

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

**Citation: 2011 TMOB 31**  
**Date of Decision: 2011-02-16**

**IN THE MATTER OF AN OPPOSITION by  
Emilio Pucci International BV to application  
No. 1,265,378 for the trade-mark EMIDIO  
TUCCI in the name of El Corte Ingles, S.A.**

[1] On July 19, 2005, El Corte Ingles, S.A. (the Applicant) filed an application to register the trade-mark EMIDIO TUCCI (the Mark) based upon proposed use of the Mark in Canada in association with the following wares: “perfumery namely, perfume, toilet water, scented water, cologne, essential oils, cosmetics namely, body, face and skin moisturizing creams, lotions and milks; leather handbags, imitation leather sold in bulk; trunks for travelling; suitcases, billfolds, wallets, briefcases, umbrellas, parasols, walking sticks, whips, and harness; clothing namely, shirts, dresses, blouses, skirts, trousers, pants, pullovers, coats, T-shirts, sweaters, caps, boots, shoes, wearing belts, blazers, suits, raincoats, stockings, scarves, gloves, slippers, hats and ties” (the Wares). The application includes a disclaimer of the right to the exclusive use of the word TUCCI apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 12, 2006.

[3] On September 12, 2006, Emilio Pucci International BV (the Opponent) filed a statement of opposition claiming that the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark

pursuant to s. 16(3)(a), (b) and (c) of the Act, in view of the fact that the Mark is confusing with the Opponent's trade-mark EMILIO PUCCI (that is registered under Nos. TMA171,229 and TMA663,889 or for which applications for registration bearing Serial Nos. 1,224,940 and 315,425(01) had been filed by the Opponent prior to the date of filing of the Applicant's application) and trade-names EMILIO PUCCI and EMILIO PUCCI INTERNATIONAL B.V., which have been used by the Opponent in Canada prior to the date of filing of the Applicant's application. The statement of opposition also claims that the application does not conform to the requirements of s. 30(e) of the Act.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Pietro Pasotti, Legal Director of Emilio Pucci S.R.L., the exclusive and worldwide licensee of the Opponent, sworn September 26, 2007, as well as certified copies of registration Nos. TMA171,229; TMA269,056; TMA663,889 and application Serial No. 315,425(01) to amend registration No. TMA171,229. In support of its application, the Applicant filed the affidavit of Juan Carlos Areces Garcia, an attorney and legal representative of the Applicant, sworn June 18, 2008 and an English translation thereof filed through the affidavit of Catalina Mora Estevan, a sworn translator for Spanish and English appointed by the Spanish Ministry of Foreign Affairs, sworn June 30, 2008. The Applicant also filed the affidavit of Lynda Palmer, a trade-mark searcher and owner of Lynda Palmer Trade Mark Searching, a company that conducts searches of records of the Canadian Intellectual Property Office (CIPO), sworn May 7, 2008.

[6] Only the Applicant filed a written argument. Both parties attended at an oral hearing.

### 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 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

### Summary of the parties' evidence

#### The Opponent's evidence - the Pasotti affidavit

[8] Mr. Pasotti first goes over the history of the EMILIO PUCCI trade-mark. He states that “the EMILIO PUCCI trade-mark has been created by the renowned Italian designer Marchese Emilio Pucci Di Barsento. Born in 1914, he created his first wearing apparels, namely ski uniforms, in 1935. Mr. Emilio Pucci opened his first boutique in Capri in 1949 and designed his famous ‘Capri pants’. In 1950, he launched his first couture collection” [paragraph 3 of his affidavit].

[9] Mr. Pasotti states that “[b]etween 1950 and up to his death in 1992, Emilio Pucci has created collections which became increasingly popular and well-known throughout the world, not to mention the numerous prizes he received for his creations, among which the Neiman-Marcus Fashion Award in 1954 and 1967” [paragraph 4 of his affidavit].

[10] Mr. Pasotti states that “[a]fter his passing in 1992, his daughter Laudomia Pucci took over and pursued the development of the EMILIO PUCCI trade-mark throughout the world. In the last several years, renowned designers like Julio Espada, Christian Lacroix and now Matthew Williamson have created different clothing items and fashion accessories under the trade-mark EMILIO PUCCI” [paragraph 5 of his affidavit].

[11] Mr. Pasotti then explains how the EMILIO PUCCI trade-mark is used in Canada. He provides as Exhibit A the details of the EMILIO PUCCI trade-mark registrations and application secured by the Opponent with CIPO, which correspond to the certified copies mentioned above filed by the Opponent as part of its evidence [paragraphs 6 and 9 of his affidavit]. I am attaching as Schedule A to my decision a table outlining the particulars of these registrations and

application.

[12] As indicated in Schedule A, application Serial No. 315,425(01) filed on March 15, 2005 to extend the statement of wares of registration No. TMA171,229 matured to registration on September 24, 2008. Application Serial No. 1,224,940, filed on July 27, 2004, matured to registration on May 10, 2006 under No. TMA663,889. I further note that registration No. TMA269,056 referred to by Mr. Pasotti has not been alleged by the Opponent in its statement of opposition. Unless indicated otherwise, I will refer to the trade-marks covered by the three registrations outlined in Schedule A as the EMILIO PUCCI Marks so as to use the same terminology as the one used by Mr. Pasotti in his affidavit. I will make the necessary distinctions when needed.

