



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

Citation: 2014 TMOB 283
Date of Decision: 2014-12-17

**IN THE MATTER OF AN OPPOSITION
by Victoria's Secret Stores Brand
Management Inc to application
No. 1,464,223 for the trade-mark V&S
Logo in the name of Vitamine and Sea**

Introduction

[1] This opposition relates to an application filed on February 17, 2010 by Vitamine and Sea (the Applicant) to register the trade-mark that has been identified as V&S Logo and reproduced below:



(the Mark)

[2] The application covers:

Organic Products, namely, Organic Shampoo, Organic Conditioner, Organic Hair Gel, Organic Hair Styling Cream, Organic Hair Treatment, Organic Infused Water, Organic Scalp Treatment,

Organic Scalp Scrub, Organic Exfoliant, Organic Hair Rinse, Organic Hair Cleanser, Organic Hair Styling Spray, Organic Hairspray, Organic Sea Salt Hair Styling Spray, Organic Hair Mask, Organic Hair Treatment, Organic Hair Treatment Cream, Organic Hair Treatment Rinse, Organic Hair Paste Organic Body Oil, Organic Body Cream, Organic Body Rinse, Organic Body Cleanser, Organic Body Spray, Organic Body Scrub, Organic Body Treatment, Organic Body Mask, Organic Hand Cream, Organic Face Cream, Organic Face Scrub, Organic Eye Cream, Organic Face Mask, Organic Face Toner, Organic Face Rinse, Organic Face Cleanser, Organic Face Exfoliant (the Wares); and

Sales of Vitamine and sea Organic Products, namely, Organic Shampoo, Organic Conditioner, Organic Hair Gel, Organic Hair Styling Cream, Organic Hair Treatment, Organic Infused Water, Organic Scalp Treatment, Organic Scalp Scrub, Organic Exfoliant, Organic Hair Rinse, Organic Hair Cleanser, Organic Hair Styling Spray, Organic Hairspray, Organic Sea Salt Hair Styling Spray, Organic Hair Mask, Organic Hair Treatment, Organic Hair Treatment Cream, Organic Hair Treatment Rinse, Organic Hair Paste Organic Body Oil, Organic Body Cream, Organic Body Rinse, Organic Body Cleanser, Organic Body Spray, Organic Body Scrub, Organic Body Treatment, Organic Body Mask, Organic Hand Cream, Organic Face Cream, Organic Face Scrub, Organic Face Mask, Organic Face Toner, Organic Eye Cream, Organic Face Rinse, Organic Face Cleanser, Organic Face Exfoliant. (the Services).

[3] The application is based on proposed use. It was advertised on February 16, 2011 in the *Trade-marks Journal*. Victoria's Secret Stores Brand Management Inc (the Opponent) filed a statement of opposition on July 6, 2011 against this application.

[4] The grounds of opposition raised by the Opponent are based on sections 30(e) and (i), 12(1)(d), 16(3)(a), and section 2 (distinctiveness) of the *Trade-Marks Act* RSC 1985 c. T-13 (the Act). The specific grounds of opposition are detailed in Annex A to this decision. The Applicant denied the grounds of opposition in a counter statement filed on September 13, 2011.

[5] The Opponent filed as its evidence the affidavit of Joe Quigley, a certified copy of the file history of application No. 1,464,223 and certified copies of Canadian trade-mark registrations TMA313,969, TMA432,093 and TMA538,755 while the Applicant filed the affidavit of Mark Cummins. Only Mr. Cummins was cross-examined and the transcript is part of the record.

[6] The Opponent filed as reply evidence a certified copy of certificate of constitution of 9226-8754 Quebec Inc. and a declaration of registration for a legal person of 9226-8754 Quebec Inc.

[7] Only the Opponent filed a written argument and both parties were represented at the hearing.

[8] For the reasons detailed hereinafter, I conclude that the Opponent has met its evidential burden with respect to the technical ground of opposition based on the combination of sections 30(e) and 2 (definition of ‘person’) of the Act in that the Applicant did not and does not intend to use the Mark in Canada as it was not a ‘person’ as defined in the Act when the application was filed. Since I conclude that the Opponent is successful under such ground there is no need to assess the other grounds of opposition that are based on the likelihood of confusion between the Mark and the Opponent’s marks listed in its statement of opposition as well as the ground of opposition based on section 30(i) of the Act.

Legal Onus and Burden of Proof

[9] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Preliminary Remarks

[10] In coming to my decision I have considered all of the evidence related to the identity of the Applicant and submissions made by the parties on such ground. The Applicant has been self-represented throughout the filing of the application and the opposition processes. At the hearing Ms. Mamroud, the Applicant’s representative was fully prepared and came with additional

documentation. I explained to her that she could only refer to the documents that were part of the record and outlined above.

