



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 189

Date of Decision: 2024-10-22

IN THE MATTER OF OPPOSITIONS

Opponent: Catherine Sidonio

Applicant: Chanel Limited

Applications: 1823809 and 2239129 for GABRIELLE

INTRODUCTION

[1] Chanel Limited (the Applicant) has filed applications to register the trademark GABRIELLE (the Mark) in association with a variety of goods comprising perfumes in Nice class 3, optical apparatus and instruments in Nice class 9, and leather and imitations of leather in Nice class 18.

[2] Catherine Sidonio (the Opponent) opposes the applications.

[3] For the reasons that follow, the applications are refused.

THE RECORDS

[4] Application No. 1823809 was initially filed on February 21, 2017 on the basis of proposed use of the Mark in Canada in association with a long list of goods comprising, in addition to the above-mentioned goods, clothing goods in Nice class 25. The Applicant subsequently requested that the class 25 goods be divided out from the application, leading to the recordal on September 24, 2020 of divisional application No. 2053825 (discussed in greater detail in the analysis below). Parent application No. 1823809 was later advertised for opposition purposes in the *Trademarks Journal* on August 18, 2021.

[5] On November 22, 2021, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[6] The main grounds of opposition raised by the Opponent initially all revolved around the likelihood of confusion between the Mark and the Opponent's identical trademark GABRIELLE (the Opponent's Trademark) which is registered in Canada in association with a variety of clothing goods (the Opponent's Goods). The full particulars of the Opponent's registration are set out in Schedule A hereto.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] Subsequently, the Applicant requested that parent application No. 1823809 be further divided into two applications, such that application No. 1823809 covers the goods belonging to classes 9 and 18, and divisional application (recorded by the Registrar on February 10, 2023 under No. 2239129) covers the goods belonging to class 3.

[9] Section 40 of the *Trademarks Regulations* (SOR/2018-227) (the Regulations) provides that any action taken in respect of an original application on or before the day on which a divisional application is filed is deemed to be an action in respect of the divisional application. As a result, the original statement of opposition filed by the

Opponent against parent application No. 1823809 is deemed to have also been filed against divisional application No. 2239129, which are both the subject of this decision.

[10] Both parties filed evidence and written representations and both parties were ably represented at an oral hearing.

[11] As stressed by the Opponent at the hearing, subsequent to the filing of the Opponent's written representations, the Applicant sought leave to amend the statement of goods of both the parent and divisional applications. The particular amendments that consist of limitation wording shown in underlining in Schedule B hereto will be discussed in greater detail in the analysis below. Suffice it to mention at this point that leave was granted by the Registrar on February 9, 2024. The Opponent thereafter amended her statements of opposition to add a new ground of opposition based on section 30(2)(a) of the Act in direct response to the Applicant's amended applications, with leave of the Registrar granted on May 10, 2024, despite the Applicant's objection. This ground of opposition will be discussed in detail below.

[12] Finally, I note that divisional application No. 2239129 was further amended by the Applicant on September 24, 2024 (that is, after the hearing in the present cases) so as to delete from the statement of goods all the cosmetic goods in class 3, except "perfumes" and accompanying limitation wording, as shown in Schedule C hereto. I note that these deletions (accepted by the Registrar by way of Office letter dated October 22, 2024) were made in the context of another opposition proceeding initiated against the Applicant's application by Gabriel Cosmetics, Inc. For the sake of clarity, my decision is with respect to the present oppositions only.

PRELIMINARY REMARK

Prior trademark opposition proceeding

[13] The parties to the present proceedings are not strangers to one another. As discussed below, they have notably been involved in a prior trademark opposition proceeding in Canada concerning the Applicant's application No. 1568398 for the trademark CHANEL'S GABRIELLE for use in association with a variety of goods in Nice

class 18, in which the Registrar rejected the Opponent's opposition [see *Catherine Sidonio v Chanel Limited*, 2023 TMOB 166 (the *2023 TMOB Decision*)].

[14] Not surprisingly, the *2023 TMOB Decision* was referenced abundantly by the parties in the present proceedings, especially given that the parties indicated both in their written representations and at the hearing that the evidence in these proceedings is largely the same as the evidence that was filed in that prior case. However, this prior decision is not necessarily determinative of the issues in the present cases. Suffice it to say that each case rests on its own merits. That being said, I will adopt some of the reasoning in the *2023 TMOB Decision* where I consider it appropriate to do so.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[15] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

OVERVIEW OF THE EVIDENCE

Summary of the Opponent's evidence

[16] The Opponent's evidence is the same in both proceedings and is comprised of a certified copy of Canadian trademark application No. 2053825 and three affidavits, which are summarized below. None of the affiants were cross-examined on their affidavits.

Application No. 2053825

[17] As indicated above, application No. 2053825 is a divisional of the original parent application No. 1823809 filed by the Applicant. It relates to the trademark GABRIELLE in association with Nice class 25 goods, namely clothing, footwear and headgear.

[18] That application had been advertised and opposed by the Opponent, but the Registrar withdrew the application from advertisement pursuant to section 37(4) of the Act and the application was removed from opposition. In their respective written representations, each party pointed out that as of the date of their representations, the application was marked “under examination” by the Trademarks Office. In any event, I agree with the Applicant that the mere existence of application No. 2053825 is by itself irrelevant to the present proceedings.

The affidavits of Justine Sidonio, sworn June 13, 2022 and September 7, 2023

[19] I note that the second affidavit of Justine Sidonio merely corrects one misstatement in her first affidavit. Consequently, I will use the singular to refer to these two affidavits.