[13] Mr. Pasotti states that “[t]he Opponent, or its predecessors in title, directly or through its licensees, has been using the EMILIO PUCCI Marks in Canada for a few decades in association with, among other products, wearing apparel for women and fashion accessories. In addition and more recently, the Opponent, directly or through its licensees, has been using the EMILIO PUCCI Marks in Canada in association with, non-exhaustively, perfumes and all kinds of bags” [paragraphs 7 and 8 of his affidavit].

[14] Mr. Pasotti states that “Emilio Pucci S.R.L. is duly licensed to use the EMILIO PUCCI Marks in Canada” and he attaches as Exhibit B, copy of the relevant extracts from the license agreement between the Opponent and Emilio Pucci S.R.L. [paragraph 10 of his affidavit]. I will revert to this point later on in my decision when assessing the extent to which the parties’ marks have become known in Canada under the s. 12(1)(d) ground of opposition.

[15] Mr. Pasotti then provides as Exhibit C samples of labels displaying the EMILIO PUCCI Marks that are sewed on the wearing apparels (identified as “beach wear”, “ready to wear” and “hats, ties, scarves”) and small leather goods, as they are offered for sale in Canada [paragraph 11 of his affidavit]. As pointed out by the Applicant, the copies of sample labels provided do not indicate that the EMILIO PUCCI Marks are used under license, or that the Opponent is the owner of the EMILIO PUCCI Marks. I will revert to this point later on in my decision when

assessing the extent to which the parties' marks have become known in Canada under the s. 12(1)(d) ground of opposition.

[16] Mr. Pasotti states that the products sold under the EMILIO PUCCI Marks in Canada can be found in the following stores: Holt Renfrew, Ogilvy, David's, Winners and Jean-Paul Fortin and he provides as Exhibit D extracts from the websites of some of these stores announcing some of the EMILIO PUCCI products. He also attaches as Exhibit E copies of invoices issued by Emilio Pucci S.R.L. for the sale of products under the EMILIO PUCCI Marks in Canada between 2002 and 2006 and he confirms that the products enumerated on those invoices relate to products commercialized in Canada under the EMILIO PUCCI Marks [paragraphs 12 and 13 of his affidavit]. While these website printouts do refer to EMILIO PUCCI wearing apparel for women and fashion accessories, only one product, shoes, is pictured associated with the EMILIO PUCCI Marks. As pointed out by the Applicant, shoes are not one of the wares claimed in association with any of the EMILIO PUCCI Marks listed in Schedule A. However, the samples of invoices attached as Exhibit E do pertain to various wearing apparel (such as ladies hats, visors, bandanas, scarves, dresses, shirts, t-shirts, trousers, Capri pants, skirts, pullovers, jackets, bikinis, swimsuits, etc.) and small leather goods (such as tote bags, hand bags, shoulder bags, beach bags, camera bags and cosmetic cases made of calf trim leather).

[17] Mr. Pasotti states that "more recently, namely in 2007, the Opponent, in collaboration with Guerlain, launched in many countries around the world, including Canada, a limited edition of cosmetic products commercialized under the name GUERLAIN BY EMILIO PUCCI." He attaches as Exhibit F a copy of a press kit as well as a media coverage report regarding the advertising of said cosmetic products in Canada [paragraph 14 of his affidavit]. I note that the publication includes photographs of the cosmetic products displaying the phrase "GUERLAIN by EMILIO PUCCI" marked on the products. As pointed out by the Applicant, the last page of the publication suggests that it was distributed by "Guerlain Paris". The Opponent is not identified anywhere in the publication. The publication simply refers to "Emilio Pucci" as "*la marque de mode Florentine*" or "*icône intemporelle de la mode*". I will revert to this point below when assessing the nature of the parties' wares and trade under the s. 12(1)(d) ground of opposition.

[18] Mr. Pasotti then provides as Exhibit G printouts extracted from the Opponent's website *www.emiliopucci.com* where its different collections are advertised under the EMILIO PUCCI Marks [paragraph 15 of his affidavit]. As pointed out by the Applicant, no connection to Canada is apparent from Exhibit G. There is no evidence that Canadians have accessed the Opponent's website. Furthermore, while Mr. Pasotti states that this website is operated by the Opponent, the printouts do not identify the Opponent or any other legal entity.

[19] Mr. Pasotti concludes his affidavit by providing his opinion as to the likelihood of confusion between the Mark and the EMILIO PUCCI Marks [paragraph 16 of his affidavit]. I am not prepared to accord weight to this latter statement of Mr. Pasotti, which constitutes inadmissible opinion evidence.

#### The Applicant's evidence

##### The Garcia affidavit

[20] The affidavit of Juan Carlos Areces Garcia is in the Spanish language. As indicated above, the Applicant has provided through the affidavit of Catalina Mora Estevan, a certified English language translation of the Spanish language contents of Mr. Garcia's affidavit [see Exhibit 3 to Ms. Estevan's affidavit]. For the ease of reference, these two affidavits will be collectively referred to as the Garcia affidavit.

