

IN THE MATTER OF AN OPPOSITION by Société Guy Laroche,
Société Anonyme to application No. 591,521 for the trade-mark
GAROCHE filed by Boutique L'Ensemble Inc.

On September 11, 1987, Boutique L'Ensemble Inc. filed an application to register the trade-mark GAROCHE based upon proposed use of the trade-mark in Canada in association with "Robes, blouses, chemises, chandails, pantalons, vestes, vestons, jeans, shorts".

The opponent, Société Guy Laroche, Société Anonyme, filed a statement of opposition on November 7, 1989 and was granted leave to file an amended statement of opposition on November 13, 1990. In its amended statement of opposition, the opponent alleged as its first two grounds of opposition that the applicant's application is not in compliance with Section 30(i) of the Trade-marks Act and that the applicant's trade-mark GAROCHE is not registrable in view of the provisions of Section 12(1)(d) of the Act in that the applicant's trade-mark is confusing with the opponent's registered trade-marks GL GUY LAROCHE & Design and GL GUY LAROCHE & Design, registration Nos. 233,510 and 325,712, representations of which appear below:

"...Clothing for men, women and
children, namely, hosiery,
stockings, socks, underwear,
shirts, scarfs, hats, ties, slippers, undershirts, bathing
boots, shoes, suits, pullovers, trousers, belts, furs,
bermuda shorts, shorts, briefs
and brassieres"

Regn. No. 233,510

"Men's and women's day wear,
robes, negligees, rain hats,
tailored suits, pants, jackets,
blazers, slips, women's dresses,
blouses, skirts, coats, overcoats, rain coats,
cloaks, dress coats, shawls, dressing
gowns, and gloves"

The opponent's third ground is that the applicant is not the person entitled to registration of the trade-mark GAROCHE in that the applicant's mark is confusing with the opponent's trade-marks GUY LAROCHE, GL GUY LAROCHE and GUY LAROCHE PARIS which had been previously used by the opponent in Canada in association with clothing.

As its final ground, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of Richard Hanckowiak and Jean Reavley while the applicant submitted the affidavits of Nicole Larue Folgado, Georges Lebel and Nicole Richer. As evidence in reply, the opponent submitted the affidavits of Ann Braden and Denis Sabourin.

Both parties submitted written arguments and both were represented at an oral hearing.

The first ground of opposition is that the applicant's application is not in compliance with section 30(i) of the Trade-marks Act in that the applicant's trade-mark is confusing with the opponent's registered trade-marks. In my opinion, these allegations do not support a ground of opposition under Section 30(i) of the Act and I have therefore rejected the first ground.

The second ground of opposition is based on Section 12(1)(d) of the Act, the opponent alleging that the applicant's trade-mark GAROCHE as applied to the wares covered in the present application is confusing with the opponent's registered trade-marks identified above. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark GAROCHE and the opponent's registered trade-marks as of the date of my decision, the material date with respect to grounds of opposition based on Section 12(1)(d) of the Trade-marks Act (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

Considering initially the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark GAROCHE is inherently distinctive in that it is neither descriptive nor suggestive of the applicant's wares, nor does it possess any other connotation which would detract from its inherent distinctiveness. The opponent's trade-marks GUY LAROCHE & Design each include a stylized design comprising the initials or letters GL and the name Guy Laroche, neither of which add much inherent distinctiveness to the opponent's marks. As a result, the opponent's trade-marks are relatively weak marks possessing limited inherent distinctiveness.

Under paragraph 6(5)(a) of the Act, the Registrar is also required to have regard to the extent to which the trade-marks at issue have become known. In the present case, the Lebel affidavit attests to sales by the applicant of its GAROCHE clothing between May of 1988 and the date of Mr. Lebel's affidavit (March 8, 1991) exceeding \$6,000,000 corresponding to approximately 200,000 items of clothing. As a result, the applicant's trade-mark GAROCHE as applied to the wares covered in the present application has become known in Canada.

The opponent has argued that its trade-mark GUY LAROCHE & Design should be entitled to the same ambit of protection as a famous trade-mark in view of the prestigious nature of the clothing associated with its GUY LAROCHE marks, as well as the notoriety associated with Guy Laroche as a well known fashion designer. However, the sales figures provided by Mr. Hanckowiak do not support the conclusion that any of the opponent's trade-marks are well known in Canada. Indeed, the opponent's sales from 1975 to 1990 inclusive amounted to less than \$3,700,000 distributed through three GUY LAROCHE Boutiques situated in Montreal and Toronto.

