



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2019 TMOB 135**

**Date of Decision: 2019-12-05**

**IN THE MATTER OF AN OPPOSITION**

**Cartier international AG**

**Opponent**

**and**

**Yin JIANG**

**Applicant**

**1,683,298 for Marcellino**

**Application**

INTRODUCTION

[1] Cartier International AG (the Opponent) opposes application no. 1,683,298 (the Application) for registration of the trademark Marcellino (the Mark) filed by Yin JIANG (the Applicant).

[2] For the reasons that follow, I refuse in part the application.

[3] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13, (the Act) came into force on June 17, 2019. In the context of opposition proceedings, the date that determines which version of the Act applies is the date on which the application being opposed was advertised in the *Trademarks Journal* for opposition purposes. In the present case, the Application was advertised prior to June 17, 2019. Consequently, pursuant to the transitional provisions in section 70 of the Act as amended, the grounds of opposition will be assessed in accordance with

the Act as it read immediately before June 17, 2019, with the exception that, in assessing confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[4] All other references to the Act in these reasons are to the Act as amended on June 17, 2019, unless otherwise indicated.

#### THE RECORD

[5] The Application was filed on June 30, 2014. It is based on use of the Mark in Canada since at least as early as February 18, 2014. It has been amended such that it now covers the following goods:

Clothing, namely jackets, coats, parkas, raincoats, blazers, suits, blouses, shirts, t-shirts, skirts, dresses, trousers, pants, jeans, shorts, jumpsuits, overalls, sweaters, cardigans, dresses, hats, headbands, belts, gloves, swimwear, hosiery, stockings, knee-high and thigh-high stockings, pantyhose, tights, socks, knit leggings; neckwear, namely scarves, ties, cowls, mufflers; Footwear, namely shoes, boots, slippers; Fragrance, body and hair care and toilet preparation products, namely soaps, shampoos, perfume, eau de cologne, eau de toilette, after-bath powder, bath oil, after bath oil, body cream, milk bath cream, bathing gel, eau de parfum, after shave, after shave moisturizer, shave cream, after shave balm, cologne, deodorant stick, moisture balm, protective skin conditioner, skin creams, beauty masks, body lotion, skin moisturizers, blush, liquid and cream makeup, skin toner, skin freshener, lip makeup, nail enamel, nail enamel remover, nail and cuticle treatment oil, make-up powder, eye makeup, skin cleansers, makeup remover, makeup brushes; Jewellery, watches, handbags, tote bags, purses, wallets, key cases, billfolds, checkbook holders, credit card cases, checkbook clutches and wallets; Ophthalmic eyeglass frames, and sunglasses. (the Goods).

[6] The Application was advertised in the *Trademarks Journal* on June 3, 2015 for the purposes of opposition.

[7] On September 30, 2015, the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 30(a), (b), (i), combination of 30(i) with 22 (compliance), 12(1)(a) and (d) (registrability), 16(1)(a) (entitlement), and 2 (distinctiveness) of the Act as it read immediately before June 17, 2019.

[8] The Applicant filed a counter statement on December 3, 2015, denying each of the grounds of opposition.

[9] The Opponent filed as its evidence the affidavit of Arnaud Carrez, dated April 12, 2016.

[10] The Applicant filed the affidavits of Yin Jiang and Christian Walker both executed on August 23, 2016.

[11] The Opponent filed as reply evidence, and in the alternative, requested leave to file as additional evidence the affidavit of Thelma Thibodeau executed on September 12, 2016. The Registrar granted leave on December 8, 2016. As the Registrar has granted leave for the filing of this affidavit, it is unnecessary for me to consider the issue whether Ms. Thibodeau's evidence is not proper reply evidence.

[12] None of the affiants was cross-examined.

[13] Neither party filed a written argument; an oral hearing was not held.

