



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

Citation: 2013 TMOB 74
Date of Decision: 2013-04-22

**IN THE MATTER OF OPPOSITIONS by
Prada S.A. to application Nos. 1,350,400 and
1,350,402 for the trade-marks MIIYU and
MIIYU Design respectively in the name of La
Maison Simons Inc.**

[1] Prada S.A. (the Opponent) opposes registration of the trade-marks MIIYU and MIIYU Design (shown below) (sometimes collectively referred to as the Marks) that are respectively the object of application Nos. 1,350,400 and 1,350,402 by La Maison Simons Inc. (the Applicant):

The trade-mark 'miiyu' is displayed in a lowercase, rounded, sans-serif font. The letters are black and centered on the page.

[2] Each application was filed on June 06, 2007 and is based on proposed use of the trade-mark in Canada in association with, generally speaking, ladies' underwear and lounge wear. The detailed statement of wares covered by both applications is attached as Schedule "A".

[3] The Opponent alleges that the Marks are not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and not distinctive under section 2 of the Act, and that the Applicant is not the person entitled to registration of the Marks under section 16(3)(a) of the Act because each of the Marks is confusing with the Opponent's word and/or design marks MIU MIU (sometimes collectively referred to as the MIU MIU Trade-marks) that are the object of the registrations and application listed in the attached Schedule "B". The determinative issue

in these proceedings is whether each of the Marks is confusing with the Opponent's trade-mark MIU MIU covered by registration Nos. TMA529,861 and TMA529,796.

[4] For the reasons that follow, each of the Applicant's applications is refused.

The Record

[5] The statements of opposition were both filed by the Opponent on February 17, 2009. Each of them was denied by the Applicant by counter statement filed on April 15, 2009.

[6] As its evidence in chief in each file, the Opponent filed certified copies of the trade-mark registrations and application referred to above in Schedule "B", and the solemn declaration of Natalie Vogel, Senior Counsel to Prada USA Corp. (Prada USA), which is the North American distributor of the Opponent, dated May 11, 2010. The Opponent also filed as further evidence in each file the affidavit of Alan Booth, President of Alan Booth & Co. Trade Mark Research Ltd., sworn January 21, 2011.

[7] As its evidence in each file, the Applicant filed the affidavit of Isabelle Gagné, Director of Advertising of the Applicant, sworn August 26, 2010. The Applicant also filed as further evidence in each file the affidavit of Annabelle Topor, paralegal employed by the law firm representing the Applicant, sworn July 12, 2011. At the oral hearing, it became apparent that the Registrar had lost or misplaced the affidavit of Ms. Topor filed in file No. 1,350,400. It was agreed that the Applicant provide the Registrar with an extra copy of that affidavit after the oral hearing, which the Applicant did by fax on March 21, 2013.

[8] As the two affidavits or solemn declarations filed by each witness in these proceedings are essentially identical, I will use the singular form to refer to them.

[9] Ms. Vogel and Ms. Gagné were both cross-examined and the transcripts of their cross-examination and answers to undertakings form part of the record.

[10] Only the Opponent filed a written argument in each case. In its written argument, the Opponent withdrew the ground of opposition based on section 30 of the Act that was originally

pleaded in each of its statements of opposition. Both parties were represented by counsel at an oral hearing.

Preliminary issue – the admissibility of the Vogel declaration

[11] At the oral hearing, the Applicant submitted that the Vogel declaration should be rejected in its entirety on the basis that it constitutes inadmissible hearsay. In the alternative, the Applicant submitted that little weight, if any, should be given to it since there is so little in the declaration which is admissible or reliable. I disagree.

[12] The Vogel declaration was substituted in replacement of the declaration of Murielle Vincenti. Ms. Vincenti could not make herself available for cross-examination and as a result her declaration was returned to the Opponent and replaced by that of Ms. Vogel. In so doing, the Opponent had assured the Applicant that no new provisions would be added to Ms. Vogel's declaration except those related to her credentials.

[13] The Vogel declaration essentially purports to evidence use of the MIU MIU Trade-marks in Canada. Ms. Vogel states that she has been working as an associate with the Legal department of Prada USA since June 14, 2004 and in her current position as Senior Counsel since January 2008. Her declaration includes examples of advertising together with "look books" (that is a sampling of the merchandise featured in a fashion show), media plans and collection books (that is a bigger version of the look book), as well as specimens of labels, hangers, cardboard boxes, etc. displaying one or the other of the MIU MIU Trade-marks, and sales figures for the MIU MIU products in Canada for the years 2003 to 2007.

