



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

Citation: 2013 TMOB 200
Date of Decision: 2013-11-21

**IN THE MATTER OF AN OPPOSITION
by Victoria's Secret Stores Brand
Management, Inc. to application
No. 1,405,840 for the trade-mark
VALENTINE SECRET and Design in the
name of Eclectic Edge, Inc.**

[1] Eclectic Edge, Inc. (the Applicant) has applied to register the trade-mark VALENTINE SECRET and Design (the Mark) based on proposed use in Canada in association with, among other things, brassieres, camisoles, sleepwear, underwear and lingerie. Victoria's Secret Stores Brand Management, Inc. (the Opponent) has opposed this registration on the basis that there is a reasonable likelihood of confusion between the Mark and the Opponent's previous use and making known of its VICTORIA'S SECRET marks in association with a wide variety of wares and services, including, among other things, clothing, undergarments, lingerie, and personal care products.

[2] For the reasons that follow, I have found that this application should be refused.

Background

[3] On August 1, 2008, the Applicant filed application No. 1,405,840 for the registration of the Mark VALENTINE SECRET and Design, shown below.



[4] The application is based on proposed use in Canada in association with the following wares:

bandanas (neckerchiefs); bath robes; bathing drawers; bathing suits, beach clothes; boas (necklets); bodices (lingerie); brassieres; camisoles; clothing for gymnastics; corsets (underclothing); drawers (clothing); dressing gowns; frocks; fur stoles; girdles gloves (clothing); jumpers (shirt fronts); knitwear (clothing); mittens; petticoats; pockets for clothing; pullovers; ready-made clothing, namely, sleepwear, underwear and lingerie; ready-made linings (parts of clothing); robes (bath); scarfs; singlets; skirts; slips (undergarments); suits; suits (bathing -); sweat-absorbent under-clothing (underwear); sweaters; teddies (undergarments); tee-shirts; tights

[5] The application claims a priority filing date of March 24, 2008 from a trade-mark application filed in Singapore.

[6] The application was advertised in the *Trade-marks Journal* on November 4, 2009, and the Opponent filed a statement of opposition on April 1, 2010. The main issue in this opposition is whether there would be a likelihood of confusion between the Mark as applied to the wares covered in the Applicant's application and one, or more, of the Opponent's trade marks identified in its statement of opposition. The registered marks relied upon by the Opponent are attached as Exhibit A to this decision.

[7] Both the Applicant and the Opponent filed a written argument and both parties were represented at an oral hearing wherein the Opponent's oppositions to the Applicant's application Nos. 1,405,838; 1,405,839; and 1,405,835 for the trade-marks VALENTINE SECRET, VALENTINE SECRET LINGERIE and Design and VS A SECRET THAT WOMEN LOVE and Design were also heard at the same time.

[8] As its evidence, the Opponent filed certified copies of Canadian trade-mark registration Nos. TMA313,969; TMA432,093 and TMA538,755, and the affidavits of Carol M. Matorin, Kaitlin Macdonald and Brian Kuchar. Both Ms. Matorin and Ms. Macdonald were cross-examined and the transcripts of their cross-examinations form part of the record.

[9] Mr. Kuchar was also cross-examined and his cross-examination transcript also forms part of the record. The parties agreed that answers given in his cross examination will apply to his affidavits submitted in respect of application Nos. 1,405,835; 1,405,839 and the present

application with some exceptions as indicated in pages 4-5 of the transcript. The Applicant did not file any evidence.

Preliminary Issues

State of the Register Evidence

[10] At the oral hearing, the Opponent submitted that I should not have regard to the state of the register evidence referred to in the Applicant's written argument. I agree.

[11] State of the register evidence cannot be considered where it is adduced through the written argument and without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [see *Unitron Industries Ltd v Miller Electronics Ltd* (1983), 78 CPR (2d) 244 at 253 (TMOB), followed in *John Labatt Ltd v WCW Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 (TMOB), followed in *Frank T Ross & Sons (1962) Ltd v Hello Cosmetics Inc* (1994), 53 CPR (3d) 124 (TMOB)].

