

**IN THE MATTER OF AN OPPOSITION by
Camiceria Pancaldi & B. S.r.l. to Application
No. 821543 for the Trade-mark VITALIANO
PANCALDI & Design filed by Le Cravatte Di
Pancaldi S.R.L.**

I The Pleadings

On August 23, 1996 Le Cravatte Di Pancaldi S.R.L. (the “Applicant”) filed an application to register the trade-mark VITALIANO PANCALDI & Design as illustrated hereinafter:



(the “Mark”)

application number 821543 in association with:

- (1) Cravates.
- (2) Nécessaires de rasage, de manucure et de pédicure; coutellerie, fourchettes et cuillers; pochettes, bourses, sacs et étuis spéciaux pour les articles précités.
- (3) Lunettes; cordonnets de lunettes; fourreaux, pochettes, bourses et étui spéciaux pour les articles précités.
- (4) Réfrigérateurs; ovens for cooking; toiles; baignoires, lavabos, water closet, bidets, douches et accessoires nommément robinets.
- (5) Watches, clocks and chronometers; joaillerie, bijouterie; pochettes, bourses, sacs et étuis spéciaux pour les articles précités.
- (6) Livres, journaux et revues, brochures; writing-desk sets; photographies; étuis et cartons pour papiers; plumes et porte-plume; cahiers, agendas, diaries, address-books, notebooks, blocs-notes; pochettes, bourses, étuis, sacs, fourreaux et covers pour les articles précités; serviettes en papier spécialement destinés au nettoyage des lunettes.
- (7) Cuir et imitations de cuir, nommément valises, bourses, sacs, sacoches, sacs à main, pochettes, sacs du soir; sacs à main pour homme, serviettes pour documents, malles, sacs à dos, beauty cases; bourses, étuis et sacs porte-objets, nommément chaussures, cravates, chemises et objets personnels et d'habillement; petits objets en cuir, nommément étuis à clefs, portefeuilles, serviettes, porte-monnaie; parapluies; fouets, harnais et sellerie.
- (8) Carreaux céramiques; bandes en bois et panneaux en bois pour le revêtement de murs et de sols.
- (9) Furniture, namely tables, chairs, bookshelves, beds and wardrobes and cupboards; petits objets décoratifs en bois, liège, roseau, jonc, osier, corne, os, ivoire, écaille, ambre, nacre et

matériaux plastiques synthétiques; pochettes, bourses, sacs et étuis spéciaux pour les articles précités.

(10) Peignes, brosses et éponges; blaireaux; all-purpose portable household containers; porcelaine, beverage glassware, porcelain figurines and dishes; assiettes; récipients, pochettes, bourses, sacs et étuis spéciaux pour les articles précités.

(11) Tissus, tissus de haute couture; couvertures de lit et de table; handkerchiefs; sponge cloth; pochettes, bourses et sacs spéciaux pour les articles précités; serviettes en tissu spécialement destinées au nettoyage des lunettes.

(12) Articles d'habillement et accessoires relatifs, notamment cravates, foulards, pochettes, noeuds papillon, plastrons, guimpes, foulards plissés pour homme (de style marin), larges ceintures pour smoking (cummerbunds), gilets, écharpes, châles, bretelles, jarrettières, chaussettes, bas, chapeaux, robes de chambre, jaquettes de chambre, peignoirs, pantoufles; pochettes, bourses, sacs, étuis et fourreaux spéciaux pour les articles précités (à l'exception des ceintures, chaussures, chemises, jupes, pantalons, bonneterie et articles d'habillement en peau).

(13) Tapis, paillasons, nattes, papier peint.

(14) Cigarette lighters, cigarettes cases and ashtrays all not of precious métal; smoking pipes; briquets.

(the "Wares")

on the basis of use in Canada, in association with Wares (1) since 1989 and on the basis of a registration and use in Italy, the Applicant's country of origin, in association with Wares (2) to (14) inclusive.

