at the alleged date of first use.

The third ground of opposition is that the application does not comply with the requirements of section 30(a) of the Act in that the applicant did not provide a statement in ordinary commercial terms of the specific wares in association with which the mark has been used.

The fourth ground of opposition is that the trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the registered trade-marks of the opponents set out in Schedule B of the amended Statement of Opposition.

The fifth ground of opposition is that the applicant is not the person entitled to registration of the trade-mark pursuant to Section 16(1)(a) of the Act because, at the alleged date of first use of the trade-mark, namely February 1, 1997, the trade-mark was confusing within the provisions of Section 6 of the Act with the opponents' registered trade-marks D&G DOLCE & GABBANA and others, set out in paragraph 2 of the amended Statement of Opposition, and common law trade-marks D & G and DG, contrary to Section 16(1)(a) of the Act.

The sixth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(c) of the Act because, at the alleged date of first use of the trade-mark, namely February 1, 1997, the trade-mark was confusing within the provisions of Section 6 of the Act with the opponents' trade name DOLCE & GABBANA that had been previously used in Canada.

The seventh ground of opposition is that the trade-mark is not distinctive of the Applicant within the provisions of Section 2 of the Act because it does not actually distinguish, nor is it adapted to distinguish, the wares of the Applicant from the wares of others or from the wares of the opponents sold in association with their common law and registered trade-marks or trade name.

The applicant filed and served a Counter Statement on June 25, 1999 in which it essentially denied all of the opponents' grounds of opposition.

On March 27, 2000, the opponents filed as their evidence a Declaration of Domenic Dolce and Stefano Gabbana, which was signed and notarized some time in March of the year 2000 (the actual day does not appear to have been provided), as well as an affidavit of Jerry Inkster sworn March 20, 2000. Since the applicant has not challenged the propriety of the date of the Dolce and Gabbana Declaration, and as I am of the view that the omission is merely a technicality, I have considered it to be admissible evidence.

By letter dated April 19, 2000, the applicant advised that it would not be filing any evidence in these proceedings.

On September 8, 2000, the opponents requested leave to file additional evidence in the form of an affidavit of Maria Leone sworn June 28, 2000. The applicant did not object to the filing of the additional evidence and leave was granted to the opponents to file the Leone affidavit on November 30, 2000.

The Dolce & Gabbana Declaration sets out the history of the opponents' business activities in the fashion field, which apparently commenced in the early 1980's. According to the Dolce & Gabbana Declaration, the opponents' products have been sold and advertised in most countries of the world, including Canada, since 1985, and their trade-marks D&G, D&G DOLCE & GABBANA, DOLCE & GABBANA, and J&ANS DOLCE & GABBANA are registered in most countries for wares in a variety of classes including Class 25 which covers clothing. According to the Declaration, the opponents have registrations in Canada for D&G DOLCE & GABBANA Design (TMA502, 982), DOLCE & GABBANA (TMA359, 530), and J&ANS DOLCE & GABBANA (TM488, 330), and DOLCE & GABBANA (TMA401, 099), as well as a pending application to register D&G DOLCE & GABBANA. The deponents state that in Canada, the opponents are also users of the trade-marks D&G, D&G DOLCE & GABBANA Design, and DOLCE & GABBANA. All of the trade-marks are allegedly owned by the opponents personally and are licensed to their wholly owned corporation, Dolce & Gabbana SpA, which in turn sub-licenses use of the trade-marks to the opponents' Canadian distributors.

The Declaration provides sales figures for merchandise bearing the D&G DOLCE & GABBANA Design trade-mark in Canada from Autumn 1994/Winter1995 to Spring 1999/Summer 1999. The sales figures provided vary from a low of \$135,816 in Spring 1999/Summer 1999 to a high of \$288,795 in Autumn 1995/Winter 1996. Canadian advertising figures are also provided for the years 1994 to 1998, varying from a low of 9,375 in 1996 to a high of \$21,088 in 1995.

