

IN THE MATTER OF AN OPPOSITION by
Helene Curtis, Inc. and Helene Curtis Ltd./Ltée.
to application No. 712,520 for the mark
SALON CREATIONS & Design filed by
Centura Brands Inc.

On September 10, 1992, the applicant, Centura Brands Inc., filed an application to register the mark SALON CREATIONS & Design, illustrated below, based on proposed use of the mark in Canada in association with a number of hair care products including hair conditioner, shampoos, creme rinse, hair colouring, and the like.

The application was advertised for opposition purposes in the Trade-marks Journal issue dated February 24, 1993 and was opposed by Helene Curtis, Inc. and Helene Curtis Ltd./Ltée on March 29, 1993. A copy of the statement of opposition was forwarded to the applicant on May 4, 1993. The applicant responded by filing and serving a counter statement. Both parties filed a written argument and both parties were represented at an oral hearing.

The grounds of opposition are that the applied for mark SALON CREATIONS & Design is not registrable and not distinctive, and that the applicant is not entitled to register the applied for mark. In this regard, the opponents allege in the statement of opposition that the applied for mark is confusing with one, or more, of their registered trade-marks namely SALON SELECTIVES, SELECTIVES SALON, and SALON BASICS previously used in Canada by the opponents in association with hair care products including shampoo and conditioners. At the oral hearing, the opponents

withdrew the grounds of opposition which relied on the mark SALON BASICS.

The opponents' evidence consists of certified copies of their trade-mark registrations for SALON SELECTIVES and SELECTIVES SALON (standing in the name of the first opponent); and the affidavit of Jack D. Pogue, President of the second opponent. The second opponent is a wholly owned subsidiary of the first opponent and was a registered user of the first opponent's marks until the rescindment of the registered user provisions of the Trade-marks Act (in 1993). In view of the second opponent's former status as a registered user, I will assume that its use of the first opponent's marks was at all material times under the direct or indirect control of the first opponent. I will continue to refer to the aforementioned marks as "the opponents' marks" even though the registrations stand solely in the name of the first opponent.

The applicant's evidence consists of the affidavit of Myles Robinson, President of the applicant company. Exhibit A-1 of Mr. Robinson's affidavit is a copy of a judgment rendered on consent by the Senior Prothonotary of the Federal Court of Canada (Court No. T-772-89, on May 2, 1990) in a case involving the present opponents, as plaintiffs, and two corporate defendants identified as Craig & Steele Inc. and Kempac Inc. (hereinafter "Kempac" will refer to both defendants). The present applicant acted as Kempac's sales agent at the time of the above-mentioned litigation. Exhibit A-1 forms part of the file record, however, the original of Mr. Robinson's affidavit is not in the file record. Either it was misplaced by the Office or the applicant neglected to file it with the Office. In any event, the opponent was served with a copy of Mr. Robinson's affidavit and kindly provided a copy to the Board. Neither party raised an objection to the Board considering the contents thereof as evidence.

The applicant raises an estoppel argument against the opponents based on the

above-mentioned consent judgment by the Senior Prothonotary. The crux of the consent judgment, as I understand it, is that the opponents herein would not object to Kempac's use of the mark SALON CREATIONS in association with shampoos so long as the mark appeared on a specific bottle get-up of the colour green. The opponents take the position that the above judgment was part of a multi-faceted settlement arrangement between the parties in litigation at that time. The opponents note that the present applicant does not claim to derive title to the applied for mark from Kempac, and therefore the consent judgment does not assist the applicant. I agree with the opponents. All that can be gleaned from the consent judgment is that the opponents were willing to tolerate Kempac's use of the mark SALON CREATIONS. In my view, the opponents have not thereby waived their rights to challenge the use of the mark SALON CREATIONS, or similar marks, by third parties such as the applicant. I mention in passing that the applicant's written argument advises that Kempac became bankrupt after the consent judgment issued.

The determinative issue in this proceeding is whether the applied for mark SALON CREATIONS & Design is confusing with the opponent's mark SALON SELECTIVES. 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 and the opponents' mark. 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), C.P.R.(3d) 308 (F.C.T.D).