[21] Mr. Garcia states that the Applicant "operates the largest chain of department stores in Spain. [It] provides a wide range of wares and retail services at its various locations, including men's and women's fashions, perfumes, cosmetics, sporting goods, electronics, toys, books, infant wear, travel services and products for the home and garden" [paragraph 3 of his affidavit].

[22] Mr. Garcia states that the Applicant "operates stores in most of the main cities in Spain and also operates in Portugal. [The Applicant] has been featured in the publication *Leading Brands of Spain* as Spain's best-known department store and as a 'must-see' place for the 60 million

tourists who visit Spain each year.” Mr. Garcia attaches as Exhibit B a copy of several pages from that publication which includes text in Spanish and English [paragraph 4 of his affidavit]. The last page of Exhibit B highlights the wares and brands sold by the Applicant at its department stores, including wares sold by the Applicant in association with the Mark.

[23] Mr. Garcia states that “the [Mark] originated with a well-known Italian tailor, Mr. Emidio Tucci, who was born on October 31, 1920. ‘Emidio’ was the name of a Saint from Ascoli, Italy. The name ‘Emidio’ is known in Italy but is not a common name outside of Italy” [paragraph 5 of his affidavit].

[24] Mr. Garcia states that “[a]s a tailor, Mr. Emidio Tucci opened his first tailor shop, named EMIDIO TUCCI, in Milan, Italy in 1949. In 1959, Mr. Emidio Tucci joined the SCIC Group in Cremona, Italy as a designer. From 1964 to 1969, Mr. Emidio Tucci was part of the team of designers of D’avenza-Chester Barrie de Avenza in Italy” [paragraph 6 of his affidavit].

[25] Mr. Garcia states that “[f]rom 1949 to 1964, Mr. Emidio Tucci also worked as a design teacher at *Snob di Torino-Accademia Profesional di Taglio* and at *Sartotecnica di Milano*. As a result of his academic and professional achievements in men’s fashion, Mr. Emidio Tucci was awarded the “Cavaliere al Lavoro Della Repubblica Italiana” (Knight of the Country for his working merits) in June, 1971” [paragraph 7 of his affidavit].

[26] Mr. Garcia states that “[i]n 1974, Mr. Emidio Tucci joined the fashion tailoring team of Industrias y Confecciones, S.A. of Spain. Industrias y Confecciones, S.A adopted the [Mark] to promote the wares of Mr. Emidio Tucci” [paragraph 8 of his affidavit].

[27] Mr. Garcia states that “[t]he [Mark] was first used in Spain in association with men’s suits in 1977. The [Mark] has been used by [the Applicant] or its predecessor since 1977 and since that date has been used in association with a wide variety of fashion items, accessories and toiletries for men including suits, trousers, jackets, vests, shirts, sweaters, ties, scarves, silk scarves, belts, suspenders, socks, t-shirts, underclothes, pajamas, shoes, coats, jackets, raincoats, caps, hats, suitcases, briefcases, wallets, cuff links, watches, perfume and cologne” [paragraph 9

of his affidavit].

[28] Mr. Garcia states that Industrias y Confecciones, S.A. assigned the Mark to the Applicant on June 10, 1997 and he attaches as Exhibit C a copy of an assignment document to this effect [paragraph 10 of his affidavit].

[29] Mr. Garcia concludes his affidavit by attaching bundles of documents comprised of certified copies of registrations demonstrating that the Applicant has registered the Mark in Portugal, the United Kingdom and Spain [Exhibit D] and that the Opponent has registered the trade-mark EMILIO PUCCI in the same jurisdictions [Exhibit E] [paragraph 11 of his affidavit]. Although I appreciate the reasons for these statements of Mr. Garcia, it is to be reminded that the Registrar is not bound by the findings made by other jurisdictions because although a mark can be registrable in another country, it may not be registrable in Canada having regard to the applicable legislation and circumstances of the case. I will revert to this point when assessing the additional surrounding circumstances under the s. 12(1)(d) ground of opposition.

#### The Palmer affidavit

[30] Ms. Palmer introduces into evidence the results of searches she conducted on April 30, 2008 of CIPO's records to locate all trade-mark applications and registered trade-marks incorporating the terms and wildcard characters "EM\*IO" or "\*UCCI" with wares or services in International Classes 25, 3, 14 or 24 of the *Nice Classification of Goods and Services* and she attaches as Exhibits A and B the results of her searches.

[31] Ms. Palmer further attaches as Exhibit C copies of printouts from various website pages that she accessed. She states that she found each of the websites from which she obtained the printouts by conducting Internet searches from the website located at *www.google.ca* for the various trade-marks in Exhibits A and B. I will revert to this point when assessing the additional surrounding circumstances under the s. 12(1)(d) ground of opposition.



### Analysis of the grounds of opposition

[32] As I consider the s. 12(1)(d) ground of opposition to present the Opponent's strongest case, I will assess that ground first.

