IN THE MATTER OF AN OPPOSITION by Alberto-Culver Company to application No. 739,439 for the trade-mark GIAN ALBERTO CAPORALE filed by Gian Alberto Caporale S.A.M.

On October 20, 1993, the applicant, Gian Alberto Caporale S.A.M., filed an application to register the trade-mark GIAN ALBERTO CAPORALE based on use and registration in France (No. 93/465642) and proposed use in Canada. The applicant claimed priority based on its corresponding French application and the effective filing date of the present application is therefore April 21, 1993. The applicant's revised statement of wares reads as follows:

> savons; parfumerie, huiles essentielles, cosmétiques, nommément fragrances, perfumerie, rouge à llèvres, lotions pour le corps, poudre; lotions pour les cheveux, dentifrices; cuir et imitations du cuir, malles et valisses; parapluies, parasols et cannes; fouets et selles; vêtements et vêtements de sport, nommément costumes, vestes, blazers, survestes, parkas, pardessus, imperméables, cabans, pantalons, chemises, maille, cravattes, pulls, tee-shirts, casquettes, gilets, vestons en jeans, pantalons en denim, polos, pullovers, vestons, cardigans, blousons; chapellerie.

The application was advertised for opposition purposes on March 12, 1997.

The opponent, Alberto-Culver Company, filed a statement of opposition on February 3, 1998, a copy of which was forwarded to the applicant on February 19, 1998. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks of the opponent:

Trade-mark	Reg. No.	Wares
ALBERTO	168,693	Cosmetic and toiletry preparations, namely hair spray, hair shampoo, creme rinse, hair dressing, hair conditioner, hair color, antiperspirant, hand and body lotion, bath oil and bath oil beads.
ALBERTO	296,880	Footwear, namely shoes and boots.
	395,721	Hair care preparations, namely styling mousse, styling gel, spray gel, shampoo, conditioner, hair spray and spritz.
	429,330	Hair care preparations, namely shampoo.

	416,928	Hair care preparations, namely conditioners.
ALBERTO ALIVE	343,285	Hair care and toiletry preparations, namely, hair styling mousse, aerosol and non-aerosol hair spray, shampoo, conditioner, and hairdressing.
ALBERTO BALSAM	185,429	Cosmetic and toiletry preparations; namely, hair shampoo, hair conditioner and antiperspirant.
	399,226	Hair care preparations, namely styling mousse, styling gel, shampoo, conditioner, and hair spray.

ALBERTO LIGHT AND FRESH BALSAM	226,603	Cosmetic and toiletry preparations, namely, hair conditioner and shampoo.
ALBERTO LIGHTS	341,083	Hair care and toiletry preparations, namely, hair styling mousse, aerosol and non-aerosol hair spray, shampoo, conditioner, hair color and hairdressing.
ALBERTO NATURAL SILK	313,972	Cosmetic and toiletry products, namely hair sprays, shampoos, hair coloring preparations, hair conditioners, hair setting gels; anti-dandruff shampoos.
ALBERTO PLUS	415,295	Hair care preparations, namely shampoo, conditioner.
ALBERTO SCULPTURE	321,808	Hair preparations, namely hair gel, hair spray, hair styling.
ALBERTO SELECT	260,558	Hair preparations, namely, hair sprays, shampoos, hair coloring preparations, creme rinses, hair conditioners, hair setting lotions and gels; anti-dandruff shampoos.
ALBERTO VO5	320,129	Hair care preparations, namely, hairsprays, shampoos, hair conditioners, mousses, hot protein treatments, hot oil treatments and hairdressings.
Alberto VO5	116,323	(1) A concentrated hair and scalp conditioner and dressing containing lanolin. (2) Shampoo.
ALBERTO'S FOR BRUNETTES ONLY	170,861	Cosmetic and toiletry preparations, namely hair color.
ALBERTO'S POUR BRUNETTES SEULMENT	178,376	Cosmetic and toiletry preparations, namely hair color.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16 of the Act because, as of the applicant's filing date and effective filing date, the applied for trade-mark was confusing with the 18 trade-marks noted above previously used in Canada by the opponent. The third ground is that the applied for trade-mark is not distinctive because it is confusing with the trade-marks of the opponent. In its statement of opposition, the opponent also alleged that it filed an application to register its trade-mark ALBERTO VO5 NATURALS on March 17, 1995 and the present application was cited against it by the Examination Section.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Generosa Castiglione and Michael Stangel. As its evidence, the applicant submitted an affidavit of Kent Fincham. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The Opponent's Evidence

The Castiglione affidavit serves simply to introduce into evidence a photocopy of the Trade-marks Office file history for the opponent's application No. 778,045 for the trade-mark ALBERTO VO5 NATURALS.