[11] An additional technical ground of opposition, also based on section 30(e) of the Act, has been raised by the Opponent with respect to the trade-mark applied for. The Opponent argued that the Applicant did not have the intention to use the Mark at the filing date of the application as the trade-mark advertised was different than the trade-mark applied for. I do not need to address this additional technical ground of opposition in details as the Opponent is successful on another issue. However, in the description of the file history I have to refer to some facts related to that additional ground of opposition and therefore I will make brief comments on it at the end of my decision.

History of the prosecution of the application

[12] In order to fully understand the Opponent's position with respect to the Applicant's status as a 'person' within the meaning of section 2 of the Act, a brief history of the prosecution of the application is necessary. The file history of application No. 1,464,223 is part of the Opponent's evidence.

[13] On December 24, 2009 the Applicant, identified as 'Vitamine and Sea' in the application, filed an application to register a trade-mark. The Applicant identified the trade-mark as: 'Vitamine and Sea Organic and design (the design portion includes the V&S logo)'. There was no drawing attached to such application. Moreover the full address of the Applicant was missing. Consequently, the Registrar issued a first office action on January 5, 2010 raising these deficiencies.

[14] In a letter addressed to the Registrar, transmitted by telecopier, and received on February 17, 2010, Ms. Mamroud included in such letter her full name and address with the additional note: 'For: Vitamine and Sea'. Attached to the letter was a drawing representing the letters 'V&S' as they appear in the Mark. Ms. Mamroud added in her letter the following: 'Logo will be used with trade name please see logo on the following page' which was the drawing I just referred to.

[15] On April 20, 2010 the Registrar issued a second office action indicating that:

- the trade-mark applied for would be a prohibited mark in view of the registration of an official mark;
- the trade-mark applied for was considered confusing with cited registered trade-marks; and
- it needed confirmation that the applicant was a legal entity. (my underlines)

[16] On May 18, 2010 the Applicant filed a revised application wherein the trade-mark reproduced was the Mark. A further revised application was filed on October 27, 2010 wherein the list of wares was amended.

[17] Finally on December 16, 2010 the Applicant filed yet another revised application which corresponds to the application as advertised. I note that there is no indication in the file history as to how the Applicant was able to overcome the preliminary objections raised by the Registrar in its April 20, 2010 office action and there is no indication that the Applicant confirmed to the Registrar that it was a legal entity. As mentioned previously Ms. Mamroud, at the hearing, referred to her notes taken from telephone conversations she had with various CIPO representatives. There is no evidence in the record of those conversations and as such I shall ignore any reference made to them by Ms. Mamroud at the hearing. As explained to Ms. Mamroud at the hearing, acting as the Applicant's representative did not entitle her to testify at the hearing on facts not in the record.

Ground of opposition based on sections 30(e) and 2 (definition of a 'person') of the Act

Was the application filed by a 'person' within the meaning of section 2 of the Act?

[18] The Opponent's position is that, at the filing date of the application, the Applicant identified as 'Vitamine and Sea' was not a legal person and thus could not have been a 'person' within the meaning of section 2 of the Act. Consequently, the Applicant as identified in the application could not and cannot intend to use the Mark in Canada.

[19] Mr. Cummings describes himself as the general manager of 9226-8754 Quebec Inc., doing business as Vitamine & Sea, since May 2009. During his cross-examination he explained

that 'Vitamine and Sea' is simply a trade name for a numbered company, namely 9226-8754 Quebec Inc. (page 5 of the transcript). He confirmed also that the inscription of 'Vitamine and Sea' as the Applicant is a reference to the numbered company and not to Ms. Mamroud (page 5 of the transcript).

[20] Finally I find it useful to reproduce the following extract of the transcript:

18 Q. In paragraph 1, you also say you have made this declaration on behalf of Yael Mamroud and the numbered company?

A. Yes.

19 Q. What's the relationship between Ms Mamroud and the numbered company?

A. She is the founder, I guess, of the company.

20 Q. So she is not the Applicant. The company is the Applicant.

A. Yes, exactly.

(...)

91 Q. Right. When you say [Ms. Mamroud] applied for, you are not saying she was the Applicant.

A. Exactly. The company is the Applicant but she was the representative from the company that applied for the trade-mark for the company.

[21] As part of its reply evidence the Opponent filed a copy of the Certificate of Constitution of 9226-8754 Quebec Inc. which clearly shows that the company was incorporated on September 1, 2010 and thus after the filing of the application (February 17, 2010). Consequently the company was not in existence at the filing date of the application.