[12] The law is also clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications are extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) at 411]. The parties to opposition proceedings are expected to prove each aspect of their case following fairly strict rules of evidence [see *Loblaw's Inc v Telecombo Inc* 2004 CarswellNat 5135 at para 13 (TMOB)]. It is not for the Registrar to exercise his discretion and have regard to anything appearing on the register that is not properly proved by evidence under these circumstances.

[13] I would like to add that the Applicant's agent also tried to introduce various registrations at the Matorin cross-examination. The Opponent's agent refused to let Ms. Matorin answer questions about them, stating that they were not relevant to her evidence. These registrations were therefore marked as exhibits for informational purposes only. In my view, it was inappropriate for the Applicant to introduce these registrations through cross-examination. As noted above, the Applicant could have easily filed certified copies of these registrations or an

affidavit attaching these registrations to it as its evidence. The Applicant, however, chose not to file any evidence. I will therefore not have regard to these registrations.

Reliability of Matorin Evidence

[14] Ms. Matorin states that she has been Senior Vice President, Senior Counsel of the Opponent since 2001. She further states that the evidence given in her declaration is within her personal knowledge or derived from the records of Victoria's Secret to which she has access.

[15] The Applicant's main objection to Ms. Matorin's evidence is that it is unreliable. The objection is based largely on the cross-examination of Ms. Matorin, wherein the following deficiencies were revealed:

- Ms. Matorin did not know how much of the Opponent's advertising expenses for the years 2004 to 2009 were for Canada;
- Ms. Matorin stated that there was a written license agreement between the Opponent and Victoria's Secret (Canada) Corp. but then was unable to produce a copy of this agreement;
- while she states in her affidavit that the terms of the Master License Agreement and the Sub-License Agreement are parallel, the Applicant questions her knowledge of the quality control since the Applicant submits that the terms are not parallel at all; and
- there is a discrepancy between the numbers provided in para. 11 of Ms. Matorin's affidavit and the numbers shown in Exhibit D to her affidavit regarding the number of catalogs distributed worldwide between 2002 and 2008.

[16] The Federal Court has held that an affiant's experience and his or her office may put him or her in a position to have personal knowledge of the facts without necessarily having been a direct witness to the event [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD) at pages 59-60; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP* (2010), 83 CPR (4th) 273 (FC) at para. 35; *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289]. Overall, despite the errors Ms. Matorin may have made in her evidence, I find

that she had personal knowledge of the Opponent's business. In my view, it seems she was in a position from her office and experience with the Opponent to know of what she deposed. I therefore reject the Applicant's submission that her evidence should be disregarded.

Onus and Material Dates

[17] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to put forward sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[18] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 16(3)(a) – the filing date of the application [section 16];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30(i) Ground – Non-Conformity

[19] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As there is no evidence of bad faith in the present case, I am dismissing this ground of opposition.

Section 12(1)(d) Ground – Non-Registrability

[20] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-marks set out in the attached Schedule A.

[21] I will assess the section 12(1)(d) ground of opposition based on confusion between the Mark and the Opponent's trade-mark registration TMA538,755 for the trade-mark VICTORIA'S SECRET as I am of the view that the Opponent's case is strongest with respect to this trade-mark.

[22] This VICTORIA'S SECRET mark of the Opponent is registered for use in association with the following wares and services:

WARES: 1) Women's lingerie (excluding hosiery and pantyhose), namely underwear, brassieres, panties, slips, bodyliners, bodystockings, garter belts, g-strings, thongs, teddies, chemises, camisoles. (2) Women's lingerie (excluding hosiery and pantyhose), namely brassieres, panties, slips, bodyliners, bodystockings, garter belts, g-strings, thongs, teddies, chemises, camisoles; women's wearing apparel, namely dresses, fragrances, namely, perfumes, colognes, eaux de cologne, air fresheners, scented sachets, scented hangers and potpourris; cosmetics and personal care products, namely, bath, hand and body lotions, moisturizers, soaps, shampoos, bath oils, bath preparations and shower gels; footwear, namely boots, loafers, clogs, shoes, pumps and slippers; lingerie bags, hanging bags and hangers; candles; combs, brushes, namely make-up brushes and cosmetic brushes, razors and atomizers; mail order catalogues, photo albums, calendars, bridal books, paper bridal shower invitations, letter openers, address books and gift wrap kits, namely, collections of boxes, tissue, paper, ribbon and a card; collections of classical music cassettes and collections of classical music compact discs; picture frames, mirrors and pillows; perfume bottles, decorative boxes, pitchers, insulated bottles, trays, flasks and shoe horns; women's and men's outer wear; underwear and nightwear, namely, loungewear, robes, gowns, caftans, kimonos, dusters, pyjamas, sleepshirts, nightdresses, shirts, blouses, pants, trousers, jeans, dresses, suits, skirts, sweaters, cardigans, turtlenecks, jumpsuits, tunics, blazers, jumpers, vests, sweatshirts, jogging pants, jackets, t-shirts, scarves, bodysuits, swimsuits, bikinis, briefs, hipsters, beach shirts, wraps, tank tops, boy's boxer shorts, ties; toy stuffed animals and dolls. (3) Women's lingerie.

