

**IN THE MATTER OF AN OPPOSITION
by Alberto-Culver Company to application
No. 1,148,391 for the trade-mark VOV Design
filed by VOV Cosmetics Co., Ltd.**

On July 30, 2002, the applicant, VOV Cosmetics Co., Ltd., filed an application to register the trade-mark VOV Design (shown below) based on proposed use in Canada.

The application was amended and then advertised for opposition purposes on September 3,

2003. The application covers the following wares:




Perfume, lipsticks, nail polish, nail polish remover, general toilet water, hair colorants, pressed powders for compact, cosmetic pencils, eye shadows, face cream, moisture lotion, lip gloss, eyeliner, after shave lotion, milk lotion, false eyelashes, cosmetic soap, shampoo, hair rinse.





The opponent, Alberto-Culver Company ("A-C U.S."), filed a statement of opposition on October 22, 2003, a copy of which was forwarded to the applicant on November 13, 2002.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada in view of the opponent's prior and extensive use of its marks relied on in this opposition.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following registered trade-marks owned by the opponent:

<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Wares</u>
	135,318	Preparations for the hair and body, namely, hair sprays, hair setting lotions, hair dressings, shampoos, shaving preparations.
	194,140	Cosmetic and toiletry preparations, namely hair spray, hair shampoo, creme rinse, hair dressing and hair conditioner.
VO5	200,509	Preparations for the hair and body, namely, hair sprays, hair setting lotions, hair dressings, shampoos, shaving preparations, permanent wave lotion, hair spray, setting lotion, creme rinse, dressing and conditioner; concentrated hair lightener; hair brightener, and conditioner for colored hair; and personal deodorant.
	116,323	(1) A concentrated hair and scalp conditioner and dressing containing lanolin. (2) Shampoo.
ALBERTO VO5	320,129	Hair care preparations, namely, hairsprays, shampoos, hair conditioners, mousses, hot protein treatments, hot oil treatments and hairdressings.
VO5 ALIVE	358,969	Hair care and toiletry preparations, namely, hair styling mousse, aerosol and non-aerosol hairspray, shampoo, conditioner, haircoloring, and hairdressing.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, the applied for mark was confusing with the six registered marks noted above and the three applied for marks shown below previously used in Canada by the opponent:

<u>Trade-mark</u>	<u>Application No.</u>	<u>Wares</u>
ALBERTO VO5 NATURALS	778,045	Hair care products, namely shampoo and conditioner.
	1,190,599	Hair care preparations.
	1,190,598	Hair care preparations.

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(b) of the Act because, as of the applicant's filing date, the applied for mark was confusing with the trade-mark ALBERTO VO5 NATURALS for which an application (No. 778,045) had previously been filed in Canada. The fifth ground is that the applicant's mark is not distinctive because it is confusing with the opponent's various trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Don Alderman. The applicant did not submit any evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

In his affidavit, Mr. Alderman identifies himself as the Vice President and General Manager of Alberto-Culver Canada Inc. ("A-C Canada") which was formerly known as Alberto-Culver of Canada Ltd. Mr. Alderman states that A-C Canada is a wholly-owned subsidiary of the opponent A-C U.S. and has been licensed by A-C U.S. to use the various trade-marks relied on in the statement of opposition.

Mr. Alderman states that his company has sold a line of hair care products in Canada in association with the trade-mark VO5 since 1961. The products have been sold through mass merchandisers like Wal-Mart and Zellers, grocery chains like Loblaws and Safeway and drug store chains like London Drugs and Shoppers Drug Mart. According to Mr. Alderman, Canadian sales of hair care products sold in association with the trade-mark VO5 for the period October 1997 to September 2003 were in excess of \$48 million. Canadian advertising expenditures in relation to VO5 products for the period October 1997 to September 2001 totaled more than \$5.4 million.

Appended as exhibits to Mr. Alderman's affidavit are examples of packaging and

labeling used by the opponent over the years as well as several magazine ads and storyboards from television advertisements. As noted by the applicant, Mr. Alderman does not provide much detail as to when and where the various advertisements appeared. While I agree that Mr. Alderman's affidavit is somewhat sketchy on certain points, overall it does establish a continuous pattern of use of the opponent's mark VO5.