It should be noted that the application was the object of numerous office actions at the examination stage. The Applicant had to disclaim the exclusive use of the word PANCALDI apart from the trade-mark as a whole. Finally the application was advertised on July 30, 2003 in the Trade-marks Journal for opposition purposes.

Camiceria Pancaldi & B. S.r.l. (the "Opponent") filed on October 10, 2003 a statement of opposition forwarded by the Registrar on January 27, 2004 to the Applicant. In a counter statement filed on February 26, 2004, the Applicant denied all grounds of opposition.

The Opponent filed certified copies of registration nos. TMA453633 and TMA248785, a certified copy of the Registrar decision in the matter of an opposition by the Opponent to application no. 604809 for the trade-mark VITALIANO PANCALDI V Design (identical to the Mark) filed by the Applicant (reported as *Camiceria Pancaldi & B S.r.l. v. Le Cravatte Di Pancaldi S.r.l.* 74 C.P.R. (3d) 551) and the affidavits of Antonio Ranicchi, Janice Walker, Stacey

Smallwood, Sonia Zibin and two affidavits of Marlene Elliott. The Applicant's evidence consists of certified copies of the following registrations:

TMA379823 for the design trade-mark VITALIANO PANCALDI

TMA591880 for the design trade-mark VITALIANO

TMA307161 for the word trade-mark CALVIN KLEIN

TMA222047 for the word trade-mark ANNE KLEIN

TMA405016 for the word trade-mark KLEIN

TMA515822 for the word trade-mark KLEIN.

No reply evidence was filed. Both parties filed written argument and were represented at an oral hearing.

II The statement of opposition

The grounds of opposition pleaded are the following:

1. The application does not conform to the requirements of s. 30 of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the "Act") in that the Applicant has not used the Mark in Canada in association with the Wares (1) since the date of first use claimed in the application;
2. The application does not conform to the requirements of s. 30 of the Act in that the Applicant has not used at any material time, particularly at the time of filing of the application, the Mark in Italy in association with the wares (2), (3), (4), (5), (6), (7), (8), (9), (10), (11), (12), (13) and (14) as claimed in the application;
3. The application does not comply with the provisions of s. 30(i) of the Act in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares in view of the Applicant's knowledge of the prior use and/or making known by the Opponent of the trade-marks PANCALDI Design and PANCALDI & B Design and the trade-name Camiceria Pancaldi & B. S.r.l.. The Applicant should have been aware that the Mark was confusing with the Opponent's foregoing trade-marks and trade-name.
4. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) of the Act since the Mark is confusing with the following registered trade-marks:
 - PANCALDI & B Design, certificate of registration TMA248785
 - PANCALDI Design, certificate of registration TMA453633
5. The Applicant is not the person entitled to the registration of the Mark pursuant to s. 16(1)(a), (b) and (c) since at the alleged date of first use of the Mark in Canada, in respect of Wares (1) the Mark was confusing with the Opponent's registered trade-mark PANCALDI & B Design and the Opponent's trade-name Camiceria Pancaldi & B. S.r.l. which had been previously used, made known and/or for which an application had been previously filed in Canada by the Opponent. Moreover, as the Applicant has not used the Mark since the date of alleged first use in Canada for the Wares (1) as claimed in the application, the Mark was also confusing with the Opponent's registered

trade-mark PANCALDI Design previously used and/or made known in Canada by the Opponent prior to any use by the Applicant, and for which an application has also been previously filed in Canada by the Opponent;