[20] Ms. Sidonio is the Vice President USA/Canada of Molly Bracken, the fashion design business of the Opponent, and also serves as CEO and Vice President of Molly US Corp., an American corporation that carries out the North American operations of Molly Bracken. Ms. Sidonio has held this position with Molly Bracken since 2017 and has been with Molly Bracken in other capacities since 2008. Through these various roles, Ms. Sidonio attests to having knowledge of the Opponent’s Molly Bracken business and to having significant knowledge of the fashion industry [paras 1-3].

[21] Echoing the summary by the Registrar in the *2023 TMOB Decision*, Ms. Sidonio essentially attests to the following in her affidavit:

- The Opponent’s Molly Bracken business designs and sells fashion collections under the house mark MOLLY BRACKEN as well as other trademarks, including the Opponent’s Trademark [para 6].
- Molly Bracken’s collections are characterized by a mix of bohemian and retro chic looks and are available in over 5,000 locations worldwide, in Europe, the United States, Canada, Asia and South America [paras 7-8].
- The Opponent’s Trademark is used in Canada in association with numerous clothing and fashion products, including dressing gowns, dresses, tunics,

cardigans, leggings, scarves, belts, trousers, t-shirts and sweatshirts; hats, scarves, caps; jumpers, jumpsuits, shorts, tights, skirts, lingerie [para 13].

- The Opponent's Trademark appears on labels sewn to the Opponent's Goods [para 17, Exhibit F] and on store signage at retail stores, typically on racks or store walls where the Opponent's Goods are sold [para 18, Exhibit G].
- Products bearing the Opponent's Trademark first appeared in the Canadian market in 2017. Sales of the Opponent's Goods have expanded substantially since then and are available in Hudson's Bay department stores throughout Canada as well as numerous independent retailers across Canada [paras 20-21].
- The Opponent's Goods are promoted in the Canadian market in several ways including in corners of Hudson's Bay stores and Hudson's Bay advertising campaigns and contests, as well as at trade shows (including in Canada), on the website *mollybracken.com* and are also promoted by "influencers" on social media [paras 26-31].

The affidavit of D. Jill Roberts, sworn June 10, 2022

[22] Ms. Roberts is a graduate of the Law Clerk program at Cambrian College in Sudbury, Ontario. She conducted searches of The Hudson's Bay Company's website *thebay.com* for the terms "Molly Bracken" [Exhibit 1] and "Gabrielle" [Exhibits 2 and 3].

[23] Ms. Roberts conducted further searches on the same website that purport to show, *inter alia*, that the goods of the Applicant (e.g. perfume) and the goods of the Opponent (e.g. clothing) are both available at The Hudson Bay's stores [Exhibits 5 and 6].

[24] Ms. Roberts also conducted other searches, such as a search for "Chanel" on the Canada411 website [Exhibit 4] and the Canadian Intellectual Property Office (CIPO) Trademarks Database [Exhibit 8].

Summary of the Applicant's evidence

[25] The Applicant's evidence is the same in both proceedings and is comprised of certified copies of trademark registrations and five affidavits. None of the affiants were cross-examined on their affidavits.

Certified copies

[26] The Applicant submitted certified copies of the following 13 registrations owned by it:

- GABRIELLE CHANEL (Reg. Nos. TMA1038675, TMA1094503 and TMA1162017).
- CHANEL (Reg. Nos. TMA569181, UCA18468, TMA194870 and TMA143,648).
- COCO (Reg. Nos. TMA158569, TMA520276 and TMA1156693).
- CC Design, depicted below and hereinafter referred to as the CC Monogram trademark (Reg. Nos. TMA345284, TMA534356, and TMA687122):



The affidavit of Philippa Bailey, sworn April 6, 2023

[27] Ms. Bailey is Senior Counsel – Intellectual Property for the Applicant, the parent company of the “House of CHANEL” that Ms. Bailey describes as “the well-known luxury fashion and beauty products and services international group of companies”. Ms. Bailey has held this position since June 2020. She was previously the Intellectual Property Counsel for the Applicant from 2015 to 2020. As a result of her position with the Applicant, Ms. Bailey is familiar with the products of the House of CHANEL, their branding and marketing, and has access to files relevant to this opposition [paras 1-4].

[28] Again, echoing the summary by the Registrar in the *2023 TMOB Decision*, Ms. Bailey's affidavit evidences the following:

- A history of the House of CHANEL (that Ms. Bailey further defines as referring to the Applicant, or its predecessors in title, and its subsidiaries and affiliates) and

its founder Gabrielle “Coco” Chanel (1883-1971), including a wealth of books and articles about Mlle Chanel and illustrating the fame and influence of Mlle Chanel, as well as that of the House of CHANEL, in the fashion and beauty industry [paras 5-12, Exhibits PB-1 to PB-3].

- A description of CHANEL Products, which Ms. Bailey defines as comprising:

a wide range of fashion and beauty products such as Ready-to-Wear clothing, leather goods, fashion accessories (including shoes, boots, gloves, scarves, belts, hats and headbands), handbags, fragrances, makeup, skincare, eyewear, jewellery, and watches, all of which are branded with one or more of the Applicant’s trademarks

including details on the manufacture of CHANEL Products, control, licensing agreements and protection of the Applicant’s trademarks [paras 7, 13-29, Exhibit PB-4].

- A description of the brands inspired by Mlle Chanel’s persona, including information about the launch, marketing and advertising campaigns for GABRIELLE formative trademarks of the House of CHANEL [paras 44-69, Exhibits PB-13 to PB-22]. Notably, Ms. Bailey indicates that “since 2017, the Mark has been used, including in Canada, in association with handbags, belts and as a colour/shade of a ROUGE COCO lipstick” [para 51].

[29] Ms. Bailey also provides the following in her affidavit:

- Global sales figures and media expenditures for the House of CHANEL’s product divisions “fragrance and beauty goods (such as cosmetics)” and “fashion goods (which include clothing, footwear and handbags but exclude haute couture)” [paras 30-32].
- Global revenue for the House of CHANEL [para 33, Exhibit PB-5].
- A description of the House of CHANEL’s advertising activities in the UK and globally which include print and digital advertising, social media channels, fashion shows, and the Applicant’s website [paras 34-39, Exhibits PB-6 to PB-9].
- Advertising of third parties featuring the Applicant’s CHANEL trademark [para 40, Exhibit PB-10].

