

IN THE MATTER OF AN OPPOSITION
by Ports International Limited to
application No. 682,304 for the mark
PORT TO PORT filed by
Open Corporate S.R.L.

On May 22, 1991, the applicant, Corporate Open S.R. L., filed an application to register the mark PORT TO PORT, based on proposed use in Canada, for various items of men's clothing and accessories, and for the operation of a retail clothing store. The accessories specified in the application are ties, belts, scarves, bow ties, handkerchieves, shoes, watches, and perfume. The subject application was advertised for opposition purposes on January 8, 1992, and was opposed by Ports International Limited on May 7, 1992. A copy of the statement of opposition was forwarded to the applicant on June 9, 1992.

The grounds of opposition are that the applied for mark PORT TO PORT is not registrable and not distinctive, and that the applicant is not entitled to register the mark, because the applied for mark PORT TO PORT is confusing with the opponent's registered marks including PORTS, PORTS & Design (shown below), PORTS INTERNATIONAL, and PORTS INTERNATIONAL & Design (shown below) covering men's and women's clothing and accessories, and confusing with the opponent's trade-names Ports and Ports International Limited, previously used by the opponent in Canada.

The applicant responded by filing and serving a counter statement generally denying the grounds of opposition.

The opponent's evidence in chief consists of the affidavit of Alfred Chan, Chairman and C.E.O. of the opponent company. The applicant's evidence consists of the affidavit of Sergio Marchese, President of a company (namely, 175383 Canada Inc.) engaged in the sale and distribution of men's clothing. At the time that these proceedings commenced, Mr. Marchese' company was a registered user of the applied for mark. For the purposes of this proceeding, I will assume that 175383 Canada Inc. was licensed to use the applied for mark, within the terms of subsection 50(1) of the Trade-marks Act, at all relevant times.

I will first consider the ground of opposition pursuant to subsection 12(1)(d), namely, that the applied for mark PORT TO PORT is not registrable because it is confusing with the opponent's registered mark PORTS & Design covering various items of women's and men's clothing and

accessories (including belts and bracelets). The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision: see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.); Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 (TMOB).

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark PORT TO PORT and the opponent's registered mark PORTS & Design. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at pp. 297-298 (F.C.T.D.).

With respect to subsection 6(5)(a), the marks PORTS & Design and PORT TO PORT both possess fairly high degrees of inherent distinctiveness, as the word "port" has no readily discernable nexus with clothing or with clothing accessories. Mr. Chan's evidence of sales and advertising under the opponent's marks does not distinguish between women's and men's lines of clothing, nor does the evidence separate out the amount of sales and the extent of advertising among the opponent's various marks. By far a greater portion of the exhibit material indicates use of the opponent's mark PORTS INTERNATIONAL & Design in association with women's clothing. Nevertheless, from the manner of use of the mark PORTS INTERNATIONAL & Design, I am satisfied that it is also use of the mark PORTS & Design *per se*: in this respect see Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at p. 358 (TMOB). On a fair reading of Mr. Chan's affidavit together with the exhibit material, and without the benefit of cross-examination, I am prepared to infer that the opponent's mark PORTS & Design has achieved a significant reputation in Canada in association with men's clothing as well as with women's clothing. I infer from Mr. Marchese's affidavit, filed on behalf of the applicant, that the applied for mark PORT TO PORT has achieved some measure of reputation in Canada, but substantially below that of the opponent's mark PORTS & Design used in association with men's clothing.

The opponent began using its mark PORTS & Design in Canada in 1973, while the applicant began use of its mark PORT TO PORT (through 175383 Canada Ltd.) in 1991. Thus, the length of time that the marks in issue have been in use favours the opponent.

The nature of the parties' clothing wares is essentially the same, and the applicant's service

namely, the operation of a retail clothing store, is of course closely related to the opponent's wares. Mr. Marchese' evidence is that the applicant operates through factory or discount outlets and attracts clientele interested in obtaining a bargain. According to Mr. Marchese, the applicant is not in competition with the opponent who attracts "the higher end consumer." Mr. Marchese also notes that the applicant's mark PORT TO PORT is always presented in a logo, such as illustrated below, "in conjunction with the words IN CAPO AL MONDO and [with a representation of] a bird, thereby making it very distinguishable . . ." To the best of his knowledge, there has never been any confusion between the mark PORT TO PORT and any of the opponent's marks.

With respect to Mr. Marchese' first point, it is not only the applicant's present method of doing business namely, through discount and factory outlets, that is relevant. Absent any restrictions in the statement of wares and services in the application of record, I must have regard to all the channels of trade which would normally be associated with the wares and services set out in the application: see Société Guy Laroche, S.A. v. Boutique l'Ensemblier Inc. (1993), 53 C.P.R.(3d) 86 at pp. 91-92 (TMOB). Further, I am not permitted to recognize a distinction between goods of the same general class in which price is the main distinguishing feature: see Bagagerie SA v Bagagerie Willy Ltée (1992), 45 C.P.R.(3d) 503 at p. 510 (F.C.A.). Thus, I must conclude that the parties' wares would attract the same clientele and that the parties' channels of trade are potentially the same namely, through customary retail clothing outlets and through large department stores. I will be commenting below on Mr. Marchese' evidence that the mark PORT TO PORT is used in conjunction with other indicia.

With respect to the subsection 6(5)(e), I find that there is a high degree of resemblance between the applied for mark and the opponent's mark in all respects, that is, visually, aurally, and in the ideas they suggest. Of course, it is the applied for mark that is compared to the opponent's mark, and not the applied for mark as it is used in conjunction with other indicia. It may be, however, that Mr. Marchese' present method of doing business through factory outlets, and the present method of use of the mark PORT TO PORT as a component in a logo, in some measure account for no reported instances of actual confusion to date. The opponent did not raise the issue of whether the applicant's use of its mark in the above logo is use of the applied for mark *per se* and therefore I too have disregarded this issue.

Considering the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark is confusing with the opponent's mark with respect to men's clothing and with respect to the operation of a retail clothing store. Keeping in mind also that a well known mark is entitled to a wider ambit of protection than that usually afforded to lesser known marks, I find that the applicant has not met the legal burden on it to show that its mark PORT TO PORT is not confusing with the opponent's mark PORTS & Design with respect to the accessory items specified in the subject application. As the opponent has succeeded on its ground of opposition pursuant to subsection 12(1)(d), I need not consider the remaining grounds.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 28th DAY OF July, 1994.

Myer Herzig,
Member,
Trade-marks Opposition Board