[14] As it came out during Ms. Vogel's cross-examination, all of the exhibits attached to her affidavit were either prepared by her counterpart at Prada S.A., Mr. Dieter Tame, or obtained by him from other persons within the Opponent's organization, and she reviewed the information contained in her declaration and the exhibits [Vogel transcript pp 32, 36, 38, 39, and 48]. Ms. Vogel also took the sales figures from her colleague Mr. Tame [Vogel transcript p 63]. The fact that Ms. Vogel's declaration mirrors Ms. Vincenti's prior declaration, and that Ms. Vogel has relied on her colleague Mr. Tame's research for getting the exhibits and part of the

information contained in her declaration does not discredit Ms. Vogel and render the entirety of her declaration inadmissible for the following reasons.

[15] First, as stressed by the Opponent in its written argument and at the oral hearing, Ms. Vogel explained during her cross-examination that Prada USA and the Opponent are affiliated companies and that all the work for Canadian wholesale clients is done by her company in the United States. The orders go through Prada USA and are shipped in Canada [Vogel transcript pp 9, 66, and 67]. As legal counsel for Prada USA for more than six years, Ms. Vogel is responsible for providing legal advice to Prada USA on a variety of subject matters, one aspect being intellectual property [Vogel transcript pp 11 and 12]. As clearly stated in her declaration, Ms. Vogel is well aware of the Opponent's operations in Canada and elsewhere, and more particularly she is informed as to the products sold and services rendered and activities led by the Opponent in connection with the MIU MIU Trade-marks [Vogel declaration para 4].

[16] Second, when commenting on the specimens of labels and cardboard boxes filed as Exhibit NV-19, Ms. Vogel did indicate that she knows what the shoebox looks like typically and knows the inside of the ready-to-wear garments because she explains "we're very strict with that. [...] that's how they're packaged, that's how all the merchandise is sold" [Vogel transcript pp 71, 72, 73, and 76]. She further explained that despite the fact that she does not know specifically who photocopied the look books attached to her declaration, she knows that the Opponent keeps a history of the look books published over the years [Vogel transcript pp 26-30]. Likewise, despite the fact that she does not know specifically in which fashion magazine (that is *Vogue* or *Elle* or *Bazaar* or *Vanity Fair*, etc.) some of the copies of the advertisings reproduced in Exhibit NV-17 were published, she remembers having seen at least some of these ads personally, just from her leisurely readings [Vogel transcript pp 49, 50, 55, 56, and 57].

[17] Third, Ms. Vogel made internal verification with her company's Finance department, Planning department, Sales Department, and Advertising department before signing her declaration [Vogel transcript pp 60, 61, 64, 65, and 70]. More particularly, she asked Chris Wile of the Advertising department, what the advertising in Canada was [Vogel transcript pp 60 and 61]. She also asked an individual named Diem in the Planning Department which of the Canadian wholesale clients listed in paragraph 36 of her declaration matched the information that

was provided to her [Vogel transcript p 65]. She further spoke with Giuseppe Scarpa of the Sales department [Vogel transcript p 70]. Ms. Vogel also explained that she had no reason to question the reliability of the sales figures provided by her counterpart, Mr. Tame. Mr. Tame works at the head office of the Opponent where every single one of the subsidiaries' information is gathered so he has access to every subsidiary's records [Vogel transcript p 47]. Ms. Vogel indicated during her cross-examination that she believes the figures were accurate based on her knowledge of the brand and the interaction that she had with the Finance department and that she had no reason to doubt the information [Vogel transcript pp 63 and 64].

[18] Lastly, relying on the decisions in *Simpson's Sears Ltd v National Football League Properties Inc* (1982), 61 CPR (2d) 170 (TMOB) and *Vapor Canada Ltd v MacDonald et al* (1972), 6 CPR (2d) 204 (FCTD), I agree with the Opponent that it is not proper to give too restrictive an interpretation to what constitutes an affiant's own knowledge in a situation like the present one. It is not sufficient to discredit Ms. Vogel merely because she indicated on cross-examination that she had acquired part of her knowledge of the facts deposed in her declaration from business records and reports to her by other members of her organization. Ms. Vogel answered the questions rigorously. As with the Applicant's own witness, Ms. Gagné, who indicated during her cross-examination that she had no knowledge of each and every aspect of the Applicant's activities, Ms. Vogel cannot be expected to have an encyclopedic knowledge of each and every aspect of the Opponent's activities.

