



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

**Citation: 2011 TMOB 98**  
**Date of Decision: 2011-06-22**

**IN THE MATTER OF AN OPPOSITION  
by London Drugs Limited to application  
No. 1,178,743 for the trade-mark BASE  
LONDON in oval design in the name of  
Base London Limited**

[1] On May 22, 2003, Base London Limited, a British company incorporated under the laws of the United Kingdom (the Applicant) filed an application to register the trade-mark BASE LONDON in oval design (the Mark), as shown below:



[2] The application has been filed on two bases: 1) proposed use of the Mark in Canada and 2) use and registration of the Mark abroad, namely in the United Kingdom. The statement of wares and services reads:

wares:

Soaps; bath preparations; shower preparations; perfumery; essential oils; hair lotions, shampoos, conditioners, creams, oils, gels and lacquers; preparations for the care of the skin; suntanning and suncreening preparations; deodorants for personal use; shaving creams and lotions; preshave and aftershave preparations; dentifrices; electronic publications downloadable from the Internet, namely, magazines and catalogues and information on shoe care; magnetic data carriers, namely, pre-recorded audio tapes and video tapes; digital audio and visual recording media, namely, CD players, CD audio recorders, tapes decks and tape players, DVD recorders and DVD players, radio receiving sets, combined radio, CD player and tape player; mobile telephones and mobile telephone accessories, namely, telephone covers, telephone charger, telephone in car charger, telephone in car holder and telephone in car head piece and loud speaker; mouse mats; sunglasses and spectacle cases; parts and fittings for the aforesaid goods; jewellery; costume jewellery; cuff links, tie pins, tie and collar studs; clocks, watches; goods made of leather or imitation leather, namely, belts, bags, wallets, purses, handbags, travelling bags, briefcases, suitcases, rucksacks, and shoes; wallets, purses, notecases; bags, handbags, travelling bags; briefcases, suitcases; rucksacks; umbrellas, parasols; articles of clothing, namely, shirts, blouses, t-shirts, sweatshirts, jerseys, cardigans, tops, trousers, jeans, shorts, pants, dresses, skirts, jackets, coats, ties, scarves, cravats, neckties, hats, caps, socks and stockings; articles of footwear, namely, shoes, boots, slippers, sandals, trainers, sport shoes and casual shoes.

services:

The operation of a retail store dealing in a variety of goods, namely, clothing, footwear, headgear, boots, shoes and slippers, gloves, eyewear, jewellery, clocks and watches, fashion accessories, mobile telephones and accessories, mouse mats, soaps, perfumery and personal grooming products, leather goods, wallets, purses, notecases, bags, handbags, travelling bags, briefcases, suitcases, rucksacks, holdalls, umbrellas, parasols.

[3] The Applicant has disclaimed the right to the exclusive use of the word LONDON apart from the Mark.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 8, 2007.

[5] On October 23, 2007, London Drugs Limited (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed the affidavit of Grant Ball. In support of its application, the Applicant filed the affidavit of Cecilia Oliveira. No cross-examinations were conducted.

[7] Only the Opponent filed a written argument. An oral hearing was not requested.

#### Summary of Grounds of Opposition and Applicable Material Dates

[8] The Opponent has pleaded five grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[9] Three of the grounds claim that the Mark is confusing with various trade-marks that incorporate the word LONDON, which are owned by the Opponent; in particular, the Opponent has pleaded:

- i) the Mark is not registrable under s. 12(1)(d) because it is confusing with 24 trade-marks that are the subject of registrations owned by the Opponent;
- ii) the Applicant is not the person entitled to register the Mark under s. 16(2)(a) because it is confusing with the Opponent's previously used 24 trade-marks; and
- iii) the Applicant is not the person entitled to register the Mark under s. 16(2)(b) because it is confusing with the trade-mark LONDON DEPARTMENT STORES that is the subject of application No. 1,095,092 previously filed by the Opponent.