The opponent has also relied upon the results of various on-line computer data base searches for Canadian publications undertaken by Jean Reavley in an attempt to demonstrate the notoriety of the fashion designer, Guy Laroche. The first group of exhibits (A-1 to A-24) annexed to Ms. Reavley's affidavit are incomplete summaries of extracts from various publications. However, the opponent failed to provide copies of the actual extracts, nor did it provide Canadian circulation figures for any of these publications. As a result, I am not according much weight to these exhibits. The second group of exhibits (B-1 to B-11) comprise photocopies of extracts from the Globe & Mail Newspaper most of which are dated between 1979 and 1982 and therefore are of limited value in determining the notoriety of Guy Laroche in Canada as of the date of my decision, or even as of the filing date of the applicant's application. A further group of extracts comprise obituary notices indicating that Guy Laroche passed away in February of 1989. In my opinion, the fact that Guy

Laroche has passed away would indicate that any continuing recognition associated with Guy Laroche in Canada is likely to continue to diminish with time.

Apart from the above, and having reviewed in detail the exhibits to the Reavley affidavit, I find that, of the 45 extracts, or summaries of extracts, more than one-third make either no reference or only passing reference to Guy Laroche in the context of an article referring to other designers. Further, about ten of the exhibits refer to Guy Laroche in the context of wares other than clothing or refer to corporate activities of the opponent. Of the dozen or so articles directed specifically to Guy Laroche, several are dated in the early 1980's and therefore are unlikely to reflect the current notoriety of Guy Laroche.

Even accepting that there may be some recognition in Canada of Guy Laroche as a fashion designer, I do not consider that the opponent's evidence supports the conclusion that Guy Laroche is well known in Canada as a fashion designer either today or as of the filing date of the applicant's application. As a result, I do not consider that the opponent's trade-marks should be accorded the scope of protection as would be accorded famous or well known trade-marks. At most, the reputation associated with Guy Laroche as a "haut couturier" may augment to some minor extent the reputation associated with the opponent's trade-marks as applied to clothing.

The length of time that the trade-marks at issue have been in use favours the opponent in this opposition.

The wares covered in the applicant's application and the opponent's registrations are overlapping. Nevertheless, the applicant submitted that the channels of trade associated with its trade-mark GAROCHE differ from the channels of trade associated with the opponent's marks. However, in assessing the likelihood of confusion between trade-marks in respect of a Section 12(1)(d) ground of opposition, the Registrar must have regard to the channels of trade which would normally be associated with the wares (or services) set forth in the applicant's application since it is the statement of wares (or services) covered in the application, rather than the applicant's actual trade to date, which determines the scope of the monopoly to be accorded to an applicant should its trade-mark proceed to registration (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pages 10-12 (F.C.A.)). Thus, absent a restriction in the applicant's statement of wares as to the channels of trade associated with those wares, the Registrar cannot take into consideration the fact that an applicant may only be selling its wares through a particular type of retail outlet or through a particular channel of trade when considering the issue of confusion (see Henkel

Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 2 C.P.R. (3d) 361, at page 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at page 112 (F.C.A.)).

In the present case, the applicant's statement of wares does not qualify or restrict the applicant's clothing so as to exclude what might be termed "high fashion" clothing. As a result, I must assume for the purposes of deciding this opposition that the present application covers all types and styles of clothing as specifically defined in the application, such that there could be a potential overlap in the respective channels of trade of the parties (see Hugo Boss AG v. Grafton-Fraser Inc., 49 C.P.R. (3d) 243, at page 250 (TMOB)). Likewise, the fact that the applicant's labels differ from the opponent's labels or packaging is of no relevance to the Section 12(1)(d) grounds of opposition (see the comments of Thurlow, C.J. in Mr. Submarine Ltd. v. Amandista Investments Ltd., supra, at pages 10-12).

Considering the degree of resemblance between the applicant's trade-mark GAROCHE and the opponent's registered trade-marks, there is a relatively little similarity in appearance and no similarity in the ideas suggested by the trade-marks at issue. As well, an anglophone would have no difficulty in distinguishing the trade-marks at issue aurally. Further, a francophone or bilingual consumer would distinguish the marks in view of the name significance of the opponent's mark and the significance of the verb "garrocher" (see exhibits A to the Sabourin affidavit and P-6/P-7 to the Richer affidavit). In this regard, the average francophone or bilingual consumer would sound the applicant's trade-mark in a manner indistinguishable from the word "garroche", the second person singular, imperative of the verb "garrocher".