The applicant contends that the various uses of the opponent's marks as shown in the exhibits do not evidence use of the trade-mark VO5 by itself either because the numeral 5 is used in a superscript form, the mark is used in a design format or the mark is invariably associated with the house mark ALBERTO. However, my examination of the exhibits suggests that any variations of the mark VO5 are only minor. Furthermore, when the mark VO5 is used with the mark ALBERTO, VO5 dominates. Thus, in accordance with the decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538 (T.M.O.B.), I find that the Alderman exhibits establish use of the trade-mark VO5 'per se.' In this regard, it should be noted that the trade-mark used since 1998, according to Mr. Alderman, is the one shown in the two most recent applications (Nos. 1,190,598 and 1,190,599) wherein the trade-mark is dominated by the mark VO5 and the word ALBERTO is of only minor significance.

The applicant further contended that the manner in which the opponent's trade-mark applications and registrations were introduced into evidence by Mr. Alderman was deficient and that the particulars presented in Exhibit A to his affidavit comprise

inadmissible hearsay evidence. I agree. However, in accordance with the decisions in John Labatt Ltd. v. W.C.W. Western Canada Water Enterprises Inc. (1991), 39 C.P.R.(3d) 442 at 445 (T.M.O.B.) and Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at 411 (T.M.O.B.), I have examined the register and confirmed the ownership and particulars of the applications and registrations relied on by the opponent.

THE APPLICANT'S EVIDENCE

As previously noted, the applicant did not file any evidence.

THE GROUNDS OF OPPOSITION

The first ground is not a proper ground of opposition. The mere prior use of the opponent's various marks does not, by itself, preclude the applicant from honestly making the statement in its application required by Section 30(i) of the Act. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those

specifically set forth in Section 6(5) of the Act. Finally, the most relevant of the opponent's registrations is No. 200,509 for the trade-mark VO5 and thus a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the second ground of opposition.

As for Section 6(5)(a) of the Act, the applicant's mark is inherently distinctive. However, it is dominated by the initials VOV. The design component of the mark comprising three blocks underscores the likelihood that the enclosed letters would be viewed as initials rather than as a single word. Thus, the applied for mark is not inherently strong. There being no evidence from the applicant, I must conclude that its proposed mark has not become known at all in Canada.

The opponent's registered mark VO5 is also inherently distinctive since it does not have any suggestive or descriptive connotation in relation to the applied for wares. However, since it is comprised of two initials and a numeral, it, too, is inherently weak. On the other hand, the evidence establishes that the mark VO5 has been widely and extensively used for hair care products for a number of years. Thus, I am able to conclude that the opponent's mark has become well known throughout Canada.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, there is an actual overlap in the statements of wares insofar as they both cover shampoo, hair rinse and hair coloring products. The remaining products are all closely related since cosmetics, moisturizing products, perfume and deodorants all

qualify as personal care products. Presumably the trades of the parties would overlap significantly.

As for Section 6(5)(e) of the Act, I consider that there is a fairly high degree of visual and phonetic resemblance between the marks at issue. Both comprise three characters, the first two of which are identical. The design component of the applicant's mark does little to distinguish it from the opponent's registered mark VO5.

At the oral hearing, the opponent's agent submitted that the degree of resemblance between the marks is even greater because consumers would view the final character in the applicant's mark as a Roman numeral five. However, as contended by the applicant's agent, the palindromic nature of the letters VOV dictates against such a finding.

At the oral hearing, both agents sought to rely on foreign opposition decisions involving the same parties and the same mark. However, in the absence of proper proof of those decisions and the applicable foreign law, they have no precedential value in this proceeding.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties and the reputation associated with the opponent's mark, I find that the applicant has failed to satisfy

the onus on it to show that its proposed mark VOV Design is not confusing with the registered mark VO5. Thus, the second ground of opposition is successful.

As for the third ground of opposition, I have again considered the opponent's trade-mark VO5 since it is the most relevant mark. The opponent has evidenced use of that mark prior to the applicant's filing date and non-abandonment of the mark as of the applicant's advertisement date. Thus, the ground remains to be decided on the issue of confusion between the mark VO5 and the mark VOV Design as of the applicant's filing date in accordance with the wording of Section 16(3) of the Act. My conclusions respecting the second ground are, for the most part, also applicable to this ground. Thus, I find that the applicant failed to satisfy the onus on it to show that its applied for mark was not confusing with the opponent's previously used mark as of the applicant's filing date. The third ground is therefore also successful.

Considering next the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - October 22, 2003): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

My conclusions respecting the second and third grounds are also applicable as of the filing of the opposition. Thus, I find that the applicant's trade-mark was confusing with the opponent's previously used and registered mark VO5 and was therefore not distinctive at that time. Thus, the fifth ground is also successful. It is therefore unnecessary to consider the fourth ground of opposition.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 21st DAY OF JUNE, 2006.

**David J. Martin,
Member,
Trade Marks Opposition Board.**