According to the deponents, as part of their marketing strategy, merchandise bearing the trade-mark D&G DOLCE & GABBANA carries a different styling,

fabric and price point from merchandise bearing the trade-mark DOLCE & GABBANA and it is common for their distributors to refer to the former, both in actual sales presentations and advertisements, as simply “D&G” in order to clearly distinguish it from the higher priced DOLCE & GABBANA line. The deponents state that their sub licensee, Leone International Marketing Inc. (“Leone”) of Vancouver, B.C., carries the two lines at opposite ends of its 20,000 square foot store with completely different fixturing and that Leone very frequently advertises the retail boutique selling D&G DOLCE & GABBANA merchandise as a “D&G BOUTIQUE” and identifies the merchandise sold therein as the “D&G Collection”.

In his affidavit, Jerry Inkster, Vice President of Finance of Leone, states that Leone imports and retails merchandise, designed and produced by the Opponents, which carries labels, designs and ornamentation depicting the trade-mark D&G DOLCE & GABBANA, wherein the letters D&G are shown in large and bold type so as to give them substantial prominence. According to Mr. Inkster, Leone started importing and retailing the opponents’ merchandise in the Autumn 1994 and Winter 1995 season.

Attached as Exhibit A to the Inkster affidavit is a copy of an invoice of Ittierre SpA, of Italy, which allegedly manufactures the opponents’ merchandise. The invoice is dated July 12, 1995 and appears to represent a sale to Leone for a total of CDN\$90,769 of a variety of “D&G Donna” and “D&G Uomo” articles (“Donna” meaning women’s wear and “Uomo” meaning men’s wear). The articles listed include clothing, shoes, and accessories. Attached as Exhibit B to the Inkster affidavit are copies of invoices allegedly found in Leone’s records, which represent a random sample of Leone’s purchases of the Merchandise from Ittierre SpA. The invoices show the following dates and amounts in Canadian dollars: February 23, 1996-\$29,119; September 19, 1995-\$43,172; September 26, 1995-\$2,287; October 5, 1995-\$1,562; March 8, 1996-\$14,443; and April 1, 1996-\$6,084. According to the deponent, Leone retails the Merchandise in a special section of its 20,000 square foot store called the “D&G Boutique”, which is partitioned off from all other sections of

the store. The D&G Boutique is decorated only with advertising materials, fixturing and furnishings bearing the mark D&G DOLCE & GABBANA.

According to Mr. Inkster, Leone is authorized to carry out, at its own expense, advertising and promotion featuring the mark D&G DOLCE & GABBANA in association with the Merchandise. Samples of these advertisements, Leone's advertising budget, and information on the advertising mediums used are sometimes reviewed by the Licensing and Brand Division of the Opponents' company, Dolce & Gabbana SpA. Mr. Inkster states that Dolce & Gabbana SpA provided its own architects and suppliers, at Leone's expense, to help decorate and furnish the D&G Boutique according to a concept created by their architects.

Attached as Exhibit C to the Inkster Affidavit is a copy of a facsimile communication dated April 19, 1999, from Leone's Advertising Assistant to the Licensing and Brand Division of Dolce & Gabbana SpA , detailing Leone's expenditures from 1994 to 1998 on advertising the D&G DOLCE & GABBANA mark.

Mr. Inkster states that Leone sends out four mail outs of catalogues or advertising leaflets per year that are delivered to customers across Canada to promote the D&G DOLCE & GABBANA merchandise. Attached as Exhibits D and E to his Affidavit are copies of examples of typical mail outs. According to Mr. Inkster, although they are not specifically intended for mail order, Leone does receive some telephone orders as a result of the mail outs.

Attached as Exhibit F to the Inkster Affidavit are copies of full page advertisements, showing the opponents' clothing and accessories, from the magazines "BCBusiness", "Vancouver", "Where Vancouver", "Living in Canada" and "Popular Lifestyle & Entertainment". Attached as Exhibit G to the Inkster Affidavit are copies of advertisements for the opponents' merchandise which appeared in the following newspapers: "The Vancouver Sun", the Chinese language "Ming Pao" (which is allegedly published in Vancouver, Calgary, Edmonton and Toronto), and the

“Seattle Times” and “Seattle Post” from Washington state. In the advertisements, reference is frequently made to the “D&G Boutique” or simply “D&G”. Further, when the mark D&G DOLCE & GABBANA is visible, it is usually depicted so that the D&G portion is prominent in relation to the DOLCE & GABBANA component.