#### Section 12(1)(d) ground of opposition

[33] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark EMILIO PUCCI registered under Nos. TMA171,229 and TMA663,889 (hereinafter collectively referred to as the EMILIO PUCCI word mark).

[34] I have exercised the Registrar's discretion to review the register of trade-marks and confirm the details of these two registrations. As they are extant, the Opponent's evidentiary burden has been satisfied.

[35] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's EMILIO PUCCI word mark. The material date to assess this issue is the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[36] 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.

[37] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 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 wares, 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; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) (*Veuve Clicquot*) for a thorough discussion of the general principles that govern the test for confusion].

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

[38] As evidenced by the Pasotti and Garcia affidavits, the parties' marks both originate from Italian fashion designers. They both consist of the personal names of their respective designers. The Pasotti affidavit is to the effect that Mr. Emilio Pucci passed away in 1992. There is no indication that Mr. Emidio Tucci is still living today or that he would have passed away; this point has not been addressed in the Garcia affidavit nor questioned by the Opponent.

[39] It is fair to say that both marks would be perceived by the average consumer as the name of an individual. That being so, and relying on authority to the effect that trade-marks dependant on personal and surname significance have little inherent distinctiveness, I consider the parties' marks to be inherently weak. I wish to reproduce on this point the following passage from Joliffe and Gill, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed., Carswell, at p. 8-27:

Marks that have no inherent distinctiveness deserve the smallest ambit of protection. As such, geographic locations, personal and surnames, initials, descriptive terms, common prefixes, common symbols and even registered marks that have become generic are not inherently distinctive and should generally not be accorded a broad ambit of protection.

[40] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is no evidence that the Applicant's proposed use Mark has been used in Canada or that it has become known to any extent whatsoever in Canada. The mere fact that the

Applicant has been featured in the publication *Leading Brands of Spain* as Spain's best-known chain of department stores and a "must-see" place for tourists does not lead to an inference that the wares and brands sold by the Applicant within its department stores, including the wares sold by the Applicant in association with the Mark, have become known to Canadians. Furthermore, while Mr. Garcia states in his affidavit that Mr. Emidio Tucci is a well-known Italian designer, the extent of his fame, particularly in Canada, has not been shown. Accordingly, I must conclude that the Mark has not become known at all in Canada.

[41] Turning to the Opponent's evidence of use of the EMILIO PUCCI word mark in Canada, I wish to address first the Applicant's argument that the evidence of record falls short of establishing that such use accrues to the benefit of the Opponent pursuant to s. 50 of the Act.

[42] I agree with the Applicant's contention that the Opponent cannot claim the benefit of s. 50(2) of the Act as none of the exhibits attached to the Pasotti affidavit gives public notice of the fact that the use of the EMILIO PUCCI Marks is a licensed use and of the identity of the owner of the marks. However, in view of the exclusive and worldwide license agreement entered into between the Opponent and Emilio Pucci S.R.L., I disagree with the Applicant's contention that the Opponent cannot claim the benefit of s. 50(1) of the Act. The license agreement attached as Exhibit B to the Pasotti affidavit includes at s. 5 a provision entitled "Quality Control" that expressly provides that the Opponent has control of the character and quality of the wares designed, manufactured, marketed, distributed and sold by Emilio Pucci S.R.L. and any of its sublicensees. The license agreement also provides at s. 2 that all uses of the EMILIO PUCCI Marks by Emilio Pucci S.R.L. shall inure to the benefit of the Opponent as licensor and that licensee agrees not to misuse or alter the EMILIO PUCCI Marks in any manner whatsoever. I can find no basis on which to conclude that the quality control provisions set out in the license agreement are not being implemented by the Opponent. There is no evidence establishing that the Opponent did not exercise, either directly or indirectly, control over the character or quality of the wares. Furthermore, Mr. Pasotti's affidavit testimony has not been challenged by cross-examination.

[43] That said, the fact remains that the Pasotti affidavit does not provide much guidance as to

the extent to which the EMILIO PUCCI word mark has become known in Canada. While I am satisfied from a fair reading of the Pasotti affidavit and accompanying exhibits that the EMILIO PUCCI word mark has been used in Canada for a considerable length of time, no sales or marketing figures are provided. Accordingly, I can only conclude that the EMILIO PUCCI word mark has become known to some extent in Canada.

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

[44] As indicated above, there is no evidence that the Applicant's proposed Mark has been used in Canada. By comparison, while the Opponent's evidence does not establish continuous use of the EMILIO PUCCI word mark with each of the wares described in the Opponent's registrations since the very first dates of use claimed therein, it does evidence use of the EMILIO PUCCI word mark in association with various wearing apparel and small leather goods over the last decade at least.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[45] When considering the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[46] The Applicant submits that the following wares are not claimed in association with any of the EMILIO PUCCI Marks: "cosmetics namely, body, face and skin moisturizing creams, lotions and milks; walking sticks, whips, and harness; caps, boots, shoes, slippers, wearing belts,

scarves, gloves and ties”. The Applicant submits that the Opponent has provided no evidence that the EMILIO PUCCI Marks have been associated with these wares or that the EMILIO PUCCI Marks are so distinctive that a consumer would assume that the Opponent is expanding the line of wares for which it allegedly uses the EMILIO PUCCI Marks. I note that contrary to the Applicant’s submission, the Opponent’s registration No. TMA171,229 includes “ladies’ scarves”, which is included in the Applicant’s statement of wares that makes no distinction between ladies’ and men’s scarves.