[10] The 24 trade-marks relied upon by the Opponent are:

- LONDON DRUGS
- THE MANY FACES OF LONDON DRUGS & Design
- THE COSMETIC DEPARTMENT OF LONDON DRUGS
- THE MANY FACES OF LONDON DRUGS

- THE OPTICAL DEPARTMENT OF LONDON DRUGS
- LONDON DRUGS Design
- LONDON CUSTOM WORKS
- LONDON COLOUR DIGITAL IMAGING
- LONDON DRUGS PHOTO STATION
- LONDON COLOUR PHOTODISK
- PCC – THE PERSONAL COMPUTER CENTER OF LONDON DRUGS
- LONDON DRUGS 1 HOUR PHOTO FINISHING
- COSMETICS DEPARTMENT OF LONDON DRUGS
- ELECTRONICS DEPARTMENT OF LONDON DRUGS
- THE JEWELLERY DEPARTMENT OF LONDON DRUGS
- AUDIO-VIDEO SYSTEMS DEPARTMENT LONDON DRUGS
- LD & LONDON Design
- LONDON GOLD MINE
- THE COMPUTER DEPARTMENT OF LONDON DRUGS
- LONDON PREMIERE
- LONDON DRUGS COMPUTERS
- LONDON NATURALS
- LONDON SPA
- PC – THE PERSONAL COMPUTER CENTRE OF LONDON DRUGS.

[11] The Opponent has also pleaded:

- iv) the Applicant is not the person entitled to register the Mark under s. 16(2)(c) because it is confusing with the trade-names London, London Drugs and London Drugs Limited, which had been previously used by the Opponent; and

- v) the Mark is not distinctive under s. 2 because it does not actually distinguish nor is it adapted to distinguish the wares and services of the Applicant from the wares and services of the Opponent.

[12] The material dates with respect to the grounds of opposition are as follows:

- s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 16(2) - the filing date of the application;

- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Onus

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Summary of Evidence

#### *Ball Affidavit*

[14] When he signed his affidavit on November 21, 2008, Mr. Ball was the General Manager, General Merchandise, of the Opponent. He refers to the Opponent's pleaded registered trade-marks, excluding its trade-mark LONDON DRUGS, collectively as the Other Trade-marks but I shall refer to them as the Other LONDON Trade-marks. Pertinent portions of his affidavit are summarized below:

- The Opponent is a leading Canadian drugstore and retailer of general merchandise, with approximately three-quarters of a million customer transactions taking place at its retail locations each week on average.

- In addition to drugstore products and services, the Opponent also offers a wide range of products and services relating to general merchandise, including but not limited to clothing, footwear, headgear, fashion accessories, cosmetics, health and beauty aids, photographic products and services, housewares, furniture, food, electronic equipment, audio-video equipment, computers, stationery, books, magazines, jewellery, watches and optical products.

- The Opponent opened its first store in Vancouver in or about 1946 and in 2008 there were 69 retail locations in British Columbia, Alberta, Saskatchewan and Manitoba.

- The Opponent's stores typically feature prominent signage at the entrance with the trade-mark LONDON DRUGS (Exhibit FF).

- The Opponent's stores are said to be "retail department stores" which provide general merchandising retail store services; they are divided into departments, such as an electronics and audio-video department, a computer department, a cosmetics department, a beauty and health products department, a camera and photofinishing department, a housewares department, and a general merchandise department (which includes toys and games, office and school supplies, home furnishings, and clothing). Although Mr. Ball focuses on the non-pharmacy departments, presumably each LONDON DRUGS location also features a pharmacy.

- The Opponent has used the trade-mark LONDON DRUGS and/or Other LONDON Trade-marks in association with a variety of general merchandise products. Such sales exceeded \$35 million in gross revenue between 2003 and 2008 (annual breakdowns have been provided).

- Hang tags displaying the LONDON DRUGS trade-mark that are used on certain clothing items and leather good products are provided as Exhibit KK. The sales attributable to only clothing or leather good products have not been provided.