SERVICES: (1) Operation of a retail mail-order catalogue.(2) Operation of a retail mail order catalogue.

[23] If there is no likelihood of confusion between the Mark and this registration then there would be no likelihood of confusion with respect to the Opponent's other registrations. As a

result, my determination of a likelihood of confusion as between the Mark and this registration will be determinative of the section 12(1)(d) ground of opposition.

[24] I have exercised my discretion and checked the register to confirm that this registration is extant [see *Quaker Oats*, above]. Therefore, the Opponent has met its initial burden with respect to this ground. As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's VICTORIA'S SECRET trade-mark.

test for confusion

[25] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. 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, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has 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 in appearance or sound or in the ideas suggested by them.

[26] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc. et al.* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[27] It has previously been held that the Opponent's VICTORIA'S SECRET trade mark is inherently distinctive [see *Manufacturiers de Bas de Nylon Doris Ltee/Doris Hosiery Mills Ltd v Victoria's Secret, Inc*(1991), 39 CPR (3d) 131 (TMOB)]. The Applicant's VALENTINE SECRET and Design mark is slightly more inherently distinctive than the Opponent's mark because of its design component.

[28] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Opponent relies on the following evidence of Ms. Matorin to establish the use and reputation of its VICTORIA'S SECRET trade-marks in Canada:

- the Opponent licenses the use of its VICTORIA'S SECRET trade-marks to various related companies who sell and offer for sale products and offer services in association with the VICTORIA'S SECRET trade-marks in Canada and elsewhere;
- for the years 2007 – 2009, the Opponent spent over \$625,000,000 promoting the VICTORIA'S SECRET products (although no breakdown for Canada has been provided) [Matorin, paras. 6 and 10];
- VICTORIA'S SECRET products are sold and offered for sale in Canada by mail order, over the Internet and in retail locations;
- between 2002 and 2008, more than 25,900,000 catalogs were mailed to Canadian addresses [Matorin, paras. 11, 15, 16 and Exhibit D];
- from 2003 – 2008, sales of VICTORIA'S SECRET products to customers in Canada through its mail order business (products having been made available to customers through the website victoriasecret.com and by catalog) exceeded US\$184,000,000 [Matorin, para. 15 and Exhibit G];
- Canadian customers have been able to purchase VICTORIA'S SECRET products at one of six VICTORIA'S SECRET PINK store locations in Canada since August 2009;

[Matorin, para. 9-11; Exhibits H and I] and sales from Oct. 2009 – Aug. 2010 were \$21.8 million;

- the VICTORIA'S SECRET fashion show has been broadcast on television annually for many years;
- between 2007 and 2010, certain beauty and personal care products were sold in association with the VICTORIA'S SECRET trade-mark at LA SENZA retail stores in Canada [Matorin, para. 18 and Exhibit J];
- two VICTORIA'S SECRET retail stores were opened in Edmonton and Toronto in August, 2010 [Matorin, para. 20 and cross-examination, lines 21-24]; and
- other VICTORIA'S SECRET retail stores have opened in Canada since the date of Ms. Matorin's affidavit [Matorin answers to undertakings, Exhibit CX-7].

