IN THE MATTER OF AN OPPOSITION by Richardson-Vicks Inc. to application No. 608,482 for the trade-mark BEAUTE SOLEIL filed by Bronzage Reynald Beauté Soleil Inc.

On June 6, 1988, Bronzage Reynald Beauté Soleil Inc. filed an application to register the trade-mark BEAUTE SOLEIL based upon proposed use of the trade-mark in Canada in association with the following wares:

> "(1) bijoux; (2) produits de beauté pour les soins de la peau, nommément crème, lotions, huiles, savons, poudres, hydratants;"

as well as being based upon use of the trade-mark in Canada since at least as early as April 1987 in association with:

> "(3) vêtements tout aller pour hommes, femmes et enfants, nommément pantalons, shorts, complets, manteaux, anoraks, vestes, blazers, chemises, gilets, tee-shirts, pantalons, chemisiers, costumes, chandails, robes, pulls, blouses, tenues d'entraînement, nommément, ensembles de jogging, chandails et pantalons en coton ouaté, survêtements, débardeurs, blousons, tuniques, bermudas, cardigans et sous-vêtements; (4) produits de bronzage, crème hydratante, huile de bronzage, crème de beauté, conservateur de bronzage, crème d'activation, lait apaisant; (5) articles promotionnels, nommément écussons, casquettes, porte-clés, gobelets, ouvre-bouteilles, sous-verres, briquets, crayons et stylos, ballons."

and since at least as early as April 1987 in association with the following services:

> "salons de bronzage"

The applicant disclaimed the right to the exclusive use of the word BEAUTE apart from its trade-mark in association with the wares identified under paragraphs numbered (2) and (4) above.

The opponent, Richardson-Vicks Inc., filed a statement of opposition on August 14, 1989 in which it alleged that the applicant's trade-mark BEAUTE SOLEIL is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant's trade-mark is confusing with the opponent's registered trade-mark BAIN DE SOLEIL, registration No. 242,568 covering suntan lotion, suntan cream and suntan oil, that had been previously used and made known in Canada by the opponent and/or its predecessors-in-title, Antoine de Paris, Inc., Charles of the Ritz Group Ltd. and Yves Saint Laurent International B.V. The opponent further alleged that the applicant's application is not in compliance with Sections 30(b) and (e) of the Trade-marks Act in that the applicant has not used the trade-mark for wares since its alleged date of first use and the applicant does not intend to use the trade-mark itself for those wares claimed on the basis of proposed use.

The applicant served and filed a counterstatement in which it denied the allegations set forth

in the statement of opposition.

The opponent filed as its evidence the affidavit of Yvon Lafreniere while the applicant submitted the statutory declaration of Reynald De Santis. Mr. De Santis was cross-examined on his statutory declaration with the transcript of the cross-examination and the responses to undertakings given during the cross-examination forming part of the opposition record.

The opponent alone submitted a written argument and neither party requested an oral hearing.

Considering initially the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the opponent has alleged that the applicant's trade-mark BEAUTE SOLEIL is not registrable in that the trade-mark BEAUTE SOLEIL is confusing with the opponent's registered trade-mark BAIN DE SOLEIL. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date in respect of a Section 12(1)(d) ground.

With respect to the inherent distinctiveness of the trade-marks at issue, considering the significance of the expression "bain de soleil" in the French language, the average consumer of the opponent's suntan products would be inclined to use those wares when sunbathing and, accordingly, the opponent's trade-mark BAIN DE SOLEIL possesses little inherent distinctiveness as applied to suntan lotion, suntan cream and suntan oil. While the applicant's trade-mark as applied to the applicant's jewellery, clothing and promotional articles is inherently distinctive, the trade-mark BEAUTE SOLEIL is somewhat suggestive of the wares identified as tanning products and beauty products for the care of the skin, as well as being suggestive of the applicant's tanning salon services. As a result, the applicant's trade-mark possesses more inherent distinctiveness than does the opponent's mark.

The statutory declaration of Reynald De Santis, President of the applicant, establishes that the applicant's trade-mark has become known to some extent in Canada in association with tanning salon services and to a lesser extent in association with the applicant's skin care products and clothing. On the other hand, the Lafreniere affidavit establishes that the opponent's trade-mark BAIN DE SOLEIL has become well known in Canada in association with suntan lotion and suntan

cream with sales exceeding $30,000,000 between 1971 and 1989. Likewise, the length of time that the trade-marks have been in use in Canada is a further factor weighing in the opponent's favour in this opposition proceeding, the opponent claiming that it and its predecessors have used the trade-mark BAIN DE SOLEIL in Canada since 1940.

