

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 198
Date of Decision: 2013-11-25
TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Rouge Cosmétiques, Inc. to application
No. 1,476,476 for the trade-mark
STUDIO ROUGE & Design in the name
of 9220-2688 Québec inc.**

Introduction

[1] Rouge Cosmétiques, Inc. (the Opponent) opposes the registration of the trade-mark STUDIO ROUGE & Design (the Mark), reproduced hereinafter, being the object of Application No. 1,476,476 in the name of 9220-2688 Québec inc. (the Applicant).



[2] This application, filed on April 1, 2010, is based on the proposed use of the Mark in Canada with respect to the following services:

Hairstyling services, namely cutting, dying, styling, perming and applying extensions to hair; esthetic care services, namely applying eyelash extensions, make-up, giving manicures, pedicures, applying nails and waxing; massage therapy services; make-up

courses; body treatments, namely paraffin wax and algae wraps, body scrubs, back treatments, facial treatments and foot treatments (the Services).

[3] The application contains a disclaimer of the right to exclusive use of the words “STUDIO” and “ROUGE” outside the Mark. The colour is claimed as characteristic of the Mark, the word “ROUGE” being in bright red.

[4] The Opponent bases its opposition on various grounds, mostly related to the question of the probability of confusion under the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) between the Mark and one or more of the trade-marks that are the object of applications and/or registrations described in the schedule, and with the trade-mark STUDIO ROUGE & Design reproduced hereinafter (sometimes collectively referred to as the “ROUGE” family) belonging to the Opponent and which have been previously used in Canada by the Opponent in the fields of esthetic care and cosmetics.



[5] As my analysis will show, I consider this opposition well founded, without it being necessary to discuss each and every ground of opposition argued by the Opponent.

The record

[6] The statement of opposition was filed on August 1, 2011. The Applicant produced a counter-statement denying each of the grounds of opposition argued. It is appropriate to note at this stage that this statement of opposition was amended by the Opponent on September 20, 2012, without objection by the Applicant and with the permission of the Registrar granted on October 5, 2012. The amendments made are essentially intended to correct a few typographical errors in the original statement of opposition and to provide a few clarifications to the grounds originally argued.

[7] In support of its opposition, the Opponent filed a statutory declaration by its founder, principal shareholder, sole director and president, Élisabeth Alarie, sworn on March 30, 2012,

and a statutory declaration by its sales representative, Isabelle Dallaire, sworn on March 29, 2012. Neither was cross-examined.

[8] No proof was filed by the Applicant.

[9] Only the Opponent filed a written argument. No hearing was requested by the parties.

The burden on the parties

[10] It is initially up to the Opponent to establish that its opposition is well-founded. However, the ultimate burden of proof that the Mark is registrable rests with the Applicant, according to the preponderance of the evidence [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, SA et al* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Analysis

[11] As mentioned above, most of the grounds of opposition argued by the Opponent are related to the question of the probability of confusion between the Mark and one or more of the trade-marks of the Opponent's "ROUGE" family.

[12] I will begin my analysis of the probability of confusion between the marks in question with regard to one of the grounds of opposition based on the non-distinctiveness of the Mark.

The non-distinctiveness of the Mark

[13] The statement of opposition alleges that the Mark is not distinctive on two grounds. One of these grounds is worded as following in paragraph 36.5 thereof:

36.5 The [M]ark [...] is not distinctive as to its design, nor can it be distinctive nor is it fit to distinguish them, particularly with regard to the design used for the Opponent's trade-marks, in that at the date of this statement of opposition, it is confusing with the trade-mark STUDIO ROUGE & Design rightfully belonging to the Opponent, being a copy of this mark, and with the Opponent's trade-marks ROUGE COSMETICS AND DESIGN [...] TMA815808, ROUGE PRO AND DESIGN [...] TMA822517, ROUGE ON THE GO AND DESIGN [...] TMA811637, and LILI ROUGE & DESIGN [...] TMA815221, having regard, in particular, without limiting the general scope of the foregoing: (i) that the

[M]ark [...] uses the same bouquet design composed of three red cherries, two black stems and three black leaves used by the Opponent's marks; and (ii) that the word "Rouge" is written in the same script letters used by the Opponent.

[TRANSLATION]

The application therefore should be refused pursuant to section 38(2)(d) of the Act.

[14] To discharge its initial burden of proof regarding non-distinctiveness, the Opponent must prove that one or more of the trade-marks it alleges had become sufficiently known in Canada at the date of the statement of opposition, namely August 1, 2011, so as to deny the distinctiveness of the Mark [see *Motel 6, Inc. v. No 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); and *Bojangles' International, LLC and Bojangles Restaurants, Inc. vs. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)].

