IN THE MATTER OF AN OPPOSITION by Lander Co. Canada Limited to application No. 734,536 for the trade-mark R. DE LANDOR & Design filed by Akhenaton Diffusion S.A.

On August 6, 1993, the applicant, Akhenaton Diffusion S.A., filed an application to register the trade-mark R. DE LANDOR & Design, a representation of which appears below, based upon use and registration of the trade-mark in Switzerland in association with:

> "Préparations cosmétiques et de parfumerie, nommément: crèmes, lotions, gels, laits hydratants, laits démaquillants, masques, ampoules biologiques, shampooings, bain moussant, lait solaire."
> [Translation] "Cosmetics and perfumery, namely: creams, lotions, gels, moisturizing milks, cleansing milks, masks, natural ampoules, shampoos, foam bath, sun milk".

The applicant claimed and was accorded a priority filing date of June 22, 1993 based on its application for registration filed in Switzerland.

R. DE LANDOR

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of July 20, 1994 and the opponent, Lander Co. Canada Limited, filed a statement of opposition on September 20, 1994, a copy of which was forwarded to the applicant on December 6, 1994. Further, the opponent requested and was granted leave to amend its statement of opposition pursuant to Rule 42 [now Rule 40] of the ***Trade-marks Regulations***. The opponent's grounds of opposition turn on the issue of confusion between the applicant's trade-mark R. DE LANDOR & Design and the opponent's registered trade-marks LANDER, LANDER WONDER CREAM and LANDER CLEAN RINSE, registration Nos. 175,848, 253,197 and 238,170, its pending applications for the trade-marks SPORTZ BY LANDER and LANDER SPORTZ, application Nos. 657,371 and 657,370, and its trade-name Lander Co. Canada Limited. Consequently, the opponent alleged that the applicant's trade-mark is not registrable and not distinctive, that the applicant is not the person entitled to registration of the trade-mark R. DE LANDOR & Design, and that the applicant's application does not comply with Section 30 of the ***Trade-marks Act***.

The applicant served and filed a counter statement in which it denied the opponent's grounds of opposition. The opponent filed as its evidence the affidavit of Ralph Rodrigues, Controller of the opponent, while the applicant elected not to file any evidence. Mr. Rodrigues was cross-examined on his affidavit, 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 filed a written argument and neither party requested an oral hearing.

In assessing 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 Subsection 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 as of the material date(s). With respect to the ground of opposition based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the material date is the date of my decision [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)] while the material date in respect of the non-entitlement ground of opposition is the applicant's priority filing date [June 22, 1993] and the material date for considering the non-distinctiveness ground is the date of opposition [September 20, 1994].

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's mark R. DE LANDOR & Design possesses some measure of inherent distinctiveness when considered in its entirety even though R. DE LANDOR would be perceived by many consumers as possessing a name significance and the initials RDL add little inherent distinctiveness to the trade-mark. The opponent's trade-mark LANDER would also be perceived by the average consumer as having a surname significance and therefore likewise possesses little inherent distinctiveness. Further, the opponent's trade-marks LANDER WONDER CREAM, LANDER CLEAN RINSE, SPORTZ BY LANDER and LANDER SPORTZ possess some measure of inherent distinctiveness when considered in their entireties although the words WONDER CREAM and CLEAN RINSE are descriptive of the wares covered in the opponent's registrations and the word SPORTZ is suggestive of the wares covered in the opponent's pending applications.

As no evidence has been furnished by the applicant, its trade-mark R. DE LANDOR & Design must be considered as not having become known to any extent in Canada. On the other hand, the Rodrigues affidavit establishes that the opponent's trade-mark LANDER has become known in Canada in association with shampoo, bubble bath, skin lotion, hair conditioners and preparations, deodorants, mouthwash and powders with total sales of these wares in association with the trade-mark LANDER exceeding $20,000,000 from 1991 to October of 1995. Thus, the extent to which the trade-marks at issue have become known clearly weighs in the opponent's favour.

The opponent has furnished evidence that its trade-mark LANDER has been used in Canada since at least 1967 in association with the wares identified above whereas no evidence has been furnished by the applicant to show that its trade-mark R. DE LANDOR & Design has been used in Canada. As a result, the length of time the trade-marks have been in use is a further surrounding circumstance which favours the opponent.

The present application covers cosmetics and perfumery, namely, creams, lotions, gels, moisturizing milks, cleansing milks, masks, natural ampoules, shampoos, foam bath, sun milk which overlap the opponent's shampoo, bubble bath, skin lotion, hair conditioners and preparations, deodorants, mouthwash and powders wares, as well as being related to the toilet preparations and cosmetics covered in the opponent's registrations and pending applications. Moreover, and in the absence of any evidence to the contrary, I would expect that the channels of trade associated with these wares could overlap.

As for the degree of resemblance between the trade-marks at issue, I consider there to be a fair degree of similarity in appearance and in sounding between the trade-marks R. DE LANDOR & Design and LANDER. However, while both marks may suggest the name or surname of an individual, the opponent has not established that it is entitled to a monopoly in respect of such an idea.

Having regard to the degree of resemblance between the applicant's trade-mark R. DE LANDOR & Design and the opponent's trade-mark LANDER, and considering that the wares and

channels of trade of the parties overlap, and bearing in mind that the applicant has filed no evidence or written argument in support of its application, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. As a result, the applicant's trade-mark R. DE LANDOR & Design is not registrable and not distinctive, and the applicant is not the person entitled to its registration

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the ***Trade-marks Act***, I refuse the applicant's application pursuant to Subsection 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC THIS 27th DAY OF FEBRUARY, 1998.

G.W. Partington
Chairperson
Trade-marks Opposition Board