

IN THE MATTER OF AN OPPOSITION
by Commerciale Abbigliamento S.p.A.
to application No. 571,651 for the
trade-mark BABY BLUES filed by
Bi-Way Stores Limited

On October 24, 1986, the applicant, Bi-Way Stores Limited, filed an application to register the trade-mark BABY BLUES based on proposed use in Canada for "girls' clothing, namely, pants, jeans, blouses and fleece tops." The application was advertised for opposition purposes on April 22, 1987.

The opponent, Commerciale Abbigliamento S.p.A., filed a statement of opposition on May 19, 1987, a copy of which was forwarded to the applicant on June 11, 1987. The grounds of opposition are that the applied for trade-mark is not registrable and is not distinctive and the applicant is not the person entitled to registration because the applied for trade-mark is confusing with the opponent's previously used trade-mark I BLUES registered under No. 267,680 for "clothing for women, namely blouses, belts, sweaters and skirts."

The applicant filed and served a counterstatement. As its evidence, the opponent filed the affidavit of Guido Rami. The applicant filed the affidavit of Linda Elford. Both parties filed written arguments but no oral hearing was conducted.

The opponent's first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's registered trade-mark I BLUES. The material time for considering the circumstances respecting this issue is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. 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 marks of both parties are inherently distinctive, neither having any obvious suggestion or connotation relating to the associated wares. There is no evidence of use of the applicant's mark and I must therefore conclude that it had not become known at all in Canada as of the material time. The Rami affidavit evidences continuous (albeit minor) use of the opponent's mark in Canada from 1980 on. Based on that evidence, I am able to conclude that the opponent's mark had become known to a very limited extent in several Canadian cities.

The length of time the marks have been in use favors the opponent. The wares of the parties are similar and presumably the trades would also be similar. The applicant speculates in its written argument that the opponent's trade consists of fashion boutiques selling expensive clothing. The applicant also submits that its trade consists of discount stores selling inexpensive goods. However, there is no evidence to substantiate either assertion. More importantly, neither the opponent's statement of wares in its registration nor the applicant's statement of wares in its application are restricted to wares of a particular price range or to wares sold only through a certain type of

establishment. In this regard, reference may be made to the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.).

As for Section 6(5) (e) of the Act, the marks of the parties bear a fair degree of visual and phonetic resemblance, primarily due to the common use of the word BLUES as the second component of each mark. To the extent that both marks include the word BLUES, there is some resemblance in the ideas suggested insofar as that word describes a state of melancholy or a type of music. However, the applicant's mark BABY BLUES, in its entirety, comprises a colloquial phrase referring to eyes. Thus, the degree of resemblance between the marks with respect to the ideas suggested is less marked.

It is the applicant's contention that the effect of the foregoing is mitigated substantially by the common adoption by other traders of similar marks for clothing. In support of this position, the applicant has relied on the Elford affidavit which lists the results of a state of the trade-marks register search respecting registrations for trade-marks including the word BLUE where the registrations cover clothing items. Appended to the Elford affidavit are certified copies of seventeen such registrations.

In view of the above, I am able to conclude that at least some of those seventeen registered marks are in use. Thus, Canadian consumers would be somewhat accustomed to seeing such marks used for clothing and would, to some extent, distinguish such marks on the basis of their other components. Such a conclusion, however, is of less note in the present case for two reasons. First, all but three of the seventeen registrations located by Ms. Elford are for trade-marks commencing with the word BLUE whereas the two marks at issue end with the word BLUES. Second, and more importantly, none of the marks located by Ms. Elford include the word BLUES. In the absence of additional evidence, I must conclude that the opponent's mark is the only one which includes the word BLUES registered for clothing items.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have further considered the similarities (or potential similarities) between the wares and trades of the parties. I have also considered the fair degree of resemblance between the marks which has, in my view, only been mitigated to a minor extent by the applicant's state of the register evidence. Finally, I have considered that the applicant's application is based on proposed use and that it would be a relatively easy matter for the applicant to commit itself to a different mark. On balance, I remain in doubt as to whether or not the marks are confusing. However, since the onus is on the applicant, I must resolve my doubt against it and find the first ground of opposition to be successful. The remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF October, 1990.

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