

IN THE MATTER OF AN OPPOSITION
by Commerciale Abbigliamento S.p.A.
to application No. 585,812 for the
trade-mark L.A. BLUES Design filed
by Jay-Gur Import Inc.

On June 11, 1987, the applicant, Jay-Gur Import Inc., filed an application to register the trade-mark L.A. BLUES Design (illustrated below) based on proposed use in Canada for the following description of wares:

jeans, underwear, socks, sweaters, T-shirts,
blouses, shirts, jackets, shorts, all pants.
All of the above should apply for boys, girls,
infants, men and ladies.

The application was advertised for opposition purposes on January 17, 1988.

The opponent, Commerciale Abbigliamento S.p.A., filed a statement of opposition on March 9, 1988, a copy of which was forwarded to the applicant on April 6, 1988. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark I BLUES registered under No. 267,680 for "clothing for women, namely blouses, belts, sweaters and skirts."

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

As for the opponent's ground of opposition based on its registered trade-mark I BLUES, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks of both parties are inherently distinctive, neither having any obvious suggestion or connotation relating to the associated wares. There is no evidence of use of the applicant's mark prior to the filing of the opposition and I must therefore conclude that it had not become known at all in Canada as of the material time. The Rami affidavit evidences continuous (albeit minor) sales in association with the opponent's mark in Canada from 1980 on. Based on that evidence, I am able to conclude that the opponent's mark had become known to a very limited extent. The opponent also sought to rely on advertisements for the opponent's mark appearing in several foreign language publications (see Exhibit B to the Rami affidavit) but there is no evidence that those publications had any circulation in Canada.

The length of time the marks have been in use favors the opponent. The wares of the parties are similar and presumably the trades would also be similar. In fact, the applicant makes the following statement at page 9 of its written argument:

The nature of the wares and of the trade
are identical.

As for Section 6(5)(e) of the Act, the marks of the parties bear a fairly high degree of visual and phonetic resemblance since both are dominated by the word BLUES. To the extent that both marks include the word BLUES, there is some resemblance in the ideas suggested insofar as that word describes a state of melancholy or a type of music. The applicant submitted that the component L.A. of its trade-mark served to distinguish it from the opponent's mark. However, that component comprises initials and is therefore inherently weak. Furthermore, it is a subsidiary feature of the applicant's mark. The subsidiary nature of the element L.A. is apparent from the applicant's hangtags (see Exhibit C to the Gurman affidavit) where the component L.A. is not easily discernible from the balance of the mark.

It is the applicant's contention that the effect of the foregoing is mitigated substantially by the common adoption by other traders of similar marks for clothing. In support of this position, the applicant has relied on the Harris affidavit which evidences about a dozen registrations for trade-marks including the word BLUES for various clothing wares. The Harris affidavit also evidences a number of pending applications for such marks but all but two of them are based on proposed use.

In view of the above, I am only able to conclude that a very few (if any) of the registered marks are in use. Thus, Canadian consumers might, to a very limited extent, be accustomed to seeing such marks used for clothing and would, to an equally limited extent, distinguish such marks on the basis of their other components. Such a conclusion, however, is of less note in the present case since the other component in the applicant's mark is subsidiary to the word BLUES which dominates the mark.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have further considered the similarities between the wares and trades of the parties. I have also considered the fairly high degree of resemblance between the marks which has, in my view, only been mitigated to a minor extent by the applicant's evidence. On balance, I remain in doubt as to whether or not the marks are confusing. However, since the onus is on the applicant, I must resolve my doubt against it and find the ground of opposition based on the opponent's registration to be successful. The remaining grounds need not be considered.

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

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

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