[29] The Opponent also relies on the evidence of Ms. Macdonald. Ms. Macdonald conducted an Internet search on August 9, 2010 using the Google Search engine for references to VICTORIA'S SECRET and VS. The results of her search included articles about the opening of the VICTORIA'S SECRET stores in Toronto and Edmonton [Macdonald, paras. 16-26 and Exhibits D-G]. At cross-examination, Ms. Macdonald stated that she did not know how many Canadians had accessed the results listed in her affidavit and admitted that she had not reviewed the results listed to determine if they actually related to the Opponent and its business in Canada.

[30] Ms. Macdonald also attended at a VICTORIA'S SECRET PINK retail store in Toronto on August 3, 2010 and attached images of the storefront as well as wares purchased at the store. On August 9, 2010, Ms. Macdonald attended a LA SENZA retail store in Toronto and purchased a bottle of lip gloss displaying the mark VICTORIA'S SECRET.

[31] The Kuchar affidavit attaches the following materials as exhibits:

- print-outs of news articles pertaining to the opening of the VICTORIA'S SECRET retail store locations in Toronto and Mississauga;

- print-outs of digital photographs Mr. Kuchar took in September 2010 of the exterior signage of the VICTORIA'S SECRET location at Yorkdale Shopping Centre in Toronto and of the goods he purchased at the store; and
- print-outs of digital photographs Mr. Kuchar took of the exterior signage of the VICTORIA'S SECRET store location at the Eaton Centre in Toronto.

[32] On cross-examination, Mr. Kuchar revealed, among other things, that he did not know how many Canadians viewed the articles located in his search, or whether such articles were distributed in printed publications in addition to Internet publications.

[33] The Applicant makes the following submissions regarding the Opponent's evidence:

- the Opponent should not be allowed to rely on its alleged use and making known of its trade-mark at all, and in particular prior to February 1, 2009, because license agreements evidenced by Ms. Matorin were not in effect during the period in which the mail order and Internet sales occurred;
- the VICTORIA'S SECRET products sold in Canada since 2007 in LA SENZA retail stores were personal care products for the skin which are unrelated to the Applicant's wares; further, the products were distributed by an entity known as Victoria's Secret Beauty Co. which has no known relationship to the Opponent;
- the trade-mark displayed on the products sold in the PINK stores is the word PINK, prominently written, with the words VICTORIA'S SECRET appearing in significantly smaller writing underneath which would not be perceived as use of VICTORIA'S SECRET; and
- while the Opponent's evidence suggests that VICTORIA'S SECRET retail stores have opened in Canada as of August 2010, no evidence of any sales of product from such stores is of record.

[34] With respect to the Applicant's first point, I agree that the Opponent should not be allowed to rely on its alleged use of its trade-marks prior to February 1, 2009. In this regard, it is

clear from the evidence that on January 31, 2009, a Master License Agreement was entered into between the Opponent (i.e. Victoria's Secret Stores Brand Management Inc.) and Victoria's Secret International, S.a.r.L. regarding use of the VICTORIA'S SECRET marks outside of the U.S. Pursuant to this licensing agreement, the Opponent has the right to control the character and quality of goods sold and services performed by affiliates of VICTORIA'S SECRET, in association with the VICTORIA'S SECRET marks.

[35] The evidence also shows that Victoria's Secret International, S.a.r.L. sub-licenses Victoria's Secret Direct Brand Management, LLC to market, sell, and execute catalog and Internet orders from and to locations out of the United States. While the control provisions in the Sub-license Agreement are not the same as those in the Master License Agreement, I am satisfied that they are sufficient to show that the Opponent had the requisite control over the character and quality of goods sold in association with the VICTORIA'S SECRET marks as of February 1, 2009.

[36] Victoria's Secret International, S.a.r.L. also has an oral sub-license with Victoria's Secret (Canada) Corp. to operate the retail stores in Canada. While Ms. Matorin was not able to provide a copy of this agreement in writing, I am satisfied from her evidence as a whole that the Opponent had the requisite control over its trade-marks to support the existence of a license agreement.

[37] With respect to the Applicant's second argument, I agree that the evidence of use of the VICTORIA SECRET mark in association with lip gloss by an entity who has not been identified in the evidence diminishes the distinctiveness the Opponent's mark may have acquired in Canada with respect to beauty products.