- The Opponent advertises its wares and services in association with its trade-marks by flyers delivered to homes and on its website (Exhibits LL and MM).

[15] Mr. Ball provides his opinion on the likelihood of confusion between the Mark and the Opponent's trade-marks, but I am disregarding those portions of his affidavit because that is the issue that is to be ultimately determined by me and Mr. Ball has not been qualified as an expert on the issue of confusion.

#### *Oliveira Affidavit*

[16] Ms. Oliveira, a trade-mark assistant employed by the Applicant's agency firm, provides copies of 245 Canadian trade-mark applications and registrations. She has not provided any analysis of these. It appears that the majority of them relate to trade-marks that incorporate the word LONDON.

#### Distinctiveness Ground of Opposition

[17] I will begin my assessment of the likelihood of confusion by considering the distinctiveness ground of opposition. In order to meet its initial burden with respect to this ground, the Opponent must establish that the marks upon which it relies were known to some extent at least in Canada as of October 23, 2007 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. The Opponent has evidenced that its LONDON DRUGS mark had a substantial reputation as of that date and I will focus my discussion on that mark.

[18] 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.

[19] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

*inherent distinctiveness of the trade-marks and the extent to which they have become known*

[20] Neither of the parties' marks is inherently strong.

[21] Geographic designations, such as LONDON, are not inherently distinctive [see *California Fashion Industries Inc. v. Reitmans (Canada) Ltd.* (1991), 38 C.P.R. (3d) 439 (F.C.T.D.) at para. 13]. However, there is no evidence before me that the city of London has a reputation as a source for any of the wares or services sold by the parties.

[22] Clearly the word DRUGS is not inherently distinctive with respect to drug store services. In contrast, the word BASE is inherently distinctive with respect to the Applicant's wares and services. The design features of the Mark are also slightly distinctive. Overall, although the Applicant's Mark is not an inherently strong mark, it has a greater degree of inherent distinctiveness than does the Opponent's LONDON DRUGS mark.

[23] A trade-mark may acquire distinctiveness through use or promotion. The Opponent's LONDON DRUGS mark has been used and promoted to such an extent that I may conclude that it has acquired distinctiveness. On the other hand, there is no evidence that the distinctiveness of the Applicant's Mark has been increased through use or promotion. Therefore the extent to which the marks have become known favours the Opponent.

*length of time each trade-mark has been in use*

[24] This factor also favours the Opponent.

*nature of the wares, services, business or trade*

[25] The parties provide similar types of wares and services and there is nothing in their statements of wares and services to indicate that their channels of trade would be restricted in



any manner. The nature of the wares, services, business and trade therefore favours the Opponent.

*degree of resemblance between the trade-marks*

[26] It is the word LONDON that creates a resemblance between the marks in appearance, sound and in ideas suggested. However, it is the first portion of a trade-mark that is the most relevant for the purposes of distinction and the first words in the marks at issue differ [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[27] The main idea suggested by the Applicant's Mark may be that the associated wares or services emanate from a source based in London. The Opponent's mark also suggests a connection with the city of London, with the word DRUGS suggesting that pharmaceutical products might be the source's main field.

*additional surrounding circumstances*

*i) state of the register evidence*

[28] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[29] The state of the register evidence introduced by Ms. Oliveira indicates that in general it is not uncommon to adopt the word LONDON as part of a trade-mark.

[30] Although the Applicant has not provided any analysis of the Oliveira evidence, the Opponent has. In particular, the Opponent has made the following pertinent points:

- Many of the registrations are for goods or services unrelated to those of the Opponent.
- Only three third parties have registered LONDON marks for retail store or department store services.
- Ten third parties have registered LONDON marks for personal care products, such as toiletries – these marks are LONDON’S PRIDE SOAP & Design; LONDON COOL; THE LONDON LOOK; WEEKEND BURBERRYS OF LONDON; CHARLES WORTHINGTON LONDON BIG HAIR & Design; TED BAKER LONDON & Design; YARDLEY LONDON BATHE SHOPPE & Design; YARDLEY LONDON & Design; AQUASCUTUM OF LONDON & Design; TAYLOR OF LONDON; and LONDON KNIGHTS.
- Eight third parties have registered LONDON marks in the field of bags and related leather goods.
- Only two third parties have registered LONDON marks for electronic equipment.
- Only three third parties have registered LONDON marks for sunglasses.
- Only six third parties have registered LONDON marks for jewellery or watches.

