

**IN THE MATTER OF AN OPPOSITION
by Chico's Concept, Inc. to application No.
1,038,916 for the trade-mark LA CHICA
filed by Utex Corporation**

On December 10, 1999, the applicant, Utex Corporation, filed an application to register the trade-mark LA CHICA for the following wares:

Ladies', men's and children's clothing, namely, jackets, suits, coats, raincoats, pants, slacks, skirts, shirts and sweaters.

The application is based on proposed use in Canada and was advertised for opposition purposes on March 28, 2001.

Chico's Fas, Inc. filed a statement of opposition on June 28, 2001, a copy of which was forwarded to the applicant on July 27, 2001. As a consequence of an assignment of various trade-marks, the opposition now stands in the name of Chico's Concept, Inc.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(e) of the Trade-marks Act because the application does not contain the statement required by that subsection. The second ground is that the application does not conform to the requirements of Section 30(i) of the Act in that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada because it was aware of the opponent's previously used trade-marks and trade-names.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(b) of the Act because, as of the applicant's filing date,

the applied for trade-mark was confusing with the trade-marks CHICO'S and CHICO'S PASSPORT for which applications had previously been filed in Canada on July 21, 1999. The application for the trade-mark CHICO'S was assigned serial number 1,023,135 and covers "retail clothing store services" and the following wares:

Men's clothing, namely, jackets, pants, shirts and tops; and women's clothing, namely, skirts, pants, sweaters, blouses, dresses, shirts, tops and jackets.

The application for the trade-mark CHICO'S PASSPORT was assigned serial number 1,023,136 and is for "credit card discount services" and "retail clothing store servivces."

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(c) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-names Chico's; Chico's Fas, Inc. and chicos.com previously used in Canada by the opponent. The fifth ground is that the applied for trade-mark is not distinctive in view of the opponent's "prior trade-marks and trade-names."

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Scott Edmonds, the President and Chief Operating Officer of Chico's Fas, Inc. The applicant chose not to submit evidence. Only the opponent filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, Section 30(e) of the Act reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....

(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

30. Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant.....

e) dans le cas d'une marque de commerce projetée, une déclaration portant que le requérant a l'intention de l'employer, au Canada, lui-même ou par l'entremise d'un licencié, ou lui-même et par l'entremise d'un licencié;[.]

The applicant's application includes the statement "The Applicant intends to use the Trade Mark in Canada, in connection with the following wares:...." The opponent contends that Section 30(e) requires the applicant to state that it intends to use the applied for mark either "by itself or through a licensee" or "by itself and through a licensee" and that the applicant must include one or other of those formulations in its application. I disagree. The first alternative "by itself or through a licensee" is worded disjunctively so that satisfying either branch of the statement satisfies the statutory requirement. Thus, the applicant's statement that it intends to use the applied for trade-mark is sufficient for the purposes of Section 30(e) of the Act. The first ground of opposition is therefore unsuccessful.

The second ground does not raise a proper ground of opposition. The mere fact that the applicant may have been aware of the opponent's trade-marks and trade-names would not, by itself, preclude the applicant from making the statement in its application required by

Section 30(i) of the Act. The opponent did not allege that the applicant adopted its trade-mark knowing it to be confusing with marks and names previously used in Canada by the opponent. Thus, the second ground of opposition is also unsuccessful.

As for the third ground of opposition, there was an initial evidential burden on the opponent to establish that its two trade-mark applications had been filed prior to the applicant's filing date as required by Section 16(3)(b) of the Act and that they were still pending as of the applicant's advertisement date as required by Section 16(4). Although the opponent did not evidence its two applications, in accordance with the opposition decision in Royal Appliance Mfg. Co. v. Iona Appliances Inc. (1990), 32 C.P.R.(3d) 525 at 529, I have exercised the Registrar's discretion and examined the records of the Trade-marks Office in relation to those applications. Those records confirm that the two applications were filed prior to the applicant's filing date and were pending as of the applicant's advertisement date.

In view of the above, the third ground remains to be decided on the issue of confusion between the marks at issue. The material time for considering the circumstances respecting that issue is the applicant's filing date. Furthermore, in applying the test for confusion set out 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. Finally, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks.

Considering first the opponent's trade-mark CHICO'S, that mark and the applicant's mark LA CHICA are both inherently distinctive in relation to clothing wares and services. There being no evidence from the applicant, I must conclude that its mark had not become known at all in Canada as of the material time. The Edmonds affidavit establishes that the opponent's predecessor-in-title, Chico's Fas, Inc., has used the trade-mark CHICO'S in association with a chain of clothing stores and a line of primarily women's clothing in the United States for a number of years. However, Mr. Edmonds did not evidence any sales or advertising activities in Canada as of or prior to the material time. Thus, I must conclude that the opponent's trade-mark had not become known at all in Canada as of that date.

The length of time the marks have been used in Canada is not a material circumstance in the present case. As for Sections 6(5)(c) and 6(5)(d) of the Act, there is a significant overlap in the wares of the parties. The opponent's application No. 1,023,135 covers various items of men's and women's clothing and "retail clothing store services." The applicant's application also covers items of men's and women's clothing. Presumably the trades of the parties would, or could, be similar.

As for Section 6(5)(e) of the Act, the marks of the parties bear a fairly high degree of resemblance. The applicant's mark LA CHICA is dominated by the component CHICA which differs by only one letter from the opponent's mark CHICO'S apart from its presentation in the possessive form. Thus, the marks look and sound much alike.

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's trade-mark LA CHICA was confusing with the opponent's trade-mark CHICO'S as of December 10, 1999. Thus, the third ground of opposition based on the opponent's previously filed application No. 1,023,135 is successful and the second aspect of that ground need not be considered.

In view of the above, it is also unnecessary to consider the opponent's fourth and fifth grounds of opposition. However, given the opponent's failure to evidence any use of its trade-names in Canada prior to the applicant's filing date or any reputation of note for its marks and names in Canada at any time, those two grounds would likely have been unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 5th DAY OF MAY, 2004.

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