The applicant's tanning products are identical to the wares covered by the opponent's registration while the applicant's beauty products for the care of the skin are similar in nature to the opponent's suntan lotion, suntan cream and suntan oil. Further, the channels of trade through which these wares would travel are identical. On the other hand, the applicant's jewellery, promotional items and clothing bear no similarity to the opponent's suntan products. Further, I would not expect that the channels of trade normally associated with these wares would overlap. The applicant's tanning salon services also differ from the opponent's wares although tanning products could well be offered for sale to the public through tanning salons and there could therefore be a potential overlap in the channels of trade associated with the applicant's services and the wares covered in the opponent's registration.

As to the degree of resemblance between the trade-marks at issue, I consider the trade-marks BEAUTE SOLEIL and BAIN DE SOLEIL to be fairly similar both in appearance and in sounding. While the opponent's trade-mark suggests a connection between its wares and sunbathing, no similar idea is suggested by the applicant's trade-mark BEAUTE SOLEIL when considered in its entirety as a matter of immediate impression even though the mark does suggest some connection with the sun.

Having regard to the above, and bearing in mind that there is a fair degree of similarity in appearance and sounding between the trade-marks at issue, that the opponent has established that its trade-mark is well known in Canada in association with wares which are either identical to the applicant's tanning products or closely related to the applicant's beauty products for the care of the skin and would therefore travel through the same channels of trade as these wares, I have concluded that the applicant has failed to discharge the legal burden upon it in respect of the issue of confusion between its trade-mark BEAUTE SOLEIL as applied to tanning and skin care products and the opponent's registered trade-mark. Further, having regard to the potential overlap in the channels of trade between the applicant's tanning salon services and the opponent's suntan products, and bearing in mind the degree of resemblance between the trade-marks at issue and the notoriety associated with the opponent's mark, I have likewise concluded that the applicant has failed to discharge the legal burden upon it in respect of the issue of confusion between the trade-marks at issue as applied to the

applicant's services and the opponent's wares. Accordingly, the applicant's trade-mark BEAUTE SOLEIL as applied to: "produits de beauté pour les soins de la peau, nommément crème, lotions, huiles, savons, poudres, hydratants; produits de bronzage, crème de beauté, conservateur de bronzage, crème d'activation, lait apaisant" and as applied to the applicant's "tanning salon" services is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act. On the other hand, I do not consider that there would be any reasonable likelihood of confusion between the applicant's trade-mark BEAUTE SOLEIL as applied to: "bijoux; vêtements tout aller pour hommes, femmes et enfants, nommément pantalons. shorts, complets, manteaux, anoraks, vestes, blazers, chemises, gilets, tee-shirts, pantalons, chemisiers, costumes, chandails, robes, pulls, blouses, tenues d'entraînement, nommément, ensembles de jogging, chandails et pantalons en coton ouaté, survêtements, débardeurs, blousons, tuniques, bermudas, cardigans et sous-vêtements; articles promotionnels, nommément écussons, casquettes, porte-clés, gobelets, ouvre-bouteilles, sous-verres, briquets, crayons et stylos, ballons" and the registered trade-mark BAIN DE SOLEIL.

The determination of the issue of confusion in relation to the Section 12(1)(d) ground is likewise applicable to the issue of confusion in respect of the opponent's non-entitlement and non-distinctiveness grounds. As a result, it is unnecessary to consider those grounds of opposition. The only remaining grounds of opposition are based on Sections 30(b) and (e) of the Trade-marks Act, the opponent alleging that the applicant has not used the trade-mark BEAUTE SOLEIL for wares since its alleged date of first use and that the applicant does not intend to use the trade-mark itself for those wares claimed on the basis of proposed use. As the applicant's application stands refused in relation to tanning products, beauty products for the care of the skin and tanning salon services, the opponent's Section 30 grounds need only be considered in relation to the applicant's jewellery and the groups of wares identified generally as clothing and promotional items.

The Section 30(e) ground of opposition is applicable to the applicant's "bijoux" as the present application is based upon proposed use of the trade-mark BEAUTE SOLEIL in association with these wares. On the other hand, the Section 30(b) ground applies to the applicant's clothing and promotional items as both of these groups of wares are based upon use of the trade-mark BEAUTE SOLEIL in Canada since at least as early as April 1987. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of its Section 30 grounds of opposition (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330). To meet the evidential burden upon it, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. Further, as pointed out by the opponent in its written argument, the applicant's application formally complies

with Sections 30(b) and (e) of the Trade-marks Act in that the applicant's application includes the required statements. Accordingly, the issue is whether the applicant's statements that it intends to use the trade-mark BEAUTE SOLEIL in association with jewellery or has used the trade-mark since at least as early as April 1987 in association with clothing and promotional items are accurate.