6. The Applicant is not the person entitled to the registration of the Mark pursuant to s. 16(2)(a), (b) and (c) since at the date of filing of the application, in respect of Wares (2) to (14) inclusive, the Mark was confusing with the Opponent's registered trade-marks PANCALDI & B Design and PANCALDI Design and the Opponent's trade-name Camiceria Pancaldi & B. S.r.l. which had been previously used, made known and/or for which an application had been previously filed in Canada by the Opponent.
7. Pursuant to s. 38(2)(d), the Applicant's Mark is not distinctive of the Applicant's Wares having regard to s. 2 of the Act since:
 - a) The Mark does not actually distinguish the Applicant's Wares from the wares of the Opponent nor is it adapted to distinguish them;
 - b) Because of the transfer of the Mark, there were subsisting rights of use of the Mark into two or more entities and those rights were exercised by those entities concurrently, contrary to the provisions of s. 48(2) of the Act;
 - c) The Mark is used outside the scope of protection governing licensed use of a trade-mark as defined in s. 50 of the Act.

III Analysis of the various grounds of opposition

The legal burden is upon the Applicant to show that its application comply with the provisions of the Act, but there is however an initial onus on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial onus is satisfied, the Applicant still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

- i) Conformity of the application to the requirements of s. 30

The first three grounds of opposition relate to the statements contained in the application. With respect to the first ground of opposition, the Opponent filed the affidavits of Mrs. Elliot. She was an articling student employed by the Opponent's agent firm. I shall not distinguish between the two affidavits she executed as they bore the same date, namely September 27, 2004. A lawyer of the Opponent's agent firm informed her that from a previous dispute, European Jewellery

Boutique was identified as the Applicant's main distributor in Canada. She provides the results of a search conducted on Dun & Bradstreet's Canadian database to locate information concerning an entity carrying on business under the trade-name European Jewellery Boutique in Toronto, Ontario. The entity found was 898112 Ontario Limited that was only incorporated on May 29, 1990. From a database maintained by Cyberbahn Inc. providing corporate information on registered Ontario corporations and business names, she was able to retrieve additional information on 898112 Ontario Limited. It would appear from these documents that it amalgamated on June 30, 2001 with 1169455 Ontario limited to form 1482948 Ontario Limited.

The Opponent is arguing that it was impossible for the Applicant to have used the Mark in Canada in association with Wares (1) as of the claimed date of first use since its distributor was not incorporated at that date. Accordingly, such evidence would be sufficient to meet the Opponent's light evidential burden. However the Opponent's evidence constitutes inadmissible hearsay evidence. The attorney, member of the Opponent's agents firm that provided the background information leading Mrs. Elliott to her search did not file an affidavit. By doing so, she avoided being cross-examined on such information. Apart from the hearsay evidence, there is no evidence that would establish a link between 898112 Ontario limited and the Opponent.

This situation can easily be distinguishable from the facts in *Pillsbury Co. v. Atlanta Imports Co.* (1999), 1 C.P.R. (4th) 252 cited by the Opponent. In that particular case the allegations that were hearsay evidence met the test set out in *R. v. Khan* [1990] 2 R.C.S. 531 of necessity and reliability. This is not our situation with respect to the background information given to Mrs. Elliott that forms the basis of her affidavit. In any event the fact that the Applicant's distributor was only incorporated after the alleged date of first use of the Mark in Canada does not preclude the situation where the Mark could have been used by the Applicant itself in Canada between the claimed date of first use and the incorporation date of the Applicant's distributor or that another distributor sold the Wares (1) in Canada during such period of time.

For these reasons I do not see any contradiction between the admissible evidence contained in Mrs. Elliott's affidavits and the allegations contained in the Applicant's application for the registration of the Mark. The first ground of opposition is therefore dismissed.

The Opponent has not adduced any evidence to meet its initial onus with respect to the second ground of opposition. It is therefore dismissed.

The Opponent filed a copy of the Registrar's decision dated November 6, 1996 in an opposition filed by the Opponent to application number 604809 in the name of the Applicant for the registration of the trade-mark VITALIANO PANCALDI V & Design in association with glasses, namely sun-glasses and sight-glasses; fittings and accessories therefore. The Registrar refused the Applicant's aforesaid application on the basis of a likelihood of confusion with the Opponent's registered trade-mark PANCALDI & B Design, certificate of registration TMA248785 raised in the present opposition. Therefore the Opponent argues that the Applicant could not have been satisfied that it was entitled to the registration of the Mark.