#### PRELIMINARY REMARKS

[14] In the absence of written arguments and an oral hearing, it is difficult to assess the position of each party in the context of an adversarial process. It is not up to the Registrar to envision all possible arguments that each party could raise under a specific ground of opposition. In this context, I shall limit my analysis of the grounds of opposition raised by the Opponent to those that are directly in line with the evidence filed by the parties. Consequently, I shall refer only to the relevant portions of the evidence in the record.

#### THE OPPONENT'S EVIDENCE

[15] Mr. Carrez is "*Directeur International Marketing et Communications*" of Cartier international SNC ("Cartier"), an affiliated company to the Opponent. He has been employed by various affiliate companies of the Opponent since 1997.

[16] Mr. Carrrez states that the Opponent is a company involved in the design, manufacture and distribution of luxurious items such as jewelry, watches and glasses, as well as bags, wallets, key holders, handbags and belts.

[17] Mr. Carrez affirms that, in the course of the Opponent's business, it adopted the trademarks MARCELLO and MARCELLO DE CARTIER. He states that the Opponent is the registered owner of the trademark MARCELLO DE CARTIER, registration number

TMA793,973 obtained on March 28, 2011 based on an application (1339035) filed on March 13, 2007 claiming a priority date of September 21, 2006. A certified copy of the registration has been filed by the Opponent. Such registration covers the following goods:

Purses, wallets, card cases, pouches, handbags, shopping bags, belt bags.

[18] Mr. Carrez provides at paragraph 9 of his affidavit, on an annual basis, the volume of the Opponent's sales in Canada of bags and wallets in association with the trademarks MARCELLO or MARCELLO DE CARTIER. Despite the fact that Mr. Carrez states that he is providing the sales figures, the column entitled "MONTANT" has remained blank and thus we are left with only the number of units sold per year from March 10, 2010 to February 29, 2016. Those sales never exceeded 173 units. Also there is no breakdown per trademark.

[19] Mr. Carrez alleges that exhibit AC-1 represents sample invoices illustrating the sale of bags, card holders and wallets in association with the trademarks MARCELLO or MARCELLO DE CARTIER as well as records of sales. However, exhibit AC-1 does not contain any invoices or shipping documents bearing any of those marks as alleged by Mr. Carrez. They appear to be extracts of computerized ledger sheets and no information is provided by Mr. Carrez as to what these extracts represent. There are titles such as "Invoiced Sales CR", "Invoiced Sales Qty". We have no indication on some of these documents if the numbers appearing under those columns are limited to Canada. Some of the volumes of sales per unit sold on an annual basis match the figures contained in paragraph 9 of his affidavit. Given the lack of information provided by Mr. Carrez in his affidavit, those documents are of very little assistance.

[20] Mr. Carrez attached as exhibit AC-2 what appears to be an extract of a catalogue illustrating various bags. The page is entitled "Bags-MARCELLO DE CARTIER". There is also two photographs of one of these bags with a label on which appears the trademark MARCELLO.

[21] As additional evidence the Opponent filed the affidavit of Ms. Thelma Thibodeau, an independent trademark agent. She attached as exhibit TT-1 different documents obtained from the BC Registry Services related to J.Y.S. Enterprise Inc. (JYS). Those documents identify the Applicant as one of the directors of that company. It was incorporated as 0858910 B.C. Ltd. on

August 13, 2009 and changed its name on October 22, 2010 to Orinan Entreprises Inc. and then to JYS on December 30, 2010.

[22] Ms. Thibodeau attached as exhibit TT-2 extracts of JYS's website wherein only the marks KARLA HANSON and PAMPERED GIRLS are referred thereto. She adds that she could not find on JYS's website any reference to the Mark.

[23] Ms. Thibodeau attached as exhibit TT-3 extracts of Virgaries Sales Ltd's (Virgaries) website. I note that the extracts filed contain references to the marks KARLA HANSON and PAMPERED GIRLS. Those marks are not in issue in this opposition. There is no reference to the Mark.

