

IN THE MATTER OF AN OPPOSITION by Eugene Gallia, une société anonyme, to application No. 542,583 for the trade-mark EUNECE filed by Johnson Publishing Company, Inc.

On May 23, 1985, the applicant, Johnson Publishing Company, Inc., filed an application to register the trade-mark EUNECE based upon use and registration of the trade-mark in the United States of America in association with "cosmetics, toiletries, perfumes, body and hair care preparations". The applicant claimed and was accorded a priority filing date of November 28, 1984 based on its application for registration of the trade-mark EUNECE filed in the United States of America under No. 510,811.

During the prosecution of its trade-mark application, the applicant amended its statement of wares to cover:

"cosmetics and toiletries, namely, perfume, cologne and toilet water; after shave lotion; creams, lotions, fresheners and astringents; soaps and cleansing preparations; hair grooming preparations; shampoos and rinses, not including rinses for tinting, dyeing and coloring; cuticle remover, nail conditioner and nail buffer; eye shadows, eye liners, mascara, rouge, lipsticks and lip gloss, nail polish and nail polish remover."

Following a requirement by the examiner that the applicant limit its statement of wares to those in association with which the trade-mark EUNECE has been registered and used in the United States of America, the applicant amended its application to cover "perfume and cologne". The applicant's trade-mark was advertised for opposition purposes in the Trade-marks Journal on May 4, 1988.

The opponent, Eugene Gallia, une société anonyme, filed a statement of opposition on August 30 1988 in which it alleged the following grounds of opposition:

(a) that the applicant's application for registration does not comply with Section 29 (now Section 30) of the Trade-marks Act in that the applicant has not used its trade-mark in the United States of America and further that the applicant's assertion in its application that it is convinced that it is entitled to use its trade-mark in Canada is false in view of the remaining allegations set forth in the statement of opposition;

(b) that the applicant's trade-mark is not registrable in that it is confusing with one, or more, of the opponent's registered trade-marks: EUGENE-GALLIA, registration No. 252,745; EUGENE DE PARIS, registration No. 332,554; GALLIA, registration No. 252,742; EUGENE, registration No. 205,395; and EUGENE & Design, registration No. TMDA 38320;

(c) that the applicant is not the person entitled to registration in that, as of the applicant's filing date and its priority filing date, the applicant's trade-mark EUNECE was confusing with one or other of the opponent's marks EUGENE GALLIA, GALLIA or EUGENE previously used or made known in Canada by the opponent or its predecessors in title in association with "cosmétiques, parfums et préparations pour les cheveux et le traitement du cuir chevelu";

(d) that the applicant is not the person entitled to registration of the trade-mark

EUNECE in that, as of the applicant's filing date and its priority filing date, the applicant's trade-mark was confusing with the trade-name EUGENE GALLIA previously used in Canada by the opponent or its predecessors in title in association with wares and services of the same nature as those which are the subject matter of the applicant's application;

(e) that the applicant is not the person entitled to registration in that: the applicant's application does not comply with Section 29 (now section 30) of the Trade-marks Act; the applicant's trade-mark is not registrable; and the applicant has not used its trade-mark as alleged;

(f) that the applicant's trade-mark is not distinctive in that it does not distinguish and is not adapted to distinguish the applicant's wares from the wares of the opponent and others.

The applicant served and filed a counter statement in which it asserted that its trade-mark is registrable and distinctive and that the applicant is the person entitled to its registration. Further, the applicant asserted that its application complies with the requirements of Section 29 (now Section 30) of the Trade-marks Act.

The opponent filed as its evidence the affidavits of Jean-François Gareau and André Féron, together with certified copies of the trade-mark registrations relied upon in this opposition. The applicant submitted as its evidence the affidavits of Jill Holmes and June A. Rhinehart.

Both parties filed written arguments and both were represented at an oral hearing.

No evidence has been adduced by the opponent in respect of its Section 30 grounds of opposition and no submissions were made by the opponent either in its written argument or at the oral hearing concerning these grounds. As a result, the opponent has failed to meet the evidential burden upon it in respect of these grounds which have therefore been rejected.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark EUNECE and one or other of the opponent's trade-marks and trade-name relied upon by it in its statement of opposition. Accordingly, the determination of the issue of confusion will resolve all the remaining grounds in this proceeding. In determining whether there would be a reasonable likelihood of confusion between the trade-marks and trade-name at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks and trade-name at issue.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538. Further, the material date in respect of the non-entitlement and non-distinctiveness grounds of opposition are the applicant's priority filing date (November 28, 1984) and the date of opposition (August 30, 1988) respectively.

Considering initially the inherent distinctiveness of the trade-marks at issue, the opponent's trade-marks EUGENE and EUGENE DE PARIS do not possess much inherent distinctiveness in view of the Christian name significance of Eugene and the geographic significance of PARIS which has been disclaimed by the opponent in registration No. 332,554 and therefore adds little inherent distinctiveness to the mark EUGENE DE PARIS. Additionally, in view of the given name significance of Eugene, the trade-mark and trade-name EUGENE GALLIA would be perceived by the average consumer as being the name of an individual and therefore possesses little inherent distinctiveness. On the other hand, the registered trade-mark EUGENE LTD. & Design possesses a fair degree of inherent distinctiveness in view of the design features which form a dominant element of the trade-mark. As noted by the applicant's trade-mark agent at the oral hearing, the trade-mark EUNECE is another spelling of the given name Eunice. As a result, the applicant's trade-mark must be considered as possessing little inherent distinctiveness.