- Details on the reputation of the House of CHANEL including samples of third-party articles and various survey firms' rankings referring to the CHANEL trademark and its status as one of the most recognized trademarks in the world [paras 42-43, Exhibits PB-11 and PB-12].

The affidavit of Sachin Garg, sworn April 11, 2023

[30] Mr. Garg is Vice President Finance of Chanel Canada ULC (Chanel Canada), a position which he has held since January 2018. Prior to his current position, Mr. Garg was employed by Chanel SARL, a Swiss Chanel entity, where he held various positions commencing in 2012. By virtue of his past and current positions, Mr. Garg states he is familiar with the history of the House of CHANEL (as defined in the Bailey Affidavit), its corporate structure, and its international operations, activities, products and their branding, and is involved in the protection and enforcement of the Applicant's intellectual property rights in Canada [paras 1-2].

[31] Again, echoing the summary by the Registrar in the *2023 TMOB Decision*, Mr. Garg's affidavit evidences the following:

- The Applicant's business in Canada, including information about the CHANEL Products (as defined in the Bailey Affidavit) offered for sale in Canada with associated pricing [paras 5-6; Exhibit A-1].
- How the CHANEL trademarks (including the Mark) are used in Canada, and the licensing structure for use of the CHANEL trademarks in Canada by Chanel Canada [paras 7-21].
- Canadian sales figures for CHANEL Products for the years 2014 to 2020, ranging from \$100 million CAD in 2014 to a high of \$260 million in 2021 [para 22].
- The Applicant's advertising activities on social media relating to the CHANEL Products [paras 23-27].
- Advertising expenditures of Chanel Canada for the years 2012 to 2017, as well as for January 1, 2018 to August 20, 2018, for all categories of CHANEL Products [para 28].

- Examples of magazine and newspaper articles from various Canadian publications featuring and discussing the CHANEL brand and CHANEL branded products [para 30, Exhibit F].
- A summary of the background and history of GABRIELLE-formative trademarks of the House of CHANEL, as well as evidence regarding use and advertising of the Mark in Canada (since 2017 including in association with handbags, belts and lipsticks) [paras 32-38, 40-42, 44-59, 65-73, Exhibits I.1, K, L-N.3, T-W].
- Copies of excerpts from Canadian press, social media and influencer posts featuring the Mark prior to and including in August 2018 [paras 43, 60-64, 74-75, Exhibits O, P, Q, R, S, X, Y].

The affidavit of Omra Masstan, sworn April 6, 2023

[32] At the time of swearing his affidavit, Mr. Masstan was a student employed by the Applicant's agent firm.

[33] At the request of a lawyer for the Applicant's agent, Mr. Masstan conducted various online searches, including *inter alia*:

- Internet searches for the given name "Gabrielle" (e.g. Canada 411's website and "baby name" websites [paras 5-9, Exhibits 1-4].
- A search on *Google.com* of third-party websites for "Gabrielle clothes Canada", "Gabrielle clothing store Canada" and "Gabrielle clothing Canada" [paras 10-20, Exhibits 5-13].
- Internet searches to try to identify websites that indicate Gabrielle Chanel is the founder of the House of CHANEL and Canadian websites offering books about Gabrielle Chanel for sale [paras 31-33, Exhibits 24-25]
- Internet searches for websites that indicate or suggest that the CHANEL trademark is a well-known trademark [paras 34-35, Exhibit 26]
- Searches of the Hudson Bay's online store and, in particular, a search for "Gabrielle" [para 37, Exhibits 28-29]

The affidavit of Glenda O'Brien, sworn April 11, 2023

[34] Ms. O'Brien is a Senior Library Reference Technician employed by the Applicant's agent firm.

[35] At the request of a lawyer for the Applicant's agent, Ms. O'Brien conducted a search of the WestlawNext Canada database (the Database) for articles that contain both the terms "Chanel" and "Gabrielle" for the last 20 years.

[36] More particularly, Ms. O'Brien explains that the Database provides electronic full text news articles published in a variety of Canadian newspapers and other Canadian news publications. She asserts that, in her experience, the electronic articles obtained by searching the Database accurately and reliably reproduce the content of the original articles as published and distributed in print or online. Finally, she indicates that her search produced a large number of results totalling more than 1,000 pages of text and that the instructing lawyer selected a portion of the articles that her search identified (the full text of the articles he selected being attached to her affidavit as Exhibit A).

The affidavit of James Haggerty, sworn April 11, 2023

[37] Mr. Haggerty is a Trademark Searcher employed by the Applicant's agent firm.

[38] At the request of a lawyer for the Applicant's agent, Mr. Haggerty conducted searches of the CIPO Trademarks Database to identify trademarks which consist of a given name with trademarks of different persons which include the same given name with another name for use with goods of Nice classes 3, 18 and/or 25 [para 3]. Particulars of the search results are set out in a table contained in his affidavit and comprise 12 examples, such as GEORGE for use with clothing that co-exists with GEORGE for use with moisturizer.

Admissibility of the parties' respective evidence

[39] In their written representations and/or at the hearing, each party objected to the admissibility of certain elements of the other party's evidence, in whole or in part, on various grounds. The Opponent submitted that certain elements of the Applicant's evidence constitute hearsay or were submitted by employees of the Applicant's agents.

The Applicant submitted that certain information in the Opponent's evidence is deficient and that the proper licensing of the Opponent's Trademark has not been evidenced.