#### THE APPLICANT'S EVIDENCE

[24] Ms. Jiang describes herself as the owner of the Mark. She explains how she chose the Mark which she affirms to be a "very beautiful Italian-sounding word". She states that the Mark is a first name of Italian origin. To support this contention, she attached as exhibit A an extract from the website located at [www.first-names-meanings.com](http://www.first-names-meanings.com) which indicates that the Mark is a boy's given name of Italian origin. She also attached as exhibit B an extract from the website Wikipedia of an article on Marcellino Lucchi who is an Italian former Grand Prix motorcycle road racer.

[25] Ms. Jiang states that she has used the Mark in association with various fashion/accessories in Canada since as least as early as year 2013. She states that she has sold handbags and purses in association with the Mark in Canada through retail distributors such as Pharmasave, an independent pharmacy and drugstore retailer.

[26] Ms. Jiang attached as exhibit C to her affidavit some sales invoices from the year 2013 to illustrate the sale of bags and wallets in Canada in association with the Mark. The unit sale price of these bags and wallets are in the range of \$2.80 to \$30. Those invoices are all issued by JYS and she states that such entity "is wholly owned by me". I wish to point out at this stage that any use of the Mark by JYS accrues to the Applicant's benefit being wholly owned by the Applicant [see section 50 of the Act and *Lindy v Canada (Registrar of Trade Marks)* 1999 FCJ No 682 (FCA)]. The oldest invoice is dated January 7, 2013.

[27] Ms. Jiang also attached as exhibit D wholesale sales report of bags and wallets bearing the Mark for the years 2015 and 2016 (up to July).

[28] Ms. Jiang affirms that she operates a retail store on Robson Street in Vancouver, BC that sells bags and wallets in association with the Mark. She attached as exhibit E a sales summary report of her MARCELLINO branded bags and wallets sold at that retail store for the period of November 1, 2014 to November 23, 2015. Again, there is reference to JYS on this document.

[29] Ms. Jiang attached as exhibit F pictures of examples of various types of bags and wallets all bearing the Mark. She states that those products are different in style, appearance and price than those of the Opponent.

[30] Ms. Jiang also attached as exhibit G an extract of CIPO's Canadian Trademarks Database of Canadian trademark registration TMA626087 for the trademark MARCELLO TARANTINO and as exhibit H an extract of the website *www.marcellotarantino.com* indicating that the company is located in Toronto and that there are products offered for sale in association with that trademark.

[31] Mr. Walter is the owner and general manager of Virgaries, a Canadian-based independent sales agency specializing in the sectors of fashion accessories, casual apparel, cosmetics and bath and beauty products. He states that Virgaries has acted as Canadian sales agent for the Applicant since 2013.

[32] Mr. Walter attached as exhibit A a copy of a purchase order recap for the year 2014 of Pharmasave stores in Canada that bought the Applicant's handbags, coin purses and wash bags sold, through Virgaries, in association with the Mark.

[33] Mr. Walter adds that Virgaries has sold the Applicant's products in association with the Mark to other retail boutiques in Canada, including Peoples Drug Marts.

#### EVIDENTIARY BURDEN

[34] The legal onus is on the applicant to show that its application complies with the provisions 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. Once this initial burden is met, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

#### GROUND OF OPPOSITION SUMMARILY DISMISSED

##### **Compliance with section 30(a) of the Act**

[35] The Opponent has the initial burden. There is nothing in the evidence described above that addresses this issue. In the absence of evidence, written or oral arguments on this issue, I conclude that the Opponent has not met its initial burden. Consequently, this ground of opposition is dismissed.

##### **Compliance with section 30(b) of the Act**

[36] The Opponent pleads that the date of first use of the Mark is false, as the Applicant's predecessors in title were not identified in the application.

[37] As mentioned above, any use by JYS is deemed to be use by the Applicant, given that there exists an implied license of use of the Mark from the Applicant to JYS given that the latter is wholly owned by the Applicant.

[38] The Opponent also pleads that any use of the Mark has been discontinued. There is no evidence in the record that supports such contention.

[39] Consequently, the grounds of opposition based on section 30(b) of the Act are dismissed.