[47] The Applicant further submits that the wares “perfumes” are only claimed by the Opponent in association with the trade-mark EMILIO PUCCI Design (Registration No. TMA269,056) which is not alleged in the statement of opposition to be confusing with the Mark. Consequently, the Applicant submits that the wares “perfumery namely, perfume, toilet water, scented water, cologne, essential oils” do not overlap with the wares of the EMILIO PUCCI word mark.

[48] As to the parties’ channels of trade, the Applicant submits that the Applicant is a large scale department store chain with operations in Spain and Portugal and products spanning a wide range of wares and retail services. The Applicant would likely place the Wares associated with the Mark in channels of trade familiar to its large scale department store industry. By comparison, the Applicant submits that the Opponent employs “renowned designers” to create different clothing items and fashion accessories. The Opponent’s wares are distributed to various clothing and fashion retailers. The Opponent operates more closely with the high fashion industry than the industry of large scale department stores.

[49] The Opponent submits for its part that except for the wares falling into the categories of perfumery and cosmetics, the entirety of the Applicant’s Wares are encompassed by the statements of wares covered by the Opponent’s EMILIO PUCCI word mark registrations. As for the wares falling into the categories of perfumery and cosmetics, the Opponent, relying on the decisions of this Board in *Charles of the Ritz Group Ltd. v. The Ritz Hotel Ltd.* (1985), 6 C.P.R. (3d) 483 at 486 and 487 and *Oscar de la Renta Ltd. v. Arto Inc.* (1986), 14 C.P.R. (3d) 37 at 40, submits that there is a close relationship between such wares and the Opponent’s wares, which are all part of the fashion industry, as further evidenced by Exhibit F to the Pasotti affidavit

showing the collaboration between “Guerlain Paris” and “EMILIO PUCCI” in the launching of a limited edition of cosmetic products commercialized under the name “GUERLAIN BY EMILIO PUCCI”.

[50] The Opponent further submits that neither of the parties’ statements of wares is restricted to particular channels of trade. The nature of the parties’ trades is the same or very similar. The Opponent, relying on the decisions *Valint N.V. v Mario Valentino S.p.A.* (1999), 4 C.P.R. (4th) 1 (F.C.T.D.) at paragraphs 42 to 44 and *Bluedot Jeanswear Co. v. 9013-0501 Québec Inc.* (2004), 31 C.P.R. (4th) 361 (F.C.) at paragraph 19, submits that it makes no difference that the Opponent’s wares are offered for sale in high end niches, as they can also be sold in large scale department stores, as evidenced by the invoices attached as Exhibit E to the Pasotti affidavit showing sales of the EMILIO PUCCI various wearing apparel and small leather goods to Winners stores.

[51] It is not necessary that the parties operate in the same general field or industry or that the respective wares be of the same type or quality for there to be a likelihood of confusion. As stated in s. 6(2) of the Act, confusion may occur “whether or not the wares or services are of the same general class”. In the present case, I agree with the Opponent that the Applicant’s wares identified as “leather handbags, imitation leather sold in bulk; trunks for travelling; suitcases, billfolds, wallets, briefcases, umbrellas, parasols; clothing namely, shirts, dresses, blouses, skirts, trousers, pants, pullovers, coats, T-shirts, sweaters, blazers, suits, raincoats, stockings, scarves” are either identical or closely related to those covered by the Opponent’s EMILIO PUCCI word mark registrations. It further seems not unlikely that they could be sold through the same or similar retail outlets as those of the Opponent’s.

[52] Likewise, relying on the decisions of this Board in *Daniel Hechter v. China National Light Industrial Products Import & Export Corp.* (1990), 29 C.P.R. (3d) 352 at 356 and *Eber San Francisco v. Irmaos Pedro Ltda* (1986), 9 C.P.R. (3d) 141 at 144, it is fair to say that there is some similarity in the nature of the Applicant’s “caps, boots, shoes, slippers, wearing belts, gloves and ties” and the Opponent’s clothing as associated with the EMILIO PUCCI word mark registrations and that these wares would travel through similar channels of trade. Wearing belts, gloves and ties in particular are articles of clothing. It is to be noted that the Applicant itself has

precisely included the wares “caps, boots, shoes, slippers, wearing belts, gloves and ties” within the category of “clothing, namely [...]” in its statement of wares. The Pasotti affidavit further evidences that the EMILIO PUCCI Marks are used in association with ladies’ hats and shoes. While such wares are not expressly covered by the Opponent’s EMILIO PUCCI word mark registrations, I find such use is illustrative of the complementarities existing between different kinds of articles of clothing and footwear.