[40] I note that similar objections were apparently raised in the *2023 TMOB Decision*. In any event, as it will become apparent from my analysis below, I do not need to address these particular objections to ultimately render this decision.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Non-conformity of the application under section 30(2)(a) of the Act – statement of the applied-for goods not in ordinary commercial terms

[41] The Opponent has pleaded that each of the applications does not conform to the requirements of section 30(2)(a) of the Act because they do not contain a statement in ordinary commercial terms of the goods in association with which the Mark is used or proposed to be used. More particularly, the Opponent pleads that the following statements are not in ordinary commercial terms:

With respect to application No. 1823809

Class 9 Goods

... all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively in the following manners, through the websites of the trademark owner (which only offer products of the trademark owner), at the trademark owner's boutiques branded with the trademark owner's house mark (which boutiques only offer products of the trademark owner), at counters or sections of authorized third-party stores branded with the trademark owner's house mark, through websites of these authorized third parties, on pages branded with the trademark owner's house mark, or on pages where the trademark owner's products offerings are identified by the house mark of the trademark owner.

Class 18 Goods

... all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively at the trademark owner's boutiques branded with the trademark owner's house mark and which boutiques only offer products of the trademark owner, and none of these goods to be sold through stores or online stores specialized in the sale of natural health products or organic products.

With respect to application No. 2239129

Class 3 Goods

...all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively in the following manners, through the websites of the trademark owner (which only offer products of the trademark owner), at the trademark owner's boutiques branded with the trademark owner's house mark (which only offer products of the trademark owner), at counters or sections of authorized third-party stores branded with the trademark owner's house mark (which counters or sections only offer products of the trademark owner), or through websites of these authorized third parties, on pages branded with the trademark owner's house mark or on pages where the trademark owner's products offerings are identified by the house mark of the trademark owner, and none of these goods to be sold through stores or online stores specialized in the sale of natural health products or organic products.

[42] I first note that in its written representations, the Applicant takes the position that “this ground of opposition is without merit and should be rejected at the outset, given that the [Registrar], by accepting the amendments to the Applications on February 9, 2024, has already recognized that these amended descriptions are compliant”. I disagree with the Applicant’s position.

[43] As rightly argued by the Opponent and as agreed upon by the Registrar in the aforementioned letter dated May 10, 2024, the Registrar’s initial acceptance of these amendments does not make them immune from challenge or opposition. If this were not the case, the tactic of making late amendments would shield an applicant from challenge. As the Opponent was granted leave to amend her statements of opposition so as to formally challenge the applications’ amended statements of goods under section 30(2)(a) of the Act, the initial acceptance of the amended statements of goods by the Registrar does not preclude me from evaluating the propriety of the challenged amendments [see by analogy *Lending Tree, LLC v Lending Tree Corp* (2006), 48 CPR (4th) 355 (FC), aff’d (2007), 55 CPR (4th) 385 (FCA) at paras 19-20]. Accordingly, I will address the conformity of the Applicant’s statements of goods with the requirements of section 30(2)(a) of the Act in light of the submissions made by the parties.

[44] As stressed by the Opponent at the hearing, the Opponent’s initial evidential burden under section 30(2)(a) of the Act is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden, i.e., the Registrar

may take judicial notice of facts in support of the Opponent's pleading [*McDonald's Corporation and McDonald's Restaurant of Canada Ltd v MA Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB); *SBG Revo Holdings, LLC v FTI Corporation Limited*, 2017 TMOB 93 at para 20; and *Gang Cao and Apple Inc*, 2023 TMOB 142 at para 21].

The Opponent's submissions

[45] At the hearing, the Opponent's agent made reference to the representations made in their letter dated April 24, 2024 in reply to the Applicant's letter dated April 18, 2024 that objected to the Opponent's request to add this new ground of opposition. The Opponent further developed these submissions at the hearing.

[46] The Opponent's submissions can be divided into two main parts: one that deals with the amendments to the statements which consist of characterization or limitation wordings that refer to the "trademark owner's house mark", and the other that essentially deals with the terms "boutiques" and "luxury goods".

[47] Considering first the references to the "trademark owner's house mark", at the hearing, the Opponent drew my attention to the following two documents that were included with its list of case law:

- The CIPO Trademarks Examination Manual (the Examination Manual) which provides at section 2.4.5.1 titled "Ordinary commercial terms" that, *inter alia* :

[...] Registered trademarks cannot be used in statements of goods or services since they are not considered to be in ordinary commercial terms.
- The CIPO practice notice titled "Exclusionary wording in statements of goods and services" which provides *inter alia* that:

[...] To be acceptable, the goods or services being excluded must be in ordinary commercial terms and described in a manner that identifies the specific goods or services. For example, the following statement would not be acceptable because the goods after the exclusionary wording are not acceptable on their own:

Class 1: “Agricultural chemicals, excluding chemical preparations”

[48] The Opponent submits that the reason why registered trademarks are not ordinary commercial terms is because their purpose is to *distinguish* one person’s goods or services from the goods or services of others, whereas an ordinary commercial term is a descriptive term. The Opponent refers on this point to section 2.4.5.1 of the Examination Manual which also provides that ordinary commercial terms are descriptions of goods and services that would normally be used by others in the same industry.

[49] In these circumstances, the Opponent submits that a “house mark” and an “ordinary commercial term” are mutually exclusive.

[50] Speaking of the indefinite term “house mark”, the Opponent notes that the Applicant indicates in its written representations that the Applicant’s house mark is CHANEL, which is a registered trademark. The Opponent submits that the reference to the “trademark owner’s house mark” as formulated in the amended statements of goods is equivalent to the inclusion of a registered trademark and that in so doing, the Applicant is attempting to distinguish the applied-for goods from those of others. The Opponent further submits that not only is the reference to “the trademark owner’s house mark” not in ordinary commercial terms, but argues that quite the contrary, such reference raises more questions than it provides clarity. For example, what if the Mark is assigned to a third party outside the House of CHANEL? The Opponent submits that a house mark can be anything that the Applicant chooses it to be: it can change over time, it can also be located anywhere on the goods and be of any size—it may even not be visible, for instance if it is located on the inside of a handbag.