##### **Compliance with section 30(i) of the Act**

[40] Section 30(i) of the Act only requires the Applicant to declare that she is satisfied that she is entitled to use the Mark in Canada in association with the Goods described in the Application. Such a statement is included in this application. An opponent may rely on section 30(i) in

specific cases such as where bad faith by the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)] or where there is a violation of a Federal Statute.

[41] There is an allegation in the statement of opposition that the Applicant falsely declared that she was entitled to use the Mark in Canada as the Applicant had knowledge of the Opponent's rights. There is no evidence in the record supporting such allegation. To the contrary, Ms. Jiang states in her affidavit that she was not aware of the Opponent's trademark MARCELLO DE CARTIER.

[42] Consequently, this ground of opposition is also dismissed.

[43] The Opponent also pleads a ground of opposition based on the combination of sections 30(i) and 22 of the Act in that the use of the Mark would have the effect to diminish the goodwill associated with the trademark of the Opponent. Again, there is no evidence in the record that supports such allegation.

[44] Therefore, this ground of opposition is also dismissed.

#### **Registrability of the Mark under Section 12(1)(a)**

[45] The Opponent pleads that the Mark is not registrable as it is the name or surname of a living individual or that he has died within the last 30 years.

[46] Again, there is no evidence in the record to support that contention. To the contrary, there is evidence in the record (see Jiang affidavit) that it is an Italian first name.

[47] Therefore, I also dismiss this ground of opposition.

#### **GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)**

[48] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with the Opponent's registered trademark MARCELLO DE CARTIER, registration No. TMA793,973, for purses, wallets, card cases, pouches, handbags, shopping bags, belt bags (the Opponent's goods).



[49] As mentioned earlier, a printout of the registration particulars from the Canadian Trademarks Database maintained by the Registrar and available online has been furnished by the Opponent. Therefore, the Opponent has met its initial burden.

[50] The relevant date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

### **The test for confusion**

[51] The test for confusion is outlined in section 6(2) of the Act, which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person.

[52] Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trademarks are set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services, or business; (d) the nature of the trade; and the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[53] The test for confusion is described in the following terms by Justice Binnie in *Veuve Clicquot*, *supra*, at paragraph 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 [applicant's mark], at a time when he or she has no more than an imperfect recollection of the [opponent's] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[54] This test does not concern confusion of the marks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source.

#### Degree of resemblance between the trademarks

[55] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks at issue is the most important factor in assessing the likelihood of confusion. One must consider the degree of resemblance between the trademarks from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64]. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [see *Veuve Clicquot, supra*].

[56] As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at para 34:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole [citations omitted].

[57] The dominant portion of the Mark is MARCELLINO while the dominant portions of the trademark MARCELLO DE CARTIER are MARCELLO and CARTIER.

[58] MARCELLO and MARCELLINO are similar in sound and visually. I used my discretion [see *National Laser Products Ltd v Canada (Registrar of Trade Marks)* (1976), 28 CPR (2d) 59, 1976 CarswellNat 491 (FCTD) ] and checked the Oxford Reference dictionary at [www.oxfordreference.com](http://www.oxfordreference.com) and “Marcellino” is defined as the pet form of “Marcello”. Therefore there is some similarity in the ideas suggested by the words “Marcello” and “Marcellino”. The addition of the words “de Cartier” (or “from Cartier” in English), in the Opponent’s trademark, suggests that MARCELLINO is a brand name and CARTIER is the supplier of the goods.

[59] Given that there are some similarities in the marks in issue, I have to determine if the other factors favour the Applicant in such a way that it would tip the balance in favour of the Applicant.

Inherent distinctiveness of the trademarks

[60] As the parties' trademarks are each comprised of a given name, they have, if any, a very low degree of inherent distinctiveness [*Glaskoch B Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co*, 2006 CarswellNat 5362 (TMOB)].

[61] The degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD)]. Both parties, as detailed above, filed evidence in this respect.

