

**IN THE MATTER OF AN OPPOSITION by Fashion World,
Inc. to application No. 729,402 for the trade-mark BIJON
SPORT filed by BRAVEK ENTERPRISES INC.**

On May 20, 1993, the applicant, BRAVEK ENTERPRISES INC., filed an application for registration of the trade-mark BIJON SPORT based on proposed use of the trade-mark in Canada in association with “costume jewellery and jewellery of precious metals.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 16, 1994 and the opponent, Fashion World, Inc., filed a statement of opposition on April 13, 1995, a copy of which was forwarded to the applicant on June 20, 1995. The applicant served and filed a counter statement in response to the statement of opposition on October 20, 1995. The opponent submitted as its evidence the affidavits of J. Stephen Felice, Tracey L. Pullen, Carol A. Luciani and Robert W. White while the applicant filed as its evidence the affidavit of Brahm Hauer. J. Stephen Felice was cross-examined on his affidavit, the transcript of the cross-examination forming part of the opposition record. Neither party submitted a written argument and neither party requested an oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

a) The present application does not conform to subsection 30(i) of the *Trade-marks Act* in that the applicant could not have properly made the statement of entitlement required. The applicant and the opponent are in the same general fields of endeavour, namely, the fashion industry which industry includes jewellery, cosmetics, clothing and the like. The opponent has used its BIJAN trade-mark in Canada for over 10 years in association with perfume, jewellery and other goods and by virtue of its extensive use and promotion, the BIJAN trade-mark has become well known to its targeted marketplace and is particularly well known by others in the fashion industry. The opponent submits that prior to the date of filing, the applicant was fully aware of the opponent’s prior rights in and to the trade-mark BIJAN previously used and registered in association with identical goods.

b) The applied for trade-mark is not registrable in view of paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant’s trade-mark is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
BIJAN	397,706	Jewelery. Perfume.
BIJAN Design	397,959	Perfume.

BIJAN

338,791

Costume jewellery; cosmetics namely perfumes, facial and hand creams and lotions, deodorants; fashion accessories, namely cosmetic bags.

c) The applicant is not the person entitled to registration of the trade-mark BIJON SPORT in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the trade-marks BIJAN of the opponent, previously used and registered in association with the same kind of wares.

d) The applied for trade-mark is not distinctive of the wares of the applicant nor is it adapted so as to distinguish the applicant's wares, nor is it capable of distinguishing applicant's wares from the wares of others, and particularly from the wares of the opponent.

The first ground of opposition is based on subsection 30(i) of the *Trade-marks Act*. While the legal burden is on the applicant to show that its application complies with section 30 of the *Act*, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence which, if believed, would support the truth of the allegations relating to the subsection 30(i) ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. In the present case, no evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark BIJON SPORT in Canada on the basis *inter alia* that it considered that its trade-mark is not confusing with the opponent's trade-marks. Moreover, to the extent that the subsection 30(i) ground is founded on allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the applicant's trade-mark is not registrable or not distinctive, or that the applicant is not the person entitled to registration of the trade-mark BIJON SPORT, as alleged in those grounds [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p.195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R.(2d) 152, at p.155]. I will therefore consider the remaining grounds of opposition.

The second ground is based on paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark BIJON SPORT is not registrable in that it is confusing with its registered trade-marks identified above. The legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark BIJON SPORT and the opponent's registered trade-marks as of the date of decision, the material date with respect to the paragraph 12(1)(d) ground [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*

et al, 37 C.P.R. (3d) 413 (F.C.A.)). Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's mark BIJON SPORT and one, or more, of the opponent's registered trade-marks, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in subsection 6(5) of the *Trade-marks Act*.

Considering initially the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], the applicant's trade-mark BIJON SPORT, when considered in its entirety as applied to the wares covered in the present application, is inherently distinctive. Further, the opponent's BIJAN trade-marks possess relatively little inherent distinctiveness as the evidence establishes that Bijan has a given name significance, the founder of the opponent being Bijan Pakzad.

With respect to the extent to which the trade-marks at issue have become known [para. 6(5)(a)] and the length of time the marks have been in use [para.6(5)(b)], the applicant submitted the affidavit of its President, Brahm Hauer, who states that the applicant commenced use of its trade-mark BIJON SPORT in Canada in 1993 and, since that time, the applicant has distributed by way of a dealer network approximately 75,000 to 100,000 pairs of earrings in association with its mark. According to Mr. Hauer, the applicant's dealers consign the applicant's costume jewellery to *inter alia* independent salons, boutiques, tanning salons and drug stores.

