



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 32
Date of Decision: 2011-02-16

**IN THE MATTER OF AN OPPOSITION by
Emilio Pucci International BV to application
No. 1,319,689 for the trade-mark EMIDIO
TUCCI in the name of El Corte Ingles, S.A.**

[1] On October 11, 2006, El Corte Ingles, S.A. (the Applicant) filed an application to register the trade-mark EMIDIO TUCCI (the Mark) based upon proposed use of the Mark in Canada in association with the following wares: “precious metals and their alloys sold in bulk; precious gemstones; jewellery; costume jewellery; watches; chronometers” (the Wares). The application includes a disclaimer of the right to the exclusive use of the word TUCCI apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 6, 2007.

[3] On October 31, 2007, Emilio Pucci International BV (the Opponent) filed a statement of opposition claiming that the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a), (b) and (c) of the Act, in view of the fact that the Mark is confusing with the Opponent’s trade-mark EMILIO PUCCI (that is registered under Nos. TMA171,229 and TMA663,889 or for which an application for registration bearing Serial No. 315,425(01) had been filed by the Opponent prior to the date of filing of the Applicant’s application) and trade-names EMILIO PUCCI and EMILIO PUCCI INTERNATIONAL B.V., which have been used by the Opponent in Canada prior to the date of filing of the Applicant’s application. The

statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(a) of the Act and that the application does not conform to the requirements of s. 30 of the Act.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Pietro Pasotti, Legal Director of Emilio Pucci S.R.L., the exclusive and worldwide licensee of the Opponent, sworn September 1, 2008, and an English translation thereof filed through the affidavit of Francesca Bonciani, in her capacity of translator for Italian and English, employed by Società Italiana Brevetti S.p.A, sworn September 3, 2008. The Opponent also filed certified copies of registration Nos. TMA171,229 and TMA663,889. In support of its application, the Applicant filed the affidavit of Juan Carlos Areces Garcia, an attorney and legal representative of the Applicant, sworn April 23, 2009 and an English translation thereof filed through the affidavit of Catalina Mora Estevan, a sworn translator for Spanish and English appointed by the Spanish Ministry of Foreign Affairs, sworn May 14, 2009. The Applicant also filed the affidavit of Lynda Palmer, a trade-mark searcher and owner of Lynda Palmer Trade Mark Searching, a company that conducts searches of records of the Canadian Intellectual Property Office (CIPO), sworn March 26, 2009.

[6] Only the Applicant filed a written argument. Both parties attended at an oral hearing.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the parties' evidence

The Opponent's evidence - the Pasotti affidavit

[8] The affidavit of Pietro Pasotti is in the Italian language. As indicated above, the Opponent has provided through the affidavit of Francesca Bonciani, a certified English language translation of the Italian language contents of Mr. Pasotti's affidavit [see Exhibit 1 to Ms. Bonciani's affidavit]. For the ease of reference, these two affidavits will be collectively referred to as the Pasotti affidavit.

[9] Mr. Pasotti goes over the history of the EMILIO PUCCI trade-mark. He states that "the trade-mark EMILIO PUCCI has been created in 1947 by the renowned Italian designer Marchese Emilio Pucci Di Barsento, also known as Emilio Pucci. Born in 1914, Emilio Pucci created his first wearing apparels, namely ski uniforms, in 1935. Emilio Pucci opened his first boutique in Capri in 1949 and designed his famous 'Capri pants'. In 1950, he launched his first couture collection" [paragraphs 4 and 5 of his affidavit].

[10] Mr. Pasotti states that "[b]etween 1950 and up to his death in 1992, Emilio Pucci has created collections which became increasingly popular and well-known throughout the world, not to mention the numerous prizes he received for his creations, among which the Neiman-Marcus Fashion Award in 1954 and 1967" [paragraph 6 of his affidavit].

[11] Mr. Pasotti states that "[a]fter his passing in 1992, his daughter Laudomia Pucci took over and pursued the development of the EMILIO PUCCI trade-mark throughout the world. In the last several years, renowned designers like Julio Espada, Christian Lacroix and more recently Matthew Williamson have created different clothing items and fashion accessories under the trade-mark EMILIO PUCCI" [paragraph 7 of his affidavit].

[12] Mr. Pasotti then provides as Exhibit A the details of the EMILIO PUCCI trade-mark registrations and application secured by the Opponent with CIPO [paragraph 8 of his affidavit]. I

am attaching as Schedule A to my decision a table outlining the particulars of these registrations and application.

[13] As indicated in Schedule A, application Serial No. 315,425(01) alleged in support of the s. 16(3)(a) ground of opposition, was filed on March 15, 2005 to extend the statement of wares of registration No. TMA171,229 and matured to registration on September 24, 2008. I further note that Registration No. TMA269,056 referred to by Mr. Pasotti has not been alleged by the Opponent in its statement of opposition. Unless indicated otherwise, I will refer to the trade-marks covered by the three registrations outlined in Schedule A as the EMILIO PUCCI Marks so as to use the same terminology as the one used by Mr. Pasotti in his affidavit. I will make the necessary distinctions when needed.

