

**IN THE MATTER OF AN OPPOSITION by
GA Modefine S.A. to application No. 896,033
for the trade-mark LE SPOSE DI GIÓ
filed by Di Gio' S.R.L.**

On November 12, 1998, the applicant, Di Gio' S.R.L., filed an application to register the trade-mark LE SPOSE DI GIÓ. This application was assigned serial number 896,033.

Application No. 896,033 is based upon proposed use of the trade-mark in Canada. The application was advertised for opposition purposes in the Trade-marks Journal of September 29, 1999. When advertised, the statement of wares read as follows: wedding dresses, formal dresses for ceremony, hats, veils, fur stoles, scarves; gloves; underwear, namely pyjamas, petticoats, dressing-gowns, slippers, brassieres, garters, tights, stockings; shoes, sandals; ribbons, artificial flowers; handbags, costume jewellery, namely earrings, necklaces, bracelets, brooches.

On November 26, 1999, the opponent, GA Modefine S.A., filed a statement of opposition against the application. The applicant filed and served a counter statement.

On April 4, 2001, the applicant amended the statement of wares in application No. 896,033 to read: wedding dresses, formal dresses for ceremony; accessories for wedding dresses namely, hats, veils, scarves, gloves, artificial flowers.

As rule 41 evidence, the opponent filed the affidavit of Christine Michel.

As rule 42 evidence, the applicant filed the affidavits of Erminio Gatti, M. Louise McLean, Ellen Anastacio, and Luca Buiani (two affidavits).

As rule 43 evidence, the opponent filed the affidavit of Michael Godwin. The applicant immediately took the position that the Godwin affidavit ought to be disregarded on the basis that it "is not in anyway confined strictly to matters in reply and, accordingly, offends Section 43 of the Trade-marks Regulations."

On November 6, 2003, the applicant was granted leave to file certified copies of certain pages from the examination file for Canadian trade-mark application No. 1,084,043, pursuant to rule 44(1).

Each party filed a written argument. An oral hearing was held at which both parties were represented.

Grounds of Opposition

The three grounds of opposition may be summarized as follows:

1. the application does not comply with the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) in that the applicant could not have been satisfied that it was entitled to use the proposed mark in Canada in association with the wares described in the application having regard to the fact that at the time of filing such application the proposed mark was confusing with the opponent’s very similar trade-marks GIO’ and ACQUA DI GIO’, which had been previously used in Canada, and for which applications had been previously filed in the Canadian Trade-marks Office in association with identical wares to those of application No. 896,033;

2. the applicant is not the person entitled to registration of the proposed trade-mark pursuant to s. 16(3)(a) and (b) of the Act since at the date that the applicant applied to register the proposed trade-mark, the proposed trade-mark was confusing with the opponent’s aforesaid previously applied for trade-marks GIO’ and ACQUA DI GIO’, application Nos. 833,621 and 833,622, respectively, both filed January 14, 1997, and both claiming priority based on applications filed in the opponent’s home country on July 18, 1996, which applications cover, inter alia, wares identical to application No. 896,033, and the trade-marks covered thereby having been previously used in Canada by the opponent in association with, inter alia, “soaps, perfumery, cosmetics and hair care preparations”.

3. the proposed mark is not distinctive in that it does not distinguish, is neither adapted to distinguish, nor capable of distinguishing the wares of the applicant as described in application No. 896,033 from the wares of others and more particularly from the wares of the opponent in association with which the opponent’s aforesaid trade-marks GIO’ and ACQUA DI GIO’ have been applied for and used in Canada.

Onus

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act, there is an initial burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [see *John Labatt Limited v. The Molson*

Companies Limited, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material date with respect to the first and second grounds of opposition is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475 and s. 16(3)]. The material date with respect to the third ground of opposition is the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324]. In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

Rule 41 Evidence

Michel Affidavit

Ms. Michel, the opponent's Company Manager, states that the opponent sells its fragrances under the trade-marks GIÓ and ACQUA DI GIÓ in Canada through its exclusive licensee L'Oréal S.A., which distributes the product through its wholly owned subsidiaries L'Oréal U.S.A. (formerly Cosmair, Inc.) and L'Oréal Canada Inc. (formerly Cosmair Canada Inc.). Interestingly, she does not provide a sample product or packaging for the GIÓ wares; instead she provides a sample product and packaging for what she refers to as GIO' DI GIORGIO ARMANI perfumed body lotion and ACQUA DI GIO' eau de toilette [Exhibits "C" and "D"].

