



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

Citation: 2015 TMOB 200
Date of Decision: 2015-11-02

IN THE MATTER OF AN OPPOSITION

Les Importations Enzo-M Ltée	Opponent
and	
Francesca's Collections, Inc.	Applicant
1,512,315 for FRANCESCA'S COLLECTIONS	Application

Introduction

[1] On January 24, 2011, Francesca's Collections, Inc. (the Applicant) filed application No. 1,512,315 to register the trade-mark FRANCESCA'S COLLECTIONS (the Mark).

[2] The application is based upon use and registration of the Mark in the United States of America in association with the following goods and services, as revised by the Applicant, and claims a priority filing date of January 13, 2011, based upon the Applicant's corresponding application in that country:

(1) Jewelry; handbags, cosmetic cases sold empty, leather cases, overnight cases, toiletry cases sold empty, vanity cases sold empty, business card cases, calling card cases, key cases, name card cases. (the Goods)

(1) Retail store and online retail store services for the sale of jewelry and handbags. (the Services)

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 17, 2012. Les Importations Enzo-M Ltée (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on December 17, 2012. The grounds of opposition are based upon sections 30(d), 30(i), 12(1)(d), 16(2)(a), and 2 of the Act.

[4] Only the Opponent filed evidence by way of a certified copy of its registration No. TMA360,782 for the trade-mark FRANCESCA in association with “shoes”.

[5] Only the Applicant filed a written argument, but both parties attended a hearing.

[6] For the reasons which follow, the opposition is dismissed.

The parties’ respective burden or onus

[7] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidentiary 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 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)].

Grounds of opposition that can be summarily dismissed

[8] At the hearing, the Opponent conceded that it had failed to meet its evidentiary burden with respect to the grounds of opposition based on sections 30(d), 30(i), 16(2)(a) and 2 of the Act. In view of this admission, and in the absence of any evidence or submissions in support of these grounds of opposition, they are all dismissed.

Remaining ground of opposition

Non-registrability of the Mark under section 12(1)(d) of the Act

[9] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent’s trade-mark

FRANCESCA that is the subject of registration No. TMA360,782 referred to above.

[10] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[11] 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 the Opponent's trade-mark FRANCESCA.

The test for confusion

[12] The test for confusion is one of first impression and imperfect recollection. 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

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

[14] 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 goods, 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].

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

[15] The Applicant submits that neither the Mark nor the Opponent's registered trade-mark is particularly distinctive. I agree.

[16] The word FRANCESCA has little inherent distinctiveness as it consists of a surname [see by analogy the comment of Mr. Justice Binnie in *Mattel, Inc., supra*, at para 3, to the effect that the name BARBIE, a common contraction of Barbara, is not as such, inherently distinctive. See also the comment of Board Member Tremblay in *Constellation Brands Québec, Inc v Julia Wine Inc*, 2013 TMOB 45 (CanLII), at para 39, to the effect that the trade-mark JULIA'S has little inherent distinctiveness as it primarily consists of the surname JULIA].

[17] In this regard, I wish to add that the Opponent's submission at the hearing that the word FRANCESCA is not defined in common parlance English or French dictionaries did not persuade me that the word FRANCESCA cannot be perceived as a surname.

[18] The word COLLECTIONS also has little inherent distinctiveness in the context of the Applicant's Goods and Services, as it merely suggests a line of selected jewelry or handbags.

[19] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, there is no evidence that either of the parties' marks has been used pursuant to section 4 of the Act or that either of them has become known to any extent whatsoever in Canada.

The length of time the trade-marks have been in use

[20] As indicated above, the Applicant's application is based upon use and registration of the Mark in the United States and there is no evidence that any use of the Mark commenced in Canada subsequent to the filing of the application.

[21] The Opponent's registration claims use of the trade-mark FRANCESCA in Canada since at least as early as 1967. However, the mere existence of a registration can establish no more than *de minimus* use of the Opponent's trade-mark and cannot give rise to an inference of

continuing use [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

The nature of the goods, services or business; and the nature of the trade

[22] The Opponent's trade-mark is registered in association with only one type of goods, namely shoes.

[23] By comparison, the Applicant's revised statement of goods and services covers:

Jewelry; handbags, cosmetic cases sold empty, leather cases, overnight cases, toiletry cases sold empty, vanity cases sold empty, business card cases, calling card cases, key cases, name card cases.

Retail store and online retail store services for the sale of jewelry and handbags.

[24] While it is true that the parties' respective goods all belong to the field of fashion, and can be considered clothing accessories, this is not equivalent to saying that there is necessarily an overlap between the Opponent's shoes and the Applicant's jewelry and bags, and their corresponding channels of trade.

[25] The intrinsic character of the Applicant's Goods differs from that of the Opponent's. There is no evidence from the Opponent pointing to the fact that the Applicant's Goods could be considered a natural extension of the Opponent's shoes in the present case. The Opponent's registration has been restricted for decades to the limited range of goods "shoes" only. There is no evidence to support the position that the Opponent would expand its current range of products to other types of fashion accessories, such as the Applicant's Goods.

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[26] There is a fair degree of resemblance between the parties' marks.

[27] The Mark incorporates the whole of the Opponent's FRANCESCA trade-mark. The descriptive word COLLECTIONS does not add much distinctiveness to the Mark. The same holds true for the apostrophe "S", which merely identifies the possessive.

Additional surrounding circumstance

[28] At the hearing, the Applicant submitted that the Opponent's trade-mark coexists on the register of trade-marks with the registered trade-mark FRANCISCA. However, this has not been put into evidence. Contrary to the Applicant's position, the Registrar generally declines to exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications identified in a statement of opposition are extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Furthermore, a single registration is not significant enough to draw any conclusion about the state of the marketplace.

Conclusion regarding the likelihood of confusion

[29] As noted by the Federal Court of Appeal in *Dion Neckwear, supra*, at page 163, the Registrar "need not be satisfied beyond doubt that confusion is unlikely. Should the 'beyond doubt' standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity."

[30] I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent's FRANCESCA trade-mark would be unlikely to conclude that the Applicant's Goods and Services originate from the same source or are otherwise related to or associated with the Opponent's registered goods.

[31] As indicated above, the Opponent's trade-mark is a weak mark and there is no evidence to suggest that it should be afforded a wide ambit of protection. As comparatively small differences may suffice to distinguish between marks of low inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)], I find that the differences existing between the parties' marks and their respective goods and/or services are sufficient enough to avoid any reasonable likelihood of confusion in the present case.

[32] Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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

Hearing Date: 2015-10-20

Appearances

Johanne Muzzo

For the Opponent

Kwan T. Loh

For the Applicant

Agents of record

Guy & Muzzo Inc.

For the Opponent

Clark Wilson LLP

For the Applicant