[53] As for the Applicant’s wares falling into the categories of “perfumery” and “cosmetics”, they are intrinsically different from those covered by the Opponent’s EMILIO PUCCI word mark registrations. The Opponent’s submission that perfumery and cosmetic products are all part of the fashion industry must be qualified in view of the decision in *S.C. Johnson & Son, Inc. v. Esprit de Corp et al* (1986), 13 C.P.R. (3d) 235 (F.C.T.D.) (*Esprit*), which allowed the appeal made by the applicant (appellant) against the Registrar’s decision who had held that the applicant’s proposed trade-mark ESPRIT for personal care products was not registrable because it was confusing with each of the opponent’s (respondent’s) trade-marks ESPRIT and ESPRIT DE CORP previously used and registered in relation to clothing. I wish to reproduce on this point the following comments of Mr. Justice Cullen, whose reproduction, though lengthy, is necessary to fully appreciate the principles that have guided me in the present case:

[p. 245] It is conceded by the applicant that clothing and cosmetics are closely associated in the top echelon or high fashion level where the same designer trade marks are used on wares from both industries. This type of trade mark used in both industries is a "designer" or "signature" mark containing the personal name of a well-known clothing designer. Most Canadian consumers are familiar with the names Pierre Cardin, Yves Saint Laurent, Givenchy, Ralph Lauren, to name but a few.

The appellant states: "these 'designer' or 'signature' marks are not only applied to fragrances and cosmetic products, but to all kinds of clothing accessories such as jewellery, shoes, belts, furs and to other wares such as chocolates, car interiors, wallpaper and household furnishings and accessories". I agree. It seems to me obvious that any person or corporation seeking a trade mark on any ware of any class using one of these "designer" or "signature" marks could not expect to succeed. I believe counsel for the applicant suggested they might event be charged with fraud, so distinctive is the “signature” or “designer” mark.

Similarly, any attempt to secure a trade mark for any wares using a strong trade mark like KODAK would be bound to fail [...].

[p. 248] In my view, the registrar erred when he felt he could take "judicial notice" of the alleged fact that cosmetics and clothing are both part of what he called the fashion industry, and then did not define fashion industry. The unquestioned expert Marina Sturdza states in her affidavits:

The clothing industry and cosmetic industry (which I define here to include fragrance, cosmetic, treatment, bath and hair care products) are not closely associated. The goods of the two industries are almost invariably produced by different non-related manufacturers and are wholesaled and marketed by different representatives using totally different sales and promotional tactics. Moreover the goods of each industry are generally retained in different stores, or in the case of department and specialty stores, at least in different departments or different locations in the same store. In addition the products

[p. 249] of the two industries fall under separate merchandising categories and are almost invariably purchased by different merchandise managers, purchasing agents or store buyers.

She elaborates on the use of "designer" or "signature" trade marks which are used in both clothing and cosmetics, and explains that the marks constitute the personal names of well-known clothing designers and have an inherently distinctive nature embodying the personal reputation of the designers. [...]

I cannot find that the respondent with its use of the trade mark ESPRIT DE CORP is inherently distinctive. As Ms. Sturdza states, "The Esprit line is not a fashion leader, nor do its designs have any directional influence on the clothing industry." and "Non-designer trade marks of the nature of the respondent's ESPRIT DE CORP are generally not used to identify high fashion clothing goods because they do not possess the type of personal goodwill, reputation or cachet that individual designers create for their fashion products" and which make their personal names transportable to all nature of fashion items.

[54] The connection between the trades of the parties in this opposition is evidenced by Exhibit F to the Pasotti affidavit pertaining to the launching of a limited edition of cosmetic products under the name "GUERLAIN BY EMILIO PUCCI". While such exhibit does not evidence use of the EMILIO PUCCI Marks *per se* accruing to the benefit of the Opponent, it does illustrate Mr. Justice Cullen's comments above concerning the practice of applying a particular fashion designer's name to a wide variety of wares, including perfumery and cosmetic products. The certified copy of the Opponent's registration No. TMA269,056 based upon use of the EMILIO PUCCI Design mark in Canada in association with perfumes, combined with Mr. Pasotti's sworn statement of use of the EMILIO PUCCI Marks in Canada in association with perfumes further tend to evidence such a link. As such, the sale of perfumery and cosmetic products may be



considered a natural extension of the Opponent's various wearing apparel and small leather goods offered for sale in Canada.

[55] This brings me to consider the Applicant's wares described as "walking sticks, whips, and harness". In view of Mr. Justice Cullen's comments above, the fact that these wares are not listed specifically in the Opponent's EMILIO PUCCI word mark registrations is not by itself determinative. I am not prepared to find, as the Opponent wishes me to do, that such wares are encompassed by the statements of wares covered by the Opponent's registrations. However, the very fact that the Applicant wishes to register the Mark in association with such wares together with the other categories of wares discussed above, supports the Opponent's contention that these wares may be associated with a fashion designer's mark. It further illustrates the variety of wares in association with which trade-marks consisting of the personal names of fashion designers are transportable.