Mr. Inkster states that the prominence of the letters D&G in the mark D&G DOLCE & GABBANA as well as the use of the mark D&G in retail and advertising has always been necessary to distinguish the Merchandise from another line of products called DOLCE & GABBANA. The D&G DOLCE & GABBANA merchandise is allegedly lower priced, with different styling and made of different material than the premium DOLCE & GABBANA line of products. According to Mr. Inkster, Leone carries both lines at opposite ends of the 20,000 square foot store and the two boutiques have completely different fixturings. Mr. Inkster further states that Leone’s advertisements and publicity have always clearly distinguished between the two boutiques by referring to them as the “D&G Boutique” versus the “DOLCE & GABBANA Boutique” and by running separate advertisements for each line. According to the deponent, the sales staff in the store usually refers to the D&G DOLCE & GABBANA merchandise as simply D&G to differentiate the two lines of products to customers because it is shorter and more efficient and because the repetition of the DOLCE & GABBANA portion of the mark causes confusion with the premium line.

Attached as Exhibit H to the Inkster Affidavit is a general product breakdown of D&G DOLCE & GABBANA merchandise sold by Leone from April 15, 1999 to November 23, 1999 showing a total of 644 items.

In her affidavit, Maria Leone, Vice President of Merchandise of Leone, states that Leone imports and retails merchandise designed and produced by the opponents which carries labels, designs and ornamentation depicting the trade-mark D&G DOLCE & GABBANA, wherein the letters D&G are shown in large and bold type to give them substantial prominence.

Attached as Exhibit “A” to the Leone affidavit are pictures of sample DOLCE & GABBANA merchandise sold to customers in the Leone DOLCE & GABBANA Boutique. It is noted by the deponent that the depicted merchandise, namely ladies’ handbags and ladies’ and men’s’ belts, is adorned with prominent metal buckles or ornaments spelling out the letters DG.

Only the Opponents filed a Written Argument. No Oral Hearing was conducted.

With respect to the grounds of opposition based on Section 30 of the Act (the first second and third grounds of opposition referred to above), the legal burden or onus is on the applicant to show that its application complies with Section 30. This includes both the question as to whether or not the applicant has filed an application that formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponents rely on allegations of fact in support of these grounds, there is an initial evidential burden on them to prove such allegations. The presence of an evidential burden on a party with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist (see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at pp. 329-330).

This Board has consistently held that the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the Act is the filing date of the application (see, for example, *Dic Dac Holdings (Canada) Ltd. V. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263 (T.M.O.B.) at p. 268). The rationale for the selection of the filing date of the application as the material time for assessing whether an application complies with Section 30 of the Act is likely based on the proposition that an application should contain accurate information as of the date that it is filed. An exception has, however, been made in situations wherein compliance with Section 30(a) of the Act is in issue. In *Eaton Williams (Millback) Ltd. v. Nortec Air Conditioning Industries Ltd.* (1982), 73 C.P.R. (2d) 70 (T.M.O.B.) at

p. 7, the Hearing Officer held that where an application has been amended in order to comply with Section 30(a) of the Act, the applicant will not be prejudiced by the original application as long as the amendment does not make the statement of wares or services broader than the statement contained in the original application. In any event, in the present situation, nothing turns on the issue of the material date for the assessment of the Section 30 grounds of opposition.

The opponents have alleged, as their second and third grounds of opposition, that the present application does not comply with Sections 30(a) and (b) of the Act in that the applicant has not used the trade-mark in association with any of the wares set out in the application and that the application does not contain a statement in ordinary commercial terms of the specific wares in association with which the mark has been used. However, since the opponents have not submitted any evidence in respect of these issues, I find that they have failed to meet their evidential burden in relation to these grounds of opposition. The second and third grounds of opposition are accordingly rejected.