As to the sounding of the trade-marks at issue, I would note the following comments of Mr. Justice Addy in Monsport Inc. v. Les Vêtements de Sport Bonnie (1978) Ltée, 22 C.P.R. (3d) 356 (F.C.T.D.), where the learned trial judge considered the degree of resemblance between the marks MONSPORT and BONSPORT & Design at page 364:

If I am incorrect and if, as submitted by the opponent, its GUY LAROCHE trade-marks are well known in Canada in relation to clothing, I would have concluded that the absence of evidence of actual confusion between the trade-marks at issue as of the date of my decision would have been a relevant surrounding circumstance weighing in the applicant's favour in respect of the issue of the likelihood of confusion between the trade-marks of the parties.

In view of the above, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in relation to the Section 12(1)(d) ground of opposition and have therefore rejected this ground.

The opponent has also challenged the applicant's entitlement to registration and the distinctiveness of the applicant's mark in view of the opponent's prior use in Canada of its trade-marks GUY LAROCHE, GUY LAROCHE PARIS and GUY LAROCHE & GL Design. With respect to the non-entitlement ground, I am satisfied that the opponent has met the initial burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act of establishing its prior use in Canada of its trade-marks prior to the applicant's filing date, as well as non-abandonment of its marks as of the date of advertisement for opposition purposes of the applicant's application in the Trade-marks Journal (April 26, 1989). Likewise, the opponent has met the evidential burden upon it in respect of the non-distinctiveness ground of opposition.

As the opponent has met the initial burden upon it in respect of both the non-entitlement and non-distinctiveness grounds of opposition, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark GAROCHE and the opponent's trade-marks as of either the filing date of its application or the date of opposition, the material dates in respect of the non-entitlement and non-distinctiveness grounds respectively. Further, as in the case of the Section 12(1)(d) ground, the Registrar must again have regard to all the surrounding circumstances in assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue.

As noted above, the applicant's trade-mark GAROCHE is inherently distinctive while the opponent's trade-marks GUY LAROCHE, GUY LAROCHE PARIS and GUY LAROCHE & GL Design possess little inherent distinctiveness.

Since the applicant commenced use of its trade-mark subsequent to filing the present application and as the Lebel affidavit does not clearly indicate the volume of the applicant's sales prior to the date of opposition, the applicant's evidence of use is of limited value in assessing the likelihood of confusion in relation to the non-entitlement and non-distinctiveness grounds of opposition. Accordingly, both the extent to which the trade-marks had become known and the length of use of the trade-marks at issue favour the opponent in relation to these grounds although, as of the applicant's filing date, the opponent's sales were only \$2,500,000 through only two GUY LAROCHE Boutiques located in Montreal. Again, for the reasons noted above, I am not prepared to accept the opponent's submission that its trade-marks should be entitled to the same protection as a famous or well known trade-mark.

In considering the issue of confusion in relation to the non-entitlement and non-distinctiveness grounds, the Registrar must have regard to the opponent's actual wares and channels of trade associated with those wares. Thus, while the wares covered in the applicant's application and the clothing sold by the opponent to its distributor in Canada are essentially identical, the channels of trade associated with the wares of the parties would not overlap. In particular, the opponent's evidence confirms that its GUY LAROCHE clothing is sold almost exclusively to Guy Laroche Boutiques which sell only the opponent's wares to consumers in Canada. As a result, the applicant's wares would not be sold through boutiques operated by the opponent's Canadian distributors.

There is relatively little similarity in appearance and no similarity in the ideas suggested by the applicant's trade-mark GAROCHE and the opponent's marks. Further, an anglophone would have no difficulty in distinguishing the trade-marks at issue aurally while the average francophone or bilingual consumer would distinguish the marks in view of the name significance of the opponent's marks and the fact that the applicant's trade-mark would be sounded in a manner indistinguishable from the second person singular, imperative, of the verb "garrocher" (see exhibits A to the Sabourin affidavit and P-6/P-7 to the Richer affidavit).

In view of the above, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in relation to the non-entitlement and non-distinctiveness grounds of opposition and I have rejected those grounds.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF DECEMBER 1993.

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