(e) The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[56] The Applicant submits that the EMILIO PUCCI word mark is a weak mark which can be distinguished from the Mark by a consumer having an imperfect recollection. More particularly, the EMILIO PUCCI word mark has small but obvious differences from the Mark EMIDIO TUCCI: the "D" replaces the "L" in "EMILIO" and the "T" replaces "P" in "PUCCI". Given the lack of distinctiveness of the EMILIO PUCCI word mark, the Applicant submits that these small differences distinguish the trade-marks, especially for a consumer who is accustomed to distinguishing similar marks in association with similar wares.

[57] The Opponent submits for its part that the parties' marks are strikingly similar. They look the same to the eye. They sound the same. They have a similar connotation in that both are Italian-sounding personal names.

[58] As indicated above, it is well-established by the jurisprudence that the likelihood of confusion is a matter of first impression and imperfect recollection. This principle has been reiterated by the Supreme Court in *Veuve Clicquot* as follows:

20 The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name *Clicquot* on the respondents' storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks. As stated by Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* (1968), [1969] S.C.R. 192 (S.C.C.), at p. 202:

It is no doubt true that if one examines both marks carefully, he will readily distinguish them. However, this is not the basis on which one should decide whether there is any likelihood of confusion.

...the marks will not normally be seen side by side and [the Court must] guard against the danger that a person seeing the new mark may think that it is the same as one he has seen before, or even that it is a new or associated mark of the proprietor of the former mark. (Citing in part *Halsbury's Laws of England*, 3<sup>rd</sup> ed., vol. 38, para. 989, at p. 590.)

[59] Applying these principles to the present case, I agree with the Opponent that there is a high degree of resemblance between the parties' marks in appearance, sound and in the ideas suggested by the marks. They share strong similarities in that they are identical except for two letters (i.e. EMILIO P<sup>U</sup>CCI v. EMIDIO T<sup>U</sup>CCI). They share the same structure in that they both consist of a four-syllable word followed by a two syllable word and have the same number of letters. They have a similar connotation in that they are Italian-sounding personal names. While it is true that the marks are not identical and can be distinguished when carefully examined side by side, the test to be applied is that of the first impression in the mind of a potential consumer somewhat in a hurry who sees the Mark on the Applicant's Wares, at a time when he or she has no more than an imperfect recollection of the EMILIO P<sup>U</sup>CCI word mark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Additional surrounding circumstances

State of the register evidence

[60] The Applicant submits that evidence of the state of CIPO trade-marks register combined with evidence of use in the Canadian marketplace can suggest that consumers are accustomed to making fine distinctions between various trade-marks by paying more attention to the small differences between the marks.

[61] More particularly, the Applicant submits that the Palmer affidavit evidences that there are at least 12 trade-marks that have been registered by other parties at various times over the last 20 years and are still active today that start with “EM” and end with “IO” or “UCCI”, namely ROBERTO CAPPUCCI (TMA306,020); MARIO PUCCI CECCIONI Design (TMA300,841); CARLO COLUCCI Design (TMA327,849); RENATO NUCCI & Design (TMA375,089); SESTO MEUCCI (TMA395,763); EMILIO ROBBA Design (TMA432,136); SIGNOR PASCUCCI (TMA457,525); MARISA MINICUCCI Design (TMA448,061); BACCO BUCCI (TMA612,237); CARLO COLLUCI (TMA617,842); EMILIO CAVALLINI (TMA629,380) and CARLO COLLUCI (TMA654,274).

[62] The Applicant further submits that Exhibit C to the Palmer affidavit evidences that each of the above third party trade-marks are used in the marketplace given that they are shown in association with websites of stores having Canadian retail locations.

[63] The Opponent submits for its part that the above state of the register evidence and alleged state of the marketplace evidence is of little assistance to the Applicant’s case given that none of these third party trade-marks is as close to the Opponent’s EMILIO PUCCI word mark as is the Applicant’s Mark. I agree. Thus, even if I were to acknowledge that Canadians are accustomed to seeing Italian-sounding personal names used as trade-marks, it does not necessarily follow that they are accustomed to making fine distinctions between very close trade-marks.

### Coexistence of the parties' marks

[64] As per my review of the Garcia affidavit, the Applicant submits that the parties' marks coexist on trade-marks registers in Portugal, the United Kingdom and Spain. However, as stressed by the Opponent, the fact that the marks may coexist on foreign trade-marks registers is not binding upon the Registrar. It is worth referring to the following observation from this Board in *Quantum Instruments Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264 (*Quantum*):

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted ... in *Re Haw Par...*, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions ... the Registrar must base [the] decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* ... [the court] pointed out that 'no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure.' Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding. [my emphasis]

[65] As in the *Quantum* case, no evidence has been adduced of the coexistence of the trade-marks at issue in the marketplace, be it in Canada or in any other country.

[66] Furthermore, as noted by the Opponent at the oral hearing, if I were to give consideration to the fact that the parties' marks coexist on the trade-marks registers in Portugal, the United Kingdom and Spain, I should give the same consideration to the fact that the Opponent has successfully opposed the Applicant's applications for registration of two stylised versions of the Mark before the United States Patent & Trademark Office (USPTO), as per copy of the decision dated April 1, 2010 issued by the USPTO in opposition Nos. 91169638 and 91177724 that was submitted as part of the Opponent's list of authorities in the present case. For the reasons outlined above in the *Quantum* case, it is unnecessary to comment further on this latter decision of the USPTO as well as the coexistence of the parties' marks on foreign trade-marks registers.

