

**IN THE MATTER OF AN OPPOSITION by
L'Oréal to application No. 718,606 for the mark
THE CORRECTORS filed by Wella Canada Inc.**

On December 10, 1992, the applicant, Wella Canada Inc., filed an application to register the mark THE CORRECTORS based on intended use in Canada in association with

hair care products namely, hair colour, hair colour removers, pigment bases and heat activated adjusting lotions.

The subject application was advertised for opposition purposes on September 14, 1994 and was opposed by L'Oréal on December 29, 1994. A copy of the statement of opposition was forwarded to the applicant on April 21, 1995. The applicant responded by filing and serving a counter statement.

The first three grounds of opposition are based on Section 30 of the Trade-marks Act and allege that the applicant used the applied for mark prior to filing the subject application; alternatively or cumulatively, that the applicant never intended to use the applied for mark; and that the applicant could not have been satisfied as to its entitlement to use the applied for mark. The fourth and fifth grounds of opposition, pursuant to subsection 12(1) of the Act, allege that the applied for mark is not registrable because whether depicted, written or sounded it is clearly descriptive or deceptively misdescriptive of the quality of the applicant's wares; and that the applied for mark is confusing with one or more of the registered trade-marks namely, (i) COLORSETS, for colognes and perfumes, standing in the name of Liz Claibourne Inc., (ii) NIGHT CORRECTOR, for facial cremes, standing in the name of Mira Linder Inc., and (iii) COLOR TRESS, for hair colour, hair bleach and peroxide, standing in the name of Unilever Plc.

The sixth ground of opposition is somewhat muddled as the opponent alleges that the applicant is not entitled to register the applied for mark in view of the prior pleadings. Nevertheless, the sixth ground specifically refers to subsection 16(3) of the Act which deals with the issue of entitlement to registration and reads as follows:

Any applicant who has filed an application in accordance with section 30 for registration of a proposed trademark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the wares or services specified in the application, unless at the date of filing of the application it was confusing with

- (a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;
- (b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- (c) a trade-name that had been previously used in Canada by any other person.

The pleadings relating to the sixth ground of opposition do not identify any trade-mark, trade-mark application or trade-name and that is reason enough to find non-compliance with paragraph 38(3)(a) of the Act which requires that a ground of opposition set out sufficient detail to enable the applicant to reply thereto. Accordingly, the sixth ground of opposition is rejected.

The last ground of opposition alleges that the applied for mark is not adapted to distinguish the applicant's wares for the following reasons:

The opponent's evidence consists of certified copies of the three third party trade-mark registrations pleaded in the statement of opposition and the affidavit of Jacques Labrèche, which affidavit merely serves to introduce into evidence definitions for the word "corrector" found in

several standard reference dictionaries. The applicant elected not to file any evidence.

Both parties filed a written argument and both were represented at an oral hearing.

With respect to the first three grounds of opposition, the legal onus is on the applicant to show that its application complies with Section 30 of the Trade-marks Act. However, there is an initial evidential burden on the opponent in respect of its allegations: 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 in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. As no evidence was submitted by the opponent to support its pleadings, the opponent has failed to meet the evidential burden upon it in respect of the Section 30 grounds of opposition which I have therefore rejected. Similarly, the opponent has not put forward any evidence in support of the last ground of opposition which is therefore also rejected.

The fifth ground of opposition alleges that the applied for mark is confusing with one or more third party trade-mark registrations namely COLORSETS, for colognes and perfumes; NIGHT CORRECTOR, for facial cremes; and COLOR TRESS, for hair colour, hair bleach and peroxide. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark THE CORRECTORS and any of the third party marks. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L.*

Marchildon and The Registrar of Trade-marks (1996), 66 C.P.R.(3d) 308 (F.C.T.D). The degree of resemblance between the marks in issue is ordinarily the most important consideration and certainly so in the absence of evidence in relation to the other factors. In the instant case, there is little resemblance between the marks COLORSETS or COLOR TRESS and the applied for mark THE CORRECTORS. Accordingly, I find that there would be no reasonable likelihood of confusion between the applied for mark and the above-mentioned third party marks. In respect of the mark NIGHT CORRECTOR, I agree with the applicant's submissions at paragraph 23 of its written argument:

The remaining ground of opposition, pursuant to paragraph 12(1)(b) of the Act, is whether the mark THE CORRECTORS is clearly descriptive or deceptively misdescriptive of the character or quality of hair colour, hair colour removers, pigment bases and adjusting lotions. That issue is to be decided from the point of view of an everyday user of the wares considering the mark in its entirety, as opposed to carefully analysing and dissecting the mark into its component parts, and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25 at 27-28 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 at 188 (F.C.T.D.). The material time for considering the circumstances respecting a ground of opposition based on Section 12(1)(b) is as of the date of my decision: see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992) 41 C.P.R.(3d) 234 (F.C.A.).

The legal burden is on the applicant to establish that its mark is not clearly descriptive or deceptively misdescriptive. Ordinarily there is an evidential burden on the opponent to adduce sufficient evidence which, if believed, would support its allegation that the applied for mark

offends the provisions of Section 12(1)(b). However, an opponent need not necessarily adduce evidence in a case such as this where the opponent's legal argument may be based entirely on the ordinary meaning of words. The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached after all the evidence is in and after the arguments are heard, then the issue must be decided against applicant: see *Joseph E. Seagram & Sons v. Seagram Real Estate Ltd.* (1984), 3 C.P.R.(3d) 325 at 329-330 (TMOB); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.).

From my review of the dictionary definitions provided by Mr. Labrèche, I conclude that the word “corrector” refers to an individual who corrects, that is, someone who points out errors or faults, for example, a critic, a censor, or a proof-reader. Thus, there is support for the applicant’s submission that the applied for mark “uses the word THE so as to personify the concept of THE CORRECTORS.” In my view, the applied for mark, taken in its entirety and as a matter of first impression, would be perceived as a somewhat laudatory phrase which suggests that the applicant’s products will remedy or improve the state of one’s hair. Of course, a mark may be suggestive without being clearly descriptive. It follows that the applied for mark cannot be deceptively misdescriptive: see *Bonus Foods Ltd. v. Essex Packers Ltd.* (1964), 43 C.P.R. 165 at 178 (Ex. C.).

In view of the foregoing, the opponent’s opposition is rejected.

DATED AT HULL, QUEBEC, THIS 5th DAY OF NOVEMBER, 1997.

Myer Herzig,
Member,
Trade-marks Opposition Board