[14] Mr. Pasotti states that “[t]he Opponent, or its predecessors in title, directly or through its licensees, has been using the EMILIO PUCCI Marks in Canada for a few decades in association with, among other products, wearing apparel for women, bags and fashion accessories. In addition and more recently, the Opponent, directly or through its licensees, has been using the EMILIO PUCCI Marks in Canada in association with, non-exhaustively, perfumes, all kinds of bags and eyeglasses” [paragraph 9 of his affidavit].

[15] Mr. Pasotti states that “[t]he Opponent, or its predecessors in title, has also been using the trade names EMILIO PUCCI and EMILIO PUCCI INTERNATIONAL [the EMILIO PUCCI Names] in Canada for the commercialization of the Opponent’s products” [paragraph 10 of his affidavit].

[16] Mr. Pasotti states that “Emilio Pucci S.R.L. is duly licensed to use the EMILIO PUCCI Marks and Names in Canada” and he attaches as Exhibit A, a copy of the relevant extracts from the license agreement between the Opponent and Emilio Pucci S.R.L. [paragraph 11 of his affidavit]. I will revert to this point later on in my decision when assessing the extent to which the parties’ marks have become known in Canada under the s. 12(1)(d) ground of opposition.

[17] Mr. Pasotti then provides the Opponent’s turnovers for products distributed in Canada

under the EMILIO PUCCI Marks for the years 1999 to 2008, the total of which amounts to 841 738,50 euros (that is over 1 million dollars) [paragraph 12 of his affidavit]. However, he does not provide a breakdown of annual sales for each of the Opponent's products.

[18] Mr. Pasotti also provides as Exhibit B samples of labels displaying the EMILIO PUCCI Marks that are sewed on the wearing apparels (identified as "beach wear", "ready to wear" and "hats, ties, scarves") and small leather goods, as they are offered for sale in Canada [paragraph 13 of his affidavit]. As pointed out by the Applicant, the copies of sample labels provided do not indicate that the EMILIO PUCCI Marks are used under license, or that the Opponent is the owner of the EMILIO PUCCI Marks. I will revert to this point later on in my decision when assessing the extent to which the parties' marks have become known in Canada under the s. 12(1)(d) ground of opposition.

[19] Mr. Pasotti states that the products sold under the EMILIO PUCCI Marks in Canada can be found in various stores including Holt Renfrew, Ogilvy and Winners and he provides as Exhibit C extracts from the websites of the Holt Renfrew and Ogilvy stores announcing some of the EMILIO PUCCI products. He also attaches as Exhibit D copies of invoices issued by Emilio Pucci S.R.L. for the sale of products under the EMILIO PUCCI Marks in Canada between 2002 and 2008 and he confirms that the products enumerated on those invoices relate to products commercialized in Canada under the EMILIO PUCCI Marks [paragraphs 14 and 15 of his affidavit]. While these website printouts do refer to EMILIO PUCCI wearing apparel for women and fashion accessories, only one product, shoes, is shown associated with the EMILIO PUCCI Marks. As pointed out by the Applicant, shoes are not one of the wares claimed in association with any of the EMILIO PUCCI Marks listed in Schedule A. However, the samples of invoices attached as Exhibit E do pertain to various wearing apparel (such as ladies hats, visors, caps, bandanas, scarves, dresses, shirts, t-shirts, trousers, Capri pants, skirts, pullovers, jackets, bikinis, swimsuits, etc.) and small leather goods (such as wallets, tote bags, hand bags, shoulder bags, beach bags, camera bags and cosmetic cases made of calf trim leather).

[20] Mr. Pasotti states that "[t]he Opponent regularly and continuously advertises and promotes the Opponent's products commercialized under the EMILIO PUCCI Marks through

catalogues, brochures, flyers and magazines put into circulation in Canada” and he attaches as Exhibit E random copies of brochures for the years 2005 to 2008. The EMILIO PUCCI collections described in the brochures include various women’s wearing apparel, boots, shoes and sandals, scarves, gloves, wearing belts, beach towels and different kinds of bags. However, the Opponent is not identified anywhere in the brochures. The brochures simply refer to “EMILIO PUCCI” or the website *www.emiliopucci.com*.

[21] Mr. Pasotti states that “more recently, namely in 2007, the Opponent, in collaboration with Guerlain, launched in many countries around the world, including Canada, a limited edition of cosmetic products commercialized under the name GUERLAIN BY EMILIO PUCCI.” He attaches as Exhibit F a copy of a press kit as well as a media coverage report regarding the advertising of said cosmetic products in Canada [paragraph 17 of his affidavit]. I note that the publication includes photographs of the cosmetic products displaying the phrase “GUERLAIN by EMILIO PUCCI” marked on the products. As pointed out by the Applicant, the last page of the publication suggests that it was distributed by “Guerlain Paris”. The Opponent is not identified anywhere in the publication. The publication simply refers to “Emilio Pucci” as “*la marque de mode Florentine*” or “*icône intemporelle de la mode*”. I will revert to this point below when assessing the nature of the parties’ wares and trade under the s. 12(1)(d) ground of opposition.