The parties' respective burden or onus

[19] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that each of the Marks is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)]. In these oppositions, the legal onus on the Applicant is to show that there would be no likelihood of confusion between each of the Marks and the Opponent's MIU MIU Trade-marks.

[20] The test for confusion is the same for each of the non-registrability, non-entitlement and non-distinctiveness grounds of opposition pleaded by the Opponent. However, as will become

apparent going through my analysis, the initial evidentiary burden on the Opponent varies for each of them. And so does the material date to assess each of these grounds.

The test for confusion

[21] Section 6(2) of the Act provides that:

The 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.

[22] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of wares or services from one source as being from another source.

[23] The test for confusion is one of first impression and imperfect recollection. As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[24] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 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 and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Analysis of the grounds of opposition

The non-registrability ground of opposition

[25] The Opponent has pleaded that each of the Marks is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with one or more of the Opponent's registered trade-marks referred to in Schedule "B". The Opponent has satisfied its evidentiary burden under this ground by providing certified copies of these registrations. I have exercised the Registrar's discretion to confirm that these registrations are in good standing as of today's date, which date is the material date to assess a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[26] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and one or the other of the Opponent's registered trade-marks. Unless indicated otherwise, I will focus my analysis on the MIU MIU word and design marks covered by registration Nos. TMA529,861 and TMA529,796, which present the Opponent's strongest case. If the Opponent is not successful with respect to any of these marks, it would not achieve a more favourable result with the other marks. I note that evidence of use or advertising of the MIU MIU design mark covered by registration No. TMA529,796 may serve as evidence of use and advertisement of the word mark MIU MIU.

Consideration of the section 6(5) factors

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

[27] Each of the trade-marks in issue possesses a fairly high degree of inherent distinctiveness.

[28] While the Applicant specifies that the word MIIYU means "belle" in Japanese, I agree with the Opponent that the vast majority of Canadians, whether Anglophones or Francophones, will not be aware of such meaning, which therefore is not pertinent in this assessment.

[29] Likewise, while the cross-examination of Ms. Vogel establishes that the Opponent's trade-mark MIU MIU is a derivative or "little diminutive" of the name of the designer of the Opponent, Miucci Prada [Vogel transcript p 20], the words MIU MIU by themselves do not possess any meaning in English or French and do not suggest any specific idea.

[30] Concerning the extent to which the trade-marks in issue have become known, there is evidence from the parties that each of their respective trade-marks has been used in Canada so as to enhance to some extent their distinctiveness, especially the Opponent's.

[31] The Vogel declaration evidences use of the Opponent's MIU MIU word and design marks in association with, generally speaking, clothing for men and women, footwear, fashion accessories, handbags, jewellery, sunglasses and frames for glasses [see in particular the look books filed under Exhibit NV-1; the samples of labels, hangers, cardboard boxes, etc. displaying the MIU MIU word and design marks filed under Exhibit NV-19; the collection books filed under Exhibit NV-20; the collection of frames of eyeglasses and sunglasses filed under Exhibit NV-21; and Ms. Vogel's oral testimony at pp 72-74 concerning the specimens of labels filed under Exhibit NV-19 that are affixed to the inside of the ready-to-wear garments shown in the look books and the collection books]. Ms. Vogel indicated during her cross-examination that she knows these products to be sold in Canada [Vogel transcript p 18]. She also provided the Opponent's sales figures in Canada, which vary between \$2 million in 2003, followed by two years where the figures were slightly under \$2 million per year and then in 2006 of more than \$2.6 million and in 2007 of \$3.76 million. However, no breakdown of annual sales for each of the Opponent's products was provided.