[51] At the hearing, the Opponent’s agent further indicated that in preparation for the hearing, he searched the CIPO Trademarks Database in order to verify if there were other occurrences of the term “house mark” used *in the same way* as in the Applicant’s applications. Except for the Applicant’s applications, he could not find any. Not that the term “house mark” was not found, but it was used to describe the trademark owner’s mark as opposed to the goods or services *per se* (e.g. trademark VALEANT of

registration No. TMA704959 in association with: “House mark for a full line of pharmaceutical preparations and dermatological products both prescription and non-prescription, namely [...]”, and trademark EQUALITY of registration No. TMA473043 in association with: “House mark for a full line of supermarket products namely carbonated and non-carbonated beverages, namely [...]”).

[52] Finally, the Opponent submits that the policies and guidelines governing the treatment of exclusionary wording equally apply to limitation wording (or “limitations”) contained in statements of goods. It submits that to be acceptable, the limitation wording must be in ordinary commercial terms and described in a manner that enables the identification of the specific goods or services.

[53] I am in general agreement with the Opponent’s submissions. Concerning the indefinite term “house mark”, I further note that Ms. Bailey states in the passages reproduced below of her affidavit that the House of CHANEL has two “house” marks, which in my view adds to the lack of clarity of the phrase “trademark owner’s house mark”:

25. The CHANEL trademark and the CC Monogram (depicted [above]) are the House of CHANEL “house” trademarks and its more valuable assets.”

26. [...] In addition to these two “house” marks, some of the CHANEL Products, including perfumes, cosmetics and/or handbags are sold in association with sub brands of the House of CHANEL, such as: GABRIELLE CHANEL, No. 5, COCO, CHANEL’S GABRIELLE, GABRIELLE, CHANCE, BOY CHANEL, or ALLURE.

(My underlining)

[54] Turning to the second part of the Opponent’s submissions, the Opponent submits that the limitation wordings contained in the Applicant’s statements of goods are not clear and concise. The Opponent submits that contrary to the guidelines provided for at section 2.4.5.1 of the Examination Manual, the Applicant’s limitation wordings are very lengthy and difficult to follow.

[55] More particularly, the Opponent notes that at paragraph 110 of the Applicant’s written representations, the Applicant indicates that it “sells its subject class 18 goods,

including [...], exclusively through CHANEL-branded boutiques (standalone or located in luxury department stores such as Holt Renfrew Ogilvy or Holt Renfrew)” and that this renders the term “boutique” in the statement of goods ambiguous because in the statement of goods, the trademark owner’s boutiques only sell the products of the trademark owner, whereas Holt Renfrew Ogilvy and Holt Renfrew stores sell the products of many different companies and are not limited to only CHANEL products. The Opponent submits that “these contrary positions of the Applicant demonstrate that these statements are not ordinary commercial terms.”

[56] The Opponent also submits that the statement “stores specialized in the sale of natural health products and organic products” is not in an ordinary commercial term and that it is unclear what this statement means in the context of class 18 goods which includes handbags, wallets, umbrellas, luggage, purses, etc.

[57] Finally, the Opponent questions the use of the term “luxury goods” in the context of some of the Applicant’s applied-for class 9 goods such as “safety helmets”, “safety goggles”, “personal safety alarms”, etc.

[58] I do not find the second part of the Opponent’s submissions persuasive. Concerning the term “boutique”, I note that the *Oxford Canadian Dictionary*, Second Edition, provides the following definition: “*n.* a small shop or department of a store selling specialized goods or services, esp. fashionable clothes or accessories.” I find this definition is consistent with the Applicant’s submissions that it sells its goods exclusively through the manners listed in its statements of goods, which include standalone boutiques or boutiques located in luxury department stores. Likewise, I see no reason to question the plain dictionary meaning of either the word “luxury” or the phrase “stores specialized in the sale of natural health products and organic products” in the Applicant’s statements of goods. Besides, I note that the CIPO Goods and Services Manual includes various examples of acceptable statements of goods or services comprising the term “luxury” (e.g. “luxury vinyl floor tiles”, “business management information services in the field of transportation logistics of art, collectibles, luxury goods and branded products”).

[59] That being said, as I have found the first part of the Opponent's submissions persuasive, the onus then shifts to the Applicant to demonstrate that the above limitation wordings are in ordinary commercial terms.

The Applicant's submissions

[60] Only the Applicant's submissions that purport to address the first part of the Opponent's submissions will be discussed.

[61] Both in its written representations and at the hearing, the Applicant submitted that with its recent amendments to the applications, the Applicant is only seeking protection for use of the Mark in association with luxury goods, at specific types of retail locations across the country, and in a specific branding context which corresponds to how it has been using its trademarks and selling its products for years and will continue to do so. The Applicant submits that the CIPO practice notice concerning the use of exclusionary wording in statements of goods and services does not apply to the present cases as the Applicant is not "excluding" goods *per se* but has rather simply added limitation wording at the end of the statements of goods to provide information as to the applied-for goods' specific channels of trade and the manner in which the goods are presented to the public at point of sale. Hence, the Applicant submits that the limitation wordings need not be stated in ordinary commercial terms.