The marks SALON SELECTIVES and SALON CREATIONS & Design are weak marks. The word SALON, when used in association with hair care products, is suggestive of a business that provides hair care services. The word SELECTIVES has a laudatory connotation. Thus, the opponents' mark as a whole suggests of a type of exclusivity or premium product used by hair care professionals: see *Helene Curtis, Inc. v. Belvedere International Inc.* (1994), 58 C.P.R.(3d) 270 at 273, para. f (TMOB). The applicant's mark SALON CREATIONS & Design in its entirety suggests a "new or original" shampoo formulated by hair care professionals, or a product used by professionals in hair care salons. Thus, the applied for mark also has a laudatory connotation although to a lesser extent than the opponents' mark. On a fair reading of Mr. Pogue's affidavit as a whole, and in the absence of cross-examination, I infer that the mark SALON SELECTIVES had, at all material times, acquired a significant reputation in Canada through sales under the mark and through advertising in magazines and on television. I also infer that the opponents' mark SELECTIVES SALON, targeted for French speaking consumers, also acquired a fairly significant reputation but to a lesser extent than its English equivalent. In this regard, the opponents' sales of hair care products under their marks SALON SELECTIVES and SELECTIVES SALON amounted to about \$3.4 million in the opponents' fiscal year 1988 rising steadily to about \$24.3 million in 1992. Sales for the fiscal year 1993 are projected to be \$25.8 million. Television advertising amounted to about \$9.7 million for the years 1989 to 1994. The applicant's evidence is that it expends about \$50,000 annually on advertising its products, however,

there is no indication of sales under its mark SALON CREATIONS & Design. On a fair reading of Mr. Robinson's affidavit as a whole, I am unable to infer that the applicant's mark SALON CREATIONS & Design acquired any more than a minimal reputation in Canada at any material time.

Of course, the parties' wares are essentially the same and would therefore travel through the same channels of trade. The opponents have been using their marks SALON SELECTIVES and SELECTIVES SALON since about October 1988 while the applicant did not begin to use its mark until after September 1992. Thus, the length of time that the marks in issue have been in use favours the opponents.

The marks SALON SELECTIVES and SALON CREATIONS & Design both begin with the word SALON and it is axiomatic that the first word or the first syllable in a trade-mark is far the more important for the purpose of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979), 26 C.P.R.(2d) 183 at 188 (F.C.T.D.). However, in a case such as this, where the first word is somewhat suggestive of the product itself, the importance of the first word is lessened. As discussed previously, both marks suggest similar laudatory ideas, that is, a product used by hair care professionals.

As a surrounding circumstance, the applicant relies on Mr. Robinson's evidence that "the bottles in which our [the applicant's] products are sold continue to be substantially different from those manufactured and sold by the opponents." However, since the parties are free to change the get-up of their products at any time, Mr. Robinson's aforementioned evidence regarding product packaging does not assist the applicant: see, for example, *Corby Distilleries v. Wellington County Brewery Ltd.* (1993), 52 C.P.R.(3d) 429 at 435, para. c (TMOB). Mr. Robinson also testifies that "use of the

word SALON by various manufacturers and vendors of similar wares is common in the industry.” Presumably, Mr. Robinson is asserting the word SALON is a common component of trade-marks in the hair care industry and that therefore the significance of any resemblance between the marks in issue is mitigated. If so, Mr. Robinson’s assertion is unsupported by any documentation whatsoever and I have not placed any reliance on it. Mr. Robinson also testifies that he had not received “any complaint as to any confusion or alleged confusion between the wares sold by the opponents and the wares sold by the applicant . . .” However, as noted previously, the applicant has failed to evidence use of its mark above the *de minimus* level. Thus, the fact that there have been no incidents of actual confusion is not surprising

Considering the above, I find that the applicant has not met the onus in it to show that its mark SALON CREATIONS & Design is not confusing with the opponents’ mark SALON SELECTIVES. Accordingly, the applicant’s application is refused.

DATED AT HULL, QUEBEC, THIS 28th DAY OF FEBRUARY, 1997.

Myer Herzig,
Member,
Trade-marks Opposition Board