

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 243

Date of Decision: 2022-12-02

IN THE MATTER OF AN OPPOSITION

Opponent: Gianfranco Ferré S.p.A.

Applicant: FEMAS METAL SANAYI VE TICARET ANONIM SIRKETI

Application: 1881571 for FERRE

INTRODUCTION

[1] Gianfranco Ferré S.p.A. (the Opponent) opposes registration of the design trademark FERRE, shown below (the Mark), which is the subject of application No. 1,881,571 (the Application), that was filed by FEMAS METAL SANAYI VE TICARET ANONIM SIRKETI (the Applicant). Colour is claimed as a feature of the trademark as follows: “the trademark is in orange.”

ferre

[2] The Application was filed on February 6, 2018, on the basis of proposed use in Canada in association with the statement of goods as reproduced below, together with the associated Nice class (CI):

CI 11 (1) Electric and gas operated apparatus, machines and equipment used in cooking, namely, deep fryers, grills, bakers' ovens, convection ovens, induction ovens, microwave ovens, pizza ovens, toaster ovens, stoves, cooking tops, electric autoclaves, electric cooking pots, barbecues, gas cooking ovens for household use, industrial cooking ovens, electric cooking ovens for household use; exhaust hoods for kitchens; laundry drying machines; electric clothes drying machines for household purposes; dish drying machines for household purposes; ice-cooling refrigerators for household purposes; beverage cooling and ice dispensing machines; water coolers; air conditioners; cooling evaporators.

[3] The Application was advertised in the *Trademarks Journal* of May 13, 2020. On November 13, 2020, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. As the Application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[4] The Opponent raises grounds of opposition based on bad faith under section 38(2)(a.1), non-registrability under section 12(1)(d), non-entitlement under sections 16(1)(a) and (c), non-distinctiveness under section 2, and non-compliance with section 38(2)(f) of the Act. All grounds of opposition revolve around the allegation of confusion between the Mark and the Opponent's trademarks, particulars of which are attached under Schedule A to this decision.

[5] For the reasons that follow, I reject the opposition.

THE RECORD

[6] As previously indicated, the Opponent filed its statement of opposition on November 13, 2020.

[7] The Applicant filed and served its counter statement on February 17, 2021, denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed certified copies of the following registrations in accordance with section 54 of the Act: TMA792,052 (FERRE'), TMA484,589 (GIEFFEFFE BY GIANFRANCO FERRE Design), TMA266,103 (GIANFRANCO FERRE'),

TMA301,712 (GIANFRANCO FERRE'), and TMA478,376 (GIEFFEFFE BY GIANFRANCO FERRE Design). As these are the same trademarks relied upon under the various grounds of opposition, refer to Schedule A to this decision for particulars of these registrations.

[9] On November 19, 2021, the Applicant filed a statement pursuant to section 52(3) of the *Trademarks Regulations*, SOR/2018-227 that it did not wish to submit evidence.

[10] Neither party filed written representations and no hearing was requested.

ANALYSIS

Grounds Summarily Rejected

Section 38(2)(a.1) Ground of Opposition

[11] The Opponent pleads that the Application was filed in bad faith because the Applicant had or should have had prior knowledge of the Opponent's registered trademarks relied upon (Schedule A to this decision) and could therefore not have been satisfied that it was entitled to use the Mark in Canada.

[12] While not all jurisprudence regarding section 30(i) of the Act, as it read prior to June 17, 2019 (the Old Act), was rooted in bad faith, to an extent, this existing jurisprudence may be assistive in the interpretation of section 38(2)(a.1) of the Act.

[13] Under section 30(i) of the Old Act, jurisprudence developed such that "bad faith" could form the basis of a valid pleading under that provision [see *Sapodilla Co Ltd v Bristol-Myers Co*, 1974 CarswellNat 476 (TMOB)]. However, it was well established that an allegation that an applicant was aware of an opponent's trademark did not by itself support a ground of opposition under section 30(i) [see *Woot Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197]. If an opponent only pleaded awareness of prior use or prior application of an allegedly confusing trademark, a ground of opposition alleging bad faith would be struck on the basis that such pleading did not result in an arguable case. See, for example, *Navsun Holdings Ltd v Sadhu Singh Hamdard Trust*, 2015 TMOB 214; *Chicago Climate Exchange, Inc v Bourse de Montréal Inc*, 2014 TMOB 78; and *Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197, where it was found that a section 30(i) ground of opposition based on an allegation of awareness of a confusingly-similar trademark cannot form the basis of a section 30(i) ground of opposition in the absence of other bad faith or exceptional circumstances being alleged.