[38] With respect to the Applicant's third point regarding use of the mark PINK in association with the VICTORIA'S SECRET marks, I acknowledge that the mark PINK is more prominent than the words VICTORIA'S SECRET on most of the examples of use that were provided in the evidence. However, the VICTORIA'S SECRET mark does appear on the store signage, shopping bags, receipts, hang tags and collar tags. I agree with the Opponent that the manner in which the marks are used show that VICTORIA'S SECRET mark is the "driver" mark. The

message to the consumer is that PINK is a brand of VICTORIA'S SECRET and that the Opponent is the source of the wares sold.

[39] With respect to the Applicant's fourth point, I note that Ms. Matorin states in her affidavit that sales for the Opponent's Edmonton store in August, 2010 have been approximately \$3,123,200. Mr. Kuchar also provides evidence of goods purchased at the VICTORIA'S SECRET location in Toronto in September, 2010.

[40] The Applicant has also identified other deficiencies in the Opponent's evidence. However, most of the Applicant's arguments regard evidence that pre-dates January 31, 2009. In view that I have found that the Opponent cannot rely on any use of its VICTORIA'S SECRET mark to its own benefit prior to February 1, 2009, I do not consider these issues to be of particular relevance to the acquired distinctiveness of the Opponent's marks after that date.

[41] The Opponent has evidenced proper licensed use of its trade-mark by its sub-licensees pursuant to section 50(1) after February 1, 2009. I am satisfied from the Opponent's evidence as a whole that the Opponent's mark has become well known in Canada in association with lingerie as of today's date. As there is no evidence of any use of the Mark, this factor favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[42] The length of time that each mark has been in use also favours the Opponent as of today's date.

sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[43] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[44] Almost all of the Applicant's wares are either closely related to, or overlap with, the Opponent's wares.

[45] With respect to the parties' channels of trade, it seems unlikely that the wares associated with the Mark would be sold and distributed in the Opponent's stores. However, there is no evidence that would allow me to conclude that the Applicant's wares would not be sold in retail stores that carry VICTORIA'S SECRET products such as La Senza. Further, neither the Opponent's registration nor the Applicant's application contains any restrictions regarding channels of trade. Therefore, in the absence of evidence to the contrary, it is presumable that the parties' channels of trade would also overlap.

section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[46] While the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [*Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA) at 263]. The Supreme Court in *Masterpiece* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[47] In the present case, I find that the most striking or unique portion of both parties' marks is the word SECRET. In view that both parties' marks comprise a V formative mark followed by this distinctive word, I find that there is a significant degree of resemblance between the marks in appearance and sound.

[48] The ideas suggested by each mark are also similar. In this regard, the Mark as a whole suggests the idea of something secretive or hidden for Valentine's Day or someone's valentine which can be viewed as an extension to the idea associated with the Opponent's mark (i.e. something secretive or hidden for an anonymous woman named Victoria).

surrounding circumstances

[49] As a further surrounding circumstance, I have considered the Opponent's evidence which shows a heart design in association with its VICTORIA'S SECRET marks. The Opponent's evidence also shows that its advertising and branding focus on the ideas of romance, beauty and sexiness. I agree with the Opponent that as a result of its branding, the Opponent's VICTORIA SECRET mark suggests similar ideas which one would connote with the Mark.

conclusion

[50] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Notwithstanding the unlicensed use of the Opponent's mark in Canada prior to February 1, 2009, in view of the resemblance between the wares and marks of the parties, I am not satisfied that the Applicant has established, on a balance of probabilities, that a consumer having an imperfect recollection of the Opponent's VICTORIA'S SECRET mark would not likely conclude that the Applicant's lingerie and other wares are from the same source or are otherwise related to or associated with the Opponent's wares and services. The section 12(1)(d) ground is therefore successful.

Section 16(3)(a) – Entitlement

[51] The Opponent's section 16(3)(a) ground of opposition is based on the allegation that the Mark was confusing with the VICTORIA'S SECRET trade-marks which had been previously used in Canada by the Opponent in association with its wares and services as of the filing date of the application.

[52] With respect to the section 16(3) ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-marks prior to the Applicant's filing date by it or a licensee whose use satisfies the requirements of Section 50 of the Act. As the Opponent's evidence does not show use of any of its marks by it or a licensee prior to August 1, 2008, the section 16(3) ground of opposition is dismissed.