Ms. Michel does provide details of when, how and to what extent the marks GIÓ and ACQUA DI GIÓ have been used in Canada. She also provides some details about the advertisement of the marks in Canada. In addition, she provides details of the two trade-mark applications that the opponent is relying upon. Applications Nos. 833,621 and 833,622 cover the following wares:

- (1) Perfumes, toilet water, personal and body deodorants, essential oils for personal use, body lotions, shower gel, bubble bath, hair shampoos, hair sprays, hair lotions, bath oils, bath pearls, skin soaps, aftershave lotions, cosmetic pencils, foundation make-up, face powders, talcum powder, rouges, lipsticks, mascaras, skin cleansing creams, skin cleansing lotions, sun screen preparation, nail polish remover, face creams, body creams, hand creams, dentifrices, gels, salts for the bath and shower, toilet soaps, shampoos.
- (2) Pullovers, gloves, cardigans, jerseys, ties, neckerchiefs, sweaters, socks, stockings, tights, trousers, leggings, skirts,

jackets, jerkins, shirts, vests, waistcoats, jumpers, track suits, blouses, blousons, jeans, sweat-shirts, sweat pants, gym suits, knickers, pants, shorts, T-shirts, suits and dresses, overcoats, coats, anoraks, raincoats, belts, suspenders, brassieres, corsets, singlets, petticoats, swimming suits, pyjamas, night-gowns, dressing gowns, shoes, boots, sandals, slippers, hats and caps, bathrobes, polo shirts, sport shirts.

Ms. Michel provides some information, but no exhibits, with regard to a web site maintained by the opponent's subsidiary, Giorgio Armani Corporation. She states that Giorgio Armani Corporation is a fashion design house that designs clothing, as well as a complete line of toiletries, including perfume and she provides examples of other fashion designers and their perfume products. She also expresses the opinion that there is a clear relationship between clothing and perfume products and that consumers have come to expect that fashion houses will also have a complete line of cosmetic and perfume products.

Rule 42 Evidence

Gatti Affidavit

Mr. Gatti, the applicant's Sole Director, begins by explaining the origin of the applicant's trademark. He states, "Giò" is "a well known short form for many popular Italian names, in particular, for the male name 'GIOVANNI' and the female name 'GIOVANNA'." "Giò" is the nickname of one of the applicant's founders, Giovanna De Capitani, and the "literal translation of the LE SPOSI DI GIÓ trademark is 'The Brides of Giò'." [Although the accent that appears on the letter "o" in the word "Gio" is not always the same as that applied for, I consider this variation to be minor and inconsequential.]

Mr. Gatti sets out where, when and how the trade-mark LE SPOSI DI GIÓ has been used and provides a sample label. He also provides copies of advertisements that he says appeared in magazines that are distributed in Canada. As of the date of his affidavit, the applicant's LE SPOSI DI GIÓ wares were not sold in any retail establishments in Canada. The applicant did however have a web site and had received e-mails from Canadians concerning its wares.

Buiani Affidavits

Ms. Buiani, a professional translator, attests that the English translations provided with respect to the Italian language affidavit of Mr. Gatti are true and correct.

McLean Affidavit

Ms. McLean, a law clerk, has provided:

- the results of searches she conducted for various fragrances in Canada;
- information that she received over the phone concerning how long certain magazines have been available in Canada (which I agree with the opponent is inadmissible hearsay);
- copies of magazine advertisements;
- and some information concerning the applicant's web site.

Anastacio Affidavit

Ms. Anastacio, a trade-mark searcher, provides:

- details of approximately 6 trade-marks on the Canadian Trade-marks Register that consist solely of the word GIO (GIO has been registered by three separate parties for children's clothing, shampoo and jewellery; a fourth party has registered GIO GIO for footwear; and the owner of GIO for children's clothing also owns an allowed application to extend its registration to cover other types of clothing, which are not specified as being for children);
- details of approximately 13 trade-marks on the Canadian Trade-marks Register that include the word GIO and relate to clothing;
- details of approximately 20 trade-marks on the Canadian Trade-marks Register that include the word GIO and relate to wares other than clothing;
- details of approximately 9 trade-marks on the Canadian Trade-marks Register which include the word GIO that are owned by Giorgio Beverly Hills, Inc. and relate to clothing and cosmetics/toiletries;
- examples of trade-marks that are the subject of registrations for clothing in the name of one party and for perfume in the name of another party.

Rule 43 Evidence

Godwin Affidavit

Mr. Godwin, a trade-mark searcher, provides the results of searches that he did of the Trade-marks Register with a view to locating trade-marks that are registered by a single entity for both perfume and clothing. He provides registration pages for more than 30 of such marks.

