

IN THE MATTER OF AN OPPOSITION by Jacques Jaunet S.A. to application No. 572,376 for the trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design filed by Ceret Fashions Limited, doing business as Mr. Mann Tailor and Shirtmaker

On November 5, 1986, the applicant, Ceret Fashions Limited, doing business as Mr. Mann Tailor and Shirtmaker, filed an application to register the trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design, a representation of which appears below, based upon use of the trade-mark in Canada since August 15, 1983 in association with services identified as "OPERATION OF A RETAIL OUTLET OFFERING CUSTOM TAILORED AND READY MADE MAN'S AND LADIES WEAR" as well as being based upon proposed use of the trade-mark in Canada in association with the "OPERATION OF A RETAIL OUTLET OFFERING MEN'S TOILETRIES" and in association with the following wares:

"MEN'S AND LADIES CUSTOM TAILORED AND READY MADE WEAR, NAMELY, CUSTOM TAILORED SUITS, SPORTS JACKETS, TROUSERS, COATS, DINNER CLOTHES, NAMELY, TUXEDO, WHITE TIE, TAILS, FROCK AND MORNING CLOTHES, NAMELY, COATS, JACKETS, TROUSERS, WAISTCOATS, VESTS, SHIRTS, AND TIES ALL FOR MORNING WEAR; RIDING CLOTHES, NAMELY, JACKETS, BREECHES, SKIRTS, SHIRTS, WAISTCOATS, TIES CRAVATS AND SCARVES, ALL FOR RIDING; HACKING JACKETS, JODPURS (sic.), BREECHES, POLO BREECHES; MILITARY DRESS ATTIRE; CUSTOM TAILORED SHIRTS, CUSTOM TAILORED LADIES BLOUSES; TAILORED BROAD CLOTH BOXER SHORTS AND PYJAMAS; AND READY-TO-WEAR COATS, BLAZERS, TROUSERS, SUITS, TUXEDOS, SHIRTS AND SLACKS, AND MEN'S TOILETRIES, NAMELY, COLOGNE AND AFTER-SHAVE"

The applicant disclaimed the right to the exclusive use of the words MANN, TAILOR and SHIRTMAKER apart from its trade-mark.

The opponent, Jacques Jaunet S.A., filed a statement of opposition on February 9, 1988 in which it alleged that the applicant's application is not in compliance with s. 29(b) (now s. 30(b)) of the Trade-marks Act in that the applicant has not used its trade-mark since the claimed date of first use. Further, the opponent alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration in that the trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design is confusing with the opponent's registered trade-marks NEW MAN & Design, registration Nos. 172,348 and 239,091 which have been

previously used in Canada in association with different articles of clothing since at least 1969.

The applicant served and filed a counter statement in which it denied the allegations of confusion as set forth in the statement of opposition and asserted that its application complies with s. 29(b) (now s. 30(b)) of the Trade-marks Act.

The opponent filed as its evidence the affidavit of Gilles Nouaille and Nicole Filion while the applicant submitted the affidavit of Cy Mann. As evidence in reply, the opponent submitted a second affidavit of Gilles Nouaille.

Both parties submitted written arguments and an oral hearing was not conducted in respect of this opposition.

As the opponent has adduced no evidence in support of its s. 30(b) ground of opposition, it has failed to meet the evidentiary burden upon it in respect of that ground. Accordingly, I have rejected the opponent's first ground of opposition.

The remaining grounds of opposition all turn upon the issue of confusion between the applicant's trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design and the opponent's registered trade-marks NEW MAN & Design, registration Nos. 172,348 and 239,091, representations of which are set out below:

172,348

239,091

Registration No. 172,348 was registered October 30, 1970 and covers "Pantalons, chemises, vestes, pull-overs, et ceintures" and includes a disclaimer of the right to the exclusive use of the word MAN apart from the trade-mark while registration No. 239,091 was registered January 11, 1980 and covers

"Vêtements, nommément: vestes, manteaux, costumes, robes, gilets, pantalons, pullovers, cardigans, jupes, corsages, chapeaux, foulards, cravates, gants, bas, chaussettes, chemises, costumes de bain, centures, corsets, soutiens-gorge, caleçons, slips".

In determining whether there would be a likelihood of confusion between the trade-marks of the parties, regard must be had to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Trade-marks Act. Further, the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's claimed date of first use or its filing date in respect of the non-entitlement grounds of opposition, or as of the date of opposition (February 9, 1988) in respect of the s. 12(1)(d) and non-distinctiveness grounds of opposition.

