

**IN THE MATTER OF AN OPPOSITION  
by The Procter & Gamble Company to application  
No. 1,211,359 for the trade-mark COVER GIRL  
filed by 2797836 Canada Inc.**

---

**On April 23, 2004, the applicant, 2797836 Canada Inc., filed an application to register the trade-mark COVER GIRL for “latex rubber gloves” based on proposed use in Canada. The application was advertised for opposition purposes on October 13, 2004.**

**The opponent, The Procter & Gamble Company, filed a statement of opposition on March 14, 2005, a copy of which was forwarded to the applicant on April 5, 2005. 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 given the opponent’s previous use of its COVER GIRL registered trade-marks.**

**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 more than thirty of the opponent’s registrations for trade-marks comprising or including the words COVER GIRL primarily for various makeup, personal care and cosmetics products. Certain registrations cover additional wares such as eye wear, contact lenses and hair accessories. The opponent’s oldest registration is No. 118,851 for the trade-mark COVER GIRL for the following wares:**

- (1) liquid make-up.
- (2) Cosmetic preparation, namely, pressed powder.
- (3) Skin cream.
- (4) Cosmetics namely liquid make-up, pressed powder, encapsulated powder, brush-on blush, cream blush, cream liquid, cream and under eye cover stick; nails make-up, namely nail polish, nail strengthener, nail conditioner and nail polish remover; eye make-up, namely mascara, brow pencil, eyeliner, powder eye shadow, cream eye

shadow, eye colour pencil and eye make-up remover; and lip make-up namely lip blush and lipstick.

(5) Personal care products namely skin lotions.

(6) Toiletries namely fragrances, perfumes, colognes and personal deodorants; and personal care products namely skin creams.

**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 trade-mark was confusing with the opponent's various registered COVER GIRL marks previously used and made known in Canada by the opponent. The fourth ground 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 trade-mark was confusing with the opponent's various registered COVER GIRL marks for which applications had previously been filed. The fifth ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's previously used marks and because the applicant has permitted use of its mark by others contrary to the licensing provisions of Section 50 of the Act.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Saquib Vali, Harry Lake and Lorraine Devitt. As its evidence, the applicant submitted two affidavits of Danny Pascal, two affidavits of Tara-Starr McConnell and the affidavits of Richard Pascal, Harold Schiff and Lawrence Schiff. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.**

## **THE OPPONENT'S EVIDENCE**

**In his affidavit, Mr. Vali identifies himself as a Category Brand Manager with the opponent in charge of marketing the company's COVER GIRL brand of products. According to Mr. Vali, COVER GIRL cosmetics have been sold in Canada since 1960. The opponent sells such products as lipstick, eye makeup, nail polish, skin cream, blush, foundation and lotions as well as related tools such as brushes, curlers, sponges and sharpeners.**

**COVER GIRL brand products are sold throughout Canada to mass retailers such as Wal-Mart, Zellers, Shopper's Drug Mart, Pharma Plus and Jean Coutu. Annual sales in Canada have been in the range of millions of dollars for many years with total sales for the period 2003-2005 being in excess of \$234 million. Marketing expenditures for the eight-year period prior to the execution of Mr. Vali's affidavit (i.e. - May 3, 2006) were greater than \$80 million. Mr. Vali states that the opponent's marketing efforts have involved the use of famous models and movie stars in product ads for many years.**

**The Devitt affidavit serves to introduce into evidence photocopies of the particulars of the opponent's various COVER GIRL trade-mark registrations. Ms. Devitt also provides photocopies of COVER GIRL advertisements from a large number of magazines which support Mr. Vali's statement that the opponent uses famous models and movie stars in its ads. Although no evidence of Canadian circulation for these magazines was provided, I can take judicial notice that such well known publications as "Vogue" and "Cosmopolitan" are available in this country. Ms. Devitt also provides copies of advertising flyers from Zellers and Shopper's Drug Mart from the spring of 2006 which include ads for COVER GIRL products.**

**The balance of Ms. Devitt's affidavit deals with her investigations of various stores in the Toronto area. She visited drug stores and department stores where she was able to purchase COVER GIRL products from the cosmetics or beauty products department of each store. In the cosmetics department of a Shopper's Drug Mart store, Ms. Devitt was able to purchase disposable vinyl gloves under the trade-mark PRO FACTOR. In a Pharma Plus outlet, she located PLAYTEX brand latex gloves in a free-standing store rack in the cosmetics department. Ms. Devitt was able to purchase latex gloves, moisturizing gloves or cotton beauty gloves at several department or drug stores.**

**In his affidavit, Mr. Lake identifies himself as a licensed private investigator. On April 18, 2006, he attended at the premises of 2797836 Canada Inc. doing business as Compagnie Carry's Company in Montreal. He met with Danny Pascal who took him into a small showroom which contained various products for sale including batteries, socks, chocolate bars, shaving cream, hand soaps, skin creams and hair care products.**

#### **THE APPLICANT'S EVIDENCE**

**In his affidavit, Harold Schiff identifies himself as the President of the applicant. Appended as Exhibit 1 to his affidavit are photocopies of proposed marketing materials for the latex rubber gloves of this application. Those materials illustrate a female model similar in appearance and pose to those used in the opponent's COVER GIRL ads. The second page of the exhibit includes the wording "for safe grip of even the most delicate and fragile items."**