[62] The invoices and the sales reports attached as exhibits C to E to Ms. Jiang's affidavit do not show great volume of sales. The invoices were issued to retailers located in Vancouver, B.C. and Edmonton, Alberta.

[63] As for the purchase order recap and the recap by product attached as exhibits A and B to Mr. Walter's affidavit, again the number of products sold in association with the Mark is not impressive: approximately 250 units for a total of over \$3000 in sales.

[64] Mr. Carrez alleges that the Opponent, by the quality of its products and its original promotional activities, has a worldwide notoriety, including in Canada. There is no evidence to support such allegation. In any event, the trademark the Opponent is relying on is MARCELLO DE CARTIER and not CARTIER. The number of bags and wallets sold on a yearly basis since March 2010 and detailed in paragraph 9 of Mr. Carrez's affidavit do not support this contention. Over a period of 6 years, approximately 700 bags and/wallets have been sold in Canada in association with the trademark MARCELLO DE CARTIER. There is no detailed information on the extent of the promotion of that trademark in Canada in association with those goods.

[65] Consequently, I conclude that the Opponent's trademark MARCELLO DE CARTIER and the Mark are known in Canada to a very limited extent.

[66] Consequently, this factor does not favour any of the parties.

Length of time the trademarks have been in use

[67] As it appears from the evidence described above, the Applicant has used the Mark in association with the Goods since at least as early January 2013 (see exhibit C to the Jiang affidavit), whereas use of the Opponent's MARCELLO DE CARTIER in association with bags and wallets goes back to at least as early as March 2010 (see Exhibit 1 to the Carrez affidavit).

[68] Accordingly, this factor favours the Opponent.

Nature of the parties' goods, services and trades

[69] When considering the nature of the goods and services and the nature of the parties' trades under section 12(1)(d) of the Act, it is the statement of goods and services as defined in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must be read with a view to determine the probable type of business or trade intended by the parties, rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[70] From a plain reading of the statements of goods in the Application and the Opponent's registration, there is a clear overlap between the Opponent's goods and the following goods of the Applicant:

handbags, tote bags, purses, wallets, key cases, billfolds, checkbook holders, credit card cases, checkbook clutches and wallets (the Overlapping goods).

[71] Given the narrow range of goods sold by the Opponent in association with the trademark MARCELLO DE CARTIER, namely various bags and wallets, I do not see the remainder of the Applicant's goods (clothing, footwear, beauty products, jewellery, watches and eyewear) being

in the natural zone of expansion for the Opponent. In fact there is no evidence in the record that could support this.

[72] Mr. Carrez affirms that the Opponent is involved in the luxurious items industry. He states that the Opponent sells its bags and wallets to its Canadian distributor Richemont Canada Inc (Richemont). However, we have no information to whom Richemont distributes the Opponent's bags and wallets in Canada.

[73] Ms. Jiang affirms, as per the invoices attached as exhibit C to her affidavit, that the unit price of the bags and wallets sold by the Applicant are in the range of \$2.80 to \$30 while, from the figures appearing in the sales reports attached as exhibit 1 to the Carrez affidavit, it would appear that the Opponent's bags and wallets are sold to Richemont at a unit price of at least a couple of hundreds of dollars.

[74] Therefore, it would appear that there is a difference in the parties' actual channels of trade in so far as the Overlapping goods are concerned. However, the Opponent's registration does not contain a restriction on the channels of trade. It is possible for the Opponent to come up with a line of wallets and bags offered for sale in the price range of the Applicant's Goods and hence the possibility of an overlap in the channels of trade.

[75] These factors favour the Opponent only in so far as the Overlapping goods are concerned.

#### Additional surrounding circumstances

[76] In her affidavit, Ms. Jiang alleges that the Opponent cannot claim a monopoly over the word MARCELLO in Canada. She adds that she conducted searches in the Canadian Intellectual Property Office (CIPO)'s database and located Canadian trademark registration TMA626,087 for the trademark MARCELLO TARANTINO, registered in 2004 covering amongst other "bags". She attached as exhibit G a copy of the printout from the CIPO's trademark database for that registration and as exhibit H the landing page for the website *www.marcellotarantino.com* of Marcello Tarantino Manufacturing Inc. of Toronto.