In his affidavit, Mr. Stangel identifies himself as the President of Alberto-Culver

Canada, Inc., a wholly-owned subsidiary of Alberto-Culver Company and a licensed user of the 18 registered trade-marks relied on in the statement of opposition. Mr. Stangel states that his company has been a manufacturer and distributor of personal care products including various hair care products in Canada since at least 1970. According to Mr. Stangel, his company has used one or more of the 18 registered ALBERTO trade-marks since 1970 in association with such hair care products as shampoo, hair spray, mousse, hot protein treatment, hot oil treatment, styling gel, fixative, hairdressing and conditioner.

Mr. Stangel states that his company's ALBERTO hair care products have been sold through mass merchandisers, grocery stores and drugstores. Total sales of ALBERTO hair care products for the period 1975 to 1998 were in excess of $538 million with promotional and advertising expenditures for that same period being greater than $177 million. Mr. Stangel did not provide a breakdown of sales by particular product line or trade-mark.

A review of the various labels and advertisements appended as exhibits to his affidavit reveals that the opponent consistently uses the trade-mark ALBERTO on all of its hair care products, usually in a script form and often with other words. In particular, those materials show use of the word mark ALBERTO (Reg. No. 168,693), the design version of that mark (Regs. Nos. 395,721 and 399,226), the trade-mark ALBERTO BALSAM (Reg. No. 185,429) and the mark ALBERTO VO5 (Reg. No. 320,129). Otherwise, however, those materials show little, if any, use of the remaining registered marks.

The Applicant's Evidence

In has affidavit, Mr. Fincham identifies himself as a patent agent trainee with the firm representing the applicant. Mr. Fincham conducted several on-line searches and the exhibits appended to his affidavit comprise the results of those searches. The first search was of something identified by Mr. Fincham as "'Canada 411' an on-line telephone directory for businesses in Canada." Appended as Exhibit A to this affidavit is a listing of 38 references located. However, many of those references are for business names using the word ALBERTON, not ALBERTO. Furthermore, Mr. Fincham has not evidenced the nature of the business, if any, carried on in association with the various business names listed nor has he evidenced any awareness of those names by Canadians. Thus, in the absence of evidence of use of these business names, the search results are of little value in this proceeding.

Mr. Fincham also conducted a search through a web site identified as "InfoSpace Canada.com" which he says includes a business and telephone directory. Exhibit B to his affidavit comprises a listing of references revealed by that search which suffers from the same deficiencies as the "Canada 411" search.

Mr. Fincham also conducted a search of the records of the Canadian Trade-marks Office through the web site of the Canadian Intellectual Property Office. Exhibit C to his affidavit lists the results of that search which revealed ten registrations for trade-marks including the word ALBERTO only four of which were subsisting, three for 'inter alia'

clothing wares and none for hair care products.

Mr. Fincham also conducted a search through the web site of the United States Patent and Trademark Office. Exhibit D to his affidavit lists the results of that search which are irrelevant in the context of this proceeding.

Finally, Mr. Fincham conducted what he called a "world internet search" using two different search engines (Lycos and Alta Vista) for the word ALBERTO. Those searches located 446,303 and 328,255 references, respectively, but did not reveal anything of relevance to this opposition.

The Grounds of Opposition

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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.

As for Section 6(5)(a) of the Act, GIAN ALBERTO CAPORALE would be perceived as an individual's name and the applicant's trade-mark is therefore inherently weak. There being no evidence of use of that mark, I must conclude that it has not become known at all in Canada.

The word ALBERTO would be perceived as an individual's given name. Thus, the opponent's registered mark ALBERTO is inherently weak. Likewise, the registered marks comprising the word ALBERTO and a descriptive word such as LIGHTS, BALSAM or PLUS are not inherently strong marks. The most inherently distinctive of the opponent's registered marks is ALBERTO VO5.

Given the extensive sales and advertising of the opponent's ALBERTO marks, I am able to conclude that the trade-mark ALBERTO has become very well known throughout Canada in association with various hair care products. Since no breakdown was provided of sales effected in association with particular trade-marks, I am unable to ascribe any reputation of note for most of the remaining registered marks of the opponent. However, given the large number of materials appearing in exhibits appended to the Stangel affidavit that show use of the mark ALBERTO VO5, I can assume that it has acquired at least some reputation in Canada. Finally, there is no evidence of any use or reputation associated with the opponent's trade-mark ALBERTO for footwear.