[15] This burden was met by the Opponent, in particular having regard to its trade-mark STUDIO ROUGE & Design, as shown by my review hereinafter of the highlights of Ms. Alarie's statutory declaration on this question.

[16] Ms. Alarie's statutory declaration establishes the following:

- The Opponent is a business in the fields of esthetic care and cosmetics.
- The Opponent offers beauty, hair care, esthetic care, make-up, manicure, pedicure and body care services, as well as esthetic care products and cosmetics, including make-up products, make-up accessories, perfume products, jewellery, hair products and accessories, creams, etc. [Also see the copies of brochures, photographs of products, and leaflets produced as Exhibits EA-2 and EA-3.]
- These products are commercialized under several marks, including those listed in the schedule hereto.
- Since at least as early as August 2003, the Opponent has used and made itself known by its logo, consisting of a design of bouquet composed of three red cherries, two black stems with three black leaves, combined with the word "Rouge" in script letters.

- In October 2007, the Opponent opened a beauty salon under the trade-marks ROUGE COSMETICS and ROUGE COSMETICS AND DESIGN, as well as a make-up school under the trade-mark STUDIO ROUGE, under the logo reproduced hereinafter. [Also see the copies of various magazine articles mentioning these openings, filed as Exhibit EA-4, and the copies of photos of the beauty salon, produced as Exhibit EA-7.]



- In spring 2009, the Opponent explored the idea of creating franchises. In October 2009, the Opponent decided to develop its chain of beauty salon franchises under the mark STUDIO ROUGE and, from then on, to operate its make-up school under the trade-mark ROUGE PRO AND DESIGN.
- Within the context of the development of the chain of STUDIO ROUGE beauty salon franchises, the Opponent retained the services of a graphic designer to modify the STUDIO ROUGE logo. Thus, the initial STUDIO ROUGE logo, reproduced above, was changed to the one reproduced in paragraph 4 of my decision.
- The new logo has been advertised by the Opponent and used ever since. [In particular, see a copy of the Opponent's price list, a copy of the invitation to the opening of its second beauty salon and a copy of a page from the Opponent's website, filed jointly as Exhibit EA-15. Also see Exhibit EA-7 described above.]
- The Opponent's products are sold in Quebec in many stores and beauty salons, such as Pharmacies Jean-Coutu, Pharmacies Uniprix, Pharmacies Brunet, and Pharmacies Familiprix. [In particular, see Exhibit EA-28].

[17] Since the Opponent has satisfied the initial burden of proof incumbent upon it, the Applicant thereupon must prove, according to the balance of probabilities, that at the date of filing of the statement of opposition, there was no risk of confusion between the Mark and one of

the Opponent's marks, the most relevant, for the purposes of my analysis, being the mark STUDIO ROUGE & Design.

[18] The confusion test is a test of first impression and imperfect memory. According to section 6(2) of the Act, the use of a trade-mark or a trade-name causes confusion with another trade-mark or trade-name if the use of both trade-marks or trade-names in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks or trade-names are manufactured, sold, leased, hired or performed by the same person, regardless of whether the wares or services are of the same general class.

[19] In deciding whether trade-marks or trade-names are confusing, the Registrar must account for all the circumstances of the case, in particular, those set out in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. This list is not exhaustive and a different weight may be assigned to each of these factors, depending on the context [see *Mattel, Inc v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

[20] In the case at bar, all of these factors together incontestably favour the Opponent.

[21] To all intents and purposes, the Mark is identical to the Opponent's mark STUDIO ROUGE & Design, which possesses a definite inherent distinctiveness. The Services covered by the application are identical to or overlap those offered by the Opponent with respect to the mark STUDIO ROUGE & Design. The nature of the parties' trade is the same. The Opponent's mark STUDIO ROUGE & Design has been used since fall 2009 (and even since October 2007 if the first version of the logo developed for the mark STUDIO ROUGE) is also considered, whereas this application is based on the proposed use of the Mark and the Applicant has not submitted any evidence proving the use of the Marks since the filing of the application.

[22] Therefore, the Applicant has not discharged the burden of proof it was incumbent on it to establish, according to the balance of probabilities, that at the date of filing of the statement of opposition, the Mark was distinctive of the Applicant's services.

[23] The ground of opposition based on non-distinctiveness, as argued in paragraph 36.5 of the statement of opposition, is therefore accepted.

