

**IN THE MATTER OF AN OPPOSITION
by Giorgio Beverly Hills, Inc. to application
No. 608,226 for the trade-mark GIORGIO
EMPORIO filed by 136329 Canada Inc.**

On June 1, 1988, the applicant, 136329 Canada Inc., filed an application to register the trade-mark GIORGIO EMPORIO for the following wares:

men's, women's and children's wearing apparel, namely jeans, pants, slacks, jackets, shirts, skirts, vests, dresses, sweaters, blouses and coats, shoes, boots, handbags, purses, luggage and costume jewellery.

The application is based on proposed use and was advertised for opposition purposes on July 26, 1989. At the oral hearing held on March 12, 1996, the applicant requested that its statement of wares be amended to delete the words "women's and children's" and "luggage and costume jewellery." Those amendments were accepted and made of record.

The opponent, Giorgio Beverly Hills, Inc., filed a statement of opposition on November 14, 1989, a copy of which was forwarded to the applicant on November 28, 1989. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks of the opponent:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares/Services</u>
344,932	GIORGIO BEVERLY HILLS	cosmetics and toiletries, namely.....
344,933	GIORGIO	cosmetics and toiletries for men and women, namely....
355,175	GIORGIO	high fashion apparel and personal care products - namely, hats, sweaters, tops, perfumes, colognes and skin lotions and moisturizers, bath and shower gels, dusting powders, perfumed soaps, after shave lotions and after shave balms retailing high fashion apparel and personal care products
355,176	GIORGIO BEVERLY HILLS	high fashion apparel and personal care products - namely, handbags, dresses, skirts, pants, suits, pantsuits, blouses, shirts, ties, scarves, handkerchiefs, hats, lingerie, jackets, coats, shawls, wraps, capes, boas, sweaters, gloves, maternity pants, tops and dresses,

robes, swimsuits, sports coats, slacks, raincoats, hosiery, belts, gloves, perfumes, colognes, skin lotions and moisturizers, bath and shower gels, dusting powders, perfumed soaps, after shave lotions and after shave balms; fine and costume jewellery, watches and clocks

retailing high fashion apparel and personal care products

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cosmetics and toiletries - namely....

retailing high fashion apparel and personal care products

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the above-noted registered marks previously used in Canada by the opponent. The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) because, as of the applicant's filing date, the applied for mark was confusing with the trade-mark GIORGIO previously made known in Canada with jewelry by the opponent. The fourth ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its Vice-President and General Counsel, Daphne Ann Sheridan Bass. As its evidence, the applicant filed an affidavit of its President, George Elian. As evidence in reply, the opponent filed a second affidavit of Ms. Bass. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

Initially, it should be noted that much of the second Bass affidavit is inadmissible. Rule 45 provides an opponent an opportunity to file evidence "...strictly confined to matter in reply...." and most of the second Bass affidavit does not qualify. In particular, the Canadian sales figures for the opponent's fragrance products set forth in paragraph five of the second Bass affidavit are not in reply to anything and should have been submitted as part of the

opponent's evidence in chief.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. Finally, the most relevant of the registrations is No. 355,175 for the trade-mark GIORGIO and a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the outcome of the first ground.

As for Section 6(5)(a) of the Act, the opponent's mark GIORGIO is inherently distinctive although it is not inherently strong since it would likely be perceived as a given name. Although the first Bass affidavit is vague and deficient in many respects, a fair reading of it does allow me to conclude that the opponent has effected significant advertising expenditures in association with its registered mark. However, as noted by the applicant's agent, those advertising activities would appear to have been carried out primarily in association with the opponent's fragrance and cosmetic products.

Ms. Bass provides several examples of Canadian newspaper ads featuring one of the opponent's fragrance products together with a clothing or accessory item to be sold to a purchaser of the fragrance product. She also states that print advertisements are placed in various magazines. However, she gives no indication what those print advertisements contain and there is no indication to support her contention that the magazines in question have circulation in Canada.

In her first affidavit, Ms. Bass provides Canadian sales figures for her company's non-

cosmetic products for the period 1988 to 1990 which are in excess of \$500,000. She states that the opponent's products are sold through major Canadian department stores. However, she does not indicate what constitutes a non-cosmetic product nor does she indicate what specific trade-mark was used with any of these products. As noted by the applicant's agent, presumably a fragrance product is a non-cosmetic product. Thus, it is difficult to attribute any significant portion of the \$500,000 figure to sales of clothing items in Canada.

To the extent that the opponent has sold clothing items in Canada, a review of the exhibits to the first Bass affidavit suggests that the opponent is not an ordinary vendor of clothing items but rather offers selected promotional items for sale (some being articles of clothing) when a consumer buys one of the opponent's fragrance or cosmetic products.