[31] The Opponent has not commented on the state of the register evidence insofar as it relates to another major category of wares listed in the Applicant’s application, namely wearing apparel including footwear. A cursory review of Ms. Oliveira’s evidence indicates that there are numerous third party registrations for LONDON trade-marks in that field, such as: i) RUSK LONDON I.N.T.; ii) FOR HER LONDON; iii) FOUR SEASONS OF LONDON; iv) PEPE JEANS LONDON; v) EYES OF EAST LONDON & Design; vi) LONDON FOG; vii) TED BAKER LONDON & Design; viii) MAAC LONDON Design; ix) LONDON BLUES; x) SACHA LONDON; xi) NEW LONDON; xii) LONDON CALLING; xiii) STUDIO LONDON; xiiii) SOUL LONDON; xiv) FLY LONDON & Design; xv) NOUGAT LONDON; xvi) Y LONDON & Design; xvii) WHISPERING SMITH LONDON; etc. Based on this evidence, I am prepared to conclude that Canadian consumers are used to seeing and distinguishing between various LONDON trade-marks that are associated with wearing apparel.

*ii) Opponent's Other LONDON Trade-marks*

[32] The Opponent has submitted that it enjoys enhanced protection for its trade-mark because it owns a family of LONDON trade-marks. However, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered and used by others [see *Thomas J. Lipton Inc. v. Fletcher's Fine Foods Ltd.* (1992), 44 C.P.R. (3d) 279 (T.M.O.B.) at 286-7]. Moreover, the Opponent has not provided evidence of use of each of the members of its alleged family [see *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)]. Nevertheless, the fact that the Opponent has used or adopted other LONDON marks is a surrounding circumstance that favours the Opponent to some extent.

*Conclusion re distinctiveness ground*

[33] In the circumstances of this case, I am satisfied that the Applicant has met its legal burden insofar as items of clothing and footwear are concerned. I reach this conclusion because the Applicant has evidenced that many other parties have registered trade-marks that incorporate the word LONDON in association with clothing or footwear. Although the Opponent has demonstrated that its LONDON DRUGS mark has acquired a significant reputation in general, the evidence concerning its use in association with clothing and footwear is not great and the state of the register evidence effectively dilutes the scope of protection to which the Opponent's mark is entitled in that particular field.

[34] On the other hand, the Applicant has not successfully demonstrated that the Opponent's rights are sufficiently diluted with respect to the remaining categories of wares and services for which it has applied to register the Mark to make confusion between BASE LONDON in oval design and LONDON DRUGS unlikely in regard thereto. In this regard I note the Opponent's reputation and registration in association with retail store services and a range of wares including specifically personal care products, jewellery, and electronics, and the lack of a sufficient number of third party registrations to dilute the Opponent's rights in those fields. I find that the balance of probabilities for and against the issue of confusion with respect to such wares and services is evenly balanced between the parties. Given that the legal onus lies on the Applicant, the distinctiveness ground of opposition as based on the Opponent's LONDON DRUGS trade-mark succeeds with respect to such wares and services.

[35] The distinctiveness ground of opposition as based on the Opponent’s other trade-marks and trade-names is no stronger than it is based on the Opponent’s LONDON DRUGS trade-mark because the evidence of use of the Opponent’s others trade-marks and trade-names is not substantial.