The Applicant is not the person entitled to registration

[24] The statement of opposition alleges that the Applicant is not the person entitled to registration of the Mark, pursuant to section 16(3)(a) of the Act, in that:

36.1 [...] at the date of filing of the application, it was confusing with another trade-mark previously used in Canada by another person, namely the Opponent, having regard, in particular, without limiting the generality of the foregoing: (i) that the Opponent has made itself known, since October 2007, under the mark STUDIO ROUGE, essentially similar to the mark registered by the Applicant for its make-up school; (ii) that the Opponent, since October 2007, has already operated an establishment doing business under the name Rouge Cosmetics and offering services essentially identical to the services offered by 9207-4186 Québec inc.; (ii) [sic] that Ms. Jessica Harvey was a representative of the Opponent and leased a manicure space in the Opponent's salon; (iii) [sic] that Ms. Jessica Harvey was in negotiation to obtain a franchise concession contract with the Opponent at the time of the filing of [this] application; and (iv) [sic] that Ms. Jessica Harvey, since at least spring [sic] 2009, had expressed the intention of opening a business based on the Opponent's establishment Rouge Cosmetics.

The bouquet design composed of three red cherries, two black stems and three black leaves, and the writing of the word "Rouge" in script letters, are the particularly striking and unique aspects of all the marks held by the Opponent, which distinguish it from its competitors.

Since these dominant aspects are common to the Opponent's marks and to the mark [...] of the Applicant, and constitute the distinctive element of the Opponent's marks, an ordinary consumer who is somewhat hurried, who has a vague memory of the Opponent's mark and who sees the [M]ark [...], and who does not stop to think about the question in depth, nor to examine the resemblances and the differences closely, will probably be confused, and it is more likely that this consumer, as a first impression, would consider that the Applicant is the Opponent's licensee and that they constitute one and the same service provider for beauty care and the sale of cosmetic products.

[TRANSLATION]

[25] This ground of opposition alleges several facts, some of which are based on the actions of third parties, namely 9207-4186 Québec inc. and Ms. Jessica Harvey. These third parties and the relations existing between them and the Applicant or the Opponent are amply described in the introductory paragraphs of the statement of opposition. These explanations are also repeated in detail in Ms. Alarie's statutory declaration.

[26] This having been said, I believe it is unnecessary to go into the details of these relations to rule on this ground of opposition.

[27] Indeed, to discharge its initial burden of proof with regard to section 16(3)(a) of the Act, the Opponent must simply prove that its trade-mark STUDIO ROUGE & Design had been used in Canada previous to the date of filing of the application and had not been abandoned at the date of advertisement of the Applicant's application [section 16(5) of the Act]. This initial burden of proof having been satisfied in the case at bar, the Applicant thereupon must prove, according to the balance of probabilities, that there was no risk of confusion between the Mark and this mark of the Opponent at the date of filing of this application, based, it should be remembered, on the proposed use of the Mark.

[28] Having previously concluded, in view of the evidence in the record, that the probability of confusion exists between the Mark and the Opponent's mark STUDIO ROUGE & Design, on the ground of opposition based on the non-distinctiveness of the Mark, and since the difference between the relevant dates has no impact on my previous analysis, I accept the ground of opposition based on section 16(3)(a) of the Act, to the extent that it is based on the mark STUDIO ROUGE & Design.

Other grounds of opposition

[29] Since I have already refused the application on two grounds, I will not examine the other grounds of opposition.

Disposition


[30] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.




Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Arnold Bennett, trad.

Schedule

Mark	Application No. and/or Registration No.	Date of the Application and/or Date of Registration	Wares and/or Services Claims
ROUGE COSMETICS	1,397,086 TMA770,847	2008-05-27 2010-6-29	1) WARES: Make - up products, namely: lipstick, lip gloss, gloss, liquid foundation, liquid foundation, powdered foundation, pressed powder, loose and compact powders, blushes, cream blush, eye shadow, loose eye shadows, eye pencils, lip pencils, eyebrow pencils and cheek pencils, cover - up sticks, eye shadow bases, mascara, liquid eye shadow sealant, concealer, bronzing powders, illuminating powders, grease paint disks, nail polish, nail polish removers, adhesive bases for nail polish, finishing layers for nail polish, make - up foundation, lip foundation products, mineral highlighters; make - up accessories, namely: brushes, bags, attaché - cases, tweezer sleeves, antibacterial shampoos with brushes, brush cleaners in spray form, cotton wool for cosmetic purposes, technical sheets, decorative patterns for cosmetic use, toiletry and make - up cases, tote bags, beach bags, handbags, sponges, applicators, sharpeners, eyelash curlers, make - up spatulas, scissors, eyebrow shapers; tights, posters, postcards, display racks; perfumery products, namely: products for scenting linen; essential oils namely essential oils for cosmetic purposes, essential oils for the body, essential oils for the bath, essential oils for use in the manufacture of scented products, essential oils for the manufacture of aromas; scented waters for personal use, eaux de senteur for personal use; incense; flower extracts, namely: for perfumery; flower - based perfume bases; soaps, namely: bath soaps in liquid or gel form, anti - perspirant soaps, deodorant soaps and anti - transpirants soaps, skin soaps, body soaps, hand soaps, deodorant soaps, washroom soaps; highlighters, namely: eye shadow, blusher, blush applicators; perfumes namely: eaux de toilette, perfumes, fragrance