[14] In the present case, other than the filing of certified copies of its relied upon registrations, the Opponent has not filed any evidence of bad faith on behalf of the Applicant. Thus, the Opponent has failed to meet its initial evidential burden for the section 38(2)(a.1) ground. Accordingly, this ground of opposition is rejected.

Sections 16(1)(a) and (c) Grounds of Opposition

[15] The Opponent pleads that the Applicant is not the person entitled to registration of the trademark pursuant to sections 16(1)(a) and (c) because the trademark applied for was, at the date of filing, confusing with the Opponent's registered trademarks and the Opponent's trade name Gianfranco Ferré, which had been previously used in Canada in association with the Opponent's various goods including clothing, accessories, cosmetics, skin care preparations, and perfumes. See Schedule A to this decision for a complete listing of the Opponent's relied upon trademarks and associated goods.

[16] The Opponent has an initial burden of establishing that one or more of its trademarks and its trade name alleged in support of these grounds of opposition were used or made known prior to the earlier of the filing date of the Application, namely, February 6, 2018, or the date of first use of the Mark in Canada, and was not abandoned at the date of advertisement of the Application for the Mark (in this case, May 13, 2020) [section 16(3) of the Act]. As the Applicant has not filed any evidence, the material date for the Opponent under this ground is the date of filing of the Application.

[17] The Opponent has not filed any evidence of use of its relied upon trademarks or trade name. The Opponent has only filed certified copies of registrations of its various trademarks it relies on under the section 16(1)(a) ground. However, any reference to use in the Opponent's registrations is not sufficient to satisfy the Opponent's evidential burden under this ground [see *Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[18] Consequently, the grounds of opposition based on sections 16(1)(a) and (c) are rejected.

Section 38(2)(f) Ground of Opposition

[19] The Opponent pleads that at the date of filing of the Applicant in Canada, the Applicant was not entitled to use the applied for mark in Canada in association with the applied for goods in view of the following:

- (i) At the filing date of the Application in Canada, the Applicant was well aware or is deemed to have been aware of the Opponent's Registered Trademarks previously used and registered in Canada in association with the Opponent's Goods (see Schedule A to this decision);
- (ii) The Applicant was not entitled to use the applied for mark in Canada in association with the applied for goods in light of the allegations set out above (which is a reference to all of the pleaded grounds of opposition);
- (iii) The Applicant was not entitled to use the applied for mark in Canada in association with the applied for goods since to do so would have the effect of depreciating the goodwill attached to the Opponent's Registered Trademarks, contrary to section 22 of the Act (see Schedule A to this decision); and
- (iv) The Applicant was not entitled to use the applied for mark in Canada in association with the applied for goods since to do so would be contrary to the passing off provisions set out in section 7 of the Act.

[20] Other than the filing of certified copies of the relied upon trademark registrations, the Opponent has not filed any evidence. The mere existence of the Opponent's registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Furthermore, there is no evidence of use or promotion or any evidence that would establish the extent to which the Opponent's relied upon trademarks have become known in Canada and/or would be contrary to section 22 or section 7 of the Act.

[21] Thus, the Opponent has failed to meet its initial evidential burden for the section 38(2)(f) ground. Accordingly, this ground of opposition is rejected.

Remaining Grounds of Opposition

Section 12(1)(d) Ground of Opposition

[22] The Opponent pleads that the Mark is not registrable because it is confusing with a registered trademark, namely each of the Opponent's registered trademarks outlined in paragraph 8 above and in Schedule A to this decision.

[23] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are in good standing. Furthermore, the Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that the Opponent's registrations relied upon under this ground of opposition are in good standing as of the date of this decision.

[24] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's relied upon trademarks.

[25] Furthermore, in considering the issue of confusion, I will primarily focus on the Opponent's FERRE' trademark registration No. TMA792,052 as I consider this trademark to represent the Opponent's best chance of success, given that it is the closest with respect to its degree of resemblance. If the Mark is not confusing with this trademark, it will not be confusing with any of the remaining trademarks relied upon by the Opponent.

[26] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's FERRE' trademark registration No. TMA792,052.