The length of time the marks have been in use favors the opponent, at least in respect

of the marks ALBERTO and ALBERTO VO5. As for Sections 6(5)(c) and 6(5)(d) of the Act, there is no direct overlap between the wares of the parties. However, the applicant's statement of wares does include hair lotions which is closely related to the opponent's various hair care products. Furthermore, such items as soaps, perfumes and cosmetics are related to the opponent's hair care products since they all fall within the general category "personal care products." To that extent, there would, or could, be an overlap in the channels of trade of the parties. On the other hand, the remaining wares listed in the applicant's statement of wares are dissimilar to the opponent's products and presumably the related trades would be distinct.

As for Section 6(5)(e) of the Act, there is some resemblance between the applicant's mark GIAN ALBERTO CAPORALE and the opponent's mark ALBERTO in all respects since the latter constitutes the middle portion of the former. The resemblance is less marked in respect of the opponent's other registered marks since they include additional distinguishing wording or design matter.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence introduced by the Fincham affidavit to minimize the effect of any resemblance found between the marks at issue. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition

Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

As noted, the Fincham search revealed only four subsisting registrations for trade-marks incorporating the word ALBERTO, none of which covers hair care products. Four such registrations is insufficient to allow me to infer that any of those marks is in active use in the marketplace. Thus, the state of the register evidence is of no assistance in this case. As previously noted, the balance of the Fincham searches also does not assist the applicant's case.

The opponent submitted that its family of trade-marks which include the word ALBERTO increases the likelihood of confusion occurring in the present case. However, although the opponent has a number of registrations for such marks, apart from the trade-marks ALBERTO, ALBERTO VO5 and possibly ALBERTO BALSAM, it did not evidence any use of them. Thus, in accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.), the opponent has failed to establish its alleged family or series of marks.

The opponent evidenced the Trade-marks Office records for its application No. 778,045 for the trade-mark ALBERTO VO5 NATURALS to rely on the Examiner's citation of the present application against it. However, that tentative ruling by the Examiner is in no way binding on the Opposition Board in the consideration of the issues at hand. The applicant also

sought to rely on those records to argue that in answering the Examiner's citation, the opponent implicitly conceded that its mark ALBERTO VO5 NATURALS was not confusing with the applicant's mark GIAN ALBERTO CAPORALE. However, a review of the opponent's submission of August 31, 1995 (as applicant) on that file reveals no such concession. The opponent merely submitted that its application had priority in view of its earlier ALBERTO registrations.

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 reputation associated with the opponent's trade-mark ALBERTO, the connection between the applicant's personal care products and the opponent's hair care products and the fact that there is at least some resemblance between that mark and the applicant's mark, I find that the applicant has failed to satisfy the onus on it to show that its trade-mark is not confusing with the opponent's trade-mark ALBERTO in respect of the following wares:

> savons; parfumerie, huiles essentielles, cosmétiques, nommément fragrances, perfumerie, rouge à llèvres, lotions pour le corps, poudre; lotions pour les cheveux, dentifrices.

On the other hand, given the differences between the remaining wares of the applicant and the opponent's hair care products, I find that the applicant's mark is not confusing with the opponent's trade-mark ALBERTO in respect of those wares. The opponent's case is even weaker in respect of its remaining registered marks. Thus, the first ground is partially successful.

As for the second ground of opposition, the opponent has evidenced prior use of its trade-marks ALBERTO and ALBERTO VO5 but not any of the remaining registered marks. Thus, the second ground of opposition remains to be decided on the issue of confusion between those two marks and the applicant's mark as of the applicant's filing date and its effective filing date. For the most part, my conclusions respecting the first ground of opposition are also applicable to the second ground. Thus, I find that the second ground is successful in relation to the applicant's personal care products only.

As for the third 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. - February 3, 1998): 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.).

The third ground essentially turns on the issue of confusion. As before, my conclusions respecting the first ground of opposition are, for the most part, also applicable here. Thus, I find that the applicant's mark was confusing with the opponent's mark ALBERTO for the applicant's personal care products only. The third ground is therefore also partially successful.

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 in respect of the following wares:

> savons; parfumerie, huiles essentielles, cosmétiques, nommément fragrances, perfumerie, rouge à llèvres, lotions pour le corps, poudre; lotions pour les cheveux, dentifrices

and I otherwise reject the opponent's opposition. Authority for such a divided result may be found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).

DATED AT GATINEAU, QUEBEC, THIS 18th DAY OF FEBRUARY, 2004.

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