Section 38(2)(d) – Non-distinctiveness

[53] In order to meet its evidential burden with respect to the distinctiveness ground, the Opponent must show that its trade-mark had become known sufficiently to negate the distinctiveness of the Mark as of the filing date of the statement of opposition, i.e. April 1, 2010 [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD); *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)]. The Opponent's evidence need not necessarily show trade-mark use within the scope of section 4(1) of the Act in order to be relied upon in challenging the distinctiveness of the Mark [see *Mutual Investco Inc v Knowledge Is Power Inc* (2001), 14 CPR (4th) 117 at p 123]. It may be based on evidence of knowledge or reputation of the Opponent's trade-mark spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6*, above].

[54] From the evidence furnished, I am satisfied that the Opponent has met its burden under this ground. This ground also turns on the determination of the issue of confusion. For the most part, my findings under the section 12(1)(d) ground of opposition are also applicable to this ground. The main difference is that the Opponent's mark had acquired less distinctiveness as of the earlier date of April 1, 2010. This difference is not sufficient to show that there was not a reasonable likelihood of confusion between the marks at the relevant date. This ground is therefore also successful.

Disposition

[55] In view of the above, and 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.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

TRADE-MARK	REGISTRATION NO.	WARES AND SERVICES
VICTORIA'S SECRET	TMA313,969	Bedding and linens and washing compound for use with lingerie and fine washables. Services associated with the operation of mail order and retail store sales of bedding and linens and washing compound for use with lingerie and fine washables.
VICTORIA'S SECRET	TMA432,093	<p>WARES:</p> <p>(1) Women's nightwear, and men's undergarments and nightwear, robes, caftans and kimonos, slippers, sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes and atomizers.</p> <p>(2) Fragrances, namely, perfumes, cologne, air fresheners, sachets, scented hangers and potpourris; cosmetics and personal care products, namely, body lotions, moisturizers, soaps, shampoos, bath oils, make-up brushes, mirrors and razors.</p> <p>SERVICES:</p> <p>(1) Services associated with the operation of mail order and retail store sales of wearing apparel.</p> <p>(2) Services associated with the operation of mail order and retail store sales of sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes, atomizers, fragrances, cosmetics and personal care products.</p>
VICTORIA'S SECRET SECOND SKIN SATIN	TMA502,552	Toiletries, namely talcum powder; hand, body and face soap; toilet soap; hand, body and face lotion; eau de toilette; cologne; fragrance and perfumeries; cologne spray; bath oil; bath essence; bubble bath; bath gel and bath beads; hair shampoo and conditioner; hair gel; sachets; body shampoo; after shave; after shave balm; shaving cream; shaving soap; essential oils for personal use; fragrant body spray; loofah sponges; potpourri; moisturizer.
VICTORIA'S SECRET THE MIRACLE BRA	TMA530,906	Clothing, namely brassieres
ANGELS BY VICTORIA'S SECRET	TMA531,897	Intimate wear, namely, bras, panties, swimwear, coverups, teddies and biker shorts.
VICTORIA'S SECRET and Design	TMA536,157	<p>WARES:</p> <p>(1) Gift wrapping.</p> <p>(2) Women's wearing apparel and women's lingerie (excluding hosiery and pantyhose), namely underwear, brassieres, panties, slips, bodyliners, bodystockings, garter belts, g-strings, thongs, teddies, chemises, camisoles;</p>