The relevant date for this ground of opposition is the filing date of the application (August 23, 1996). [See *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984) 3 C.P.R. (3d) 469] The Registrar's decision was not yet rendered when the Applicant filed the present application. Therefore the Applicant could not have been in bad faith when it filed this application. The third ground of opposition is also dismissed.

ii) Registrability

The material time for considering the issue of the registrability of the Mark is the date of the Registrar's decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)]

The Opponent filed a copy of the certificates of registration alleged in support of this ground of opposition. Therefore it has met its initial onus. The Registrar must then look at the evidence in the record to determine if there is a likelihood of confusion in the mind of the average consumer between the Mark and the Opponent's registered trade-marks illustrated hereinafter:

PANCALDI&B

certificate of registration TMA248785 in association with articles of clothing, namely dresses, shirts, blouses, pyjamas, dressing gowns, bodices, foulards, ties and belts; and

PANCALDI

certificate of registration TMA453633 in association with cosmetics, namely perfumes, essential oils, soaps for personal use, bath salts, dusty and compact powders, lipsticks and face rouges, beauty creams, nail enamels, hair sprays, shampoos and lotions, eye shadows.

The test for confusion is outlined in s. 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in s. 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

In *Miss Universe Inc. v. Bohna* (1995), 58 C.P.R. (3d) 381 Mr. Justice Décary described the test applicable to determine if there exists a likelihood of confusion in the following terms:

To decide whether the use of a trade-mark or of a trade-name causes confusion with another trade-mark or another trade-name, the Court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague recollection of that other mark or name [\[FN5\]](#), the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class. [\[FN6\]](#)

10 In determining whether there is a likelihood of confusion, the Court shall have regard to *all* the surrounding circumstances, including those described in subsection 6(5) above.

11 The onus is always upon an applicant for the registration of a trade-mark to establish that, on the balance of probabilities, there is no likelihood of confusion with a previously used and registered trade-mark.[\[FN7\]](#)

12 The stronger the mark is, the greater the ambit of the protection it should be accorded and the more difficult it will be for an applicant to discharge the onus. As noted by Mahoney J. (as he then was) in *Carson v. Reynolds*,[\[FN8\]](#) a trade-mark may be:

...so generally identified with [a person] that its use in association with anything else, however remote from entertainment services, would be confusing in the sense that its use in both associations would be likely to lead to the inference that all the wares and services, whatever they might be, emanated from [that person].

Examples abound, in the jurisprudence respecting opposition to registration of trade-marks, of the scope of protection to be afforded to strong marks [\[FN9\]](#) . The same is true in infringement cases[\[FN10\]](#) as well as in injunction cases[\[FN11\]](#) where weaker marks have also successfully passed the test.[\[FN12\]](#)

13 The factors enunciated in paragraphs 6(5)(a) to (e) need not be interpreted as having equal weight in all circumstances. Where, for example, a strong trade-mark is measured against a proposed mark, criteria (c) and (d), i.e. the nature of the wares, services or business and the nature of the trade, are not particularly determinative.

It is with these general principles in mind that I shall review the pertinent evidence and assess each relevant factor identified above and others if deemed necessary.

In *Camiceria Pancaldi & B S.r.l. v. Le Cravatte Di Pancaldi S.r.l.* 74 C.P.R. (3d) 551, the Registrar made the following findings with respect to the first relevant factor:

As noted by the applicant in its written argument, the opponent's mark possesses little inherent distinctiveness because the main component of the mark, that is, PANCALDI, is the surname of a person or would be perceived as the surname of a fictitious person. Thus, in the absence of acquired distinctiveness, the opponent's mark is not entitled to a wide ambit of protection. However, the opponent has shown that its mark has acquired some reputation in Canada through sales and advertising. In this respect, the opponent's evidence shows that it has sold clothing under its mark in the cities of Vancouver, Edmonton, Toronto, and Montreal (among others), at least as early as 1975, such sales amounting to about \$20,000 in 1975, rising to about \$245,000 in 1985 and thereafter falling to about \$61,000 in 1990. Similarly, the

applied for mark does not possess a high degree of inherent distinctiveness since the main components of the mark, that is, VITALIANO PANCALDI, would be perceived as the name of a real or fictitious person. The V design feature adds to the mark's inherent distinctiveness, however, there is no evidence showing that the applied for mark had acquired any reputation in Canada. The length of time that the marks in issue have been used in Canada favours the opponent, as the opponent has been using its mark in Canada since at least as early as 1975 and there is no evidence that the applicant has begun to use its mark.

Obviously the issue of acquired distinctiveness of the parties' marks has to be determined in accordance with the evidence filed. Ms. Zibin has translated Mr. Ranicchi's affidavit, the Opponent's Chairman of the Board, from Italian to English. He alleges that the Opponent's registered trade-marks have been used in Italy since 1949 and thereafter in many other countries around the world including Canada. Mr Ranicchi states:

10. My Company [the Opponent] began selling its clothing articles and fashion accessories to Canadian retailers under one or more of the PANCALDI Trade-Marks in the 1970s, and thereafter sold other goods in Canada under the PANCALDI Trade-Marks, including perfumery.

"PANCALDI Trade-Marks" is a defined term in his affidavit that includes the Opponent's registered trade-marks identified in the statement of opposition as well as other trade-marks. The Registrar cannot expand the grounds of opposition beyond what has been clearly defined as in this case. If the Opponent's intention was to rely on other trade-marks it ought to amend its statement of opposition which it failed to do so. The Applicant has to know what it is facing and will tailor its evidence and argumentation accordingly. [See *Imperial Developments Inc. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12]

Mr. Ranicchi alleges that merchandise sold by the Opponent have labels or tags fixed to the garments bearing one of those marks. He filed samples of labels and packaging used in Canada since the 1970s in association with articles of clothing. He provides the sales figures for Canada of products sold in association with the PANCALDI Trade-Marks from 1984 to October 2003 as well as for the years 1975 to 1977 inclusive. He filed samples of invoices issued to Canadian customers to evidence the sale of merchandise bearing the PANCALDI Trade-Marks. One would

think that such evidence would be sufficient to conclude that the Opponent's registered trademarks have been in use in Canada since the 1970s in association with articles of clothing. The Applicant, not surprisingly, thinks differently.

The Applicant argues that the sample tags, labels and boxes illustrated on the photographs exhibit B to Mr. Ranicchi's affidavit do not constitute evidence of use of the registered trademark PANCALDI & B Design as illustrated above. The mark represented therein consists of the trade-mark PANCALDI & B written in block letters without the black line underlining the trade-mark, which could be viewed as a stylized B. To support such contention the Applicant cited the case of *Hughes Etigson v. Newell Industries Canada Inc.* (1998), 82 C.P.R. 560. The Registrar concluded that the absence of the distinctive blind design element, which looks like a dark line underlining the trade-mark, was fatal. The test applicable in those situations has been set out in *Promafil Canada Ltée v. Munsingwear Inc.* (1992) 44 C.P.R. (3d) 59, where MacGuigan J.A. stated:

Obviously, with every variation the owner of the trademark is playing with fire. In the words of Maclean J., "the practice of departing from the precise form of a trade-mark as registered . . . is very dangerous to the registrant." But cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser. (My underlines)

I agree with the Applicant's position. The stylized B that includes the underlining of the trade-mark as well as the lettering used in the word PANCALDI are essential features of the trade-mark PANCALDI & B Design. Therefore I cannot consider the use of the word mark PANCALDI & B as use of the registered trade-mark. It could not also be considered as use of the PANCALDI & Design trade-mark because the stylized P, the lettering used and the black line underling the trade-mark are all missing essential features.