The opponents have also alleged that the present application is contrary to Section 30(i) of the Act in that the applicant cannot have been satisfied that it was entitled to use the mark in Canada in association with the wares set out in the application since the mark was confusing with the opponents' registered and common law trade-marks and trade name. No evidence has, however, been furnished by the opponents to show that the applicant was even aware of their trade-marks or trade name prior to filing its application. Moreover, even if it was established that the applicant was aware of the opponents' trade-marks or trade name prior to filing the application, no evidence has been filed to show that the applicant could not have been satisfied of its entitlement to use the trade-mark in Canada in association with the goods listed in the application, on the basis, *inter alia*, that its trade-mark is not confusing with any of the opponents' trade-marks or trade name. Thus, any possibility of success of this ground of opposition is contingent upon a finding that the applicant's trade-mark is confusing with one or more of the opponents' marks (see *Consumer Distributing Co. v. Toy World Ltd.* (1990), 30 C.P.R. (3d) 191 (T.M.O.B.) at p. 195;

and *Sapodilla Co. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at p. 155). I will therefore consider the remaining grounds of opposition, all of which turn on the issue of confusion.

The material date for assessing the ground of opposition based on Section 12(1)(d) of the Act is the date of this decision [see: *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. The material date for assessing the non-entitlement ground of opposition is the applicant's claimed date of first use (February 1, 1997) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (April 30, 1999) [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. In any event, in the present circumstances, the different material dates are not critical in the assessment of confusion.

In support of the ground of opposition based on Section 12(1)(d) of the Act, the opponents have referred to the following registered trade-marks: TMA502,982-D&G DOLCE & GABBANA Design; TMA359,530-DOLCE & GABBANA; TMA488,330-J&ANS DOLCE&GABBANA Design; and TMA401,099-DOLCE&GABBANA. Surprisingly, while the opponents did attach copies of those registrations to their Statement of Opposition, they did not file copies of those registrations in evidence. In the present situation, however, I have relied upon the Registrar's discretion to check the register in order to determine whether those registrations are in good standing and to ascertain the particulars of those registrations. While the general position of the Registrar is that he will not, in opposition proceedings, have regard to anything appearing on the register that is not properly submitted as evidence, in view of the public interest in having a ground of opposition relying on Section 12(1)(d) of the Act properly disposed of, I consider it appropriate to exercise the Registrar's discretion to check the register in the present circumstances. In support of this position, see, for example, *Quaker Oats of*

Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410. Accordingly, having been delegated the powers of the Registrar pursuant to 63(3) of the Act, I have determined that those registrations are currently in good standing and extend to a variety of cosmetics, electronic equipment, clothing, footwear and accessories.

In assessing whether there is a reasonable likelihood of confusion between the trade-marks in issue within the scope of Subsection 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the Act. The factors enumerated at Subsection 6(5) of the Act are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time the marks have been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be afforded to each relevant factor may vary depending on the circumstances [see *Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R.(3d) 483 (F.C.T.D.)* and *Gainers Inc. v. Marchildon (1996), 66 C.P.R.(3d) 308 (F.C.T.D.)*].

As for the inherent distinctiveness of the marks and the extent to which they have become known, the applicant's trade-mark, when considered in its entirety, is somewhat more inherently distinctive than the opponents' trade-marks. The letters D&G in the applied for mark appear in a square and are superimposed over a design of what appears to be a smaller and a larger male fighting, suggestive of the Biblical story of David and Goliath. Below the square design are the words David and Goliath in script. There is a background design covering most of the mark. The opponents' marks on the other hand are comprised primarily of the letters D&G and/or the words Dolce and Gabbana which are surnames and therefore inherently weak. The D&G component, which is the dominant element of the applicant's mark and of the opponents' marks which consist of or incorporate those letters, adds little inherent distinctiveness to any of the marks since it is well established that marks comprised of or dominated by letters or initials are weak

marks which are only entitled to a narrow ambit of protection [*see: GSW Ltd. v. Great West Steel Industries Ltd. et al. (1975), 22 C.P.R. (2d) 154*].

