

IN THE MATTER OF AN OPPOSITION by Hugo Boss AG to
application No. 586,911 for the trade-mark VICTOR HUGO &
Design filed by Paragon Clothing Ltd.

On June 29, 1987, the applicant, Paragon Clothing Ltd., filed an application to register the trade-mark VICTOR HUGO & Design, a representation of which appears below, based on proposed use of the trade-mark in Canada in association with "men's suits, jackets, vests, coats and pants, constructed and unconstructed". The application was advertised for opposition purposes on February 24, 1988.

The opponent, Hugo Boss AG, filed a statement of opposition on March 21, 1988, a copy of which was forwarded to the applicant on April 13, 1988. The grounds of opposition include, among others, that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark HUGO BOSS previously used in Canada by the opponent with "men's clothing, including pants, jackets, suits, vests and coats".

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavit of Konrad Jud while the applicant filed the affidavit of Marvin Tkatch.

The opponent subsequently requested and was granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to file as further evidence the affidavits of Ian Luis Mendes and John Ribeiro. Both Mr. Mendes and Mr. Ribeiro were cross-examined on their affidavits and the transcripts of the cross-examinations, together with exhibits to the cross-examinations and an undertaking furnished by the opponent, form part of the opposition record. In response to the Mendes and Ribeiro affidavits, the applicant filed the affidavit of Jack Korman and a second affidavit of Marvin Tkatch.

Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

With respect to the ground of prior entitlement based on Section 16(3) of the Act, the Jud affidavit establishes that the opponent has used its trade-mark HUGO BOSS in Canada in association with men's clothing prior to the applicant's filing date. The Jud affidavit also evidences non-abandonment of the opponent's mark as of the date of advertisement (February 24, 1988) of the applicant's application for opposition purposes in the Trade-marks Journal. Accordingly, the opponent has met the initial burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act.

In view of the above, the ground of prior entitlement remains to be decided on the issue of confusion between the trade-marks VICTOR HUGO & Design and HUGO BOSS. In accordance with the clear wording of Section 16(3) of the Act, the material time for considering the circumstances respecting this issue is as of the applicant's filing date. Furthermore, the onus or legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Trade-marks Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

Both the applicant's mark VICTOR HUGO & Design and the opponent's mark HUGO BOSS are inherently weak since both marks would be perceived by the average Canadian consumer as being the name of a person. In this regard, the trade-mark HUGO BOSS was the name of the founder of the opponent's business (see paragraph 3 of the Jud affidavit) while the mark VICTOR HUGO would be recognized by many Canadians as being the name of the French author.

The applicant did not commence using its trade-mark until after filing its proposed use trade-mark application. Consequently, the applicant's mark had not become known at all in Canada as of the filing date of its application, the material time in respect of the Section 16(3) ground of opposition. There had, however, been fairly extensive use of the opponent's trade-mark HUGO BOSS in Canada in association with men's clothing, Canadian sales for the period 1984 to 1986 alone being about \$5 million. As noted by the applicant and as confirmed by the opponent's agent at the oral hearing, the opponent often employs its trade-mark HUGO BOSS in conjunction with and subsidiary to its trade-mark BOSS. Nevertheless, having regard to the opponent's evidence, I am able to conclude that its trade-mark HUGO BOSS had become known to some extent in Canada as of the applicant's filing date.

The length of time the trade-marks have been in use (Section 6(5)(b)) clearly favours the opponent, its mark having been used in Canada since at least as early as 1975. The wares (Section

6(5)(c) of the parties are the same and, having regard to the evidence of the parties, the channels of trade (Section 6(5)(d)) associated with their wares would overlap. Indeed, the wares of the parties have been sold through the same men's retail clothing stores in Canada.

As for Section 6(5)(e) of the Act, the applicant's trade-mark is dominated visually by the word HUGO which is the initial element of the opponent's trade-mark. However, the opponent's evidence establishes that its trade-mark HUGO BOSS is often used in conjunction with and subsidiary to the mark BOSS. As such, the element BOSS would be perceived visually by the average consumer as being the dominant element of the opponent's trade-mark. Nevertheless, there does appear to be at least some similarity in appearance between the trade-marks VICTOR HUGO & Design and HUGO BOSS when considered as a matter of immediate impression and imperfect recollection. Further, the trade-marks VICTOR HUGO & Design and HUGO BOSS bear little resemblance when sounded.

While both marks suggest the idea of the name of a person including the element HUGO, the word HUGO is a given name in the opponent's trade-mark HUGO BOSS and a Christian name in the applicant's trade-mark VICTOR HUGO & Design. As well, the applicant's trade-mark suggests the name of the French novelist Victor Hugo.

In his first affidavit, Mr. Tkatch states that sales of the applicant's wares in association with its trade-mark VICTOR HUGO for the period July 1987 to June 1989 totalled \$1,015,793.05. Mr. Tkatch has also provided evidence relating to the advertising and promotion of the applicant's VICTOR HUGO suits in Canada. Further, the affiant points out that, despite the extensive sales and advertising of the applicant's VICTOR HUGO men's clothing, no instances of confusion with respect to the opponent's HUGO BOSS trade-mark have been brought to the attention of the applicant by any of the applicant's customers or any consumer. On the other hand, the opponent has relied upon the Mendes and Ribeiro affidavits as evidence of actual confusion involving the trade-marks at issue. Both affiants were cross-examined at length on their respective affidavits and the applicant submitted the affidavits of Jack Korman and Marvin Tkatch as evidence in rebuttal.

At the oral hearing, the agent for the applicant argued that there were a number of inconsistencies in the evidence of Mendes and Ribeiro relating to the instances of actual confusion, such that little or no weight ought to be accorded to their affidavits. However, having reviewed the affidavits of Mendes and Ribeiro and the transcripts of their cross-examinations, as well as the affidavits of Korman and Tkatch, I find it impossible to determine whose evidence is the more

credible as to the events which took place surrounding the purchase of the two suits by Mendes and Ribeiro in a retail clothing store in Toronto operated by Jack Korman. Further, I am far from certain whether the events as related by the opponent's affiants constitute evidence of actual confusion between the trade-marks at issue. For example, the evidence is far from clear as to whether Mr. Mendes had any idea as to the make of suit which he had purchased or, indeed, as to whether he had any interest in the make of suit which he had purchased.

It may well be that Messrs. Ribeiro and Mendes were under a misapprehension as to where the suits were made as opposed to the make of the suits which they purchased. In this regard, at the time of purchase, Mr. Mendes' suit had a woven label on its sleeve, a representation of which appears below, which would clearly indicate to the average consumer that the suit was made in Paris and therefore was imported from France when, in fact, the suit was made by the applicant in Canada.

The events relating to the instances of actual confusion do indicate the potential nature of the trade relating to the purchase of suits in that Mr. Korman would remove suits from the rack for his customers to try on, such that the customer may not necessarily notice or otherwise carefully check the labels on the suit prior to its purchase. That being the case, the applicant's wares might well be identified by a salesman as being HUGO suits, as opposed to VICTOR HUGO suits, which could result in a consumer being confused and particularly so when he is in a retail establishment which is also selling HUGO BOSS suits.

Having regard to the above, including the situation relating to the instances of actual confusion, I am left in doubt as to whether there might be a likelihood of confusion between the trade-marks at issue. As a result, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue. Consequently, the ground of prior entitlement is successful and I have therefore not considered the remaining grounds of opposition.

In view of the above, I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 30th DAY OF October, 1992.

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