[62] More particularly, the Applicant submits that it seeks to register the Mark with descriptions that have been "qualified and limited" because the amendments: i) "limit the scope of registration protection sought by the Applicant", and ii) "clearly show that the type of goods of the Applicant are different from the goods of the Opponent and are sold in a manner that clearly and conspicuously links the GABRIELLE branded products of the Applicant to its CHANEL house mark" [para 121 of the Applicant's written representations]. In this regard, I further note that in its letter objecting to the Opponent's request for leave to amend its statement of opposition, the Applicant also submitted that the amendments were "crucial to the Applicant's position in these opposition proceedings" and "directly address the [Registrar's] following comments made in [the 2023 TMOB Decision]:

[63] When considering [the section 6(5)(c) and (d)] factor[s] in the assessment of confusion, it is the statement of goods as defined in the registration relied upon by the Opponent and the statement of goods in the application that govern the assessment of the likelihood of confusion [...].

[...]

[66] I do not consider the fact that the Goods are generally considered to be luxury goods assists the Applicant in the assessment of this factor **as there is no restriction on the Goods in the application for the Mark**, or any exclusion of luxury items in the statement of goods in the registration for the Opponent's Trademark.

[Bold and underlining by the Applicant]

[63] The Applicant submits that the limitations “dramatically restricted the protection being sought by the Applicant” [para 10 of the Applicant's written representations] and “clearly specify that the Applicant's goods are luxury goods bearing the Applicant's house mark (i.e. CHANEL) which are sold through channels of trade that clearly identify and associate the products of the Applicant with the Applicant's house mark” [para A.3 of the Applicant's written representations].

[64] Concerning the reference to the “trademark owner's house mark”, the Applicant submits that the Registrar “would have rejected the amendments if the Applicant had referred to its actual house mark, CHANEL” [para 74 of the Applicant's written representations]. The Applicant further acknowledged at the hearing that “the trademark owner's house mark” could change and be another trademark. Still, the Applicant submitted that this does not affect the acceptance of the Applicant's amended statements of goods as the goods are still described in ordinary commercial terms and it should be permissible to include that kind of limitation wording aimed at positioning the statements of goods so as to avoid a finding of confusion. In this regard, the Applicant drew a parallel between the present cases and the Registrar's decision in *Arc'Teryx Equipment Inc v Kawasaki Jukogyo Kabushiki Kaisha (Kawasaki Heavy Industries, Ltd)*, 2015 TMOB 60 (Kawasaki), in which the applicant's statement of goods was amended a few days prior to the hearing to read as follows (as emphasized in bold):

(1) Land vehicles, namely, buggy type vehicles for off-road recreation designed to carry passengers and a payload of cargo; clothing for use in association with motor sports and

motor recreation activities, namely t-shirts, polo shirts, sweat shirts, shirts, jackets, vests, wind vests, pants **sold through distributors or dealers of Kawasaki utility vehicles for off-road recreation; clothing for use in association with motor sports and motor recreation activities, namely t-shirts, polo shirts, sweat shirts, shirts, jackets, vests, wind vests, pants displaying the image of a Kawasaki motor vehicle thereon;** footwear for use in association with motor sports and motor recreation activities, namely shoes and boots **sold through distributors or dealers of Kawasaki utility vehicles for off-road recreation; footwear for use in association with motor sports and motor recreation activities, namely shoes and boots displaying the image of a Kawasaki motor vehicle thereon;** headgear (not including helmets) for use in association with motor sports and motor recreation activities, namely hats and caps **sold through distributors or dealers of Kawasaki utility vehicles for off-road recreation; headgear (not including helmets) for use in association with motor sports and motor recreation activities, namely hats and caps displaying the image of a Kawasaki motor vehicle thereon;**

[65] In the *Kawaski* decision, the Registrar opined that the amendments contain two restrictions. More particularly, the Registrar found that the first restriction is to the channels of trade in that the clothing, footwear and headgear are restricted to be sold through distributors or dealers of Kawasaki utility vehicles for off-road recreation. The Registrar found that the second restriction is also for the clothing, footwear and headgear but does not include restriction as to their channels of trade. Instead, the Registrar found it is a restriction that the applied-for trademark can only be used on such goods if the goods also display the image of a Kawasaki motor vehicle thereon. The Registrar considered the amendments acceptable. However, I note that the statement of opposition was not amended so as to specifically address the propriety of the amendments. Rather, the opponent's objection focused on the description "clothing, footwear and headgear for use in association with motor sports and motor recreation activities" rather than the goods which appear after the word "namely" for each of these items. I will return to this point below.

[66] Finally, the Applicant submits that if I were to conclude that the amendments contravene section 30(2)(a) of the Act, I should simply remove/delete the limitation wordings and "keep the rest" of the Applicant's statements of goods. The Applicant submits that prior to the applications being amended, the Opponent had not objected to the propriety of the original statements of goods under section 30(2)(a) of the Act.

[67] Before addressing the Applicant's submissions, I shall note the following submissions in reply that the Opponent made at the hearing.

The Opponent's submissions in reply

[68] The Opponent's submissions in reply focused on three issues.

[69] First, with respect to the Applicant's submissions that limitation wording need not be in ordinary commercial terms, the Opponent stresses that section 30(2)(a) of the Act provides that the application shall contain "a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used". The Opponent submits that the Act does not make any exception for exclusionary or limitation wordings; everything in the statement of goods must be in ordinary commercial terms.

[70] Second, with respect to the *Kawasaki* decision, the Opponent submits that the situation in the present cases is different as the Applicant is using a "house mark" to distinguish its goods, whereas in the *Kawasaki* decision there is no mention in the statement of goods that the goods must bear the trademark Kawaski or are to be sold in stores bearing the trademark Kawaski. The goods need only be sold through distributors or dealers of Kawasaki vehicles or display the image of a Kawasaki motor vehicle.

[71] Third, the Opponent submits that I cannot simply remove the limitation wordings and "keep the rest" of the statements of goods as suggested by the Applicant. The Opponent submits the statements of goods cannot be broadened by removing those limitations as this would contravene section 35(2)(c)(ii) of the Regulations, reproduced below:

35 (1) An application for the registration of a trademark may be amended before the trademark is registered.