[22] Mr. Pasotti then provides as Exhibit G printouts extracted from the Opponent’s website *www.emiliopucci.com* where its different collections are advertised under the EMILIO PUCCI Marks [paragraph 18 of his affidavit]. As pointed out by the Applicant, no connection to Canada is apparent from Exhibit G. There is no evidence that Canadians have accessed the Opponent’s website. Furthermore, while Mr. Pasotti states that this website is operated by the Opponent, the printouts do not identify the Opponent or any other legal entity.

[23] Mr. Pasotti concludes his affidavit by providing his opinion as to the likelihood of confusion between the Mark and the EMILIO PUCCI Marks [paragraph 19 of his affidavit]. I am not prepared to accord weight to this latter statement of Mr. Pasotti, which constitutes inadmissible opinion evidence.

The Applicant's evidence

The Garcia affidavit

[24] The affidavit of Juan Carlos Areces Garcia is in the Spanish language. As indicated above, the Applicant has provided through the affidavit of Catalina Mora Estevan, a certified English language translation of the Spanish language contents of Mr. Garcia's affidavit [see Exhibit 3 to Ms. Estevan's affidavit]. For the ease of reference, these two affidavits will be collectively referred to as the Garcia affidavit.

[25] Mr. Garcia states that the Applicant "operates the largest chain of department stores in Spain. [It] provides a wide range of wares and retail services at its various locations. The wares provided by [the Applicant] at its department stores include watches. The wares that [the Applicant] intends to provide at its department stores include precious metals and their alloys sold in bulk, precious gemstones, jewellery, costume jewellery and chronometers" [paragraph 4 of his affidavit].

[26] Mr. Garcia states that the Applicant "operates stores in most of the main cities in Spain and also operates in Portugal. [The Applicant] has been featured in the publication *Leading Brands of Spain* as Spain's best-known department store and as a 'must-see' place for the 60 million tourists who visit Spain each year." Mr. Garcia attaches as Exhibit B a copy of several pages from that publication which includes text in Spanish and English [paragraph 6 of his affidavit]. The last page of Exhibit B highlights the wares and brands sold by the Applicant at its department stores, including wares sold by the Applicant in association with the Mark.

[27] Mr. Garcia states that "[d]uring [his] years of employment with [the Applicant], [he] ha[s] become knowledgeable about retail marketing, including the display of retail items. In [his] experience, wares such as the Applicant's Wares are frequently available to the public in specialized retail stores or through other channels such as specialized websites from which wares such as [...] the "Opponent's Wares" [covered by the Opponent's registration Nos. TMA171,229

and TMA663,889] are not available. Alternatively, in [his] experience, when wares such as the Applicant's Wares and wares such as the Opponent's Wares are available in the same retail stores (such as department stores) or through other channels, they are displayed in different locations within the stores or separately from one another (for example on different pages of a website)" [paragraph 5 of his affidavit].

[28] Mr. Garcia states that "the [Mark] originated with a well-known Italian tailor, Mr. Emidio Tucci, who was born on October 31, 1920. 'Emidio' was the name of a Saint from Ascoli, Italy. The name 'Emidio' is known in Italy but is not a common name outside of Italy" [paragraph 7 of his affidavit].

[29] Mr. Garcia states that "[a]s a tailor, Mr. Emidio Tucci opened his first tailor shop, named EMIDIO TUCCI, in Milan, Italy in 1949. In 1959, Mr. Emidio Tucci joined the SCIC Group in Cremona, Italy as a designer. From 1964 to 1969, Mr. Emidio Tucci was part of the team of designers of D'avenza-Chester Barrie de Avenza in Italy" [paragraph 8 of his affidavit].

[30] Mr. Garcia states that "[f]rom 1949 to 1964, Mr. Emidio Tucci also worked as a design teacher at *Snob di Torino-Accademia Profesional di Taglio* and at *Sartotecnica di Milano*. As a result of his academic and professional achievements in men's fashion, Mr. Emidio Tucci was awarded the "Cavaliere al Lavoro Della Republica Italiana" (Knight of the Country for his working merits) in June, 1971" [paragraph 9 of his affidavit].

[31] Mr. Garcia states that "[i]n 1974, Mr. Emidio Tucci joined the fashion tailoring team of Industrias y Confecciones, S.A. of Spain. Industrias y Confecciones, S.A adopted the [Mark] to promote the wares of Mr. Emidio Tucci" [paragraph 10 of his affidavit].

[32] Mr. Garcia states that "[t]he [Mark] was first used in Spain in association with men's suits in 1977. The [Mark] has been used by [the Applicant] or its predecessor since 1977. The Mark has been used in association with watches since at least as early as 1999" [paragraph 11 of his affidavit].

[33] Mr. Garcia states that Industrias y Confecciones, S.A. assigned the Mark to the Applicant on June 10, 1997 and he attaches as Exhibit C a copy of an assignment document to this effect [paragraph 12 of his affidavit].