The inscription Pancaldi & B Design appears on the invoices attached to Mr. Ranicchi's affidavit. Mr. Ranicchi states that the invoices "...have travelled with My Company's goods at the time of sale to Canadian customers under one or more of the PANCALDI Trade-Marks". The representation of the trade-mark PANCALDI & B Design on the invoices is similar to the

situation described in the unreported decision of the Registrar in a s. 45 proceeding with respect to registration TMA373989 dated January 31, 2006. The trade-mark PANCALDI & B Design appears in greater prominence than the rest of the information appearing on the top left hand portion of the invoices. I do consider such inscription on the invoices as proper evidence of use of the trade-mark PANCALDI & B Design as contemplated in s. 4(1) of the Act.

There has been no evidence of use of the Mark in Canada. From the above I conclude that neither the Opponent's registered trade-marks nor the Mark are inherently distinctive. However there is some limited evidence of use of the Opponent's trade-mark PANCALDI & B Design between 1973 and 2000. As such it is known in Canada to some limited extent. Consequently the first factor does slightly favour the Opponent.

The length of time the trade-marks in issue have been used favours the Opponent as there is some evidence of use of the trade-mark PANCALDI & B Design as detailed in the preceding paragraphs.

As for the nature of the Wares there is an overlap between the wares covered by the Opponent's certificates of registration and the Applicant's following wares:

Cravates;

Nécessaires de rasage, de manucure et de pédicure;

Peignes, brosses et éponges; blaireaux;

Tissus, tissus de haute couture, handkerchiefs; sponge cloth;

Articles d'habillement et accessoires relatifs, nommément cravates, foulards, pochettes, noeuds papillon, plastrons, guimpes, foulards plissés pour homme (de style marin), larges ceintures pour smoking (cummerbunds), gilets, écharpes, châles, bretelles, jarretières, chaussettes, bas, chapeaux, robes de chambre, jaquettes de chambre, peignoirs, pantoufles; pochettes, bourses, sacs, étuis et fourreaux spéciaux pour les articles précités.(hereinafter referred to as the « Overlapping Wares »

In *Camiceria Pancaldi & B S.r.l. supra*, my colleague Mike Herzig made the following statement:

The parties' wares are of course different. However, the unchallenged and uncontradicted evidence of Messrs. De Stefanis and Inghirami is that it is common for the same mark to be used in association with both clothing and with fashion accessories including eye-glasses and sun-glasses. Their evidence is further supported, to some extent, by Ms. McDonald's state of the trade-marks register

evidence. The state of the register evidence shows various marks "that consist of, or appear to consist of, designer's names" including PIERRE BALMAN, PIERRE CARDIN, BILL BASS, DONNA KARAN NEW YORK, SIMON CHANG, and CHRISTIAN DIOR [about eighteen names in all], are registered for clothing as well as for eyeglasses and sunglasses.

I do not have the same allegations in Mr. Ranicchi's affidavit. However I do have state of the register evidence. Ms. Smallwood, a trade-mark agent employed by the Opponent's agents firm, filed approximately 75 extracts of the register consisting of names or surnames of real or fictitious persons that are recognized in the clothing business. To name a few the search includes LACOSTE, OSCAR DE LA RENTA, GIORGIO ARMANI, BOSS HUGO BOSS & design, CHRISTIAN DIOR, GUCCI, RALPH LAUREN, LIZ CLAIRBORNE, YVES SAINT LAURENT, SIMON CHANG etc... The registrations and applications referred thereto cover not only articles of clothing but also clothing related and non-clothing items. There are various trade-mark registrations covering articles of clothing and related clothing products such as eyewear and jewellery. As such I would add to the list of wares covered by the defined term Overlapping Wares the following related wares:

Lunettes; cordonnets de lunettes; fourreaux, pochettes, bourses et étui spéciaux pour les articles précités;
joaillerie, bijouterie.