**In his first affidavit, Danny Pascal identifies himself as the President of Jenvali Holdings Inc. which he says carries on business from time to time with the applicant. Mr. Pascal describes a visit he had on April 18, 2006 from a Harry St. Jean at the applicant's Montreal offices. He took Mr. St. Jean into an office with a small showroom area displaying a variety of products. According to Mr. Pascal, at no time did Mr. St. Jean express any interest in gloves. Presumably, Harry St. Jean is the alias employed by the private investigator Harry Lake when he visited the applicant's premises.**

**In her first affidavit, Ms. McConnell states that she visited the opponent's website for its COVER GIRL product line and Exhibit 1 to her affidavit comprises a printed copy of all the products featured on the site. She notes that the site does not include any type of glove or any product which requires the use of a glove.**

**The remaining affidavits all relate to visits that the affiants made to various stores in Montreal, Toronto or Vancouver including Zellers, Wal-Mart, Canadian Tire, Pharmaprix, Jean Coutu, Shopper's Drug Mart, London Drugs and Safeway. The affiants consistently state that where a store had a cosmetics section, there were no latex rubber gloves. Such products were sold in the household goods section. If gloves were sold in a cosmetics section, they were vinyl or cotton gloves.**

#### **THE GROUNDS OF OPPOSITION**

**The first ground does not raise a proper ground of opposition. The mere fact that the opponent may have previously used its COVER GIRL trade-marks in Canada does not**

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.

Likewise, the fourth ground does not raise a proper ground of opposition. Although all of the opponent's applications underlying the more than thirty registrations relied on were filed prior to the applicant's filing date, none of those applications was pending as of the applicant's advertisement date as required by Section 16(4) of the Act. Thus, the fourth ground is also 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 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.). 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 pertinent of the opponent's registrations is No. 118,851 for the trade-mark COVER GIRL and thus a consideration of the issue of confusion as between that mark and the applicant's proposed mark will effectively decide the outcome of the second ground.

As for Section 6(5)(a) of the Act, the opponent's registered mark COVER GIRL is inherently distinctive in relation to makeup, cosmetics and the like. However, it is somewhat

suggestive or laudatory of those wares and is therefore not an inherently strong mark. However, given the widespread use and advertising of that mark for many years, I am able to conclude that it has become very well known throughout Canada.

The applicant's mark COVER GIRL is inherently distinctive in relation to latex rubber gloves and, given that it has no obviously suggestive connotation for such wares, it is an inherently stronger mark than the opponent's registered mark. Given the absence of evidence of use or advertising from the applicant, I must conclude that its mark has not become known at all in Canada.

As for Section 6(5)(b) of the Act, the length of time the marks have been in use clearly favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statement of wares and the statement of wares in the opponent's registration that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The wares of the parties differ. The opponent sells makeup, cosmetics, personal care products and related items whereas the applicant intends to sell latex rubber gloves. However,

the type of wares sold by both parties are, in many cases, sold through the same stores, particularly stores that have a cosmetics department. Furthermore, it is apparent that certain types of gloves are sold in cosmetics departments although the opponent was only able to evidence one instance where latex rubber gloves were sold in that section of a store. Thus, there is at least some overlap in the trades of the parties.

As for Section 6(5)(e) of the Act, the marks at issue are identical in all respects.

As a surrounding circumstance, I have considered the manner in which the applicant intends to market and advertise its wares as shown in Exhibit 1 to the affidavit of Harold Schiff. By using a fashion model to advertise its rubber latex gloves and by emphasizing that they can be used with “delicate and fragile items”, the applicant has underscored a possible connection between its mark and the opponent’s mark COVER GIRL.

In its written argument, the applicant sought to rely on two third party registrations for the trade-mark COVER GIRL for hosiery. However, those registrations were not introduced into evidence. In any event, 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. Thus, even if the two registrations were properly in evidence, the mere existence of two registrations owned by one company does not allow any meaningful inferences to be made regarding the possible common adoption of the mark COVER GIRL by others.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion on a balance of probabilities. That means that if the probabilities favor neither side, I must resolve the issue against the applicant. In view of my conclusions above, and particularly in view of the identity between the marks, the extent to which the opponent's mark has become known in Canada, the existence of at least some overlap in the trades of the parties and the applicant's own apparent proposed attempt to connect its mark to that of the opponent, I find that the applicant has failed to show on a balance of probabilities that its proposed mark COVER GIRL is not confusing with the opponent's registered mark COVER GIRL. At the very least, the average consumer will likely assume that the opponent has licensed, approved or otherwise sponsored the applicant's use of its mark COVER GIRL for latex rubber gloves. Thus, the second ground of opposition is successful.

As for 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. - March 14, 2005): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fifth ground of opposition essentially turns on the issue of confusion between the applicant's proposed mark and the opponent's mark COVER GIRL. For the most part, my conclusions respecting the second ground of opposition also apply to the fifth ground. Thus, I find, on a balance of probabilities, that the applicant has failed to show that its proposed mark was not confusing with the opponent's registered mark as of the filing of the opposition. Thus, the fifth ground is also successful and it is unnecessary to consider the remaining ground.

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 21<sup>st</sup> DAY OF FEBRUARY, 2008.

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