No evidence was submitted by the opponent in support of its allegations that the applicant has not used its trade-mark since the claimed date of first use and does not intend to use its trade-mark BEAUTE SOLEIL in Canada for those wares claimed on a proposed use basis. However, at pages 24 to 25 of its written argument, the opponent submitted the following with respect to its Section 30 grounds:

> "On Cross-Examination, Mr. de Santis was presented with a sample of his product which pointed to a company identified as Groupe Beaute Soleil Inc. The affiant confirmed that this corporate name continues to appear on his product but he does not know whether this is another company or whether this company has obtained a trading style registration. In response to an undertaking, Mr. de Santis confirmed that there is no trading style registration for Groupe Beaute Soleil Inc. nor is there a corporate entity under that name. (See pages 13 to 16 of the de Santis transcript.) Through Cross-Examinations and in response to undertakings, Mr. de Santis also identified his distributor/licensee as Clinique du Bronzage Solaris Inc.
>
> In response to an undertaking, Mr. de Santis provided the Opposition Board and the agents for the applicant with a copy of an agreement between the applicant and Clinique du Bronzage Solaris Inc. It will be noted from the wording of the agreement between the applicant and Clinique du Bronzage Solaris Inc. that the latter has the exclusive right to use the trade mark BEAUTE SOLEIL. Furthermore, Mr. de Santis stated in his statutory declaration that there are no limitations as to where the distributor or licensee would sell the product. (See Cross-Examination transcript pages 30 to 31.) Furthermore, the agreement between the parties does not place any such limitations.
>
> In addition, the clothing etc. (Exhibit F to Mr. de Santis' affidavit) show labels identifying the source as "de Santis" not the applicant or an approved registered user or a licensee.
>
> The application under Serial No. 608,482 was not accompanied by an application for registration of either the company Groupe Beaute Soleil Inc. that appears on the actual packaging or Clinique de Bronzage Solaris Inc., the company the applicant admits in its undertaking (dated September 22, 1992) is the company to which the applicant has an exclusive license agreement to sell its products.
>
> Given the muddled history of use of the trade mark BEAUTE SOLEIL in Canada, the applicant's statement in its application that it intended to use the trade mark BEAUTE SOLEIL and that is has used the trade mark BEAUTE SOLEIL since 1987 is ambiguous."

The applicant has stated as a response to an undertaking given during the De Santis cross-examination that Groupe Beauté Soleil Inc. is not the name of an existing corporate entity, but rather is a trading style adopted and used by the applicant. That being the case, I do not understand how the opponent could expect there to be a license or registered user agreement between the applicant and Groupe Beauté Soleil Inc. As the name Groupe Beauté Soleil Inc. points to the applicant and to no other entity, I do not consider that the applicant's use of the trading style Groupe Beauté Soleil Inc. raises any specific concerns as to the applicant's compliance with either Sections 30(b) or (e) of

the Trade-marks Act.

The opponent has also referred to the exclusive license agreement between the applicant and Clinique du Bronzage Solaris Inc. However, the agreement relates only to the applicant's skin care and tanning products and is an exclusive agreement limited only to the province of Quebec and the Maritime provinces. Further, the agreement does not prevent the applicant from selling its skin care and tanning products to persons operating tanning salons under the mark BEAUTE SOLEIL. As such, I do not consider the agreement to be of relevance to the Section 30 grounds as related to the applicant's clothing, promotional items and jewellery.

In the portion of its written argument referred to above, the opponent also alleges that the clothing labels annexed as exhibits to the de Santis declaration identify the source of the wares as de Santis and not the applicant. However, the clothing labels clearly identify de Santis as a trade-mark and not a trade-name and therefore the labels do not point to an entity other than the applicant as a source of these wares.

In view of the above, I have concluded that the opponent has failed to meet the evidential burden upon it in respect of the Section 30 grounds of opposition in relation to the applicant's clothing, promotional items and jewellery and I have therefore rejected these grounds of opposition.

I refuse the applicant's application in respect of: "produits de beauté pour les soins de la peau, nommément crème, lotions, huiles, savons, poudres, hydratants; produits de bronzage, crème hydratante, huile de bronzage, crème de beauté, conservateur de bronzage, crème d'activation, lait apaisant" and in respect of services identified as "salons de bronzage" and otherwise reject the opponent's opposition to registration of the applicant's application in view of the provisions of Section 38(8) of the Trade-marks Act in respect of the following wares: "bijoux; vêtements tout aller pour hommes, femmes et enfants, nommément pantalons, shorts, complets, manteaux, anoraks, vestes, blazers, chemises, gilets, tee-shirts, pantalons, chemisiers, costumes, chandails, robes, pulls, blouses, tenues d'entraînement, nommément, ensembles de jogging, chandails et pantalons en coton ouaté, survêtements, débardeurs, blousons, tuniques, bermudas, cardigans et sous-vêtements; articles promotionnels, nommément écussons, casquettes, porte-clés, gobelets, ouvre-bouteilles, sous-verres, briquets, crayons et stylos, ballons". In this regard, I would note the finding of the Federal Court, Trial Division in respect of there being authority to render a split decision in Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492.

DATED AT HULL, QUEBEC, THIS _31st__ DAY OF __January_____, 1995.

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