[34] Mr. Garcia concludes his affidavit by attaching bundles of documents comprised of certified copies of registrations demonstrating that the Applicant has registered the Mark for use in association with wares in International Class 14 of the *Nice Classification of Goods and Services* in numerous jurisdictions in the world [Exhibit D] and owns International Registration No. 910209 covering also various countries [Exhibit E]. Mr. Garcia further states that he is aware that the Opponent has applied for or registered the trade-mark EMILIO PUCCI in some of these countries [Exhibit F]. The Opponent also registered the EMILIO PUCCI trade-mark as a Community trade-mark [Exhibit H] and under International Registration Nos. 947383 and 317878 [Exhibit I] [paragraphs 13 and 14 of his affidavit]. Although I appreciate the reasons for these statements of Mr. Garcia, it is to be reminded that the Registrar is not bound by the findings made by other jurisdictions because although a mark can be registrable in another country, it may not be registrable in Canada having regard to the applicable legislation and circumstances of the case. I will revert to this point when assessing the additional surrounding circumstances under the s. 12(1)(d) ground of opposition.

The Palmer affidavit

[35] Ms. Palmer introduces into evidence the results of searches she conducted on March 24, 2009 of CIPO's records to locate all active trade-mark applications and registered trade-marks incorporating the terms and wildcard characters "EM*IO" or "*UCCI" with wares or services in International Classes 3, 14, 18, 24 or 25 of the *Nice Classification of Goods and Services* and she attaches as Exhibits B and C the results of her searches.

[36] Ms. Palmer further attaches as Exhibit D copies of printouts from various website pages that she accessed. She states that she found each of the websites from which she obtained the printouts by conducting Internet searches from the website located at *www.google.ca* for the various trade-marks in Exhibits B and C. I will revert to this point when assessing the additional

surrounding circumstances under the s. 12(1)(d) ground of opposition.

Analysis of the grounds of opposition

[37] As I consider the s. 12(1)(d) ground of opposition to present the Opponent's strongest case, I will assess that ground first.

Section 12(1)(d) ground of opposition

[38] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark EMILIO PUCCI registered under Nos. TMA171,229 and TMA663,889 (hereinafter collectively referred to as the EMILIO PUCCI word mark).

[39] I have exercised the Registrar's discretion to review the register of trade-marks and confirm the details of these two registrations. As they are extant, the Opponent's evidentiary burden has been satisfied.

[40] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's EMILIO PUCCI word mark. The material date to assess this issue is the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[41] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[42] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness

of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) (*Veuve Clicquot*) for a thorough discussion of the general principles that govern the test for confusion].

(a) The inherent distinctiveness of the trade-marks and the extent to which they have become known

[43] As evidenced by the Pasotti and Garcia affidavits, the parties' marks both originate from Italian fashion designers. They both consist of the personal names of their respective designers. The Pasotti affidavit is to the effect that Mr. Emilio Pucci passed away in 1992. There is no indication that Mr. Emidio Tucci is still living today or that he would have passed away; this point has not been addressed in the Garcia affidavit nor questioned by the Opponent.

[44] It is fair to say that both marks would be perceived by the average consumer as the name of an individual. That being so, and relying on authority to the effect that trade-marks dependant on personal and surname significance have little inherent distinctiveness, I consider the parties' marks to be inherently weak. I wish to reproduce on this point the following passage from Joliffe and Gill, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed., Carswell, at p. 8-27:

Marks that have no inherent distinctiveness deserve the smallest ambit of protection. As such, geographic locations, personal and surnames, initials, descriptive terms, common prefixes, common symbols and even registered marks that have become generic are not inherently distinctive and should generally not be accorded a broad ambit of protection.

[45] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is no evidence that the Applicant's proposed use Mark has been used in

Canada or that it has become known to any extent whatsoever in Canada. The mere fact that the Applicant has been featured in the publication *Leading Brands of Spain* as Spain's best-known chain of department stores and a "must-see" place for tourists does not lead to an inference that the wares and brands sold by the Applicant within its department stores, including the wares sold by the Applicant in association with the Mark, have become known to Canadians. Furthermore, while the Garcia affidavit is to the effect that Mr. Emidio Tucci is a well-known Italian designer, the extent of his fame, particularly in Canada, has not been shown. Accordingly, I must conclude that the Mark has not become known at all in Canada.

[46] Turning to the Opponent's evidence of use of the EMILIO PUCCI word mark in Canada, I wish to address first the Applicant's argument that the evidence of record falls short of establishing that such use accrues to the benefit of the Opponent pursuant to s. 50 of the Act.

[47] I agree with the Applicant's contention that the Opponent cannot claim the benefit of s. 50(2) of the Act as none of the exhibits attached to the Pasotti affidavit gives public notice of the fact that the use of the EMILIO PUCCI Marks is a licensed use and of the identity of the owner of the marks. However, in view of the exclusive and worldwide license agreement entered into between the Opponent and Emilio Pucci S.R.L., I disagree with the Applicant's contention that the Opponent cannot claim the benefit of s. 50(1) of the Act. The license agreement attached as Exhibit B to the Pasotti affidavit includes at s. 5 a provision entitled "Quality Control" that expressly provides that the Opponent has control of the character and quality of the wares designed, manufactured, marketed, distributed and sold by Emilio Pucci S.R.L. and any of its sublicensees. The license agreement also provides at s. 2 that all uses of the EMILIO PUCCI Marks by Emilio Pucci S.R.L. shall inure to the benefit of the Opponent as licensor and that licensee agrees not to misuse or alter the EMILIO PUCCI Marks in any manner whatsoever. I can find no basis on which to conclude that the quality control provisions set out in the license agreement are not being implemented by the Opponent. There is no evidence establishing that the Opponent did not exercise, either directly or indirectly, control over the character or quality of the wares. Furthermore, Mr. Pasotti's affidavit testimony has not been challenged by cross-examination.