Contrary to the applicant's submissions, I find that Mr. Godwin's evidence is proper reply evidence, being clearly in reply to matters raised in the Anastacio affidavit.

Rule 44(1) Evidence

Certified copies were provided of four items from the opponent's application No. 1,084,043 for the trade-mark GIO' DE GIORGIO ARMANI Design, which is shown below:



I note that this is the trade-mark that appears on the product and packaging in Exhibit "C" to the Michel affidavit, although Ms. Michel refers to her exhibit as showing a sample of GIO' DI GIORGIO ARMANI.

Section 50 Issues

As a preliminary matter, I will address the issue of whether the use of the opponent's marks in Canada enures to its benefit.

The only way that third party use of a trade-mark is deemed to be that of the registered trade-mark owner is when s. 50 of the Act is satisfied. Sections 50(1) and (2) are reproduced below:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same

effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

In the present case, the only references to entities that appear on the GIÓ and ACQUA DI GIÓ products are the following:

- on the outer box :
 - DISTRIBUTION RÉSERVÉE AUX DÉPOSITAIRES AGRÉÉS PAR GIORGIO ARMANI PARFUMS 16 PLACE VENDÔME 75001 PARIS
 - DIST. IN U.S.A. BY GIORGIO ARMANI PARFUMS, DIV. OF COSMAIR, INC., NEW YORK, N.Y. 10017, DIST. COSMAIR CANADA INC. MONTREAL, H4T 1K5 MADE IN FRANCE

- on the bottom of the bottle: Dist. U.S.A. Giorgio Armani Parfums, Cosmair, Inc. New York N.Y. 10017 Giorgio Armani Parfums – Paris Made in France

The various distributors of the product do not concern me because a consumer understands that distributors are not the ultimate source of the product. However, I am concerned by the reference to Giorgio Armani Parfums of Paris. The opponent is of course GA Modefine S.A. of Switzerland and there is no reference to it on the wares or their packaging. Instead, Giorgio Armani Parfums of Paris appears to be the source of the wares and there is no indication in the opponent's evidence as to what that entity is. As there is no evidence that Giorgio Armani Parfums is a trading style of the opponent, or a licensee of the opponent whose use is controlled as required by s. 50, I cannot attribute the sales of the GIÓ and ACQUA DI GIÓ products in Canada to the opponent.

I will further add that corporate structure alone does not establish the existence of a licensing arrangement. [see *Loblaws Inc. v. Tritap Food Broker*, 3 C.P.R. (4th) 108 (T.M.O.B.)] Accordingly, any use of trade-marks by the opponent's subsidiary Giorgio Armani Corporation does not accrue to the opponent's benefit in the absence of evidence of the use being controlled pursuant to a license.

Likelihood of Confusion

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Those factors specifically set out in s. 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has 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 given 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.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

At the oral hearing, both parties agreed that names such as GIO do not possess much inherent distinctiveness. Nevertheless, I conclude that the trade-mark LE SPOSI DI GIÓ has a fair degree of inherent distinctiveness as one cannot assume that the average Canadian consumer understands that it is Italian for “the brides of Gio”. For similar reasons, the opponent’s trade-mark ACQUA DI GIO’ has a fair degree of inherent distinctiveness in Canada.

The opponent’s marks have acquired distinctiveness through sales and promotion in Canada, but see my discussion above regarding whom has benefited from this acquired distinctiveness. Furthermore, I have some doubt as to whether the mark GIO’ itself has acquired distinctiveness as opposed to the composite marks GIO’ DE/DI GEORGIO ARMANI and ACQUA DI GIO’.

The applicant’s evidence concerning the promotion of its mark in Canada is insufficient to give rise to any significant acquired distinctiveness.

Section 6(5)(b) favours the opponent, because the GIO’ and ACQUA DI GIO’ products have been sold in Canada since August 1993 and April 1995, respectively. [Michel affidavit, paragraph 9]

The opponent argues that fragrances are closely related to wearing apparel. Whether or not one accepts that proposition, the applications that the opponent relies upon in support of its s. 16(3)(b) ground cover clothing in addition to fragrances.

The evidence seems to go both ways on the question of whether it is common for a single party to use the same trade-mark in association with both clothing and perfume. The applicant's evidence suggests otherwise but the opponent counters that it is a common situation where a designer's mark is involved. However, there is no evidence here that the opponent owns a designer's mark.

