

**IN THE MATTER OF AN OPPOSITION by Chantelle to
application No. 730,153 for the trade-mark CHANDEAL &
Design filed by Kabushiki Kaisha Chandeal**

On June 3, 1993, the applicant, Kabushiki Kaisha Chandeal, filed an application to register the trade-mark CHANDEAL & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with

“Trousers; skirts; blouses; sweaters; jackets; jumpers; suits; coats; overcoats; shirts; pants; furs; underclothing; lingerie; brassieres; belts; caps; ear muffs; gloves; lace boots; neckties; scarves; suspenders; girdles”.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of January 26, 1994 and the opponent, Chantelle, filed a statement of opposition on June 27, 1994, a copy of which was forwarded to the applicant on August 10, 1994. The applicant served and filed a counter statement on November 28, 1994 in which it effectively denied the opponent's grounds of opposition. The opponent submitted as its evidence the affidavits of Gilles Morin and Chantal Bouchard, together with a certified copy of registration No. 132,230 for the trade-mark CHANTELE. The applicant filed as its evidence the affidavit of Philippe Martin. As evidence in reply, the opponent submitted a second affidavit of Chantal Bouchard. The applicant alone filed a written argument and the opponent alone was represented at an oral hearing.

As its first ground, the opponent alleged that the present application does not satisfy the requirements of Section 30 of the *Trade-marks Act* in that the applicant had already used the trade-mark CHANDEAL & Design in Canada or, in the alternative, that the applicant never had the intention of using the trade-mark in Canada. Finally, the opponent alleged that the applicant's claim that it is satisfied that it is entitled to use the trade-mark CHANDEAL & Design is false, having regard to the remaining submissions set forth in the statement of opposition. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*,

there is an initial evidentiary burden on the opponent in respect of the Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidentiary burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. Further, the opponent may rely upon the applicant's evidence to meet its initial evidentiary burden. The material date for considering this ground is the filing date of the present application.

No evidence has been furnished by the opponent in respect of its Subsection 30(e) ground and there is nothing in the Martin affidavit which is inconsistent with the applicant's claim that, as of the filing date of the present application, the applicant intended to use the trade-mark CHANDEAL & Design in Canada. As a result, I have dismissed the first two issues raised under the Section 30 ground. The third issue relates to the applicant's application being in compliance with Subsection 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant's claim that it is satisfied that it is entitled to use the trade-mark CHANDEAL & Design is false, having regard to the remaining submissions set forth in the statement of opposition. However, no evidence has been furnished by the opponent to show that the applicant could not properly have been satisfied that it was entitled to use its trade-mark CHANDEAL & Design in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-mark CHANTELLE. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition which are based on allegations of confusion between the applicant's trade-mark CHANDEAL & Design and the opponent's trade-mark and trade-name CHANTELLE.

The second ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark CHANDEAL & Design is not registrable in that it is confusing with the registered trade-mark CHANTELLE, registration No. 132,230, covering "corselettes and brassieres; gaines, gaine-culottes et culottes". As its third ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark CHANDEAL

& Design in view of Paragraph 16(3)(a) of the *Trade-marks Act* in that the applicant's mark is confusing with its trade-mark CHANTELE which had previously been used and made known in Canada by it and its predecessors-in-title in association with its wares, services and its lingerie business. The fourth ground is based on Paragraph 16(3)(c) of the *Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark CHANDEAL & Design in that the applicant's mark is confusing with its trade-name Chantelle which had been previously used in Canada in association with its wares, services and its lingerie business.