			<p>concentrates; e aux de cologne, eaux de toilette; jewellery namely: necklaces, charms, bracelets, chains, earrings, guitar pics, charms, rings, pendants, brooches, ankle chains, watches, watch bands; hair products, namely: for care of the hair, shampoos, conditioning creams , fixative gels, hair glitter, hair treatments, hair dye, hair accessories, namely: barrettes, elastic bands, clips, hair jewellery; creams, namely: slimming creams, sunscreen preparations, namely: creams, milks, gels and oils for skin protection and tanning, lotions for tanning the skin, cosmetic preparations to tan the skin, beauty masks, creams to whiten the skin, cosmetic formulations for the bath, bath salts for non - medical use, products to remove make - up, namely: milks, oils, gels to remove make - up, towelettes saturated with these products, lotions to remove make - up; deodorants (for personal use), cosmetic lotion - filled towel; cleaners, lotions, toners, creams, eye creams, pads to re move mascara, hand and body lotions, creams for the hands, coloured moisturizers, suntanning oils, suntan moisturizers; toothpaste, tinted emulsions, namely: day creams, anti - wrinkle creams, tinted moisturizing creams, anti - wrinkle creams, exfoliators, talc; clothing and accessories, namely: purses, wallets, umbrellas; shoes namely shoes, slippers, sandals; hats, dresses, skirts, jackets, vests, pants, knitwear, stockings, tights, lingerie and bathing suits, beach coats, dressing gowns, sashes, scarves, belts, gloves, shirts, blouses, ankle socks and socks, night shirts and pajamas, raincoats, suits, camisoles, T - shirts. Used in CANADA since at least as early as November 2003.</p>
	<p>1,491,959 TMA815,808</p>	<p>2010-08-11 2012-01-20</p>	<p>Merchandise: idem as for the Mark ROUGE COSMETICS.</p> <p>Services: (1) Make - up, eyebrow hair removal, creation of eyebrow lines, eyebrow cleaning, half - leg hair removal, full - leg hair removal, underarm hair removal, bikini hair removal, moustache hair removal, back hair removal,</p>

			upper lip hair removal, torso hair removal, facials, make - up classes. Used in CANADA since at least as early as August 2003.
STUDIO ROUGE	1,488,286 N/A	2010-07-12 N/A	(1) Beauty, hairdressing, esthetics, make – up, manicure, pedicure, body-care salons; make – up school. Used in CANADA since at least as early as October 1 st 2007.
LILI ROUGE	1,407,994 TMA771,198	2008-08-20 2010-07-06	Merchandise: idem as for the Mark ROUGE COSMETICS. Used in CANADA since at least as early as August 1 st 2003
	1,488,131 TMA815,221	2010-07-09 2012-01-10	Merchandise: idem as for the Mark ROUGE COSMETICS, except it does not include clothing and accessories. Used in CANADA since at least as early as August 1st 2008.
	1,492,299 TMA811,637	2010-08-13 2011-11-14	(1) Make - up, eyebrow hair removal, creation of eyebrow lines, eyebrow cleaning, waxing, facials, make - up classes, manicures, pedicures, nail application. Used in CANADA since at least as early as September 2007.
	1,492,300 TMA822,517	2010-08-13 2012-04-19	(1) Make - up products, namely: lipstick, lip gloss, glosses, liquid foundation, cream foundation, powdered foundation, pressed powders, loose and compact powders, blusher, cream blusher, eye shadow, loose eye shadow, eye pencils, lip pencils, eyebrow pencils and cheek pencils, cover - up sticks, eye shadow bases, mascara, eye shadow sealant liquids, blemish concealers, bronzing powders, highlighting powders, grease make - up disks, nail polish, nail polish remover, adhesive bases for nail polish, nail polish finishing coats, make - up bases, lip product bases, mineral highlighters; make - up accessories, namely: brushes, cases, carry cases, brush sleeves, antibacterial brush shampoos, brush cleaning sprays, cotton wool for cosmetic use, publications, namely brochures containing

			<p>advice related to make - up and esthetic care, temporary tattoos with decorative patterns for cosmetic use, make - up kits, tote bags, beach bags, handbags, sponges, applicators, sharpeners, eyelash curlers, cosmetic spatulas, scissors, eyebrow razors.</p> <p>Services: idem as for the Mark ROUGE ON THE GO & Dessin.</p> <p>Used in CANADA since at least as early as October 2009 on services. Used in CANADA since as early as October 2009 on wares.</p>
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