[36] The distinctiveness ground therefore succeeds with respect to the wares and services other than the following:

articles of clothing, namely, shirts, blouses, t-shirts, sweatshirts, jerseys, cardigans, tops, trousers, jeans, shorts, pants, dresses, skirts, jackets, coats, ties, scarves, cravats, neckties, hats, caps, socks and stockings; articles of footwear, namely, shoes, boots, slippers, sandals, trainers, sport shoes and casual shoes.

Section 12(1)(d) Grounds of Opposition

[37] Given that the primary mark of the Opponent appears from the evidence to be its LONDON DRUGS mark, my analysis of the likelihood of confusion under this ground will focus on that mark as it presents the Opponent’s strongest case. I have exercised the Registrar’s discretion to confirm that the following registrations for LONDON DRUGS are currently extant:

| <u>Registration No.</u> | <u>Wares/Services</u>  |
|-------------------------|--|
| TMA538,386              | <p>(1) Dental hygiene products, namely interdental stimulators, dental tape, dental floss, fluoride drops; vitamin and mineral supplements; anti-nausea tablets.</p> <p>(2) Body cream, namely vitamin E cream.</p> <p>(3) Oral hygiene products, namely mouthwash and antiseptic rinse; baby care products, namely baby oil, baby shampoo.</p> <p>(4) Baby care products, namely baby powder, baby lotion; hydrogen peroxide; isopropyl rubbing alcohol; petroleum jelly; shampoo; creams and lotions, namely collagen elastin cream, cold cream, cocoa butter, aloe vera cream, hand cream; car care products, namely windshield cleaning and antifreeze solution.</p> <p>(5) Baby care products, namely baby wipes; household cleaning products, namely dishwashing liquid detergent, dishwasher detergent, liquid toilet bowl cleaner, window cleaning liquid, all purpose liquid cleaner, disinfectant liquid cleaner, all purpose spray cleaner, drain opener.</p> |

