

**IN THE MATTER OF AN OPPOSITION
by Artema S.p.A. to application No. 674,337
for the trade-mark REVERE filed by
Jantzen Canada Inc.**

On January 23, 1991, the applicant, Jantzen Canada Inc., filed an application to register the trade-mark REVERE for "clothing namely sweaters, shorts, pants, shirts and bathing suits" based on proposed use in Canada. The application was advertised for opposition purposes on October 2, 1991.

The opponent, Della Rovere S.p.A. (now Artema S.p.A.), filed a statement of opposition on July 2, 1992, a copy of which was forwarded to the applicant on August 11, 1992. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(a) of the Trade-marks Act because it is primarily merely a surname. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark DELLA ROVERE Design (illustrated below) registered under No. 394,149 for the following wares:

men's and women's knitwear, namely pullovers, polo-shirts, waistcoats, cardigans, sweaters, blouses, and T-shirts, made of cashmere, alpaca, mohair, camel hair, lambswool silk, wool, linen, cotton and other fine wools.

The third 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 mark was confusing with the trade-mark DELLA ROVERE previously used in Canada by the opponent in association with its registered clothing wares. 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. The opponent's evidence consists of an affidavit of its President, Luciano Donatelli, and a certified copy of its trade-mark registration. As its evidence, the applicant filed the affidavits of Catherine E. Burnside and George F. Daley. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

As for the first ground of opposition, Section 12(1)(a) of the Act reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
- (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.....

The material time for considering the issue arising pursuant to Section 12(1)(a) of the Act is as of the date of my decision: see Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243. Furthermore, the onus or legal burden is on the applicant to show that its applied for trade-mark is registrable. Finally, in considering this issue, I am guided by the decision of Mr. Justice Cattnach in Gerhard Horn Investments Ltd. v. Registrar of Trade Marks (1983), 73 C.P.R.(2d) 23 (F.C.T.D.). At page 30 of the reported reasons, Mr. Justice Cattnach states as follows:

The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

In the present case, the opponent has failed to evidence its contention that Revere is a surname. The only evidence on point is from the applicant which establishes that Paul Revere was a folk hero of the American Revolution (see Exhibit E to the Burnside affidavit). However, Paul Revere is an individual who died more than thirty years ago. It therefore follows that the first ground of opposition is unsuccessful. Even had the opponent evidenced that Revere is the surname of a living individual or one who has recently died, I doubt that its first ground would have been successful in any event given the fact that "revere" is a common

dictionary word and is the name of a famous historical personality. Thus, it is unlikely that one could find that REVERE is primarily merely the surname of an individual.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act 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.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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.

The applicant's mark REVERE is inherently distinctive since it has no readily apparent meaning relating to the character, quality or origin of clothing. The Daley affidavit evidences that the applicant has commenced use of its mark for sweaters with sales in excess of \$600,000 for the period 1991-1993. Thus, I can conclude that the applicant's mark has become known to a very limited extent.

The opponent's mark DELLA ROVERE Design is inherently distinctive. However, it is not an inherently strong mark since it would be perceived as the name of an individual. The Donatelli affidavit evidences Canadian sales in association with the opponent's mark of approximately \$20,000 for the period 1990-1992. Given the minor sales by the opponent, I must assume that it has not become known in Canada.

The length of time the marks have been in use is not a material circumstance in the present case. As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of the parties are the same or similar and presumably the trades of the parties would, or could, overlap.

As for Section 6(5)(e) of the Act, there is a fairly high degree of resemblance between

the marks at issue both visually and phonetically. The applicant's mark is almost identical to the second component of the opponent's mark. Furthermore, given that the opponent's mark would be perceived as the name of an individual, it would seem likely that wholesalers, retailers and consumers might shorten that mark on occasion to simply ROVERE thereby enhancing the likelihood for confusion. The marks do not bear any resemblance in the ideas suggested, the opponent's mark suggesting a particular individual and the applicant's mark suggesting the common English word "revere."

As an additional surrounding circumstance, the applicant has relied on Mr. Daley's observation as the Vice-President Marketing of the applicant that he is not aware of any instances of confusion having arisen between the marks at issue. However, given the minimal use of the opponent's mark to date, such an observation is of little import.

Although not referred to in its written argument, it appears that the applicant also sought to rely on the state of the register evidence found in Exhibit A to the Burnside affidavit to minimize any resemblance between the marks at issue. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present case, the state of the register evidence does not advance the applicant's case. Ms. Burnside's search revealed a dozen registrations for trade-marks incorporating the word REVERE but all were in unrelated fields. For example, six of the registrations are owned by one company and cover tobacco products. Four further registrations are owned by another company and cover cooking utensils and the like. None of the twelve registrations located by Ms. Burnside are for anything remotely similar to clothing items. Thus, there is no

evidence from which I could conclude that there has been any adoption by others of trade-marks incorporating the word REVERE in the clothing field, much less common adoption of such marks.

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 legal burden on it to show that its applied for mark REVERE is not confusing with the opponent's registered mark DELLA ROVERE Design. The second 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 10th DAY OF JANAUARY, 1996.

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