IN THE MATTER OF AN OPPOSITION by Chanel, S.A. to application No. 581,004 for the trade-mark CIRCLES Design filed by Shannon Ford

On March 30, 1987, the applicant, Shannon Ford, filed an application to register the trade-mark CIRCLES Design (illustrated below) for "jewellery and statuettes" based on use in Canada since December 12, 1986. The application was advertised for opposition purposes on December 23, 1987.

The opponent, Chanel, S.A., filed a statement of opposition on March 29, 1988, a copy of which was forwarded to the applicant on April 22, 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 CC Design (illustrated below) registered under No. UCA18537 for a number of wares including various toiletry preparations, cosmetic products, clothing items, hair accessories and "costume jewelry."

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Bernard Lehmann and Normand S. Pitre. The applicant filed the affidavit of Shannon Ford. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

The material time for considering the circumstances respecting the opponent's ground of opposition based on Section 12(1)(d) of the Act 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 between the marks of the parties. 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 opponent's design mark is inherently distinctive although it is perhaps not inherently strong in view of the use of the letter C and its mirror image as components

of the mark. There is no clear evidence of use of the opponent's mark in association with costume jewelry. There is, however, some evidence of use of that mark for wearing apparel and accessories and extensive evidence of use of that mark for toiletry preparations and cosmetic products. Thus, although the opponent has evidenced no reputation for its mark in relation to costume jewelry, it has evidenced a minor reputation in relation to wearing apparel and accessories and its mark has become very well known in Canada in association with toiletry prepartions and cosmetic products.

The applicant's mark is also inherently distinctive although it, too, could be perceived as including the letter C and its mirror image. To that extent, the applicant's mark is not inherently strong. The applicant has only evidenced limited use of her mark in the Calgary area such that I can only ascribe to it a limited acquired reputation.

The length of time the marks have been in use is not a material factor in the present case. Although the opponent has apparently had lengthy use of its mark for such products as perfume, it would appear that it did not commence use of its mark for costume jewelry until 1986. Notwithstanding the applicant's claimed date of first use, it would appear that she first used her mark as early as 1984.

For the most part, the wares of the parties are different. However, the opponent's registration does cover "costume jewelry" which presumably falls within the wares "jewellery and statuettes" set forth in the applicant's application. The applicant submitted that its wares and trade are different from the opponent's in that the applicant's wares are not mass-produced, are not sold through regular retail outlets and are made from precious metals. However, the applicant's statement of wares contains none of these restrictions and it is the statements of wares of both parties that govern: see the decisions of the Federal Court of Appeal in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112. Thus, I must conclude that there is a potential overlap in the wares and trades of the parties as claimed.

As for Section 6(5)(e) of the Act, the marks of the parties bear a fairly high degree of visual resemblance. Both marks comprise a circle enclosing two interlocked elements which could be viewed as the letter C and its mirror image. Insofar as both marks include the similar interlocked elements, there is also a potential phonetic resemblance between the marks since they both could be identified as CC.

The applicant submitted that an additional surrounding circumstance in the present case is the absence of evidence of incidents of actual confusion between the marks. However, given the lack of evidence of any contemporaneous use of the two marks in the same geographical area, the absence of evidence of actual confusion is hardly surprising.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities in the wares, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing

with the opponent's registered mark. The ground of opposition based on Section 12(1)(d) of the Act is therefore successful and 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 April, 1991.

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