Exceptions

(2) Despite subsection (1), the application must not be amended

[...]

(c) to broaden the scope of the statement of the goods or services contained in the application beyond the scope of

[...] (ii) the narrower of that statement as advertised under subsection 37(1) of the Act and that statement as amended after that advertisement

The Applicant has failed to satisfy its ultimate legal onus

[72] With respect, I do not find the Applicant's submissions persuasive.

[73] By amending its applications with the above-described limitation wordings referring to "the trademark owner's house mark", the Applicant has rendered each of the goods covered by its original statements of goods dependent on limitations that are vague and ambiguous. As indicated above in my review of the Opponent's submissions in chief, it is anything but clear what the term "trademark owner's house mark" is or could be [see by analogy *Canada Post Corporation v G3 Worldwide Mail N.V.*, 2010 TMOB 27, in which the exclusionary wording "outside the exclusive privilege of Canada Post" was found by the Registrar to be vague and ambiguous in that it did not provide a clear understanding of the scope of the applied-for services].

[74] As stressed by the Applicant itself in its written representations, the Applicant has "qualified and limited" the scope of the description of goods (see also paragraph 114 of its written representations in which the Applicant emphasizes again "the restrictions on the nature of the goods" and "the manner in which they are sold"). While I acknowledge that limitation wording may be used to overcome a confusion objection in some circumstances, I find the reference to the term "trademark owner's house mark" that aims to restrict the nature of the Applicant's applied-for goods and their channels of trade is not in ordinary commercial terms to describe the goods themselves.

[75] I further agree with the Opponent that the present cases can be distinguished from the *Kawasaki* decision. In fact, as the propriety of the particular amendments made by the applicant was not challenged by the opponent in that case, I do not consider the *Kawaski* decision on par with the present cases.

[76] Finally, I disagree with the Applicant's submissions that I may simply delete the limitation wordings referring to "the trademark owner's house mark". Not only is the broadening of the Applicant's statements of goods not permitted under section 35(2)(c)(ii) of the Regulations, but I am of the view that I do not have authority to do so. Indeed, per section 38(12) of the Act:

After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others. [...]

[77] As the Applicant has rendered each of the goods covered by its amended applications dependent on unacceptable limitation wordings, I find I have no other choice than to refuse each of the Applicant's applications with respect to all of the applied-for goods.

[78] Accordingly, the section 30(2)(a) ground of opposition succeeds in each case.

Not using and did not propose to use the mark – Section 38(2)(e) ground

[79] The Opponent has pleaded that at the filing date of each of the applications, the Applicant was not using and did not propose to use the Mark in Canada in association with the applied-for goods.

[80] Section 38(2)(e) of the Act states as follows:

(2) A statement of opposition may be based on any of the following grounds:

[...]

(e) that, at the filing date of the application in Canada [...], the applicant was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application; [...]

[81] The only submissions made by the Opponent with respect to this ground of opposition are found in her written representations. The Opponent submits that due to the length of time between the filing date of each of the applications and the filing date of the Applicant's evidence in these proceedings, the Registrar should infer that the

Applicant was not using and did not propose to use the Mark in Canada in association with the applied-for goods. More particularly, drawing a parallel between the present cases and the decision *Advanced Purification Engineering Corporation (APEC Water Systems) v iSpring Water Systems, LLC*, 2022 FC 388, the Opponent submits that “the Applicant’s evidence was submitted [...] over six years after the filing date of the [Applicant’s applications]” and “the Applicant has not provided sufficient evidence demonstrating use or promotion of the [Mark] in Canada.”

[82] I agree with the Applicant that this argument is without merit. The Federal Court decision relied on by the Opponent is distinguishable because it pertained to an entirely different context and type of proceeding. In fact, I find the ground of opposition is insufficiently pleaded and there is no evidence to cure the pleading or to otherwise support this ground.

[83] Accordingly, the ground of opposition based on section 38(2)(e) of the Act is rejected in each case.

Remaining grounds of opposition

[84] Each of the remaining grounds of opposition revolve around the likelihood of confusion between the Mark and the Opponent’s Trademark.

[85] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. The weight to be given to each factor may vary, depending on the circumstances [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 for a thorough discussion of the general principals that govern the test for confusion].

[86] In the present cases, both in its written representations and at the hearing, the Applicant put much emphasis on the limitation wordings added to the Applicant’s statements of goods, submitting *inter alia*, that:

- “these amendments [...] in the Applicant’s view, all but eliminate the risk of confusion” [at para 10];
- “[...] while the Applicant’s well-known CHANEL house mark is not part of the Applicant’s subject mark, it is present on the packaging of all its products and is central to the presentation of all the products at the point of sale and the advertising relating to its products, as confirmed by the Applicant’s current description of goods included in its Applications for the subject Mark. These factors play an important role in distinguishing the parties’ marks” [para 77];
- “[...] the fact that the GABRIELLE products will also bear the CHANEL mark and will be sold in an environment branded with the CHANEL mark, the link to Chanel will be automatic (especially given that Gabrielle is also the name of the founder of the House of Chanel)” [para 109]; and
- “[...] we submit that the restrictions on the nature of the goods, the manner in which they are sold and the different price points at which the parties [*sic*] goods are sold all but eliminate a likelihood of confusion” [para 114].

[87] In view of my conclusion above under the section 30(2)(a) ground of opposition with respect to the Applicant’s amended statements of goods, I find that I cannot then properly assess the likelihood of confusion between the Mark and the Opponent’s Trademark, particularly the section 6(5)(c) and (d) factors. In any event, as the Opponent has already succeeded under the section 30(2)(a) ground of opposition, I do not consider it necessary to address the remaining grounds of opposition.