[48] That said, I am satisfied from a fair reading of the Pasotti affidavit and accompanying exhibits that the EMILIO PUCCI word mark has been used in Canada for a considerable length of time. While no breakdown of annual sales for each of the Opponent's products is provided by Mr. Pasotti, the specimens of invoices attached as Exhibit D to his affidavit do illustrate the various types of wearing apparel and small leather goods sold in Canada under the EMILIO PUCCI word mark. As the sales figures provided by Mr. Pasotti show average annual sales in excess of 100,000 dollars, it is fair to conclude that the EMILIO PUCCI word mark has become known in Canada to some extent at least.

(b) The length of time the trade-marks have been in use

[49] As indicated above, there is no evidence that the Applicant's proposed Mark has been used in Canada. By comparison, while the Opponent's evidence does not establish continuous use of the EMILIO PUCCI word mark with each of the wares described in the Opponent's registrations since the very first dates of use claimed therein, it does evidence use of the EMILIO PUCCI word mark in association with various wearing apparel and small leather goods over the last decade at least.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[50] When considering the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[51] The Applicant submits that there is no evidence that the Opponent has used the EMILIO PUCCI Marks in association with any of the Applicant's Wares. Further, none of the Wares are listed in any of the EMILIO PUCCI trade-mark registrations listed in Schedule A. The Applicant also submits that there is no evidence that the EMILIO PUCCI Marks are so distinctive that a consumer would assume that the Opponent is expanding the line of wares for which it allegedly uses the EMILIO PUCCI Marks.

[52] As to the parties' channels of trade, the Applicant submits that the Applicant's unchallenged evidence is that the Wares are frequently available to the public in specialized retail stores or through other channels such as specialized websites from which wares such as women's apparel, bags and accessories and umbrellas are not available. Alternatively, where the Wares and the women's apparel, bags and accessories and umbrellas are available in the same stores or through other channels, they are displayed in different locations within those stores or separately from one another.

[53] In support of the above submissions, the Applicant relies on the decision of this Board in *Sasson Licensing Corp. v. Swarovski AG*, 1999 CarswellNat 3474 (*Sasson*) at paragraphs 9 and 12, where it was found that the applicant's jewellery differed from the wearing apparel, cosmetics and perfumery products covered by the opponent's registrations and that in the absence of any evidence to the contrary, the nature of the trade associated with these wares also differed.

[54] The Opponent, relying on the decisions of this Board in *Charles of the Ritz Group Ltd. v. The Ritz Hotel Ltd.* (1985), 6 C.P.R. (3d) 483 at 486 and 487 and *Oscar de la Renta Ltd. v. Arto Inc.* (1986), 14 C.P.R. (3d) 37 at 40, submits for its part that there is a close relationship between the Applicant's Wares and the Opponent's wares, which are all part of the fashion industry. The Opponent notes that some of the invoices attached as Exhibit D to the Pasotti affidavit evidence the sale of EMILIO PUCCI woman dresses with "mother of pearl buttons attached to the garment".

[55] The Opponent further submits that neither of the parties' statements of wares is restricted

to particular channels of trade. The nature of the parties' trades is the same or very similar. The Opponent, relying on the decisions *Valint N.V. v Mario Valentino S.p.A.* (1999), 4 C.P.R. (4th) 1 (F.C.T.D.) at paragraphs 42 to 44 and *Bluedot Jeanswear Co. v. 9013-0501 Québec Inc.* (2004), 31 C.P.R. (4th) 361 (F.C.) at paragraph 19, submits that it makes no difference that the Opponent's wares are offered for sale in high end niches, as they can also be sold in large scale department stores, as evidenced by the invoices attached as Exhibit D to the Pasotti affidavit showing sales of the EMILIO PUCCI various wearing apparel and small leather goods to Winners stores.

[56] It is not necessary that the parties operate in the same general field or industry or that the respective wares be of the same type or quality for there to be a likelihood of confusion. As stated in s. 6(2) of the Act, confusion may occur "whether or not the wares or services are of the same general class". The Opponent's submission that the Applicant's Wares are all part of the fashion industry must be qualified in view of the decision in *S.C. Johnson & Son, Inc. v. Esprit de Corp et al* (1986), 13 C.P.R. (3d) 235 (F.C.T.D.) (*Esprit*), which allowed the appeal made by the applicant (appellant) against the Registrar's decision who had held that the applicant's proposed trade-mark ESPRIT for personal care products was not registrable because it was confusing with each of the opponent's (respondent's) trade-marks ESPRIT and ESPRIT DE CORP previously used and registered in relation to clothing. I wish to reproduce on this point the following comments of Mr. Justice Cullen, whose reproduction, though lengthy, is necessary to fully appreciate the principles that have guided me in the present case:

[p. 245] It is conceded by the applicant that clothing and cosmetics are closely associated in the top echelon or high fashion level where the same designer trade marks are used on wares from both industries. This type of trade mark used in both industries is a "designer" or "signature" mark containing the personal name of a well-known clothing designer. Most Canadian consumers are familiar with the names Pierre Cardin, Yves Saint Laurent, Givenchy, Ralph Lauren, to name but a few.