With respect to the inherent distinctiveness of the trade-marks of the parties, the opponent's trade-marks NEW MAN & Design possess some inherent distinctiveness as applied to the opponent's wares even though the word MAN describes the persons to whom certain of the opponent's wares are directed and has been disclaimed by the opponent in registration No. 172,348. As well, the opponent's marks might also suggest to some consumers that the opponent's clothing is fashionable and modern. The applicant's trade-mark comprises the surname MANN and the descriptive terms TAILOR and SHIRTMAKER although the courtesy title MR. and the minimal design features associated with the trade-mark do add at least some measure of inherent distinctiveness to the applicant's trade-mark.

The extent to which the trade-marks have become known in Canada and the length of time the trade-marks have been in use both favour the opponent to some extent. In particular, as of the date of opposition, sales of the opponent's NEW MAN & Design clothing in this country had exceeded \$5,500,000 while the applicant's sales appear to have been of the order of \$4,000,000 as of February 9, 1988. On the other hand, the opponent's advertising and promotion of its NEW MAN & Design clothing appears to have been more extensive in Canada than has the applicant's promotion of its wares and services associated with the trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design. Accordingly, the opponent's trade-marks have become known to a somewhat greater extent in Canada than has the applicant's trade-mark although I do not consider that the opponent's marks have become known to such an extent as to justify my according the protection to its marks as would be accorded to trade-marks which have become well known in this country.

The opponent has used its NEW MAN & Design trade-mark in Canada since 1969 whereas the applicant has used its trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design in this country in association with the operation of a retail outlet offering custom tailored and ready made man's and ladies wear only since August of 1983. Further, the applicant's application is based upon proposed use in respect of the wares covered in the application as well as the services relating to the operation of a retail outlet offering men's toiletries. As a result, the length of time that the trade-marks at issue have been in use in Canada does favour the opponent in this opposition.

The wares of the parties are clearly overlapping in that the opponent's registrations and the applicant's application all cover various articles of clothing. As there is no limitation in the opponent's registration in respect of its clothing, the opponent's NEW MAN & Design clothing could very well be tailored or custom made, as are a number of the applicant's items of clothing. Further, the applicant's application does cover ready-to-wear coats, blazers, trousers, shirts, suits and slacks which clearly overlap with the opponent's "pantalons, chemises, manteaux, costumes, gilets". On the other hand, the applicant's toiletries and its services relating to the operation of a retail outlet offering men's toiletries differ from the opponent's clothing as would the channels of trade associated with these wares (see S.C. Johnson & Son, Inc. v. Esprit de Corp. et al, 13 C.P.R. (3d) 235, at pages 248-249). Further, I consider there to be some similarity between the applicant's services relating to the operation of a retail outlet offering men's and ladies wear and the opponent's articles of clothing which would be sold in such a retail outlet. I would note, however, that many of the items of clothing covered in the applicant's application are defined as being custom tailored or as falling within such general categories as riding clothes or dinner clothes and would therefore not, in my opinion, be wares which would be purchased in a hurried manner and without due consideration by the average consumer prior to making the purchase. Likewise, the applicant's military dress attire, polo breeches, hacking jackets and the like appear to be types of clothing which would not be purchased without due consideration by the customer.

To the extent that the ready-to-wear clothing of the applicant are identical to the opponent's wares, the channels of trade associated with these wares would or could be the same. Further, as the applicant's application covers both ready-to-wear and custom made clothing which are sold through the applicant's retail outlet, I have concluded that the articles of clothing covered in the applicant's application which are other than ready-to-wear could also be sold through the same type of retail outlets as the opponent's wares. Likewise, there would appear to be an overlapping between the applicant's services relating to the operation of a retail outlet offering men's and ladies wear and the opponent's wares.

With respect to the degree of resemblance between the trade-marks at issue, I consider there to be little similarity in either sounding or appearance between the trade-marks NEW MAN & Design and MR. MANN TAILOR AND SHIRTMAKER & Design when considered in their entireties as a matter of first impression and imperfect recollection. Further, having regard to the comments above in respect of the inherent distinctiveness of the trade-marks at issue, I consider there to be no similarity in the ideas suggested by the trade-marks of the parties.

Having regard to the above and, in particular, to the inherent weakness of the trade-marks at issue and the minimal degree of similarity between the opponent's trade-marks NEW MAN & Design and the applicant's trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design when considered in their entireties as a matter of immediate impression, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue. Accordingly, I have rejected the opponent's grounds of opposition based on its allegations of confusion between applicant's trade-mark MR. MANN TAILOR AND SHIRTMAKER & Design and its NEW MAN & Design trade-marks.

I reject the opponent's opposition pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 28th DAY OF FEBRUARY 1991.

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