The Opponent invites the Registrar to expand the protection of its registered trade-marks to non-related fashion items on the basis that a consumer, familiar with a designer trade-mark would associate such designer as the source of any non-related fashion products. I am not convinced that the evidence filed by the Opponent establishes that it is a well-known fashion designer. The name of a real or fictitious character could be registered in association with articles of clothing without necessarily qualifying such name as a fashion designer. I am not prepared to entertain the possibility of expanding the scope of protection afforded by Opponent's certificates of registration beyond the Overlapping Wares.

The Applicant failed to file evidence that would enable me to conclude that there is no overlap in the channels of trade it used or will be using for the sale of the Overlapping Wares. For these wares, this factor also favors the Opponent.

In *Camiceria Pancaldi & B S.r.l.* supra at page 556, the Registrar concluded that the Mark resembles the Opponent's registered trade-mark PANCALDI & B Design as it incorporates the entirety of the most distinctive portion of the aforesaid Opponent's trade-mark and the idea suggested by the parties' respective trade-marks is the surname of a real or fictitious fashion designer. I have no reason to depart from such conclusion. Therefore this factor favours the Opponent.

As additional surrounding circumstances the Opponent argued the existence of a family of trade-marks that would entitle its trade-marks to a wider ambit of protection. The Applicant argued that it obtained a certificate of registration for the trade-mark VITALIANO PANCALDI & Design (slightly different than the Mark) number TMA379823 covering high fashion clothing for men and women and ready-to-wear clothing, namely ties and foulards as well as certificate of registration TMA591880 for the trade-mark VITALIANO & Design in association with articles of clothing and various accessories thereof. Finally it also filed state of the register evidence to argue that names and surnames of designers such as Klein and variation thereof coexist with designers' trade-marks when registered in association with wares unrelated to clothing items. I shall address each of these issues.

In order to successfully argue the existence of a family of trade-marks the Opponent must tender evidence of use of its trade-marks that are part of the alleged family of trade-marks. [See *MacDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R.(2d)101] The Opponent refers in its statement of opposition to two registered trade-marks illustrated above. There is limited evidence of use of only one of them. Therefore I cannot consider the Opponent's argument that there exists a family of trade-mark. In any event, two trade-marks does not create a family of trade-marks.

The Applicant filed a copy of certificates of registration it obtained previously. The fact that a trade-mark appears on the register does not give an automatic right to its owner to the registration of a similar trade-mark. [See *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.* (1985), 4 C.P.R. (3d) 108]

Finally the state of the register evidence filed by the Applicant in the form of the certificates of registration for the trade-mark CALVIN KLEIN, ANNE KLEIN and two different registrations for the trade-mark KLEIN is too tenuous to draw a conclusion that consumers are able to make a distinction between various designers' names that incorporate the same surname. Certificate of registration TMA405016 for the trade-mark KLEIN covers professional and industrial hand tools while certificate of registration TMA515822 (for the same trade-mark) covers bicycles. The connection between those wares and articles of clothing or related wares is so remote that these trade-marks are able to coexist on the register.

From the above analysis I conclude, on a balance of probabilities, that a consumer with an imperfect recollection of the Opponent's registered trade-marks PANCALDI & B Design and PANCALDI Design would think that the Overlapping Wares originate from the Opponent. I reach this conclusion on the basis of the similarities of the parties' respective wares, in so far as the Overlapping Wares are concerned and the degree of resemblance between the Mark and the Opponent's registered trade-marks. Therefore the Applicant has not met its burden to prove on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registered trade-marks in so far as the Overlapping Wares are concerned. The fourth ground of opposition is maintained only with respect to the Overlapping Wares. The difference in the nature of the remainder of the Wares and their possible channels of trade is sufficient to conclude that, on a balance of probabilities, there exists no likelihood of confusion between the Mark and the Opponent's registered trade-marks for those wares.

iii) Entitlement

The material time for considering the issue of non-entitlement to the registration of the Mark is the alleged date of first use of the Mark for the portion of the application based on use. [See s.