The test for confusion

[27] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees an applicant's mark, at a time when he or she has no more than an imperfect recollection of an opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[28] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: 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 e) the degree of resemblance between the trademarks

including 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 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Section 6(5)(a) – the inherent distinctiveness of the trademarks and the extent to which they have become known

[29] The Mark is a coined word in English that has no clear meaning in association with the Applicant's goods. It may perhaps be derived from the word "ferrum", which is the chemical name of the element iron, which could imply that the Applicant's goods are either made from iron or strong like iron.

[30] Additionally, the Mark does resemble the French word FERRÉ, which is defined as per Le Petit Robert French language dictionary as:

1. Garni de fer ; muni d'une garniture de fer, d'acier. Bâton, lacet ferré. Des coffres « cloutés et ferrés » (Huysmans). Voie ferrée, de chemin de fer. Réseau ferré. → ferroviaire.

◆ Qui a des fers. Cheval ferré. Souliers ferrés ; brodequins ferrés et cloutés. → crampon.

2. FIG. Être ferré sur un sujet, une question. → calé, 1. Fort, instruit, trapu (cf. S'y connaître).

[31] Thus, once again, the implication being that the Applicant's appliances are either made from iron or strong like iron. However, as it is at most, suggestive, and yet still a coined word, the Mark has a measure of inherent distinctiveness.

[32] The word FERRE' in the Opponent's trademark, has no clear meaning in association with the Opponent's goods. Thus, the Opponent's trademark, also a coined word, shares a similar degree of inherent distinctiveness as does the Mark.

[33] While the strength of a trademark may be increased by means of it becoming known in Canada through promotion or use, neither party has filed any evidence to support that their trademark has become known in Canada through promotion and use. Furthermore, as

previously stated, the mere existence of the Opponent's registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use [see *Entre Computer, supra*].

[34] In conclusion, I find that this factor doesn't favour either party, as the trademarks of both parties appear to be coined words with no clear meaning in association with their respective goods.

Section 6(5)(b) – the length of time of use

[35] The Applicant has not yet commenced use of the Mark in Canada.

[36] The Opponent has not filed any evidence of use of its relied upon registrations; but merely its certified copies which can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use [see *Entre Computer, supra*].

[37] Thus, this factor does not favour either party.

Sections 6(5)(c) and (d) – the nature of the services and channels of trade

[38] The Applicant has applied for goods which can be described as a variety of small kitchen appliances and household appliances.

[39] The Opponent's registered goods on the other hand, consist of various articles of clothing, accessories, cosmetics, skin care preparations, and perfumes.

[40] The goods of the parties on their face are quite distinct. Furthermore, given the highly disparate nature of the parties' goods, absent evidence to the contrary, it follows that their respective goods would generally likely not travel through the same channels of trade.

[41] Accordingly, I find that these factors strongly favour the Applicant.

Section 6(5)(e) – the degree of resemblance

[42] The marks of the parties are visually quite similar; indeed almost identical, with the exception of the apostrophe following the Opponent's trademark, which in my view does not alter the degree of resemblance. The parties' trademarks also appear to be identical when sounded, and with respect to the ideas suggested, there is no clear meaning with respect to either parties' trademarks.

[43] In view of the strong resemblance between the parties' marks, in appearance and when sounded, I find this factor favours the Opponent.

Conclusion

[44] In most instances, the degree of resemblance between the marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Masterpiece, supra* and *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf 60 CPR (2d) 70 (FCTD)]. However, in the present case, notwithstanding any similarity between the marks in appearance or when sounded, I find the differences in the nature of the parties' goods and respective trades to be significant [for a similar finding but with respect to identical trademarks see: *Miller Industries Towing Equipment Inc v Kawasaki Jukogyo Kabushiki Kaisha, doing business as Kawasaki Heavy*, 2020 TMOB 7].

[45] Thus, the ground of opposition based on section 12(1)(d) of the Act is rejected.

Section 2 Ground of Opposition

[46] The Opponent alleges that the Mark is not distinctive, having regard to the provisions of sections 38(2)(d) and 2 of the Act, because it is not capable of distinguishing the Applicant's services from the services of the Opponent. Specifically, the Mark is confusing with the Opponent's trademarks, and therefore is not distinctive.

[47] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, November 13, 2020, one or more of the Opponent's trademarks had become known to such an extent that it could negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427].

[48] The Opponent has not filed any evidence other than certified copies of its relied upon registrations. Once again, the mere existence of the Opponent's registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use [see *Entre Computer, supra*]. Furthermore, any reference to use in the Opponent's registrations is not sufficient to satisfy the Opponent's evidence burden under this ground [see *Rooxs, supra*].