The extent to which the marks have become known clearly favours the opponents since the applicant has not provided any evidence of use of the applied for mark. The opponents, on the other hand, have provided a fair amount of evidence of use and advertising of their trade-marks in Canada, by their licensee, Leone in association with clothing, footwear and accessories. While the opponents, in their Written Argument, have taken the position that their marks have acquired distinctiveness through use in Canada and should be classified as very well known or famous marks, the evidence does not support such a position. The opponents' evidence with respect to sales and advertising of their marks in Canada, while not insignificant, is not so extensive that it would support a conclusion that their marks are famous or are even well known in Canada.

In the alternative, the opponents have submitted that their marks should be recognized as "enjoying the beginning of their famousness". In support of the latter contention, the opponents have cited the decision of the Federal Court Trial Division in *Toyota Jidosha Kabushiki Kaisha v. Lexus Foods Inc. (1999), 2 C.P.R. (4th) 62 at 66*. However, in the appeal from that decision [9 C.P.R. (4th) 297 at p. 302], the Federal Court of Appeal commented:

The Trial Judge's reliance on the finding that the LEXUS mark was either famous or becoming so led him to be overly protective of it. While the notoriety of a mark may well be a significant factor to consider, as is the length of time it has been used, factors (a) and (b), it is not controlling. Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the rest of the factors. If the fame of a name could prevent any other use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless. Moreover, as for there being any obligation on the Court to nurture up-and-coming trade marks "to preserve [their] rising reputation", as implied in the reasons of the Trial Judge, that is not supportable. The Court must take the facts as they exist on the issue of fame as at the time of its decision.

Thus, even if the opponents' marks were to be considered to be enjoying the "beginning of their famousness" in Canada, there is no obligation on the Court (or this Board) to nurture "up-and-coming trade-marks" to preserve their rising reputation.

As for the length of time the marks have been in use, the opponents' evidence demonstrates use of its trade-marks in Canada since autumn of 1995. While the application under consideration claims use of the trade-mark in Canada since February 1, 1997, the applicant has failed to submit any admissible evidence by way of affidavit or statutory declaration in support of such a claim. Thus, the length of time the trade-marks in issue have been in use favours the opponents.

As for the nature of the wares and the nature of the trade of the parties, the applicant's wares are identified in the application as:

"sports clothing, namely: pants, jackets and vests, namely: lined and unlined jackets, jackets made of nylon and/or other fibres, lined and unlined pants, pants made of nylon and/or other fibres, lined and unlined anoraks, anoraks made of nylon and/or other fibres, sweaters, polos and T-shirts".

The registrations relied upon by the opponents, as noted above, extend to a variety of cosmetics, electronic equipment, clothing, footwear and accessories. Thus, there is clear overlap between the wares of the applicant and the wares of the opponents since the marks of both parties are for use in association with clothing.

While the applicant indicated in its Counter Statement that its clothing is designed for very large and very small persons in particular, no evidence has been submitted to that effect. Further, in any event, it is the applicant's and the opponents' statements of wares which must be considered in assessing the likelihood of confusion in relation to the Section 12(1)(d) ground of opposition [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), [19 C.P.R. \(3d\) 3](#) (F.C.A.) at pp. 10-11; *Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.* (1986), [12 C.P.R. \(3d\) 110](#) (F.C.A.) at p. 112; and *Miss Universe, Inc. v. Bohna* (1994), [58 C.P.R. \(3d\) 381](#) (F.C.A.) at pp. 390-392]. The statements of wares are to

be read with a view to determining the probable type of business or trade intended by the parties, and evidence of the actual trades of the parties may be useful (see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.) at p. 169). However, since the applicant has not filed any evidence with respect to the specific nature of its business, it is the applicant's statement of wares that must be considered. Accordingly, for the purposes of an assessment of the likelihood of confusion in this case, I consider that there is direct overlap in the wares and the trade of the parties.