The applicant's evidence does not establish that its trade-mark has become known to any measurable extent in Canada. In particular, sales of the applicant's EUNECE perfume and cologne in Canada from 1985 to 1989 amounted to only \$115,000 while evidence of newspaper advertising in Canada has been limited to the applicant's EUNECE cologne being identified as one of five products which are distributed as a bonus gift set with the purchase of FASHION FAIR products at Eaton's Department Stores. On the other hand, Mr. Gareau, President of VFG Cosmétiques, states in his affidavit that from 1986 to 1989, his company has effected more than \$1,000,000 in sales annually of the opponent's hair-care products to beauty salons while advertising expenditures associated with the opponent's trade-marks during this time exceeded \$100,000. However, while Mr. Gareau asserts that the hair-care products sold by his company bear the opponent's trade-marks, the specimen packages and labels annexed as exhibits to his affidavit only confirm use of the trade-mark EUGENE DE PARIS and the trade-name Eugene Gallia.

The length of time that the trade-marks at issue have been in use also favours the opponent

in this opposition. In particular, in view of the provisions of Section 54(3) of the Trade-marks Act, the certified copy of registration No. 205,395 is evidence of the facts set out therein, including the claimed date of first use (1925) of the trade-mark EUGENE in Canada in association with hair creme by the opponent's predecessor-in-title. On the other hand, the Rhinehart affidavit attests to use of the trade-mark EUNECE in Canada in association with perfume and cologne since 1985. However, the applicant's use of its trade-mark EUNECE in this country predates the use by the opponent of its trade-mark EUGENE DE PARIS which, from the certified copy of registration No. 332,554, appears to have commenced subsequent to May, 1986.

The applicant's perfume and cologne associated with its trade-mark EUNECE differ from the various hair care products associated with the opponent's trade-marks EUGENE and EUGENE DE PARIS although these wares all appear to fall within the broad category of personal care products intended primarily for women. While the opponent's registrations for the trade-marks EUGENE-GALLIA and GALLIA cover cosmetics, there is no evidence to confirm use in Canada of any of the opponent's trade-marks, including the marks GALLIA and EUGENE GALLIA, in association with cosmetics.

The channels of trade associated with the wares of the parties could well overlap even though the opponent appears in recent times to have limited sales of its hair-care products to professional hair stylists or beauty salons. There is, however, no restriction in any of the opponent's registrations which limit sales of its wares to professional hair stylists and its wares could therefore be sold through the same channels of trade as cologne and perfume. Indeed, André Féron in his affidavit does indicate that between 1985 and 1986, the opponent's wares were distributed in Canada by "les pharmacies Universelles".

As to the degree of resemblance between the trade-marks of the parties, I consider there to be little similarity either in appearance or in sounding between the applicant's trade-mark EUNECE and the opponent's trade-marks EUGENE DE PARIS and EUGENE-GALLIA and trade-name Eugene Gallia when the marks are considered in their entirety as a matter of immediate impression and imperfect recollection. There does, however, appear to be some similarity in appearance between the applicant's trade-mark and the opponent's trade-mark EUGENE although the marks do differ in sounding. Further, apart from the female Christian name significance of Eunece and the male Christian name significance of Eugene, the trade-marks at issue do not suggest any particular idea in common. I would also note that there is no similarity between the applicant's trade-mark EUNECE and the opponent's trade-mark GALLIA.

As a further surrounding circumstance, the applicant relied upon state of the register evidence filed by way of the Holmes affidavit. However, Ms. Holmes did not conduct the search referred to in her affidavit and the results of the search are therefore hearsay evidence. Ms. Holmes has also annexed to her affidavit certified copies of registrations obtained on her behalf from the Trade-marks Office which, in view of the provisions of Section 54(3) of the Trade-marks Act, are evidence of the facts set forth therein. The certified copies reveal the existence of registrations for the following trade-marks which have been identified by the applicant as comprising or including female given names: EVELYN for hair care products and cologne; ELEANOR A. for cosmetics, perfumes and colognes; ESMERALDA for eau de cologne and perfumes; ELIDA for perfumes, cosmetics and preparations for the hair; ESKA covering hair care preparations and related wares; LADY ESTHER covering various personal care products; and EMILY ROGERS for inter alia lipstick, eye shadow, and dry skin cream. However, no evidence of use of any of these marks was adduced by the applicant and, given the relatively small number of marks covered by the certified copies, I do not consider that any meaningful inferences can be drawn from this evidence.

Having regard to the above, it is apparent that the most relevant of the opponent's trade-marks and trade-name with respect to the issue of confusion is the opponent's registered trade-mark EUGENE. As a result, the determination of the issue of confusion between the applicant's trade-mark EUNECE and the opponent's trade-mark EUGENE will effectively resolve the issues of confusion in this opposition. Being a Christian name and therefore a weak mark entitled to a limited ambit of protection, and considering that the wares of the parties associated with these marks differ, absent evidence of acquired distinctiveness of the trade-mark EUGENE, I have concluded that the applicant has met the legal burden upon it of establishing that, when considered as a matter of first impression and imperfect recollection, there would be no reasonable likelihood of confusion between its trade-mark EUNECE and the opponent's registered trade-mark EUGENE. Likewise, there would in my opinion be no reasonable likelihood of confusion between the applicant's trade-mark and any of the other trade-marks or trade-name relied upon by the opponent. Accordingly, I have rejected the opponent's grounds of opposition based on the allegations of confusion set forth in the statement of opposition.

In view of the above, I reject the opponent's opposition pursuant Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31ST DAY OF JULY 1992.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.