In his affidavit, J. Stephen Felice, counsel to the opponent, states that the opponent has sold BIJAN products in Canada since 1990 and has provided the annual wholesale sales for the period 1990 to 1994 inclusive, the total during this time exceeding \$1,250,000. Further, Mr. Felice has furnished evidence of advertising and promotion of its BIJAN perfume, eau de parfum, eau de toilette, after shave and bath and body products in publications which circulate in Canada. As a result, I find that both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use both weigh in the opponent's favour. I would note, however, that the opponent's evidence fails to establish that it has used its trade-mark BIJAN in Canada in association with jewellery. In this regard, I do not believe that the average consumer would consider the opponent's "perfume pendant" as being jewellery.

As for the nature of the wares of the parties [para.6(5)(c)] and the nature of the trade associated with their respective wares [para.6(5)(d)], it is the applicant's statement of wares and the statements of wares covered in the opponent's registrations which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. In this regard, the applicant's "costume jewellery and jewellery of precious metals" overlap the "costume jewellery" covered in registration No. 338,791. Further, I would expect that the respective channels of trade of the parties could potentially overlap in relation to the costume jewellery covered in the present application and in registration No. 338,791.

Brahm Hauer in his affidavit asserts that the applicant's costume jewellery is sold on store counters or at small kiosks located in stores or in malls while the opponent's perfume and related body products are sold in high end retail establishments. However, absent a restriction in the statements of wares set forth in the opponent's registration as to the channels of trade associated with its wares, the Registrar cannot, when considering the issue of confusion, take into consideration the fact that the opponent may only have sold its wares through particular retail outlets to date [see *Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.*, referred to above]. Furthermore, in *Pernod Ricard v. Molson Breweries*, 44 C.P.R. (3d) 359, at page 368, Mr. Justice Denault commented as follows:

"The courts have held that in attempting to establish a likelihood of confusion, it is not necessary to prove that the wares of both parties are sold in the same outlets, as long as the parties are entitled to do so: *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 at p. 73, 10 A.C.W.S. (2d) 493 (F.C.T.D.); *Eminence, SA v. Registrar of Trade Marks* (1977), 39 C.P.R. (2d) 40 (F.C.T.D.) at p. 43. In this instance, the wares of both parties are products of the same industry and, as such, there exists the very real possibility that they would be made available to consumers in many of the same outlets. The appellant argued that even if its products were sold in the same retail outlets as those of the respondent, they would be sold in distinct portions of the store, and never side by side. Again, I must emphasize that the potential does exist."

Consequently, the fact that the opponent's products may not have been sold through the same type of retail outlets to date in Canada is of limited assistance to the applicant in assessing the issue of the likelihood of confusion in relation to the paragraph 12(1)(d) ground.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, Mr. Felice in his affidavit states that the opponent, as is common in fashion and beauty product retailing, has included a 'Sport Spray' in its line of BIJAN fragrance products and has annexed copies of advertisements for BIJAN Sport Spray as Exhibit C to his affidavit. Moreover, in her affidavit, Tracey L. Pullen has furnished evidence of use of the trade-marks: POLO SPORT and RALPH LAUREN POLO SPORT WOMAN in association with various toiletry items; LIZSPORT clothing, as well as LIZ CLAIBORNE earrings and fragrance; and JONES NEW YORK SPORT clothing and JONES NEW YORK earrings.

The Luciani affidavit introduces into evidence the results of a trade-marks search for trade-marks covering goods in the fashion industry which have subsequently been refiled or registered to include the word SPORT as a component of the trade-mark. The Pullen affidavit has annexed to it the results of a computer data base search conducted by the affiant of the Trade-marks Register for various well known fashion marks in order to examine the history of diversity for each of these marks. The results of the Pullen and Luciani trade-mark searches reveal registrations for *inter alia* the trade-marks POLO SPORT, ESPRIT SPORT Design, SUNG SPORT, ALFRED SUNG SPORT & Design, MENNEN SPORT, MARINA SPORT, BIANCA SPORT, DANIEL HECHTER SPORT & Design and LIZSPORT. Thus, the opponent's evidence establishes both the adoption and the use of the word SPORT trade-marks by the owners of various fashion marks in combination with other of their marks.

Having regard to the foregoing and, in particular, to the degree of resemblance between the trade-marks BIJON SPORT and BIJAN as applied both to cosmetic jewellery, and bearing in mind the inherent weakness of the word SPORT in the fashion and cosmetic industry and even considering that the opponent's trade-mark BIJAN is inherently weak and is therefore not entitled to a broad ambit of protection, I find that the applicant has not met the legal burden on it of satisfying the Registrar that there would be no reasonable likelihood of confusion between its trade-mark BIJON SPORT and the opponent's registered trade-mark BIJAN covered by registration No. 338,791. Thus, the paragraph 12(1)(d) ground is successful.

Having been delegated by the Registrar of Trade-marks pursuant to subsection 63(3) of the *Trade-marks Act*, I refuse the present application pursuant to subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 24th DAY OF JANUARY, 2001.

G.W. Partington,
Chairperson,
Trade-marks Opposition Board.