Considering next the degree of resemblance between the trade-marks in issue, the applied for trade-mark and the opponents' registered trade-mark number TMA502, 982-D&G DOLCE & GABBANA bear some similarity both visually and phonetically in that the D&G component is the dominant component of both marks. However, it is trite that when assessing the likelihood of confusion, marks are to be considered as totalities and not dissected [see, for example *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.) and *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189 (S.C.C.)]. When the marks in issue are considered as such, and even bearing in mind that the wares and the respective channels of trade of the parties overlap, I find that the applied for trade-mark is not confusing with, *inter alia*, the opponents' registered trade-mark number TMA502, 982, considering that the marks are inherently weak and that there are substantial differences between the marks. Further, as none of the remaining registered trade-marks relied on by the opponents incorporate the D&G component, in my opinion, they are even less likely to be confused with the applied for trade-mark. The fourth ground of opposition is therefore unsuccessful.

The same can be said with respect to the opponents' trade name DOLCE & GABBANA and I accordingly reject the sixth ground of opposition as well.

In order to satisfy its evidential burden with respect to the Paragraph 16(1)(a) ground of opposition, the opponents must file sufficient evidence to show that their

marks were used prior to the applicant's alleged date of first use of its trade-mark (in this case, February 1, 1997). Further, Subsections 16(5) and 17(1) of the Act place a burden on the opponents to establish non-abandonment of their trade-marks as of the date of advertisement of the applicant's application (in this case, December 2, 1998). The opponents' evidence clearly shows use of their trade-marks in association with clothing, footwear and accessories since prior to the applicant's alleged date of first use. Further, it is clear from the opponents' evidence that those marks have not been abandoned.

As noted above, I do not consider the trade-mark which is the subject matter of this opposition proceeding to be confusing with the opponents' registered trade-marks. I do, however, consider that there is a likelihood of confusion between the opponents' common law trade-marks D&G and DG and the applied for trade-mark which incorporates the entirety of the opponents' D&G trade-mark as the first and dominant component of its mark. In this regard, see the decision *Conde Nast Publications Inc. v. Union Des Editions Modernes (1979)*, 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188.

Having regard to the foregoing and, in particular, to the degree of resemblance between the opponents' common law D&G trade-mark as applied to similar wares which could travel through the same channels of trade and considering that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks in issue as of its claimed date of first use, I find that the fifth ground of opposition is successful.

The last ground of opposition is that the Applicant's trade-mark is not distinctive since it does not actually distinguish nor is it adapted to distinguish the wares of the Applicant from the wares of others or from the wares of the opponents, sold in association with their common law and registered trade-marks or trade name.

The legal onus is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from the wares of others throughout Canada

[Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R. (3d) 272 (TMOB)]. However, there is an evidential burden on the opponents to prove the allegations of fact supporting this ground of opposition. The opponents have satisfied their evidential burden in this regard but the Applicant has not filed any evidence to support its position. As noted above, I am satisfied that there would be a reasonable likelihood of confusion between the applied for mark and the opponents' common law D&G trade-mark. I therefore find that the applied for trade-mark is not distinctive of the applicant since it does not distinguish the wares of the applicant from the wares of the opponents.

Finally, in view of the foregoing discussion regarding the likelihood of confusion between the applicant's mark and the opponents' D&G mark, I consider that the opponents have met their evidential burden with respect to the Section 30(i) ground of opposition. It may be that, notwithstanding the foregoing, the applicant still felt that it was entitled to use the applied for trade-mark in Canada. However, since the applicant has not filed any evidence, it has not met its onus to show that its application complies with Section 30(i) of the Act and I therefore find that this ground of opposition is successful as well.

For the foregoing reasons, and bearing in mind that the applicant has not taken any active steps in this opposition subsequent to the filing of a counterstatement, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application.

DATED IN GATINEAU, QUEBEC, AUGUST 5, 2004

Jennifer McKay

Hearing Officer

Trade-marks Opposition Board