The appellant states: "these 'designer' or 'signature' marks are not only applied to fragrances and cosmetic products, but to all kinds of clothing accessories such as jewellery, shoes, belts, furs and to other wares such as chocolates, car interiors, wallpaper and household furnishings and accessories". I agree. It seems to me obvious that any person or corporation seeking a trade mark on any ware of any class using one of these "designer" or "signature" marks could not expect to succeed. I believe counsel for the applicant

suggested they might event be charged with fraud, so distinctive is the “signature” or “designer” mark.

Similarly, any attempt to secure a trade mark for any wares using a strong trade mark like KODAK would be bound to fail [...].

[p. 248] In my view, the registrar erred when he felt he could take "judicial notice" of the alleged fact that cosmetics and clothing are both part of what he called the fashion industry, and then did not define fashion industry. The unquestioned expert Marina Sturdza states in her affidavits:

The clothing industry and cosmetic industry (which I define here to include fragrance, cosmetic, treatment, bath and hair care products) are not closely associated. The goods of the two industries are almost invariably produced by different non-related manufacturers and are wholesaled and marketed by different representatives using totally different sales and promotional tactics. Moreover the goods of each industry are generally retained in different stores, or in the case of department and specialty stores, at least in different departments or different locations in the same store. In addition the products

[p. 249] of the two industries fall under separate merchandising categories and are almost invariably purchased by different merchandise managers, purchasing agents or store buyers.

She elaborates on the use of "designer" or "signature" trade marks which are used in both clothing and cosmetics, and explains that the marks constitute the personal names of well-known clothing designers and have an inherently distinctive nature embodying the personal reputation of the designers. [...]

I cannot find that the respondent with its use of the trade mark ESPRIT DE CORP is inherently distinctive. As Ms. Sturdza states, "The Esprit line is not a fashion leader, nor do its designs have any directional influence on the clothing industry." and "Non-designer trade marks of the nature of the respondent's ESPRIT DE CORP are generally not used to identify high fashion clothing goods because they do not possess the type of personal goodwill, reputation or cachet that individual designers create for their fashion products" and which make their personal names transportable to all nature of fashion items.

[57] In view of Mr. Justice Cullen’s comments above, the fact that the Applicant’s Wares are not listed specifically in the Opponent’s EMILIO PUCCI word mark registrations is not by itself determinative. An argument can be made that such wares may to some extent be considered as “clothing” or “fashion” accessories. Jewellery, costume jewellery and watches in particular are decorative items that supplement and complement clothes. A further argument can be made that the statements of wares covered by the Applicant’s application and the Opponent’s EMILIO PUCCI word mark registrations are both illustrative of the variety of wares in association with

which trade-marks consisting of the personal names of fashion designers are transportable, as evidenced by Exhibit F to the Pasotti affidavit pertaining to the launching of a limited edition of cosmetic products under the name “GUERLAIN BY EMILIO PUCCI”. While such exhibit does not evidence use of the EMILIO PUCCI Marks *per se* accruing to the benefit of the Opponent, it does illustrate Mr. Justice Cullen’s comments above concerning the practice of applying a particular fashion designer’s name to a wide variety of wares, such as cosmetic products. The certified copy of the Opponent’s registration No. TMA269,056 based upon use of the EMILIO PUCCI Design mark in Canada in association with perfumes, combined with Mr. Pasotti’s sworn statement of use of the EMILIO PUCCI Marks in Canada in association with perfumes further tend to evidence such practice. As such, I find it is fair to say that the type of wares covered by the Applicant’s application could be considered a natural extension of the Opponent’s various wearing apparel and small leather goods offered for sale in Canada. I wish to add that the facts of the present case differ from the ones in the *Sasson* case, if not only because the marks under review in that case did not consist of the personal names of fashion designers.

(e) The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[58] The Applicant submits that the EMILIO PUCCI word mark is a weak mark which can be distinguished from the Mark by a consumer having an imperfect recollection. More particularly, the EMILIO PUCCI word mark has small but obvious differences from the Mark EMIDIO TUCCI: the “D” replaces the “L” in “EMILIO” and the “T” replaces “P” in “PUCCI”. Given the lack of distinctiveness of the EMILIO PUCCI word mark, the Applicant submits that these small differences distinguish the trade-marks, especially for a consumer who is accustomed to distinguishing similar marks in association with similar wares.

[59] The Opponent submits for its part that the parties’ marks are strikingly similar. They look the same to the eye. They sound the same. They have a similar connotation in that both are Italian-sounding personal names.