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|  | <p>(6) Thermometers; hot water bottles; elasticated fabric bandages; plastic bandages; rubber gloves; make-up removal pads; cotton facial pads.</p> <p>(7) Disposable diapers; antibiotic topical ointment; cough syrup; enteric-coated acetaminophen tablets; acetylsalicylic acid tablets; cotton swabs; absorbent cotton balls; motor oil; household products, namely plastic sandwich bags, plastic food wrap; plastic drawstring garbage bags, plastic garbage bags for household use, plastic gardening garbage bags, aluminum foil; air fresheners; school and stationery supplies, namely maths sets, pencils, rulers, tape.</p> <p>(8) Dental hygiene products, namely children's and adult toothbrushes; travel kits, namely toothbrush and toothpaste sets; laxatives; sunscreen lotion, sunburn relief gel; sunless tanning lotion; feminine hygiene products, namely panty liners, sanitary napkins; men's and women's deodorants; clothes' hangers; reusable kitchen cloths; household ammonia; laundry cleaning products, namely fabric softener, bleach, stain remover.</p> <p>(9) Oral hygiene products, namely breath spray; absorbent roll bandages; liquid antacid; glycerin suppositories; children's acetaminophen tablets, adult's acetaminophen tablets; cold remedies, namely hot lemon decongestant liquids, cold capsules, nose drops, nasal decongestants; mineral oil; antihistamines; artificial sweeteners; facial tissues; toilet tissues.</p> <p>(10) Oral hygiene products, namely dental rinse; baby care products, namely disposable baby bottle liners; petroleum jelly; hairspray, hair conditioner; bath oil, plastic and wooden bath brushes; loofah bath sponges, loofah bath gloves, loofah bath brushes, loofah body and facial pads; bath sea sponges; liquid soap; razor blade cartridges; disposable razors; shaving brushes; cosmetic implements and accessories, namely sponge tip eye shadow brushes, cosmetic sponges and facial puffs; powder puffs; tweezers, eyelash curlers, eyelash curler refills, cosmetic pencil sharpeners; makeup sponges; mirrors; cosmetic brushes; nail care products, namely nail polish remover, cuticle scissors, nail scissors, nail clippers, toe nail clippers, cuticle nippers, nail nippers, nail files, emery boards, nail pencils, cuticle pushers, cuticle trimmers, manicure sticks, manicure brushes; personal grooming implements, namely barber scissors, thinning scissors, mustache scissors; pumice stones, pumice sponges, corn plane removers, corn plane blades; bingo markers; gardening tools, namely forks, rakes, trowels and hoes; lunch bags; stationery products, namely envelopes, stationery paper, writing blocks, blank video cassettes; photographic film.</p> <p>(11) Clumping cat litter.</p> <p>(12) Pregnancy tests.</p> <p>(13) Aerosol lint remover for electronic equipment.</p> <p>(14) Stepping stools.</p> |
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|            | <p>(1) Operation of a retail and general merchandise store; the operation of a drugstore; photofinishing services; the operation of a retail photographic equipment and photographic accessories outlet; camera store services.</p> <p>(2) Operation of a retail store specializing in the sale of cosmetics, hair care products, skin care products, perfumery products and toilet preparations.</p> <p>(3) Operation of a retail store specializing in the sale of radio and sound reproduction equipment, audio reproduction equipment, video reproduction equipment, electrical and electronic devices and instruments, telephones, clocks, audio and video accessories.</p> <p>(4) Operation of retail and wholesale outlets dealing in computer software, computer hardware and computer related accessories; computer services, namely customer training, computer repairs, computer education services, computer systems integration and computer programming.</p> <p>(5) Operation of a retail business dealing in the sale, distribution, installation, delivery and system balancing and assembly of sound, projection and audio and video hardware equipment and products.</p>  |
| TMA423,787 | <p>(1) Dental hygiene products, namely interdental stimulators, dental tape, dental floss, fluoride drops; vitamin and mineral supplements; anti-nausea tablets.</p> <p>(2) Body cream, namely vitamin E cream.</p> <p>(3) Oral hygiene products, namely mouthwash and antiseptic rinse; baby care products, namely baby oil, baby shampoo.</p> <p>(4) Baby care products, namely baby powder, baby lotion; hydrogen peroxide; isopropyl rubbing alcohol; petroleum jelly; shampoo; creams and lotions, namely collagen elastin cream, cold cream, cocoa butter, aloe vera cream, hand cream; car care products, namely windshield cleaning and antifreeze solution.</p> <p>(5) Baby care products, namely baby wipes; household cleaning products, namely dishwashing liquid detergent, dishwasher detergent, liquid toilet bowl cleaner, window cleaning liquid, all purpose liquid cleaner, disinfectant liquid cleaner, all purpose spray cleaner, drain opener.</p> <p>(6) Thermometers; hot water bottles; elasticated fabric bandages; plastic bandages; rubber gloves; make-up removal pads; cotton facial pads.</p> <p>(7) acetaminophen tablets; acetylsalicylic acid tablets; cotton swabs; absorbent cotton balls; motor oil; household products, namely plastic sandwich bags, plastic food wrap, plastic drawstring garbage bags, kitchen catcher plastic garbage bags, plastic gardening garbage bags, aluminum foil; air fresheners; school and stationery supplies, namely</p> |