[77] We have no information on how the searches on CIPO's trademarks database have been performed. Moreover, in three recent decisions [see *McDowell v Laverana GmbH & Co KG*,

2017 FC 327, 154 CPR (4th) 128, *McDowell v The Body Shop International PLC*, 2017 FC 581, 148 CPR (4th) 195, and *Canada Bread Company, Limited v Dr. Smood APS*, 2019 FC 306, 2019 CarswellNat 694], the Federal Court ruled that, unless a large number of trademarks is identified in the state of the register evidence, use of the trademarks cited must be established. Where a large number of relevant trademarks is identified, the Registrar can infer that the element they all have in common is used in the marketplace, such that consumers are able to distinguish these marks by their additional features. Where the number of trademarks identified is not large, evidence of such use needs to be furnished.

[78] I assume that the Applicant is referring to the state of the register and the marketplace evidence with exhibits G and H to Ms. Jiang's affidavit. However, I cannot infer from one citation that MARCELLO is a trademark commonly used in Canada in association with goods related to the Goods such that Canadian consumers are accustomed to seeing numerous trademarks having as a component the word MARCELLO and are therefore able to distinguish one trademark over the others.

[79] Accordingly, this factor is not a significant surrounding circumstance in the present case.

#### Conclusion on the likelihood of confusion

[80] In the case of given names marks, they are considered weak marks such that small differences may suffice to distinguish one mark from the other [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at 240; *Joseph Ltd v XES-NY Ltd* (2005), 44 CPR (4th) 314 (TMOB), *Prince Edward Island Mutual Insurance Co. v. Insurance Co. of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD) at paras 32-34 and *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 2005 FC 1550 (CanLII), 46 CPR (4th) 112 at para 31 (FCTD)].

[81] The issue is whether a consumer who has a general and not precise recollection of the opponent's trademark will be likely to think, upon seeing the applicant's mark, that the goods and services associated with both trademarks might share a common source. However, the onus is not on the opponent to show that confusion is likely but rather on the applicant to satisfy the Registrar that there is no reasonable likelihood of confusion.

[82] Given that there is some resemblance between the parties' marks, visually, as sounded and in the meaning of the marks, as MARCELLINO is a pet form of MARCELLO, and given that there is some overlap in the parties' goods in so far as the Overlapping goods are concerned, I conclude that the Applicant has not met its burden to prove, on a balance of probabilities, that the Mark is not confusing with the Opponent's trademark MARCELLO DE CARTIER when used in association with the Overlapping goods. At best for the Applicant, I could have come to a conclusion that the probabilities between a likelihood of confusion or not is evenly balanced, given the fact that given names are weak marks. Since the ultimate burden is on the Applicant, such result would still favour the Opponent. Had there be evidence in the record of a significant number of registrations on the register of trademarks having as a component the word MARCELLO or evidence of use in the marketplace of that word as a component of many trademarks, I may have come to a different conclusion.

[83] Consequently, this ground of opposition is maintained in part, for the Overlapping goods only.

GROUND OF OPPOSITION BASED ON ENTITLEMENT TO REGISTRATION UNDER SECTION 16(1)(A)

[84] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark because, at the date when the Applicant claims to have first used the Mark in association with the Goods, namely since at least as early as February 18, 2014, the Mark was confusing with the Opponent's trademarks MARCELLO and MARCELLO DE CARTIER, previously used in Canada by the Opponent in association with the Opponent's goods.

[85] To meet its initial burden under this ground, the Opponent must evidence not only the prior use of these trademarks in accordance with section 16(1)(a) of the Act, but also that its trademarks had not been abandoned at the date of advertisement of the Application (June 3, 2015), as stipulated in section 16(5) of the Act.