[22] The Opponent also filed a Certificate of Conformity with respect to a Declaration of Registration for a Legal Person of 9226-8754 Quebec Inc which shows that 'Vitamine and Sea' is another name used by such company. Such declaration was signed by Ms. Mamroud on September 1, 2010.

[23] Under these circumstances the Opponent argues that 'Vitamine and Sea', which is clearly a trade name for 9226-8754 Quebec Inc., was not a 'person', within the meaning of section 2 of

the Act when the application was filed (either December 24, 2009 when a first application was filed but incomplete, as appears from the file history, or the date recorded by the Registrar, namely February 17, 2010 when a revised application was filed containing the full address of the Applicant and a drawing of the letters ‘V&S’).

[24] I agree with the Opponent. Clearly ‘Vitamine and Sea’ was a trade name. The evidence shows that the corporation 9226-8754 Quebec Inc. did not exist at the filing date of the application and thus could not be a ‘person’ at that date within the meaning of section 2 of the Act. As such the Applicant could not have been, at the filing date of this application, a person that intended to use the Mark in Canada [*see Cie des Montres Longiness Francillon SA v Pinto Trading Co* (1983) 75 CPR (2d) 283 (TMOB)].

[25] I wish to add that nowhere in the Applicant’s evidence, or in the affidavit of Mr. Cummings, or during his cross-examination, is there an indication that ‘Vitamine and Sea’ could have been a trade name used by Ms. Mamroud and/or Mr. Cummings; that subsequently it would have been assigned to 9226-8754 Quebec Inc. To the contrary when specifically asked during the cross-examination who was ‘Vitamine and Sea’ Mr. Cummings repeated on two separate occasions that the trade name ‘Vitamine and Sea’ referred to 9226-8754 Quebec Inc which was incorporated only on September 1, 2010.

[26] For all these reasons I maintain this ground of opposition.

Other grounds of opposition

[27] Since I conclude that the Opponent is successful for the reasons described above, there is no need to assess the grounds of opposition based on the likelihood of confusion between the Mark and the Opponent’s marks listed in its statement of opposition or the ground of opposition based on section 30(i) of the Act.

[28] I will however comment briefly on yet another technical ground of opposition also based on section 30(e) of the Act, namely that the Applicant could not have had the intention to use the Mark since the trade-mark originally applied for was not the Mark. Despite the fact that there is no need to discuss the merit of that ground of opposition in view of the Opponent’s success

under the ground of opposition assessed previously, I would have been inclined to agree with the Opponent.

[29] In fact, through subsequent correspondence after the filing of the original application, the trade-mark applied for evolved to the Mark as advertised. As a consequence the Opponent takes the position that the Applicant could not have had the intention to use the original trade-mark applied for. The Opponent argues that it is only after the application was advertised and a review of the file history that it was in a position to raise those facts as a ground of opposition. By taking this approach the Opponent is not relying on the non-compliance to rule 31 of the *Trade-mark Regulations*; it goes to the Applicant's intention to use the trade-mark appearing on the application originally filed under section 30(e) of the Act.

[30] The drawing originally filed did not correspond to the Mark. Moreover even though Ms. Mamroud indicated in her letter of February 17, 2010, addressed to the Registrar, that the letters 'V&S' would be used in conjunction with the trade name 'Vitamine & Sea', the Mark as advertised contained additional elements such as 'EST. 2010' and 'Montreal'.

Disposition

Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application, pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Annex A

The grounds of opposition raised by the Opponent can be summarized as follow:

1. The application does not comply with the requirements of section 30 of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant did not and does not intend to use the Mark in Canada as a trade-mark;
2. The application does not comply with the requirements of section 30 of the Act in that the Applicant did not intend and does not intend to use the Mark in Canada because the Mark has a different distinctive character or identity as compared with the trade-mark included in the application as at the filing date of the application;
3. The application does not conform to the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares since at the filing date of the application, the Applicant was or should have been aware of the Opponent's well-known and famous Victoria's Secrets trade-marks listed in Schedule A of the statement of opposition, previously adopted in association with a wide variety of wares and services described therein;
4. The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the registered trade-marks of the opponent referred to in Schedule A of the statement of opposition and any application listed therein which will issue to registration prior to the hearing date of this opposition;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the Victoria's Secrets trade-marks which had been previously used in Canada by the Opponent in association with the Opponent's wares and services;
6. The Applicant is not the person entitled to registration since the Applicant is not a 'person' as defined in section 2 of the Act;
7. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive in that does not actually distinguish the wares in association with which it is proposed to be used by the Applicant from the wares or services of others, including the Opponent's wares and services sold in association with the Opponent's Victoria's Secret trade-marks, nor is the Mark adapted so as to distinguish the Applicant's Wares.