Ms. Bass also evidences a number of sales of non-cosmetic items in the nature of clothing items to Canadians through her company's retail outlet in Beverly Hills, California although the copies of invoices appended to her first affidavit all date back to 1983 or 1984. Thus, I am able to conclude that the opponent's mark GIORGIO has become known to some extent in Canada in association with toiletries and cosmetic products. However, given the deficiencies in the opponent's evidence, I cannot ascribe any reputation of note for the mark GIORGIO in association with the other wares listed in registration No. 355,175 or the registered services.

The applicant submitted that any examples of sales or advertising of the opponent's clothing items in the opponent's evidence cover items bearing one of the opponent's composite or design marks and that use of any of those marks does not constitute use of the mark GIORGIO. I disagree. In the decision Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 (T.M.O.B.), Mr. Troicuk held at page 538 as follows:

Use of a mark in combination with additional material constitutes use of the mark 'per se' as a trade mark if the public, as a matter of first impression, would perceive the mark 'per se' as being used as a trade mark.

(Reference may also be made to the decision in Registrar of Trade Marks v. Compagnie

Internationale pour L'Informatique CII Honeywell Bull, S.A. (1985), 4 C.P.R.(3d) 523 (F.C.A.).) In my view, the trade-mark GIORGIO stands out from the other elements of most of the opponent's design or composite marks such that use of those marks constitutes use of GIORGIO 'per se.'

The applicant's mark GIORGIO EMPORIO is also inherently distinctive although it, too, is not inherently strong since the average consumer would likely assume it is the name of an individual or that it is similar to "Giorgio's Emporium." Mr. Elian states that his company has operated a retail men's clothing store in Montreal under the trade-mark GIORGIO EMPORIO and that some of the clothing sold through his store had labels bearing that trade-mark. According to Mr. Elian, sales through his company's retail outlet totalled about \$3 million for the period 1988 to 1991. Thus, I am able to conclude that the applicant's mark has become known to some extent in the Montreal area in association with its retail store. However, since Mr. Elian did not specify what portion of his sales were of clothing bearing the trade-mark GIORGIO EMPORIO, I cannot ascribe any reputation of note for that mark in association with clothing. If the mark is known at all for clothing, it is only in the Montreal area.

The length of time the marks have been in use is not a material circumstance in the present case. There is an overlap between the statements of wares at issue since the applicant's covers men's shirts, sweaters and blouses and the opponent's includes sweaters and tops. The opponent's personal care products, however, are quite different from the applicant's wares. The opponent contended that both groups of products are connected because they are part of the fashion trade but this concept has been disapproved of by the Federal Court in S.C. Johnson & Son, Inc. v. Esprit de Corp. (1986), 13 C.P.R.(3d) 235 at 245 except where the mark is a "designer" or "signature" mark.

There would also appear to be a potential connection between the trades of the parties. The applicant sells its wares through a retail clothing outlet. Although the opponent's sales

of GIORGIO clothing items in Canadian department stores would appear to be tied in as promotional sales with the opponent's fragrance and cosmetics products, Ms. Bass has established that the opponent operates retail boutiques in the United States. Thus, the opponent's registered services of "retailing high fashion apparel and personal care products" could be performed in Canada through retail boutiques or clothing stores. In this regard, it is the statements of wares and services that govern, not the actual trade engaged in to date in Canada: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.).

Mr. Elian investigated the availability of the opponent's GIORGIO clothing wares through a number of department stores in Montreal and Toronto. For the most part, he was unable to locate any such wares. Nevertheless, the opponent's registration covers some of the same wares as set forth in the present application and, as noted, it is the statements of wares that govern.

As for Section 6(5)(e) of the Act, I consider that there is a high degree of resemblance between the marks at issue in all respects. In fact, the first and more important component of the applicant's mark is identical to the opponent's registered mark.

The opponent contended that an additional surrounding circumstance in the present case is the existence of its family or series of trade-marks. Basically, the opponent's marks comprise the word GIORGIO with or without the words BEVERLY HILLS and/or a design. I fail to see any family of marks in that grouping. Even if there was, however, the opponent has not evidenced the extent of use of each specific registered mark. Thus, the concept of a family or series of marks would have no application in this case, in any event.

The applicant contended that an additional surrounding circumstance is Mr. Elian's statement that no instances of actual confusion between the marks at issue have been reported to him or have come to his attention. Given that he was unable to locate any of the opponent's

clothing wares in different Montreal department stores and given that it is unclear as to the extent to which the applicant has used its mark on clothing items (as opposed to storefronts and shopping bags), the absence of any instances of actual confusion is not surprising.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark GIORGIO EMPORIO is not confusing with the opponent's registered mark GIORGIO. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 26th DAY OF MARCH, 1996.

**David J. Martin,
Member,
Trade Marks Opposition Board.**