[49] Consequently, the ground of opposition based on section 2 of the Act is rejected.


DISPOSITION


[50] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's Canadian Trademark Registrations

Trademark and claims	Reg. No.	Goods
<p>FERRE'</p> <p>Declaration of use filed on February 14, 2011</p>	<p>TMA792,052</p>	<p>(1) Perfumes, toilet water, personal deodorants, body lotions, aftershave lotions, shower gel, bubble bath, body creams; hair shampoos.</p>
 <p>Claims:</p> <p>Priority Filing Date: September 4, 1995, Country: {unknown address} in association with the same kind of goods</p> <p>Declaration of Use filed October 3, 1997</p>	<p>TMA484,589</p>	<p>(1) Handbags, luggage, shoulder bags, beach bags, briefcases, clutch cases, all purpose sports bags, attaché cases, school bags, tote bags, travelling bags, credit card cases, document cases, passport cases, non-fitted vanity cases, keycases, knapsacks, rucksacks, purses, wallets; travelling trunks and suitcases, umbrellas, parasols; brassieres, corsets, hosiery, petticoats, nightgowns, pyjamas, pullovers, dressing gowns, bathrobes, gloves, cardigans, hats, caps, jerseys, neckties, foulards, scarves, sweaters, socks, stockings, trousers, leggings, skirts, jackets, jerkins, shirts, vests, jumpers, track suits, blouses, jeans, pants, bermuda shorts, t-shirts, panties, sweat shirts, suits and dresses, overcoats, coats, anoraks, raincoats, bathing suits, belts, braces, shoes, boots, slippers.</p>
<p>GIANFRANCO FERRE'</p> <p>Claims:</p> <p>Used in CANADA since at least as early as April 27, 1979 on goods (1)</p>	<p>TMA266,103</p>	<p>(1) Women's shoes and clothing for women, namely skirts, jackets, blouses, dresses, belts and scarves.</p> <p>(2) Beauty creams, bath soaps, nail polishes, bath foams, essential oils, cosmetic oils, tanning oils and creams, lipsticks, face powders, eye pencils, rouge, mascara, eye</p>

<p>Used in CANADA since at least as early as April 1984 on goods (3)</p> <p>Used in ITALY on goods (2)</p> <p>Registered in or for ITALY on November 25, 1978, under No. 312,501 on goods (2)</p>		<p>shadows, tonics, cleansing milk; bags, handbags, wallets, purses, money bags, beauty cases; women's shoes and clothing for women, namely skirts, jackets, blouses, dresses, belts and scarves.</p> <p>(3) Perfume, toilet water, eau de parfum, deodorant spray, deodorant stick, deodorant cream, shampoo, bath oil, bath pearls, dusting powder, aftershave lotion, aftershave balm, foundation, make-up removing preparations, nail varnish removing preparations, body lotion.</p>
<p>GIANFRANCO FERRE'</p> <p>Claims:</p> <p>Priority Filing Date: May 19, 1983, Country: {unknown address} in association with the same kind of goods</p> <p>Used in ITALY</p> <p>Registered in or for ITALY on August 6, 1983, under No. 335,677</p>	<p>TMA301,712</p>	<p>(1) Sunglasses, spectacles; jewellery, horology and other chronometric instruments, namely wrist-watches, watches, clocks, necklaces, bracelets, rings, earrings, brooches, tie-pins in precious metals and/or coated therewith; tissues (piece goods) bed and table covers.</p>
 <p>Claims:</p> <p>Priority Filing Date: March 22, 1995, Country: {unknown address} in association with the same kind of goods</p> <p>Declaration of Use filed May 22, 1997</p>	<p>TMA478,376</p>	<p>(1) Perfumes, toilet water, eau de parfum, personal deodorants, essential oils for personal use, body lotions, shower gel, bath foams, bath oils, bath pearls, perfumed soaps, aftershave balms, shaving creams, aftershave lotions, cosmetic pencils, foundation make-up, face powders, talcum powders, rouges, lipsticks, mascaras, skin cleansing creams, skin cleansing lotions, sun screen preparation, nail varnishes, nail varnish removers, beauty masks, facial scrubs, face creams, body creams, hair</p>

		shampoos, hair sprays, hair lotions, dentifrices.
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Appearances and Agents of Record

HEARING DATE: No hearing held.

AGENTS OF RECORD

For the Opponent: Marks & Clerk

For the Applicant: NEOMARK LTD.