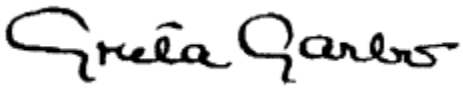
IN THE MATTER OF AN OPPOSITION by Garbo Group Inc. to application No. 1,110,684 for the trade-mark GRETA GARBO Design filed by Harriet Brown & Company

On July 26, 2001, Harriet Brown & Company (the "Applicant") filed an application to register the trade-mark GRETA GARBO Design (the "Mark") for jewelry, claiming a convention priority date of February 23, 2001. The application was filed on two bases: 1) use of the Mark in Canada since at least as early as January 29, 2001 and 2) use and registration in the United States of America. The right to the exclusive use of the words GRETA GARBO is disclaimed apart from the trade-mark. Consent to the use of the signature of Greta Garbo is of record. The Mark is shown below:



The application was advertised for opposition purposes in the Trade-marks Journal of June 16, 2004. On November 16, 2004, Garbo Group Inc. (the "Opponent") filed a statement of opposition.

The Applicant filed and served a counter statement on April 21, 2005.

In support of its opposition, the Opponent filed the affidavits of its President, Gary Grundman, and a law clerk, Lorraine Devitt. The Applicant obtained orders for the cross-examination of these affiants, but did not conduct any cross-examinations.

On February 21, 2006, the Opponent was granted leave to amend its statement of opposition.

The Applicant elected to not file any evidence in support of its application.

Only the Opponent filed a written argument and participated in an oral hearing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act,* R.S.C. 1985, c. T-13 (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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(a) ground of opposition

In its amended statement of opposition, the Opponent added the ground that the Mark is not registrable having regard to s. 12(1)(a) of the Act since GRETA GARBO is primarily merely the name of an individual who has died within the preceding thirty years.

The Opponent has met its initial burden with respect to this ground because it has filed evidence that indicates that Greta Garbo died on April 15, 1990 (see Volume 2, Exhibit B, Devitt Affidavit).

The Applicant's counter statement of April 21, 2005 does not contain a general denial of all of the grounds/allegations in the Opponent's statement of opposition; instead it specifically denies each of the specific pleadings contained in the original statement of opposition. Accordingly, the Applicant has not denied the amended statement of opposition's s. 12(1)(a) ground. As noted earlier, the Applicant has also not filed either evidence or argument.

The s. 12(1)(a) ground, having been neither denied nor rebutted, succeeds.

Distinctiveness ground of opposition

The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish nor is it adapted to distinguish the Applicant's jewelry from the jewelry and fashion accessories of the Opponent. The Opponent's pleadings allege that the Opponent has used or made known the trade-mark GARBO in Canada in association with jewelry since at least as early as August 12, 1987.

The material date with respect to this ground is the filing of the opposition [*Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324]. In order for the distinctiveness ground of opposition to succeed, the Opponent need only show that as of November 16, 2004 its GARBO trade-mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd*. (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. The Opponent has met this initial burden.

By affidavit dated November 17, 2005, the Opponent's President attested that the Opponent has, since 1984, continuously and extensively advertised and sold jewelry and other fashion accessories in association with trade-marks containing the word GARBO. Products bearing the Opponent's GARBO marks are sold in hundreds of stores in Canada including chain and department stores and women's fashion, accessory and apparel stores. The Opponent has advertised its products bearing its GARBO marks in various media in Canada; samples of ads have been provided that promote jewelry in association with GARBO between 1986 and 2005. The ads provided include ones placed in leading Canadian newspapers, such as the *Toronto Star* (judicial notice can be taken of the circulation of leading Canadian newspapers: *Carling O'Keefe Breweries of Canada Ltd. v. Anheuser Busch, Inc*. (1985), 4 C.P.R. (3d) 216 (T.M.H.O.)). Wholesale sales figures of products bearing the Opponent's GARBO marks have been approximately half a million dollars in each of the years 2001 through 2005.

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.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Each of these is discussed below.

s. 6(5)(a): Neither party's mark is inherently strong since each is the name/surname of an individual. Only the Opponent has evidenced that its mark has acquired some reputation through use or promotion.

s. 6(5)(b): The Opponent claims to have used its mark for 14 years longer than has the Applicant.

s. 6(5)(c): The party's wares are identical.

s. 6(5)(d): It is fair to assume that both parties' jewelry would travel similar channels of trade.

s. 6(5)(e): The Applicant's Mark incorporates the whole of the Opponent's mark. Although the word GARBO is the second portion of the Applicant's Mark, this does not serve to distinguish the marks very much since it is not uncommon to shorten an individual's name to his/her surname. Overall, there is a fair degree of resemblance between GRETA GARBO Design and GARBO in appearance, sound and idea suggested.

Each of the foregoing factors favours the Opponent. As confusion between the marks appears likely, the Applicant has not established that its Mark is distinctive.

As the Applicant has not met its legal onus, the distinctiveness ground succeeds.

Remaining grounds of opposition

As I have already refused the application under two grounds, I will not address the remaining grounds of opposition. I will however mention that the Applicant and the Opponent were engaged in another opposition, which was ultimately concluded in favour of the present Applicant [*Garbo Creations Inc. v. Harriet Brown & Co.* (1999), 3 C.P.R. (4th) 224 (F.C.T.D.)]. The Opponent made various submissions concerning this prior decision, but I consider it sufficient to say that it is highly distinguishable from the present case for various reasons, two of which are that the wares at issue in that proceeding were not identical and the Applicant filed evidence in that proceeding.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 20th DAY OF FEBRUARY 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board