DISPOSITION

[88] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each of the Applicant's applications pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Particulars of the Opponent's registration No. TMA1012358 for GABRIELLE

Statement of goods

Articles of clothing namely, dressing gowns, dresses, tunics, cardigans, leggings, scarves, belts, tutus, trousers, t-shirts and sweatshirts; headgear, namely hats, scarves, caps, earmuffs; footwear, namely, boots, shoes, slippers, flip-flops and sandal slides; jumpers, jumpsuits, shorts, tights, skirts, swimsuits, lingerie

Registration date

January 8, 2019

SCHEDULE B

Applicant's statements of goods (with the particular amendments that consist of limitation wording shown in underlining)

Application No. 1823809

Class 9 Goods

Optical apparatus and instruments, namely spectacles, sunglasses, eye glasses, field glasses, binoculars, cases, cords and chains for the aforesaid goods, spectacle and sunglasses frames and lenses, headphones, earphones, cases for headphones, anti-glare glasses and anti-glare visors, contact lens cases, anti-theft locks for skis and ski equipment, clothing, namely vests, coats and gloves for protection against accidents, safety helmets, riding hats, safety goggles, personal safety alarms, fascias, cases, covers and carry bags for telephones and telecommunications apparatus and instruments namely tablet computers and laptops, fascias, cases, covers and carry bags for electronic devices namely cell phones and digital music players, battery power packs for mobile phones, cell phones, laptop computers, PC and digital tablets, mobile telephone cards, downloadable ring tones and icons, machine readable pre-paid mobile airtime vouchers, downloadable electronic publications namely books and periodicals, stands, holders and mounts for telephones, cell phones, computers and electronic handheld devices, namely tablet computers, laptops and digital music players, encoded club cards, charge cards, payment cards, loyalty cards and debit cards, education and teaching apparatus and instruments, namely, electronic books and manuals and pre-recorded DVDs and discs, electronic learning aids namely, books and manuals, apparatus for recording, transmission or reproduction of sound or images namely, digital audio tape recorder, DVD recorders, computers, downloadable printed publications, namely, books, magazines and periodicals in electronically readable form, computer operating system software, computer software applications for electronic devices namely, downloadable applications to read periodicals, books and magazines, downloadable applications to enable the streaming of music and the editing of images and videos, mouse mats, blank CD Rom, DVD and digital optical discs, decorative magnets, smart phones in the shape of a watch, computer peripherals and accessories namely, flash memory cards, flash memory expansion modules, selfie sticks, USB flash

drives, personal digital assistants, multifunctional electronic devices for tracking and managing personal health and fitness information namely smart watches and pedometers, films for covering and protecting surfaces of mobile phones, personal digital assistants, electronic personal organisers, tablet computers, portable computers, cameras, electronic book readers, smart watches, measuring tapes, all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively in the following manners, through the websites of the trademark owner (which only offer products of the trademark owner), at the trademark owner's boutiques branded with the trademark owner's house mark (which boutiques only offer products of the trademark owner), at counters or sections of authorized third-party stores branded with the trademark owner's house mark, through websites of these authorized third parties, on pages branded with the trademark owner's house mark, or on pages where the trademark owner's products offerings are identified by the house mark of the trademark owner.

Class 18 Goods:

Leather and imitation leather, skins and hides, handbags, pocket wallets, umbrellas, parasols, briefcases, luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts, bags namely, travel bags, tote bags, clutch bags, duffel bags, sporrans, credit card holders, card holders, key holders, pet clothing, pet collars, dog leashes, riding whips, parts and fittings for handbags, pocket wallets, umbrellas, parasols, briefcases, luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts, bags namely, travel bags, tote bags, clutch bags, duffel bags, sporrans, credit card holders, card holders, key holders, pet clothing, pet collars, dog leashes, riding whips, all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively at the trademark owner's boutiques branded with the trademark owner's house mark and which boutiques only offer products of the trademark owner, and none of these goods to be sold through stores or online stores specialized in the sale of natural health products or organic products.

Application No. 2239129

Class 3 Goods

Cosmetic preparations for the care of the skin, scalp, hair and nails, soaps for personal use, perfumes, essential oils for personal use, aromatic essential oils, essential oils for cosmetic purposes, essential oils for aromatherapy, make-up, deodorants for personal use, cosmetics, all these goods being luxury goods bearing the trade mark owner's house mark, sold exclusively in the following manners, through the websites of the trademark owner (which only offer products of the trademark owner), at the trademark owner's boutiques branded with the trademark owner's house mark (which only offer products of the trademark owner), at counters or sections of authorized third-party stores branded with the trademark owner's house mark (which counters or sections only offer products of the trademark owner), or through websites of these authorized third parties, on pages branded with the trademark owner's house mark or on pages where the trademark owner's products offerings are identified by the house mark of the trademark owner, and none of these goods to be sold through stores or online stores specialized in the sale of natural health products or organic products

SCHEDULE C

Applicant's last amended statement of goods – application No. 223919

Class 3 Goods

Perfumes, being luxury goods bearing the trade mark owner's house mark, sold exclusively in the following manners, through the websites of the trademark owner (which only offer products of the trademark owner), at the trademark owner's boutiques branded with the trademark owner's house mark (which only offer products of the trademark owner), at counters or sections of authorized third-party stores branded with the trademark owner's house mark (which counters or sections only offer products of the trademark owner), or through websites of these authorized third parties, on pages branded with the trademark owner's house mark or on pages where the trademark owner's products offerings are identified by the house mark of the trademark owner, and none of these perfumes to be sold through stores or online stores specialized in the sale of natural health products or organic products

Appearances and Agents of Record

HEARING DATE: 2024-09-11

APPEARANCES

For the Opponent: Geoff Langen

For the Applicant: Nelson Godfrey and Sébastien Gardère

AGENTS OF RECORD

For the Opponent: Moffat & Co.

For the Applicant: Gowling WLG (Canada) LLP