[32] Turning to the promotion and advertising of the MIU MIU word and design marks in Canada, except for advertisements made in American fashion magazines that are circulated in Canada, there are no advertising investments directly made in Canada [Vogel declaration para 30, Vogel transcript pp 58 and 60]. Nonetheless, I acknowledge that the Opponent apparently spends a considerable amount of money for the promotion and advertising of the MIU MIU word and design marks in American fashion magazines [see the amounts indicated in the tables included in Exhibits NV-17 and 18; see also para 31 of the Vogel declaration to the effect that the MIU MIU products have been endorsed by international fashion figures and celebrities,

as corroborated by some of the excerpts of the American fashion magazines attached to her declaration] and that some, if not most, of these magazines were circulated in Canada. Indeed, I note that the cover pages of some of the magazines reproduced under Exhibit NV-17 display prices in both USA and Canadian dollars, for instance *Interview* (March 1993 issue) and *Mirabella* (March 1993 issue), while others display a price for the USA (\$3.50) and one “Foreign” (\$4.50) [see also *Bodum USA, Inc et al v Meyer Housewares Canada Inc* (2012) FC 1450, in which the Court has acknowledged the effects of American media on the Canadian market].

[33] Turning to the Applicant’s Marks, it is difficult to assess the extent to which they have become known in Canada. While the Gagné affidavit evidences that the Applicant has commenced use of the Marks in association with some of the Wares described in Schedule “A” in or about September 2008 and that the MIIYU products have since then been regularly advertised in the Applicant’s seasonal catalogues, which Ms. Gagné states are distributed by mass mailing to some 630000 clients and potential clients of the Applicant [Gagné affidavit para 16, Exhibit “IG-3”], Ms. Gagné did not reveal the sales figures for the MIIYU products in Canada. Furthermore, the Applicant only sells the MIIYU products in the province of Quebec [Gagné transcript pp 24 and 25].

[34] To sum up, the overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent. While the Opponent’s evidence of use and advertising of the MIU MIU word and design marks in Canada may not be as detailed as it could be, a fair reading of Ms. Vogel’s written and oral testimony leads me to conclude that the MIU MIU word and design marks have become known in Canada to a greater extent than those of the Applicant, especially in view of the Opponent’s sales figures, which amount to more than \$12 million dollars for the period between 2003 and 2007, and the effects of spillover communications from the United States.

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

[35] The Opponent’s date of first use in Canada identified in the certificates of registration Nos. TMA529,796 and TMA529,861 is at least as early as May 30 and 31, 2000 respectively and the Opponent provides sales figures dating as far back as 2003. By comparison, the applications

for the Marks are based on proposed use and the Applicant only commenced use of the Marks in association with some of the Wares in or about September 2008. The length of time the trademarks have been used thus favours the Opponent.

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

[36] As for the nature of the wares and services and the nature of the trade, I must compare the Applicant's statement of Wares with the statement of wares in the Opponent's registrations [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[37] As indicated above, the applications for the Marks cover, generally speaking, ladies' underwear and lounge wear. By comparison, the Opponent's registration Nos. TMA529,796 and TMA529,861 cover, among other things, clothing for women, including coats, raincoats, belts, waistcoat, blouses and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear, socks and stockings, gloves, ties, scarves.

[38] The parties' wares are either identical or overlapping. As stressed by the Opponent in its written argument and at the oral hearing, the parties' wares are not specialized (such as athletic, wedding, etc.), or aimed at a specific function. Both parties' wares include clothing worn on a daily basis by women. Furthermore, and as acknowledged by the Applicant through Ms. Gagné's oral testimony, the Applicant's lingerie and lounge wear ("*vêtement d'intérieur*") may be worn different ways by the customer [Gagné transcript p 22]. For example, a customer could decide to wear the Applicant's brassieres as swimwear, or the Applicant's lounging dresses as casual dresses. In other words, and as acknowledged by Ms. Gagné during her cross-examination, what the client does with the Applicant's Wares is up to the client [Gagné transcript p 22].

[39] In this regard, the fact that the Opponent's wares are high end clothing wear and accessories as opposed to the Applicant's Wares, which Ms. Gagné describes as "small-budget" [Gagné affidavit paras 12 and 13], does not assist the Applicant as nothing prevents the Applicant from selling high quality products under the Marks. Indeed, the Gagné affidavit and cross-examination establish that the Applicant also sells within its premises designers' clothing

and carries various clothing items that are high quality products (and therefore aimed at the same clientele as the one for the MIU MIU products). The Applicant's evidence further establishes that the Applicant not only sells designer clothing and accessories but that it has also had collaborations with fashion designers in the past to produce clothing collections sold in the Applicant's premises, as evidenced by the following exhibits, which were referred to during Ms. Gagné's cross-examination:

- Exhibit "A" that consists of the Applicant's fall season catalogue of 2010. The catalogue shows that the Applicant offers for sale and sells clothing items of the type sold by the Opponent as well as lingerie either made by the Applicant or by third parties such as those sold under third parties' trade-marks PASSIONATA and PRINCESS TAM TAM. The catalogue further includes references to clothing items designed by Philippe Dubuc, a fashion designer;
- Exhibit "B" that refers to page 11 of the Applicant's catalogue which identifies the brand SCOTCH & SODA, which Ms. Gagné identified as a third party's brand [Gagné transcript p 77];
- Exhibit "C" that portrays model Tony Ward wearing John Bartlett's design clothing [Gagné transcript pp 77 and 78]. Ms. Gagné specified that the Applicant and John Bartlett collaborated for the design of clothing and that those products were sold in the Applicant's premises;
- Exhibit "D" that illustrates the Philippe Dubuc clothing line which was offered for sale and sold in the Applicant's premises; and
- Exhibit "E" that shows lingerie bearing a third party's brand PRINCESS TAM TAM.

[40] Also, Ms. Gagné, in reply to undertakings taken during her cross-examination, provided in response number E-5 a detailed list of over 50 brands of fashion designers that are sold in the Applicant's premises, such as BALMAIN, CHLOÉ, GIVENCHY, etc.

[41] As mentioned above, the nature of the parties' clientele is also the same. As stressed by the Opponent in its written argument and at the oral hearing, the women who buy and wear

clothing and accessories from the Opponent could be the same as those who buy the Applicant's Wares. Again, the more probative evidence of this is the fact that the Applicant offers for sale and sells in the same premises not only MIIYU products but also clothing items manufactured by fashion designers.

[42] The fact that the Applicant is only selling the Wares in one channel of trade, namely the Applicant's own retail stores, does not assist the Applicant as nothing prevents the Applicant from selling the Wares in other channels such as those where the Opponent's MIU MIU products have been sold in Canada [see *Eminence SA v Registrar of Trade-marks* (1977), 39 CPR (2d) 40 (FCTD)]. Furthermore, and as indicated above, the Applicant offers for sale and sells in the same premises not only MIIYU products but also clothing items manufactured by fashion designers, which could include the Opponent's. In other words, the products of both parties could be found in the same premises.

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

[43] There is a fair degree of resemblance between each of the Marks and the Opponent's MIU MIU word and design marks when considered in their entireties.

[44] At the oral hearing, the Applicant submitted that the repetition of the word MIU in the Opponent's trade-marks constitutes the dominant element of the marks and sets them apart from each of the Marks, which are made of a single word. I disagree.

[45] As indicated above, the trade-marks in issue do not convey any meaning for both Canadian Anglophones and Francophones. There is no "anchor point" (or root) which allows a differentiation of the marks. As a result, the role played by the repetition of the word MIU is lessened. Furthermore, the Marks themselves also include an element of repetition, namely the two letters "I", which are followed by the letter "Y".

[46] While the spelling of the trade-marks in issue differs slightly the visual impression is very similar. This is particularly true when considering each of the parties' design marks. Indeed, the Applicant's MIIYU Design mark and the Opponent's MIU MIU Design mark are both made of

stylised letters having a round shape.

[47] In addition, I agree with the Opponent that the variation in the spelling of the trade-marks in issue does not have much importance in terms of imperfect recollection. It is doubtful that someone would remember the exact spelling of the Marks, which is not easy to remember because it is not frequently used in the English or French languages. To remember that spelling would require a high level of attention, which is not the test for the likelihood of confusion.

[48] From the phonetic viewpoint, the only distinction between each of the Marks and the Opponent's MIU MIU word and design marks comes from the fact that the Opponent's marks repeat MIU while each of the Applicant's Marks only refers to it once. Otherwise, the marks in issue are quite identical.

Additional surrounding circumstances

[49] As a further surrounding circumstance, the Opponent submits that the Booth affidavit as well as Ms. Gagné's cross-examination, reveal that the Applicant knew about the existence of the Opponent's MIU MIU Trade-marks because such marks were cited during the prosecution of each of the Applicant's applications and that the Applicant decided to continue with its applications notwithstanding that. However, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage. Accordingly, little weight, if any, can be accorded to this particular surrounding circumstance.