Regarding channels of trade, it seems reasonable that the parties' wares could be sold in close proximity, for example in department stores. Although the applicant only sells its wares abroad in specialty bridal boutiques, and states that this is its intention with respect to Canada, the statement of wares in its application is not so restricted. Consequently, I shall assume that the parties' channels of trade could overlap.

When sounded, the parties' marks are very different. They also look very different. They have some resemblance in the idea suggested in that both suggest something foreign, being in the Italian language. I cannot assess to what extent the average Canadian consumer would recognize Gio as a name.

A significant surrounding circumstance is the state of the register/marketplace evidence. The following companies own registrations for the trade-mark GIO for fashion-related wares:

1. Gio Sport Design Manufacturing Inc. for children's clothing, children's hair accessories, tote bags and sport bags
2. Giovanni Management Canada Ltd. for shampoos
3. Giovanni Jewelry Company for jewellery
4. Aldo Shoes Inc. for women's footwear.

In addition, there are the following third party marks, each of which has been registered for clothing by a different party:

1. GIORGIO

2. GIORDANO & Design
3. GIORGIO FERRINI
4. GIORGIO GRATI
5. GIORGIO KAUTEN
6. GIORGIO MATEO
7. GIORGIO RIMALDI
8. GIORGIO SANT'ANGELO
9. GIORGIO SAPPINI & Design.
10. GIORGIO VERDICE
11. GIORGIO TORLONIA & Design

The applicant submits that another significant circumstance to consider exists in the submissions made by the opponent during the prosecution of its application No. 1,084,043 for GIO' DE GIORGIO ARMANI Design. It successfully overcame an examiner's objection that such mark was likely to cause confusion with the prior marks GIO registered for clothing and accessories by Gio Sport Design Manufacturing Inc. and DI GIO applied for by the present applicant for wedding dresses and accessories. In so doing, the opponent relied heavily on the inclusion of the words GIORGIO ARMANI in its trade-mark. I agree with the opponent that, to the extent that the argument made with respect to application No. 1,084,083 did not relate to the marks in question in the present proceedings, it is of little assistance. However, I do note that the opponent has gone on record in the past to say that it is the words GIORGIO ARMANI that dominate the context and make it clear that the word GIO in GIO' DE GIORGIO ARMANI Design refers to Giorgio Armani and not to some other company that uses the word GIO. Given that the only evidence of use provided by the opponent in the present case shows GIO' or ACQUA DI GIO' in close proximity to the name Giorgio Armani, the question is raised whether it is only in this context that the trade-marks relied upon by the opponent can distinguish the source of its wares from those of other marks that incorporate GIO. To put it another way, I am not certain that any reputation that the opponent may have acquired through use or promotion could be isolated as relating to the two marks relied upon, as opposed to them in combination with the other words that appear to consistently accompany them.

The opponent has argued that the marks being relied upon by the opponent are “designer” or “signature” marks and that they comprise the personal name (Gio) of the well known clothing designer, Giorgio Armani. The opponent submits that “as such, these ‘designer’ or ‘signature’ marks embody the personal goodwill, reputation or cachet that Mr. Armani has created and developed in respect of his fashion products.” [opponent’s written argument, paragraph 84] The opponent proceeds to submit that well-known “designer” or “signature” marks are to be given a wide ambit of protection that is often extended beyond the wares registered in association with the “designer” mark. I will not discuss the various case law that the opponent puts forth in support of this position, for the simple reason that there is no evidence on which I can conclude that the opponent owns a “designer” mark. No evidence has been provided concerning the individual Giorgio Armani and I cannot take judicial notice that he might be a well-known designer. Even if he were a well-known designer, the opponent would have to establish that the nickname Gio, rather than his full name, is a designer mark since the marks that the opponent relies upon do not include his full name. In any event, there is no evidence of how Mr. Armani is related to the opponent.

Having considered all of the surrounding circumstances, I conclude that on a balance of probabilities the applicant has satisfied the burden on it to show that there is not a reasonable likelihood of confusion between LE SPOSE DI GIÓ and either of the marks GIO’ or ACQUA DI GIO’ at either of the material dates. In particular, in view of the inherent weakness of the common component GIO, the adoption of marks that comprise GIO by third parties in similar fields, and the questions raised above concerning what distinctiveness the opponent has itself acquired with respect to GIO, I find that the applicant’s mark is sufficiently distinguished from the opponent’s marks to make confusion unlikely. As each of the pleaded grounds of opposition is premised on a likelihood of confusion between LE SPOSE DI GIÓ and GIO’ or ACQUA DI GIO’, each ground of opposition fails.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 28th DAY OF OCTOBER 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board