		<p>fragrances, namely, perfumes, colognes, eau de cologne, air fresheners, scented sachets, scented hangers and potpourris; cosmetics and personal care products, namely, bath, hand and body lotions, moisturizers, soaps, shampoos, bath oils, bath preparations, shower gels and washing compounds for use with lingerie and fine washables; footwear, namely, boots, loafers, clogs, shoes, pumps and slippers; lingerie bags, hanging bags and hangers, candles, combs, brushes, namely make-up brushes and cosmetic brushes, razors and atomizers, mail order catalogues, photo albums, calendars, bridal books, paper bridal shower invitations, letter openers, address books and gift wrap kits, namely, collections of boxes, tissue, paper, ribbon and a card, collections of classical music cassettes and collections of classical music compact discs, picture frames, mirrors and pillows, perfume bottles, decorative boxes, pitchers, insulated bottles, trays, flasks and shoe horns, linens, towels and bedding, namely comforters, pillow cases, pillows, sheets, bedskirts, shams and dust ruffles, draperies, valences and throw rugs, women's and men's outer wear, underwear and nightwear, namely, loungewear, namely teddies, tap pants and silk panties; robes, gowns, caftans, kimonos, dusters, pyjamas, sleepshirts, nightdresses, shirts, blouses, pants, trousers, jeans, dresses, suits, skirts, sweaters, cardigans, turtlenecks, jumpsuits, tunics, blazers, jumpers, vests, sweatshirts, jogging pants, jackets, t-shirts, scarves, bodysuits, swimsuits, bikinis, briefs, hipsters, namely bikini underwear; beach shirts, wraps, tank tops, boy's boxer shorts, ties, toy stuffed animals and dolls.</p> <p>SERVICES:</p> <p>(1) Operation of mail order sales of women's wearing apparel, mail order services for lingerie care preparations, personal care preparations, candles, picture frames, cosmetic and perfume applicators, bedding, women's and men's lingerie, undergarments and clothing, hangers, toys and dolls.</p>
VICTORIA'S SECRET	TMA538,765	<p>WARES:</p> <p>(1) Women's lingerie (excluding hosiery and pantyhose), namely underwear, brassieres, panties, slips, bodyliners, bodystockings, garter belts, g-strings, thongs, teddies, chemises, camisoles.</p> <p>(2) Women's lingerie (excluding hosiery and pantyhose), namely brassieres, panties, slips, bodyliners, bodystockings, garter belts, g-</p>

		<p>strings, thongs, teddies, chemises, camisoles; women's wearing apparel, namely dresses, fragrances, namely, perfumes, colognes, eaux de cologne, air fresheners, scented sachets, scented hangers and potpourris; cosmetics and personal care products, namely, bath, hand and body lotions, moisturizers, soaps, shampoos, bath oils, bath preparations and shower gels; footwear, namely boots, loafers, clogs, shoes, pumps and slippers; lingerie bags, hanging bags and hangers; candles; combs, brushes, namely make-up brushes and cosmetic brushes, razors and atomizers; mail order catalogues, photo albums, calendars, bridal books, paper bridal shower invitations, letter openers, address books and gift wrap kits, namely, collections of boxes, tissue, paper, ribbon and a card; collections of classical music cassettes and collections of classical music compact discs; picture frames, mirrors and pillows; perfume bottles, decorative boxes, pitchers, insulated bottles, trays, flasks and shoe horns; women's and men's outer wear; underwear and nightwear, namely, loungewear, robes, gowns, caftans, kimonos, dusters, pyjamas, sleepshirts, nightdresses, shirts, blouses, pants, trousers, jeans, dresses, suits, skirts, sweaters, cardigans, turtlenecks, jumpsuits, tunics, blazers, jumpers, vests, sweatshirts, jogging pants, jackets, t-shirts, scarves, bodysuits, swimsuits, bikinis, briefs, hipsters, beach shirts, wraps, tank tops, boy's boxer shorts, ties; toy stuffed animals and dolls.</p> <p>(3) Women's lingerie.</p> <p>SERVICES:</p> <p>(1) Operation of a retail mail-order catalogue. (2) Operation of a retail mail order catalogue.</p>
DREAM ANGELS BY VICTORIA'S SECRET	TMA539,023	Lingerie
VICTORIA'S SECRET VERY SEXY FOR HER	TMA728,454	Personal care products, namely, aftershave gels, aftershave lotion, bath oil, body mist, body oil, body wash, cologne, cream for the body, essential oils for personal use, fragrant body mist, lotion for the body, perfume.
VICTORIA'S SECRET VERY SEXY FOR HIM	TMA728,455	Personal care products, namely, aftershave gels, aftershave lotion, bath oil, body mist, body oil, body wash, cologne, cream for the body, essential oils for personal use, fragrant body mist, lotion for the body, perfume.
VICTORIA'S SECRET GARDEN	TMA730,641	Personal care products, toiletries, cosmetics, perfumes, namely, body butter, body wash, body lotion, bubble bath, body scrub, body mist, body powder, hand and body cream, eau de toilette spray and body splash.

