

**IN THE MATTER OF AN  
OPPOSITION by Helena Rubinstein,  
société en nom collectif, to Application  
No. 819835 for the Trade-mark HR  
and design filed by Holt, Renfrew &  
Co., Limited**

**I The Pleadings**

On August 6, 1996, Holt, Renfrew & Co., Limited (the «Applicant») filed an application, based on use in Canada since at least as early as May 1995, to register the trade-mark HR and design as reproduced below:



in association with retail department store services (the “Services”). The application was advertised on March 26, 1997 in the Trade-marks Journal for opposition purposes.

After having obtained numerous extensions of time with the Applicant’s consent, Helena Rubinstein, société en nom collectif, (the “Opponent”) filed on February 26, 2001, a statement of opposition raising the following grounds of opposition:

- 1) « La requérante n’a pas employé comme il est dit ces services. » (as drafted in the statement of opposition)
- 2) The Mark is not distinctive and does not and cannot act to distinguish the Services from the services of the Opponent nor is it adapted so to distinguish them as :
  - a) by its transfer there were rights subsisting into two or more entities in the use of the Mark and those rights were exercised by those entities

- concurrently, the whole in contravention to section 48(2) of the Trade-marks Act (the “Act”);
- b) the Applicant has allowed third parties to use the Mark in Canada and in fact those third parties have used it outside the scope of legislative protection governing the use of a mark under license, the whole in contravention to the provisions of Section 50 of the Act.

The Applicant filed on April 27, 2001, a counterstatement denying each and every grounds of opposition.

The Opponent’s evidence consists of the affidavit of Manon Goudreau together with exhibits MG-1 to MG-3. There was an order issued on February 24, 2003 by the Registrar for the cross-examination of Ms. Gaudreau. No transcript was filed into the record.

The Applicant filed no evidence. Only the Applicant filed written submissions and there was no oral hearing requested.

## **II The Evidence**

Ms. Gaudreau has been an employee of the Opponent’s agent firm since March 1991. She is familiar with the database CDNameSearch having performed searches on such database on a daily basis. It contains all the trade-mark applications filed and registrations on the register. On April 29, 2002 she conducted a search using such database to locate all pending applications and registrations of trade-marks having the component “HR” in association with clothing or cosmetics. Twenty-three (23) trade-marks were located: thirteen (13) trade-marks owned by the Opponent, all in association with cosmetics and beauty products and related wares, and five (5) owned by the Applicant, all related with clothing.

She performed a second search to locate all the pending applications or registrations in the name of the Opponent: 86 trade-marks were located, all in association with cosmetics, perfume and other beauty products.

### **III Relevant Dates and Burden of Proof**

The legal onus is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant still has to prove that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The presence of this initial onus on the Opponent means that in order for an issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support a ground of opposition exist. [See *Redsand Inc. v. Dylex Ltd. (1997)*, 74 C.P.R. (3d) 373 (F.C.T.D.)]

I did reproduced in its original form, the first ground of opposition, as it lacks, to say the least, clarity. Does the Opponent argue that at the filing date of the application, the Applicant was not using the Mark in association with the Services, or does it plead that the Applicant did not use the Mark in association with the Services at the claimed date of first use. In any event, I do not have to extrapolate on the intention of the Opponent as I agree with the Applicant that the Opponent failed to meet its initial onus with respect to this ground of opposition. State of the register evidence is irrelevant to the issue raised in the first ground of opposition. Therefore the first ground of opposition is dismissed.

As for the second ground of opposition, the Opponent bears an initial evidentiary burden given that they rely on allegations of facts. It should be noted that the Opponent neither in its statement of opposition nor in its evidence provided further details. The Opponent had the burden to adduce evidence of facts supporting its contention that the Opponent's Mark is non-distinctive for the reasons outlined in its statement of opposition.

The Opponent failed to put forward evidence that would, in any way, substantiate its allegations of non-distinctiveness as pleaded and reproduced above. Accordingly, the Opponent did not meet its initial evidentiary burden with respect to its non-distinctiveness grounds of opposition. As such, these grounds of opposition are also dismissed.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I dismiss the opposition filed by the Opponent against the Applicant's application for the registration of the Mark, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 11th DAY OF JULY 2005.

Jean Carrière,  
Member,  
Trade-marks Opposition Board