As its final ground, the opponent alleged that the applicant's trade-mark CHANDEAL & Design is not distinctive in view of the adoption, registration, use and making known of the opponent's trade-mark and trade-name. As well, the opponent alleged that the applicant's trade-mark is not distinctive in that, as a result of the transfer of the applicant's mark, there existed rights in two or more persons to the use of the trade-mark CHANDEAL & Design and these rights have been exercised concurrently by these persons. Finally, the opponent alleged that the applicant's trade-mark is not distinctive in that the applicant has permitted third parties to use the trade-mark CHANDEAL & Design in Canada outside the legislative provisions regulating the use under license of a trade-mark, contrary to Section 50 of the *Trade-marks Act*.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks CHANDEAL & Design and CHANTELE as of the material dates, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically set forth in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material dates. In this regard, the material date in respect of the ground of opposition based on Paragraph 12(1)(d) of the *Act* is the date of decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)] while the material date for considering the non-entitlement grounds of opposition is the applicant's filing date [June 3, 1993] and the material date relating to the non-distinctiveness ground is the date of opposition [June 27, 1994].

With respect to Paragraph 6(5)(a) of the *Act*, both the applicant's trade-mark CHANDEAL & Design and the opponent's trade-mark CHANTELLE appear to be coined terms and are therefore inherently distinctive. As no evidence relating to use of the trade-mark CHANDEAL & Design has been adduced by the applicant, its trade-mark must be considered as not having become known to any extent in Canada. The affidavit of Gilles Morin, Vice-President of Operations of the opponent's Canadian distributor, Saint-Hilaire Inc., establishes that the trade-mark CHANTELLE has become fairly well known in Canada in association with women's undergarments with sales of \$23,000,000. by Saint-Hilaire Inc. to retailers in Canada between December 1978 and December 1994. According to Mr. Morin, this figure can be multiplied by two to arrive at the dollar value of retail sales of the opponent's wares in association with the trade-mark CHANTELLE. Further, according to Mr. Morin, his company expended more than \$1,100,000 between 1978 and 1994 advertising and promoting the opponent's CHANTELLE wares in Canada. As a result, the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] weighs in the opponent's favour. Likewise, the length of time the marks have been in use [Para. 6(5)(b)] is a further factor weighing in the opponent's favour in that the trade-mark CHANTELLE has been used in Canada since at least 1978 in association with brassieres, corselettes, girdles, culottes, slips, panties, camisoles, garters, corsets and pyjamas whereas no evidence has been furnished by the applicant relating to its use of the trade-mark CHANDEAL & Design in Canada.

Paragraphs 6(5)(c) and (d) of the *Act* require the Registrar to have regard to the nature of the wares of the parties and their respective channels of trade. The present application covers underclothing, lingerie, brassieres, and girdles which overlap the "corselettes and brassieres; gaines, gaine-culottes et culottes" covered in registration No. 132,230 while the applicant's trousers, skirts, blouses, sweaters, jackets, jumpers, suits, coats, overcoats, shirts, pants, furs, belts, caps, ear muffs, gloves, lace boots, suspenders, neckties and scarves fall within the general category of wearing apparel and are therefore related to the opponent's wares. Further, and in the absence of any evidence to the contrary, I would expect that there could be a potential overlap in the respective channels of trade of the parties.

As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the trade-

marks CHANDEAL & Design and CHANTELLE bear at least some similarity in appearance when considered in their entireties as a matter of immediate impression from the point of view of the average consumer having an imperfect recollection of the opponent's mark. With respect to the applicant's mark, I would also note that the script lettering is such that some consumers might well identify the mark as being CHARDEAL rather than CHANDEAL although I have proceeded on the basis that the average consumer is more likely to identify the mark as CHANDEAL & Design. Furthermore, the trade-marks CHANDEAL & Design and CHANTELLE do not appear to convey similar ideas.

