

IN THE MATTER OF AN OPPOSITION by Nygard International
Ltd. to application No. 537,119 for the trade-mark NERO-BIANCO
filed by Jean-Luc Transon

On February 25, 1985, the applicant, Jean-Luc Transon, filed an application to register the trade-mark NERO-BIANCO based upon proposed use of the trade-mark in Canada in association with the following wares:

"vêtements pour enfants, pour hommes et pour femmes nommément pantalons, jeans, chemises, chandails, gilets, t-shirts, vestes, robes, jupes, blouses, chemisiers, chapeaux, casquettes, manteaux, foulards, bas, chaussettes, sous-vêtements, souliers et bottes"

and in association with the following services:

"services de magasin de vente au détail de vêtements pour enfants, pour hommes et pour femmes y compris les souliers et les bottes"

The opponent, Nygard International Ltd., filed a statement of opposition on June 23, 1986 in which it alleged that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-marks BIANCA, registration No. 233,485 and BIANCA NYGARD, registration No. 271,251. The opponent also challenged the applicant's entitlement to registration of the trade-mark NERO-BIANCO, alleging that the applicant's trade-mark is confusing with the opponent's registered trade-marks BIANCA (registration No. 233,485), BIANCA NYGARD Design (registration No. 271,251), BIANCA NYGARD Design (registration No. 311,672), BIANCA NYGARD & Design (registration No. 311,673), BIANCA Design (registration No. 311,674) and BIANCA NYGARD & Design (registration No. 311,676) as previously used in Canada by the opponent in association with ladies' clothing, namely jackets, skirts, blouses, tops, pants, pant suits, shirts, coats, sweaters, tunics, housecoats, jumpers, jeans, cords, T-shirts, vests, tank tops, culottes, tunics, suits and over-tops. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement in which it asserted that the applicant's trade-mark is not confusing with the opponent's trade-marks.

The opponent filed as its evidence the affidavit of J. Kenneth Butterill while the applicant filed as its evidence the affidavit of Jean-Luc Transon. As evidence in reply, the opponent submitted the affidavit of Alistair G. Simpson.

Both parties submitted written arguments and both were represented at an oral hearing.

During the opposition proceeding, the applicant submitted an amended application in which its statement of wares was amended to cover "souliers et bottes" and its statement of services was amended to read "service de magasin de vente au détail de souliers et bottes".

The main issue in this opposition is whether there would be a reasonable likelihood of confusion between the applicant's trade-mark NERO-BIANCO as applied to the wares and services covered in the applicant's amended application and the opponent's trade-marks BIANCA and BIANCA NYGARD Design as registered and previously used in Canada. In determining whether there would be a reasonable likelihood of confusion between these trade-marks, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark and the opponent's registered trade-marks.

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark NERO-BIANCO is inherently distinctive as applied to the applicant's wares and services. With respect to the opponent's trade-marks, the applicant submitted that the trade-mark BIANCA possesses a given name significance and therefore possesses little inherent distinctiveness. However, there is no evidence of record to support the applicant's contention and, even if the trade-mark BIANCA does possess a given name significance, it certainly is not a common name and therefore must be considered as possessing some inherent distinctiveness. In any event, the opponent's evidence establishes that the trade-mark BIANCA has acquired distinctiveness as a result of the relatively extensive sales and advertising of the opponent's BIANCA ladies' clothing in Canada as of either the applicant's filing date or the date of the opponent's opposition, the material dates with respect to the registrability and entitlement grounds of opposition respectively. Likewise, while it is arguable that the opponent's trade-mark BIANCA NYGARD does not possess a great deal of inherent distinctiveness in view of the name significance which the average consumer of ladies' clothing might associate with the trade-mark, the opponent's evidence establishes that the trade-mark has acquired distinctiveness through sales and advertising in this country. On the other hand, the applicant's trade-mark NERO-BIANCO had not become known to any extent in Canada as of the filing date of its proposed use application and, while it would appear that the applicant may have commenced use of its trade-mark in Canada as of the date of opposition, the Transon affidavit does not provide any evidence from which I could conclude that the applicant's trade-mark had become known to any measurable extent in this country in association with either the wares or services covered in its amended application as of June 23, 1986, the date of the opponent's opposition.

As to the nature of the wares and services of the parties, and the respective channels of trade associated with these wares and services, the Member of the Opposition Board in Eber San Francisco v. Irmaos Pedro Ltda., 9 C.P.R. (3d) 141 concluded that footwear, namely: shoes, boots, sandals and athletic shoes are wares which are different from but are related to clothing items and, furthermore, that these wares would travel through similar channels of trade. In any event, and if as argued by the applicant, the wares and channels of trade associated with the wares of the parties do differ, the burden was on the applicant to furnish evidence which would support this conclusion, bearing in mind that the legal burden is on the applicant in respect of the issue of confusion. Further, the opponent's reply evidence supports the conclusion that a number of traders have adopted and used their trade-marks in association with both clothing and footwear. Likewise, I consider the applicant's services to be related to the opponent's wares, bearing in mind that the Butterill affidavit further establishes that the opponent's trade-mark BIANCA NYGARD has been associated with the operation of retail outlets selling ladies' clothing.

Considering the degree of resemblance between the trade-marks at issue, I consider there to be no similarity in ideas suggested by the applicant's trade-mark NERO-BIANCO and the opponent's trade-marks BIANCA and BIANCA NYGARD and, as a matter of immediate impression and imperfect recollection, I consider there to be relatively little similarity in either appearance or sounding between the applicant's trade-marks and the opponent's trade-marks.

As a further surrounding circumstance, the opponent sought to rely upon its series of BIANCA and BIANCA NYGARD trade-marks in support of its argument that the applicant's trade-mark NERO-BIANCO would be perceived by the average consumer of the wares of the parties as another of the opponent's series of trade-marks. However, the opponent's evidence establishes that it essentially has adopted and used only the two trade-marks BIANCA and BIANCA NYGARD albeit in various stylized lettering and in combination with other relatively minor design features. As such, I do not consider that the opponent's submission relating to its alleged family of trade-marks enhances its position in respect of the issue of confusion between the applicant's trade-mark and the opponent's trade-marks.

Having regard to the above and, in particular, to the little similarity in appearance and sounding of the trade-marks at issue, I am of the view that there would be no reasonable likelihood of confusion between the applicant's trade-mark NERO-BIANCO and the opponent's BIANCA and BIANCA NYGARD trade-marks or the design versions of these trade-marks. Accordingly, the applicant's trade-mark is registrable and distinctive, and the applicant is the person entitled to its

registration.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF APRIL 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.