16(1) of the Act]. As for the remainder of the application, the relevant date is the filing date of the present application. [See s. 16(2) of the Act]

Such ground of opposition can only succeed if there is evidence of prior use of the trade-marks alleged by the Opponent in support of this ground of opposition. The Opponent has specifically referred to the prior use of the trade-marks identified in the fourth ground of opposition. I already determined that there was evidence of use of the Opponent's registered trade-mark PANCALDI & B Design. Such evidence is limited to the period of 1973 to 2000. The Opponent had to prove that it did not abandon the use of its trade-mark at the advertisement date of the application, namely July 30, 2003. There is no evidence of use of such trade-mark between 2001 and the advertisement date.

The Opponent is also alleging prior use of the trade-name Camiceria Pancaldi & B S.r.l. in support of such ground of opposition. The only relevant evidence with respect to this issue are invoices attached to Mr. Ranicchi's affidavit. However the first invoice on which appears the aforesaid trade-name is dated August 26, 1999 which is subsequent to the alleged date of first use with respect to Wares (1) and the filing date of the application with respect to Wares (2). Lastly, application 689124 for the trade-mark PANCALDI & Design that lead to the issuance of certificate of registration TMA453633 was filed on September 13, 1991. It was registered on February 9, 1996. As such it was no longer pending when the present application was advertised. (See s. 16(4) of the Act). The Opponent failed to meet its initial onus on each ground of opposition under entitlement. Therefore the fifth and sixth ground of opposition are also dismissed.

iv) Distinctiveness

It is generally accepted that the filing date of the statement of opposition is the critical date to assess the distinctiveness of the Mark as a ground of opposition. [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.), *Park Avenue Furniture Corporation, op. cit* and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]

The Opponent failed to adduce any evidence to meet its initial onus with respect to paragraph 7 b) and c) described above. As such those grounds are dismissed.

Paragraph a) is a mere reproduction of the wording of the Act. There are no material facts alleged to support such ground of opposition. It is therefore dismissed. In any event assuming that the Opponent's evidence does establish that its trade-mark PANCALDI & B Design was known in Canada to some extent at the relevant date, the issue would be to determine if there exists a likelihood of confusion between such trade-mark and the Mark. The difference in the material date would not alter the conclusion I reach under the registrability ground of opposition. The net result would be that this ground of opposition would be maintained only for the Overlapping Wares.

IV Conclusion

In view of the above, pursuant to s. 38(8) of the Act and having been delegated by the Registrar of Trade-marks by virtue of s. 63(3), I refuse the present application as applied for the following wares:

Cravates;

Nécessaires de rasage, de manucure et de pédicure;

Peignes, brosses et éponges; blaireaux;

Lunettes; cordonnets de lunettes; fourreaux, pochettes, bourses et étui spéciaux pour les articles précités;

joaillerie, bijouterie;

Tissus, tissus de haute couture, handkerchiefs; sponge cloth;

Articles d'habillement et accessoires relatifs, notamment cravates, foulards, pochettes, noeuds papillon, plastrons, guimpes, foulards plissés pour homme (de style marin), larges ceintures pour smoking (cummerbunds), gilets, écharpes, châles, bretelles, jarretières, chaussettes, bas, chapeaux, robes de chambre, jaquettes de chambre, peignoirs, pantoufles; pochettes, bourses, sacs, étuis et fourreaux spéciaux pour les articles précités

and otherwise reject the Opponent's opposition to the registration of the Applicant's Mark as applied to the remainder of the wares. In this regard, I would note the decision of the Federal Court, Trial Division in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf*

GmbH, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED IN BOUCHERVILLE, QUEBEC, THIS 14th DAY OF MAY 2007.

Jean Carrière,
Member,
Trade-marks Opposition Board