With respect to the sounding of the trade-marks at issue, the opponent has relied upon the affidavits of Chantal Bouchard, a linguist, while the applicant has submitted the affidavit of Philippe Martin who identifies himself as also being a linguist by training. Having regard to their respective qualifications, I am satisfied that both Ms. Bouchard and Mr. Martin have qualified themselves as experts in linguistics and their opinions are therefore admissible as expert opinion evidence. Further, having regard to the decision in *Ethicon Inc. v. Cyanamid of Canada Ltd.*, 35 C.P.R. (2d) 126, at pp. 135-136, expert evidence relating to the pronunciation of a word would appear to be admissible evidence. However, while Ms. Bouchard has qualified herself to give expert opinion evidence in respect of the pronunciation of the trade-marks at issue in the French language, she has not qualified herself to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in the English language. On the other hand, Mr. Martin has qualified himself to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in both the English and French languages and is therefore qualified to give his opinion relating to the pronunciation of the trade-marks from the point of view of the average bilingual Canadian. In this regard, and bearing in mind the bilingual character of Canada, it is the average bilingual consumer, either anglophone or francophone, who must be considered in assessing the issue of confusion. Further, equal importance must be accorded to the English language as to the French language in assessing this issue [see *Boy Scouts of Canada v. Alfred Strenjakob GmbH & Co. KG et al*, 2 C.P.R. (3d) 407, at pp. 412-413; *Scott Paper Co. v. Beghin-Say S.A.*, 5 C.P.R. (3d) 225, at p. 231; *Ferrero S.p.A. v. Les Produits Freddy Inc.*, 22 C.P.R. (3d) 346]. In *Les Vins La Salle Inc. v. Les Vignobles Chantecler Ltée*, 6 C.P.R. (3d) 533, at pp. 535-536, the Hearing Officer commented on the issue of the average bilingual

consumer as follows:

In addition to giving evidence relating to the pronunciation of the trade-marks at issue, both Ms. Bouchard and Mr. Martin have given their opinions as to whether the public would be confused by the sounding of the trade-marks as issue. In *Etablissements Leon Duhamel, now K Way International v. Creations K.T.M. Inc.*, 11 C.P.R. (3d) 33, the following comments concerning the admissibility of expert opinion evidence on the ultimate issue to be decided in an opposition appear

at pp. 40-41:

The conflicting opinions of the experts in the present case emphasizes the fact that the Registrar of Trade-marks is not justified in adopting an expert's opinion simply on the basis of his or her expertise. As Mr. Justice Mahoney pointed out in *William H. Rorer (Canada) Ltd. v.*

Johnson & Johnson, 48 C.P.R. (2d) 58, at p. 62, referred to in the above extract from the *Etablissements Leon Duhamel* decision, the adjudicator must know the facts and/or assumptions upon which the expert bases his or her opinion so that he can assess the validity of the opinion and the process by which it was reached. In the present case, both experts based their opinions on similar assumptions and yet appeared to reach opposite opinions on the issue of confusion.

Having considered the affidavits of Philippe Martin and Chantal Bouchard, I am inclined to agree with the analysis and conclusions reached by Ms. Bouchard relating at least to the pronunciation of the trade-marks at issue from the point of view of the average francophone. As a result, I cannot give much weight to Mr. Martin's opinion relating to the pronunciation of the trade-marks at issue from the perspective of the average bilingual Canadian which is based in part on his opinion as to the pronunciation of the trade-marks at issue by the average francophone. I have concluded therefore that there is some similarity in the sounding of the trade-marks at issue when the marks are pronounced by the average bilingual Canadian in view of the identical initial components of the marks. Further, I am mindful that greater emphasis is placed on the initial components of trade-marks when considering the degree of similarity between them in their sounding.

Having regard to the degree of similarity both in appearance and in sounding between the trade-marks at issue as applied to related wares which could travel through the same channels of trade, and bearing in mind that the opponent has established that its trade-mark CHANTELLE is fairly well known in Canada, I am left in doubt on the issue of confusion and therefore find that the applicant has failed to meet the legal burden upon it of satisfying the Registrar that there would be no reasonable likelihood of confusion between the applicant's trade-mark CHANDEAL & Design and the opponent's registered trade-mark CHANTELLE. Consequently, the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 19th DAY OF MARCH, 1998.

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