

IN THE MATTER OF AN OPPOSITION by
Yves Saint Laurent International B. V. to
application No. 706,526 for the mark YVES ST.
CLAIR DESIGN filed by Sport Collection Paris Inc.

On June 5, 1992, Sport Collection Paris Inc. filed an application to register the trade-mark YVES ST. CLAIR DESIGN based on use of the mark in Canada since February 1992 in association with

ladies', misses', juniors' and girls' blouses, shirts and tops

and based on proposed use of the mark in Canada in association with

ladies', misses', juniors' and girls' dresses, pantsuits, pant-dresses, dusters, house-coats, jerseys, skirts, pyjamas, jackets, blazers, sweaters, vests, jodhpurs, shorts, jumpers and culottes.

The applicant subsequently disclaimed the right to the exclusive use of the component ST. CLAIR apart from the mark as a whole. The subject application was advertised for opposition purposes in the Trade-marks Journal of June 30, 1993 after the applicant had overcome an objection at the examination stage that its mark was confusing with the registered mark SAINT-CLAIR & Design also covering clothing.

Yves Saint Laurent International B. V. filed a statement of opposition on August 30, 1993, a copy of which was forwarded to the applicant on October 28, 1993. The grounds of opposition are reproduced below. The applicant responded by filing and serving a counter statement.

The applied for mark and the opponent's design mark are shown below:

The opponent's evidence consists of the affidavits of Laurent Levasseur, C.E.O. of Yves Saint Laurent of America, and Todd D. Bailey, student at law. The applicant's evidence consists of the affidavit of Phil Cohen, V.P. of the applicant company. Both parties filed a written argument, however, neither party requested an oral hearing.

The first ground of opposition pursuant, to Section 12(1)(d), alleges that the applied for mark YVES ST. CLAIR is not registrable because it is confusing with one, or both, of the opponent's registered marks YVES SAINT LAURENT and YVES SAINT LAURENT & Design covering various items of clothing. The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision: see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (TMOB). I will refer to both of the opponent's marks simply as YVES SAINT LAURENT and I will refer to the applied for mark simply as YVES ST. CLAIR.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark YVES ST. CLAIR and the opponent's mark YVES SAINT LAURENT . The presence of an 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: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or

sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (March 12, 1996, T-1530-94, yet unreported).

The opponent's mark YVES SAINT LAURENT possesses little inherent distinctiveness since it is the name of a person; similarly, the mark YVES ST. CLAIR possesses little inherent distinctiveness because it too would be perceived as the name of a person. The opponent's mark YVES SAINT LAURENT has acquired a fairly significant reputation in Canada by virtue of sales of clothing and clothing accessories under the mark amounting to about \$22 million for the period 1988-1993 inclusive. Advertising and promotion for clothing and accessories sold under the opponent's mark for the same period was about \$750,000. Further, the opponent's evidence illustrates references to the individual Yves Saint Laurent in various publications circulated in Canada. Thus, Mr. Saint Laurent has acquired a significant reputation in Canada as a leading fashion designer living and working in Paris, France. His personal reputation further augments the distinctiveness acquired by the mark YVES SAINT LAURENT. In view of the above, the opponent's mark is entitled to a fairly broad ambit of protection. The applied for mark YVES ST. CLAIR has acquired some reputation in Canada as a result of sales under the mark amounting to \$2 million for the period 1992-1994 inclusive.

The opponent has been using its mark YVES SAINT LAURENT in Canada since at least as early as 1985 (see paragraph 5 of Mr. Levasseur's affidavit). Thus, the length of time that the marks have been in use favours the opponent. The parties' wares are the same or closely related and, despite Mr. Cohen's assertions to the contrary, I must

consider that the parties' wares would travel through the same or overlapping channels of trade (even if there was no evidence of the parties' actual channels of trade). In this regard, the applicant has not restricted its trade-mark application to any particular channel of trade and neither has the opponent in its trade-marks registrations. It is the application and registrations that govern considerations under Section 6(5) of the Act. In other words, I am obliged to consider whether confusion would be likely if the applicant and opponent were to operate in any way open to them: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). In any event, in the instant case, Mr. Cohen's evidence is that the applicant sells clothing "bearing the YVES ST. CLAIR DESIGN trade-mark primarily to stores such as Reitmans, Lindor, The Bay and Eatons" while Mr. Levasseur's evidence is that the opponent sells clothing under its mark YVES SAINT LAURENT through various retail outlets including Eatons and The Bay.

Mr. Cohen (at paragraph 10 of his affidavit) attempts to distinguish his clothing from the opponent's on the basis that

However, I am not permitted to recognize a distinction between goods of the same general class in which price is the main distinguishing feature: see *Bagagerie SA v. Bagagerie Willy Ltée* (1992), 45 C.P.R. (3d) 503 at 509-510 (F.C.A.). In any event, the

opponent's evidence illustrates that the opponent also deals in clothing which would be described as popularly priced.

The parties' marks resemble each other visually and aurally to the extent that they both begin with the component YVES followed by the component SAINT or its abbreviation ST. However, it is the first part of a mark which is the more important for the purpose of distinction: see *Conde Naste Inc. v. Union Des Editions Modernes* (1979), 46 C.P.R.(2d) 183 (F.C.T.D.). The idea suggested by the opponent's mark is the fashion designer Yves Saint Laurent while the idea suggested by the applicant's mark is the name of a fictitious person.

At page 7 of its written argument, the applicant points to contemporaneous use of the parties' marks during the period 1992-1994:

Of course, the opponent is under no obligation to adduce evidence of actual confusion and the absence of such evidence does not necessarily raise any presumptions unfavourable to the opponent nor is it determinative of the issue of confusion. For example, in *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.), the Court found that the defendant's marks MR. SUBS'N PIZZA and MR. 29 MIN. SUBS'N PIZZA were confusing with the plaintiff's mark MR. SUBMARINE although there was no evidence of actual confusion despite 10 years of contemporaneous use in the area of Dartmouth. The absence of evidence of actual confusion is of course

one circumstance among the many to be considered.

Another surrounding circumstance raised by the applicant is that the mark YVES ST. CLAIR (owned by a third party) for ladies' blouses and tops has been on the United States trade-mark register since 1989 without being challenged by the opponent.

However, this circumstance in isolation does nothing to advance the applicant's case.

I have also taken note of the following quotation (which originates from a United States case) referred to approvingly in *Source Perrier (Societe Anonyme) v. Canada Dry Ltd.* (1982), 64 C.P.R.(2d) 116 at 121(Ont. H.C.):

Another factor that I have taken into consideration is that the applicant's invoices (to retailers) show the applicant's corporate name as illustrated below, thereby suggesting a connection between the applicant's wares sold under the mark YVES ST. CLAIR and a clothing collection originating in Paris, France.

In view of all of the circumstances and considerations discussed above, I find that the applied for mark is confusing with the opponent's mark. The factors which weighed most in my decision were the fame of the individual Yves Saint Laurent, the acquired distinctiveness of the mark YVES SAINT LAURENT, and that the applicant has

incorporated the similar prefix YVES ST. for its mark.

The applicant's application is therefore refused.

DATED AT HULL, QUEBEC, THIS 17 DAY OF OCTOBER, 1996.

Myer Herzig,
Member,
Trade-marks Opposition Board