[60] As indicated above, it is well-established by the jurisprudence that the likelihood of confusion is a matter of first impression and imperfect recollection. This principle has been reiterated by the Supreme Court in *Veuve Clicquot* as follows:

20 The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name *Clicquot* on the respondents' storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks. As stated by Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* (1968), [1969] S.C.R. 192 (S.C.C.), at p. 202:

It is no doubt true that if one examines both marks carefully, he will readily distinguish them. However, this is not the basis on which one should decide whether there is any likelihood of confusion.

...the marks will not normally be seen side by side and [the Court must] guard against the danger that a person seeing the new mark may think that it is the same as one he has seen before, or even that it is a new or associated mark of the proprietor of the former mark. (Citing in part *Halsbury's Laws of England*, 3rd ed., vol. 38, para. 989, at p. 590.)

[61] Applying these principles to the present case, I agree with the Opponent that there is a high degree of resemblance between the parties' marks in appearance, sound and in the ideas suggested by the marks. They share strong similarities in that they are identical except for two letters (i.e. EMILIO PUCCI v. EMIDIO TUCCI). They share the same structure in that they both consist of a four-syllable word followed by a two syllable word and have the same number of letters. They have a similar connotation in that they are Italian-sounding personal names. While it is true that the marks are not identical and can be distinguished when carefully examined side by side, the test to be applied is that of the first impression in the mind of a potential consumer somewhat in a hurry who sees the Mark on the Applicant's Wares, at a time when he or she has no more than an imperfect recollection of the EMILIO P UCCI word mark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Additional surrounding circumstances

State of the register evidence

[62] The Applicant submits that evidence of the state of CIPO trade-marks register combined with evidence of use in the Canadian marketplace can suggest that consumers are accustomed to making fine distinctions between various trade-marks by paying more attention to the small differences between the marks.

[63] More particularly, the Applicant submits that the Palmer affidavit evidences that there are at least 12 trade-marks that have been registered by other parties at various times over the last 20 years and are still active today that start with “EM” and end with “IO” or “UCCI”, namely ROBERTO CAPPUCCI (TMA306,020); MARIO PUCCI CECCIONI Design (TMA300,841); CARLO COLUCCI Design (TMA327,849); RENATO NUCCI & Design (TMA375,089); SESTO MEUCCI (TMA395,763); EMILIO ROBBA Design (TMA432,136); SIGNOR PASCUCCI (TMA457,525); MARISA MINICUCCI Design (TMA448,061); BACCO BUCCI (TMA612,237); CARLO COLLUCI (TMA617,842); EMILIO CAVALLINI (TMA629,380) and CARLO COLLUCI (TMA654,274).

[64] The Applicant further submits that Exhibit C to the Palmer affidavit evidences that each of the above third party trade-marks are used in the marketplace given that they are shown in association with websites of stores having Canadian retail locations.

[65] The Opponent submits for its part that the above state of the register evidence and alleged state of the marketplace evidence is of little assistance to the Applicant’s case given that none of these third party trade-marks is as close to the Opponent’s EMILIO PUCCI word mark as is the Applicant’s Mark. I agree. Thus, even if I were to acknowledge that Canadians are accustomed to seeing Italian-sounding personal names used as trade-marks, it does not necessarily follow that they are accustomed to making fine distinctions between very close trade-marks.

Coexistence of the parties' marks

[66] As per my review of the Garcia affidavit, the Applicant submits that the parties' marks coexist on trade-marks registers in various jurisdictions in the world. However, as stressed by the Opponent, the fact that the marks may coexist on foreign trade-marks registers is not binding upon the Registrar. It is worth referring to the following observation from this Board in *Quantum Instruments Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264 (*Quantum*):

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted ... in *Re Haw Par...*, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions ... the Registrar must base [the] decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* ... [the court] pointed out that 'no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure.' Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding. [my emphasis]

[67] As in the *Quantum* case, no evidence has been adduced of the coexistence of the trade-marks at issue in the marketplace, be it in Canada or in any other country.

[68] Furthermore, as noted by the Opponent at the oral hearing, if I were to give consideration to the fact that the parties' marks coexist on the trade-marks registers listed in the Garcia affidavit, I should give the same consideration to the fact that the Opponent has successfully opposed the Applicant's applications for registration of two stylised versions of the Mark before the United States Patent & Trademark Office (USPTO), as per copy of the decision dated April 1, 2010 issued by the USPTO in opposition Nos. 91169638 and 91177724 that was submitted as part of the Opponent's list of authorities in the present case. For the reasons outlined above in the *Quantum* case, it is unnecessary to comment further on this latter decision of the USPTO as well as the coexistence of the parties' marks on foreign trade-marks registers.

Conclusion regarding the likelihood of confusion

[69] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a legal onus 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.

[70] As per my comments above, the parties' marks are inherently weak and not entitled to a broad ambit of protection. However, transposing Mr. Justice Cullen's comments in the *Esprit* decision to the present case, I believe it is fair to say that the parties' marks, which both consist of the personal names of fashion designers, are associated with closely associated wares in the high fashion level that are likely to travel through the same or similar channels of trade.

