IN THE MATTER OF AN OPPOSITION by House of Faces, Inc. to application No. 538,056 for the trade-mark FASHION FACES filed by B & B Cosmetics Inc., and presently standing in the name of Belvedere International Inc.

On March 12, 1985, the applicant, B & B Cosmetics Inc., filed an application to register the trade-mark FASHION FACES based upon use of the trade-mark in Canada since February 1, 1985 in association with "cosmetic kits, sponges, applicators, creams, lotions, moisturizers, eye shadows, mascara, lipstick, lip liner, blushers and cover creams". The applicant disclaimed the right to the exclusive use of the word FACES apart from its trade-mark.

The opponent, House of Faces, Inc., filed a statement of opposition on June 9, 1986 in which it alleged that the applicant's trade-mark FASHION FACES is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user by the opponent of its registered trade-marks HOUSE OF FACES, registration No. 284,256 and FACES Design, registration No. 252,551.

The applicant served and filed a counterstatement in which it denied the allegations of confusion set forth in the opponent's statement of opposition.

The opponent filed as its evidence the affidavit of Pierre LeBlanc while the applicant submitted the affidavit of Don Belvedere.

The applicant alone submitted a written argument and the applicant alone was represented at an oral hearing.

The applicant amalgamated with a number of other companies and the name of the amalgamated company is Belvedere International Inc., the present applicant of record.

The only issue for consideration in this opposition is whether there would be a likelihood of confusion between the applicant's trade-mark FASHION FACES and one or both of the opponent's registered trade-marks HOUSE OF FACES and FACES Design.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's claimed date of first use (the material date in respect of the non-entitlement ground of opposition) or as of the date of opposition (the material date in respect of the s. 12(1)(d) and non-distinctiveness grounds of opposition), the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Trade-marks

Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's registered trade-mark FACES Design, a representation of which appears below, possesses very little inherent distinctiveness as applied to cosmetics and skin care products, creams, lotions, shampoo, toiletries, perfumes and accessories, as well as possessing little inherent distinctiveness as applied to services identified as cosmetics and toiletry consultations and the operation of retail outlets for cosmetics, skin care, toiletries and related accessories. On the other hand, I consider that the opponent's trade-mark HOUSE OF FACES as well as the applicant's trade-mark FASHION FACES both possess more inherent distinctiveness than the trade-mark FACES Design when considered in their entireties as applied to the respective wares and services of the parties. I would note that the opponent's registrations and the applicant's application include a disclaimer of the word FACES apart from the respective trade-marks.

The opponent's evidence establishes that its trade-mark FACES Design has become relatively well known in Canada in association with cosmetics and skin care products, having regard to the evidence of sales of approximately $25,000,000 from 1982 to 1985 inclusive corresponding to 6,500,00 items sold in association with the trade-mark FACES Design while the opponent's advertising budget during this time exceeded $215,000. On the other hand, the opponent's evidence fails to substantiate use of the trade-mark HOUSE OF FACES in association with any of the wares or services covered in its registration. Accordingly, I have concluded that the trade-mark HOUSE OF FACES has not become known to any extent in Canada as of either of the material dates in this opposition.

The applicant's evidence establishes that its trade-mark FASHION FACES has become known to some extent in Canada in association with sponges and applicators with sales of approximately $250,000 and advertising expenditures of approximately $12,500 during 1985 and the first five months of 1986. Further, the length of time that the trade-marks have been in use favours the opponent in that its trade-mark FACES Design has been used in this country since at least 1982 whereas the applicant has used its trade-mark FASHION FACES in Canada since February 1985.

The wares covered in the applicant's application are identical to the wares covered in the opponent's registrations. As there is no restriction as to the channels of trade through which the applicant's wares would be made available to the public, I must conclude for the purposes of deciding this opposition that the trades of the parties would, or could, be identical. In this regard, and in assessing the likelihood of confusion between trade-marks, the Registrar must consider the channels of trade which would normally be associated with the wares as set forth in the applicant's application since it is the statement of wares as covered in the application which determines the scope of the monopoly to be accorded to an applicant should its trade-mark proceed to registration. As with a registered trade-mark in an infringement action, the scope of an applicant's trade is to be determined by reference to the statement of wares covered in the application rather than the applicant's actual trade to date (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pp. 10-12 (F.C.A.)). Thus, the fact that either an applicant or an opponent may be selling its wares through a particular type of retail outlet or through a particular channel of trade is irrelevant when considering the issue of confusion under s. 12(1)(d) of the Trade-marks Act (see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 2 C.P.R. (3d) 361, at pg. 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at pg. 112 (F.C.A.)).

Considering the degree of resemblance between the trade-marks at issue, I consider there to be little similarity in appearance, sounding and ideas suggested by the trade-marks FASHION FACES and HOUSE OF FACES when considered in their entireties as a matter of first impression and imperfect recollection. On the other hand, I consider there to be some similarity in appearance and an even greater degree of similarity in sounding between the trade-marks FASHION FACES and FACES Design when considered as a matter of first impression and imperfect recollection. However, to the extent that both trade-marks suggest the idea that the wares are facial products, I do not consider that either party should be entitled to a monopoly in respect of such an idea as applied to cosmetics and skin care products.

At the oral hearing, the applicant relied upon the decision in House of Faces, Inc. v. Face Makers Cosmetics Ltd., 13 C.P.R. (3d) 375 where the Opposition Board considered the issue of confusion between the applicant's trade-mark FACE MAKERS as applied to cosmetic products and the operation of retail cosmetic outlets and the opponent's trade-mark FACES Design, the trade-mark being relied upon by the opponent in the present opposition proceedings. At page 377 of the reported decision, the hearing officer commented as follows:

> "The natures of the respective wares and services and thus also the natures of the respective trades are essentially identical. Despite this, bearing in mind that the only resemblance between the applicant's trade marks and the opponent's trade mark FACES & Design is that

> they all include the word "face" which is suggestive in relation to the subject wares and services and as established by the Brule affidavit is commonly used in trade marks in the cosmetic trade, and bearing in mind that the opponent has filed no evidence, I am satisfied that when the applicant's trade marks and the opponent's trade mark FACES & Design are considered in their totalities and as a matter of first impression and imperfect recollection they are not confusing within the meaning of s. 6 of the Trade Marks Act."

Unlike the situation in the FACE MAKERS opposition, the opponent in the present proceeding filed evidence establishing that there has been relatively substantial use of the trade-mark FACES Design in Canada while the applicant in this opposition failed to file state of the register evidence to establish that the word "face" is commonly used in trade-marks in the cosmetics trade. Accordingly, I do not consider the decision of the hearing officer in the FACE MAKERS opposition to be binding upon me in the present opposition.

Having regard to the above and, in particular, to the degree of resemblance between the trade-marks FASHION FACES and FACES Design in both sounding and appearance, and bearing in mind that the opponent's evidence establishes that its trade-mark FACES Design has become relatively well known in Canada in association with cosmetics and that the wares associated with the trade-marks at issue are identical and must therefore be considered as potentially travelling through the same channels of trade in the absence of any limitation in the applicant's statement of wares or in the wares covered by the opponent's registration, I have concluded that the applicant has failed to discharge the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks FASHION FACES and FACES Design, such that the applicant's trade-mark is not registrable in view of s. 12(1)(d) of the Act.

In view of the above, I refuse the applicant's application pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31ST DAY OF OCTOBER 1990.

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