[50] As a further circumstance, the Opponent submits that the Toppor affidavit reveals that the Applicant would apparently be opposing a third party's application for registration of the trade-mark MIYU based on proposed use of the trade-mark in Canada in association with, among others, cosmetics and hair care preparations, beverages, and food supplements. The Opponent wonders how the Applicant considers the situation prevailing in the present cases given that the Opponent's wares are closer to the Applicant's than those covered by this third party's application. However, the reason why the Applicant decided to introduce into evidence the

Toppor affidavit is unclear. The reason why the Applicant decided to oppose this third party's application is also unclear. At the oral hearing, the Applicant argued that the degree of resemblance existing between this third party's trade-mark and the Marks is greater than the one existing between the Opponent's trade-marks and the Marks. As each case must be decided on its own merits, I am not prepared to accord weight to this surrounding circumstance.

[51] As a further surrounding circumstance, the Opponent notes that the transcript of Ms. Gagné's cross-examination reveals that the Opponent's MIU MIU word mark and the Applicant's word mark MIIYU were apparently inadvertently confused by Ms. Gagné and counsel and by the stenographer at some point of the cross-examination. However, I am not prepared to accord significant weight to this circumstance, which seems to be more of the nature of an anecdote resulting from the formulation of Q. 187 asked by Opponent's counsel.

[52] Lastly, while this was not submitted by the Applicant at the oral hearing, I note that Ms. Gagné concludes her affidavit stating that she is not personally aware of any instances of confusion between the marks in issue. However, I am not prepared to accord significant weight to this surrounding circumstance in the absence of any information as to the extent of the sales made of the Wares bearing the Marks by the Applicant, which sales would have further been restricted to the province of Quebec only.

Conclusion regarding the likelihood of confusion

[53] As indicated above, section 6(2) of the Act is not concerned with the confusion of the marks themselves, but confusion of wares and services from one source as being from another source. In the present cases, the question posed is whether an individual, who has an imperfect recollection of the Opponent's MIU MIU word and design marks as applied to the Opponent's registered wares, would, as a matter of first impression and imperfect recollection, be likely to conclude that the Applicant's Wares are manufactured or sold by the Opponent.

[54] While I acknowledge the fact that the marks in issue are not identical, I find that the differences existing between them are not sufficient to outweigh the overall consideration of the section 6(5) factors discussed above. At best for the Applicant, I find the balance of probabilities as to the likelihood of confusion as to the source of the parties' wares to be evenly balanced. As

the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[55] The non-registrability ground of opposition therefore succeeds in each case.

The non-distinctiveness ground of opposition

[56] The Opponent has pleaded that each of the Marks does not and cannot act to distinguish the Wares from the wares and services of the Opponent, nor are they adapted so to distinguish them in view of the provisions of section 2 of the Act since each of the Marks creates confusion with the Opponent's MIU MIU Trade-marks.

[57] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition (in this case, February 17, 2009) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. The Opponent has met this burden with respect to the MIU MIU word and design marks that are the object of registration Nos. TMA529,861 and TMA529,796, and which have been used in Canada with clothing for women, footwear, fashion accessories and handbags.

[58] The difference in relevant dates does not substantially affect my analysis above under the non-registrability ground of opposition. As a result, my finding made above concerning the likelihood of confusion between each of the Marks and the Opponent's MIU MIU word and design marks remains applicable. Accordingly, the non-distinctiveness ground of opposition succeeds in each case.

The non-entitlement ground of opposition

[59] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Marks in view of the provisions of section 16(3)(a) of the Act since at the date of filing of the Applicant's applications, each of the Marks was confusing with the Opponent's MIU MIU Trade-marks.

[60] An opponent meets its evidentiary burden with respect to a section 16(3)(a) ground if it

shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. The Opponent has met this burden with respect to the MIU MIU word and design marks that are the object of registration Nos. TMA529,861 and TMA529,796, and which have been used in Canada with clothing for women, footwear, fashion accessories and handbags.

[61] As there is no evidence of use of the Marks as of the material date to assess the section 16(3)(a) ground of opposition, my comments made above under the non-registrability ground of opposition with respect to the extent to which the Marks have become known and the coexistence of the parties' marks do not apply. Otherwise, my finding made above concerning the likelihood of confusion between each of the Marks and the Opponent's MIU MIU word and design marks remains applicable. Accordingly, the non-entitlement ground of opposition succeeds in each case.