[86] As discussed above under the section 12(1)(d) ground of opposition, the Carrez's affidavit provides evidence of use of the Opponent's MARCELLO DE CARTIER prior to February 18, 2014 and that such use was not abandoned at the advertisement date of the present application.

[87] The Opponent relies also on the previous use of the trademark MARCELLO. Exhibits 1 and 2 to the Carrez affidavit show some prior use of that trademark.

[88] Accordingly, I find that the Opponent has also met its initial burden under this ground of opposition.

[89] The analysis of the relevant factors set out in section 6(5) of the Act at the earlier relevant date associated with the 16(1)(a) ground of opposition does not significantly alter the conclusion reached under the previous ground of opposition when comparing the Mark with MARCELLO DE CARTIER. A Similar conclusion also applies when comparing the Mark with MARCELLO.

[90] Consequently, this ground of opposition is partly maintained as well; only for the Overlapping goods.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2 OF THE ACT

[91] The relevant date for this ground would be the date of filing the statement of opposition (September 30, 2015) [see *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)].

[92] The Opponent pleads the following:

*LA MARQUE ne distingue pas les produits en liaison avec lesquels LA MARQUE aurait été employée ou qu'il serait projeté de l'employer par la requérante des produits de l'opposante et ce, eu égard à ce qu'aux présentes mentionné.*

[93] Reading the statement of opposition as a whole, in conjunction with the Opponent's evidence, it is clear that the Opponent is relying on its trademarks MARCELLO and MARCELLO DE CARTIER. Given the evidence in the record and described above, I conclude that the Opponent has not met its initial burden of proof under this ground of opposition for the following reasons.

[94] The Opponent had to establish that the trademarks MARCELLO and/or MARCELLO DE CARTIER were known in Canada to some extent as of the filing date of the statement of



opposition (September 30, 2015) so as to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[95] Mr. Carrez makes reference to sales figures from the Opponent to its Canadian distributor Richemont Canada Inc. The sales figures appearing in exhibit 1 are not broken down per trademark and per province. Consequently, it is impossible to draw a conclusion that the trademarks MARCELLO and/or MARCELLO DE CARTIER were known to some extent in Canada or well known in an area of Canada such that it would negate the distinctiveness of the Mark.

[96] Consequently, I reject this ground of opposition as the Opponent failed to meet its initial burden of proof.

DISPOSITION:

[97] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to

handbags, tote bags, purses, wallets, key cases, billfolds, checkbook holders, credit card cases, checkbook clutches and wallets

[98] and I reject the opposition with respect to the following goods:

clothing, namely jackets, coats, parkas, raincoats, blazers, suits, blouses, shirts, t-shirts, skirts, dresses, trousers, pants, jeans, shorts, jumpsuits, overalls, sweaters, cardigans, dresses, hats, headbands, belts, gloves, swimwear, hosiery, stockings, knee-high and thigh-high stockings, pantyhose, tights, socks, knit leggings; neckwear, namely scarves, ties, cowls, mufflers; Footwear, namely shoes, boots, slippers; Fragrance, body and hair care and toilet preparation products, namely soaps, shampoos, perfume, eau de cologne, eau de toilette, after-bath powder, bath oil, after bath oil, body cream, milk bath cream, bathing gel, eau de parfum, after shave, after shave moisturizer, shave cream, after shave balm, cologne, deodorant stick, moisture balm, protective skin conditioner, skin creams, beauty masks, body lotion, skin moisturizers, blush, liquid and cream makeup, skin toner, skin freshener, lip makeup, nail enamel, nail enamel remover, nail and cuticle treatment oil, make-up powder, eye makeup, skin cleansers, makeup remover, makeup brushes; Jewellery, watches; ophthalmic eyeglass frames, and sunglasses.

The whole pursuant to section 38(12) of the Act.

---

Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

SCHEDULE A

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

---

No Hearing Held

**AGENTS OF RECORD**

Robic S.E.N.C.R.L.

FOR THE OPPONENT

Yunwei (Edmund)Xie

FOR THE APPLICANT