### Conclusion regarding the likelihood of confusion

[67] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[68] As per my comments above, the parties' marks are inherently weak and not entitled to a broad ambit of protection. However, transposing Mr. Justice Cullen's comments in the *Esprit* decision to the present case, I believe it is fair to say that the parties' marks, which both consist of the personal names of fashion designers, are associated with either identical or closely associated wares in the high fashion level that are likely to travel through the same or similar channels of trade.

[69] While the Opponent's evidence with respect to the use of the EMILIO PUCCI word mark in association with perfumery and cosmetic products is tenuous, I find it raises sufficient doubts as to the likelihood of confusion in respect of the Applicant's wares falling into the categories of perfumery and cosmetics, as such wares could be considered a natural extension of the Opponent's various wearing apparel and small leather goods offered for sale in Canada.

[70] As per my findings above, the parties' marks are strikingly similar. While the Opponent's EMILIO PUCCI word mark may only deserve a narrow scope of protection, I find that the Applicant has not met its legal onus to show that it is not reasonably likely that an individual who has an imperfect recollection of the Opponent's EMILIO PUCCI word mark as applied to the various wares covered by the Opponent's word mark registrations, would not, as a matter of first impression and imperfect recollection conclude that the Applicant's Wares share a common source.

[71] Accordingly, the s. 12(1)(d) ground of opposition succeeds.

### Section 30(e) ground of opposition

[72] The Opponent has pleaded that the application does not comply with the requirements of s. 30(e) of the Act in that the Applicant never intended to use the Mark in Canada. The material date that applies to this ground of opposition is the date the application was filed.

[73] Since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada, it formally complies with s. 30(e). Based on the evidence in the record, I am unable to conclude that the Applicant did not truly intend to use the Mark when it filed its application. Accordingly, the s. 30(e) ground of opposition is dismissed on the basis that the Opponent has not met its initial burden.

### Remaining grounds of opposition

[74] As indicated above, the non-distinctiveness and non-entitlement grounds of opposition essentially turn on the issue of confusion between the Mark and the Opponent's EMILIO PUCCI word mark. The Opponent's evidentiary burden as well as the material dates with respect to these remaining grounds of opposition differ from the ones under the s. 12(1)(d) ground of opposition. As I consider the issue of the likelihood of confusion to be strongest with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, and as I have already found in favour of the Opponent under that ground, I will not address the remaining grounds of opposition.

### Disposition


[75] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the

Act, I refuse the application pursuant to s. 38(8) of the Act.

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

SCHEDULE A

Trade-mark	Reg. No & Reg. Date	Wares & Dates of first use
1) EMILIO PUCCI	TMA171,229 Sept. 18, 1970	<p>(1) Ladies' clothing, namely dresses [sic], skirts, shirts, shifts, chemises, shorts, pants, suits, coats, bathing suits; fur pieces, coats, jackets and stoles, evening capes, raincoats, hosiery, sweaters and scarves. (2) Eyeglasses, sunglasses, spectacles cases, cameras.</p> <p>The right to the exclusive use of the word PUCCI is disclaimed apart from the trade-mark on wares (2).</p> <p>Used in CANADA since at least as early as 1952 on wares (1). Declaration of use filed on August 28, 2008 with wares (2).</p> <p>Used in ITALY on wares (1). Registered in or for ITALY on September 22, 1966 under No. 181829 on wares (1).</p> <p>Registrability Recognized under Section 14 of the Trade-marks Act on wares (1).</p> <p>The wares (2) were added on September 24, 2008 following application Serial No. 315,425(01) filed on March 15, 2005 to extend the statement of wares of registration No. TMA171,229.</p>
<p>2)</p> 	TMA269,056 May 14, 1982	<p>(1) Perfumes. (2) Shoulder bags, handbags, travelling bags, suitcases, purses, wallets and umbrellas. (3) Wine. (4) Eyeglasses, frames and cases for eyeglasses.</p> <p>Used in CANADA since at least 1970 on wares (1). Used in CANADA since April 1975 on wares (2). Used in CANADA since August 1976 on wares (3). Declaration of Use filed March 12, 1982 on wares (4).</p> <p>Consent to the use of EMILIO PUCCI's signature is of record.</p> <p>The right to the exclusive use of the words EMILIO PUCCI is disclaimed apart from the trade-mark.</p>
3) EMILIO PUCCI	TMA663,889 May 10, 2006 (resulting from Appl. No. 1,224,940 filed on July 27, 2004)	<p>Leather and imitations of leather; travelling bags, travelling sets (leatherware), trunks and valises, garment bags for travel, vanity-cases (not fitted), rucksacks, shoulder bags, handbags, attaché-cases, briefcases, pouches, pocket wallets, purses, key-holders, card holders; umbrellas.</p> <p>Used since as early as December 31, 1980</p>