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|            | <p>maths sets, pencils, rulers, tape.</p> <p>(8) Dental hygiene products, namely children's and adult toothbrushes; travel kits, namely toothbrush and toothpaste sets; laxatives; sunscreen lotion, sunburn relief gel; sunless tanning lotion; feminine hygiene products, namely panty liners, sanitary napkins; men's and women's deodorants; clothes' hangers; reusable kitchen cloths; household ammonia; laundry cleaning products, namely fabric softener, bleach, stain remover.</p> <p>(9) Oral hygiene products, namely breath spray; absorbent roll bandages; liquid antacid; glycerin suppositories; children's acetaminophen tablets, adult's acetaminophen tablets; cold remedies, namely hot lemon decongestant liquids, cold capsules, nose drops, nasal decongestants; mineral oil; antihistamines; artificial sweeteners; facial tissues; toilet tissues.</p> <p>(10) Oral hygiene products, namely dental rinse; baby care products, namely disposable baby bottle liners; petroleum jelly; hairspray, hair conditioner; bath oil, plastic and wooden bath brushes; loofah bath sponges, loofah bath gloves, loofah bath brushes, loofah body and facial pads; bath sea sponges; liquid soap; razor blade cartridges; disposable razor; shaving brushes; cosmetic implements and accessories, namely sponge tip eyeshadow brushes, cosmetic sponges and facial puffs; powder puffs; tweezers, eyelash curlers, eyelash curler refills, cosmetic pencil sharpeners; makeup sponges; mirrors; cosmetic brushes; nail care products, namely nail polish remover, cuticle scissors, nail scissors, nail clippers, toe nail clippers, cuticle nippers, nail nippers, nail files, emery boards, nail pencils, cuticle pushers, cuticle trimmers, manicure sticks, manicure brushes; personal grooming implements, namely barber scissors, thinning scissors, mustache scissors; pumice stones, pumice sponges, corn plane removers, corn plane blades; bingo markers; gardening tools, namely forks, rakes, trowels and hoes; lunch bags; stationery products, namely envelopes, stationery paper, writing blocks; video cassettes; photographic film.</p> <p>(1) Operation of a drug and general merchandise store, namely retail store services incorporating the marketing of merchandise of various kinds and sundry household and consumer products.</p> |
| TMA703,635 | Bottled water.   |
| TMA297,076 | <p>1) Drugstore and department stores.</p> <p>(2) Operation of a retail outlet dealing in optical accessories.</p> <p>(3) Operation of a retail outlet dealing in the sale of watches and jewellery and repairing watches and jewellery.</p> <p>(4) Operation of a retail outlet dealing in the sale and rental of video</p>   |

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|            | tapes, video equipment and all services and accessories related thereto.<br>(5) Operation of a retail outlet dealing in computer repairs, computer education programs, customer training in the use of computer software, consulting services to purchasers of computer software.<br>(6) Operation of a retail outlet providing photofinishing, photographic equipment, cameras, accessories and camera store services. |
| TMA311,269 | Operation of a drugstore and the operation of a department store.   |

[38] It is noted that none of the Opponent’s registrations cover clothing or footwear.

[39] A consideration of the s. 6(5) factors as of today’s date does not result in any conclusions different from those reached with respect to the material date of October 23, 2007. Accordingly, my conclusion under the s. 12(1)(d) grounds of opposition is the same as that reached under the distinctiveness ground of opposition.

Section 16(2) Grounds of Opposition

[40] The Opponent has met its initial burden under s. 16(2)(a), at least with respect to its LONDON DRUGS trade-mark, by evidencing that such mark was in use in Canada prior to May 22, 2003. In addition, the Opponent has met its initial burden under s. 16(2)(b) because the application relied upon, No. 1,095,092 for LONDON DEPARTMENT STORES, was filed March 6, 2001 and was still pending on August 8, 2007 (see s. 16(5)). However, the Opponent has not met its initial burden under s. 16(2)(c), at least with respect to its alleged trade-name London.

[41] The success of the s. 16(2) grounds is no greater than the success of the distinctiveness ground; in fact it is less because the s. 16(2) grounds of opposition only relate to one of the bases of the application, namely the basis of use and registration abroad.

Disposition

[42] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition with respect to the wares “articles of clothing, namely, shirts, blouses, t-shirts, sweatshirts,



jerseys, cardigans, tops, trousers, jeans, shorts, pants, dresses, skirts, jackets, coats, ties, scarves, cravats, neckties, hats, caps, socks and stockings; articles of footwear, namely, shoes, boots, slippers, sandals, trainers, sport shoes and casual shoes” and I refuse the application with respect to the remainder of the wares and services, pursuant to s. 38(8) of the Act [see *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision].

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