Disposition

[62] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse both applications pursuant to section 38(8) of the Act.

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

Schedule“A”

Statement of wares (the Wares) covered by application Nos. 1,350,400 and 1,350,402:

Ladies' slips, half-slips and camisoles; ladies' panties, bikinis, support panties; ladies' sleep wear namely night gowns, baby-dolls, pyjamas; ladies' bathrobes and lounge wear namely peignoirs, bed-jackets, lounging dresses and pant suits; ladies' brassieres, girdles, and sets of brassieres with panties; ladies' bathing-suits

Schedule "B"

Trade-mark	Reg. or Appl'n No. / Reg. or Appl'n Date	Wares and/or Services Date of first use
טור טור	TMA635,182 2005-03-14	Retail store services, namely retail sale of clothing, footwear, fashion accessories, leather goods and accessories thereof, bags, jewelry, glasses, sunglasses and frames for glasses. Declaration of Use filed February 23, 2005.
טור טור	TMA529,796 2000-06-27	(1) Books and magazines; stationery articles, namely: exercise books, address books and notebooks, numerical and alphabetical inserts, envelopes, calendars and agendas; writing and marking instruments, namely: fountain pens, ball pens, felt-tipped pens, markers, highlighting pens, pencil and pencil leads, refills for pens; handbags, wallets, luggage, attache cases, tote bags, briefcases, all purpose sport bags, travelling trunks and carry-on bags, shoulder bags, garment bags for travelling, keycases, umbrellas; clothing for men, women and children, namely: coats, raincoats, belts, waistcoat, blouses and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear, socks and stockings, gloves, ties, scarfs, hats and caps, boots, shoes and slippers. Declaration of Use filed May 30, 2000.
טור טור	TMA442,501 1995-05-05	(1) Hand-bags; suitcases; trunks for travel; wallets; purses; portfolios; school bags; briefcases; bags for men; umbrellas; parasols; walking sticks; harnesses and saddles; clothing articles for men, women and children; namely suits and dresses made of leather; shirts; blouses; skirts; coats; trousers pants; vests; jerseys; pajamas; socks and stockings; singlets; corsets; garters; underpants; petticoats; hats; head scarves; neckties; raincoats; overcoats; greatcoats; bathing suits, sport overalls; wind-resistant jackets; ski pants; belts; fur coats; scarves; gloves; dressing gowns; footwear; namely shoes; sport shoes; slippers and boots. Priority Filing Date: October 05, 1992 in association with the same kind of wares. Used in ITALY. Registered in or for ITALY on October 05, 1992 under No. 00578994.

<p>MIU MIU</p>	<p>TMA529,861 2000-06-29</p>	<p>(1) Handbags, wallets, luggage, attache cases, tote bags, briefcases, all purpose sport bags, travelling trunks and carry-on bags, shoulder bags, garment bags for travelling, keycases, umbrellas, parasols; clothing for men, women and children, namely coats, raincoats, belts, waistcoat, blouses and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear, socks and stockings, gloves, ties, scarves, hats and caps, boots, shoes and slippers. Declaration of Use filed May 31, 2000.</p>
<p>MIU MIU</p>	<p>1,384,327 2008-02-21</p>	<p>(1) Lenses namely camera lenses, contact lenses, eyeglass lenses, magnifying lenses, spectacles, sunglasses, lenses for spectacles and for sunglasses, frames for spectacles and for sunglasses, spectacle cases. (2) Telephones, mobile telephones and accessories therefore namely cases for telephones and mobile phones, media players namely MP3 and MP4 players and cases for media players namely MP3 and MP4 players; cosmetics, namely, day cream and night cream, cleaning preparations for face and body, bubble bath, shaving cream, after-shave, foundation cream, nail varnish, deodorants for men and women, toilet soap and baby soap, hair shampoos and rinses, hair sprays, toothpaste and scents, namely perfume, eau de toilette and essential oils for personal use for men and women. (1) Restaurants services, hotels services, motels services, bars services, cocktail lounges services, tourist home services namely providing temporary housing accomodations. Used in CANADA since at least as early as January 2001 on wares (1). Proposed Use in CANADA on wares (2) and on services.</p>