[71] While the Opponent has not evidenced use of the EMILIO PUCCI word mark in association with any of the Applicant's Wares, I am of the view that the Opponent's evidence raises sufficient doubts as to the likelihood of confusion considering the fact that the parties' marks are strikingly similar, that the Opponent's mark has achieved at least some reputation in Canada, and that the type of wares covered by the Applicant's application could be considered a natural extension of the Opponent's various wearing apparel and small leather goods offered for sale in Canada. As such, I find that the Applicant has not met its legal onus to show that it is not reasonably likely that an individual who has an imperfect recollection of the Opponent's EMILIO PUCCI word mark as applied to the various wares covered by the Opponent's word mark registrations, would not, as a matter of first impression and imperfect recollection conclude that the Applicant's Wares share a common source.

[72] Accordingly, the s. 12(1)(d) ground of opposition succeeds.

Section 12(1)(a) ground of opposition

[73] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(a) of the Act in that it is primarily merely the name or the surname of an individual

who is living or has died within the preceding thirty years. The material date to assess this issue is the filing date of the Applicant's application [see *Calvin Klein Trade-mark Trust v. Wertex Hosiery Inc.* (2004), 41 C.P.R. (4th) 552 (T.M.O.B.); and *Jurak Holdings Ltd. v. Matol Biotech Laboratories Ltd.* (2006), 50 C.P.R. (4th) 337 (T.M.O.B.)].

[74] As indicated above, there is no evidence in the record regarding whether Mr. Tucci is still living, or whether he has died, and if so, his date of death. Accordingly, the s. 12(1)(a) ground of opposition is dismissed on the basis that the Opponent has not met its initial burden. I wish to add that had the Opponent met its initial burden, such ground would have likely succeeded.

Section 30 grounds of opposition

[75] The Opponent has pleaded that the application does not comply with the requirements of s. 30 of the Act in that at the date of filing of the application, the Applicant allegedly had used the Mark in Canada in association with the Wares; that the Mark used by the Applicant is not the Mark; that the Applicant did not intend to use the Mark in association with the Wares; and that the Applicant allegedly could not have been satisfied that it was entitled to use the Mark in view of the Applicant's knowledge of the Opponent's rights. The material date that applies to all of these s. 30 grounds of opposition is the date the application was filed.

[76] All of these grounds are dismissed on the basis that the Opponent has not met its initial burden. Suffice it to say that the application formally complies with s. 30(e) and (i) as it contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada and that the Applicant is satisfied that it is entitled to use the Mark in Canada. Based on the evidence in the record, I am unable to conclude that the Applicant did not truly intend to use the Mark when it filed its application and that it could not be satisfied that it was entitled to use the Mark in Canada.

Remaining grounds of opposition


[77] As indicated above, the non-distinctiveness and non-entitlement grounds of opposition essentially turn on the issue of confusion between the Mark and the Opponent's EMILIO PUCCI word mark. The Opponent's evidentiary burden as well as the material dates with respect to these remaining grounds of opposition differ from the ones under the s. 12(1)(d) ground of opposition. As I consider the issue of the likelihood of confusion to be strongest with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, and as I have already found in favour of the Opponent under that ground, I will not address the remaining grounds of opposition.

Disposition

[78] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trade-mark	Reg. No & Reg. Date	Wares & Dates of first use
1) EMILIO PUCCI	TMA171,229 Sept. 18, 1970	<p>(1) Ladies' clothing, namely dresses [sic], skirts, shirts, shifts, chemises, shorts, pants, suits, coats, bathing suits; fur pieces, coats, jackets and stoles, evening capes, raincoats, hosiery, sweaters and scarves. (2) Eyeglasses, sunglasses, spectacles cases, cameras.</p> <p>The right to the exclusive use of the word PUCCI is disclaimed apart from the trade-mark on wares (2).</p> <p>Used in CANADA since at least as early as 1952 on wares (1). Declaration of use filed on August 28, 2008 with wares (2).</p> <p>Used in ITALY on wares (1). Registered in or for ITALY on September 22, 1966 under No. 181829 on wares (1).</p> <p>Registrability Recognized under Section 14 of the Trade-marks Act on wares (1).</p> <p>The wares (2) were added on September 24, 2008 following application Serial No. 315,425(01) filed on March 15, 2005 to extend the statement of wares of registration No. TMA171,229.</p>
<p>2)</p> 	TMA269,056 May 14, 1982	<p>(1) Perfumes. (2) Shoulder bags, handbags, travelling bags, suitcases, purses, wallets and umbrellas. (3) Wine. (4) Eyeglasses, frames and cases for eyeglasses.</p> <p>Used in CANADA since at least 1970 on wares (1). Used in CANADA since April 1975 on wares (2). Used in CANADA since August 1976 on wares (3). Declaration of Use filed March 12, 1982 on wares (4).</p> <p>Consent to the use of EMILIO PUCCI's signature is of record.</p> <p>The right to the exclusive use of the words EMILIO PUCCI is disclaimed apart from the trade-mark.</p>
3) EMILIO PUCCI	TMA663,889	<p>Leather and imitations of leather; travelling bags, travelling sets (leatherware), trunks and valises, garment bags for travel, vanity-cases (not fitted), rucksacks, shoulder bags, handbags, attaché-cases, briefcases, pouches, pocket wallets, purses, key-holders, card holders; umbrellas.</p> <p>Used since as early as December 31, 1980</p>