

## TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION by Dans  
un Jardin Inc. to application for registration No. 791493  
of the trade-mark LA JARDINIÈRE belonging to  
Mr. Yvon Garneau**

On August 30, 1995, Yvon Garneau (“the Applicant”) filed an application for registration of the trade-mark LA JARDINIÈRE (hereinafter “the Trade-mark”), bearing number 791493, used in Canada since at least as early as November 1990 in connection with a long list of wares and services and based on its projected use in connection with certain wares and services. I shall refer below to the wares and services to which these opposition proceedings relate.

The application for registration was published in the October 30, 1996, edition of the *Trade-Marks Journal* for the purposes of opposition. Dans un Jardin Inc. (the “Opponent”) filed a statement of opposition on December 30, 1996. Paragraph 1 (a) of the statement of opposition should be quoted here in order to define the scope of these proceedings:

[TRANSLATION]

1. The undersigned, DANS UN JARDIN INC., (hereinafter referred to as ‘the opponent’).... The grounds of opposition are as follows:

- (a) The applicant in the application wishes to obtain registration of the words  
“LA JARDINIÈRE” in connection with the following wares and services:

WARES: ... toilettries including after-shave lotions, eau de cologne, cream rinses, creams, deodorants, make-up for the face including false eyelashes, cheek rouge, talc, anti-wrinkle cream, eyebrow pencils, lip contour, eye-contour make-up, hair colouring, hairdressing products, namely, fixing lotion, hair lotion, shampoo, cream rinses, eye shadow, mascara, soap, skin cleansers, nail polish, toothpaste, mouth-wash, sun and tanning creams and lotions, toilet soap, skin lotions, nail brushes, hair brushes, combs, astringents, moisturizers, perfumes, essential oils, foam bath, hand cream, face cream, before-shave lotion, toilet water, hand and body lotions, body cream, lip balm, shaving cream, breath fresheners, manicure kits, cosmetic bags, make-up kits, sponges, travel kits, lipstick, anti-perspirants, atomizers, foundation

make-up, make-up brushes, devices and containers for diffusing essential oils, pumice stone, liquid soap, cleansing cream, moisturizing cream, fragrances, aromatic dried plants and flowers to dispel odours, insect repellent lotions ... [hereinafter the “Wares”]

SERVICES: Business of manufacturing, processing, importing, retail sales, ...

It should be noted that the Opponent did not indicate the services in respect of which it opposed the registration of the Trade-mark. The services listed in the application for registration of the Trade-mark does not cover the services of selling the Wares. However, I have reproduced a list of the services indicated in the Applicant’s application for registration:

[TRANSLATION]

Business of manufacturing, processing, importing, wholesale and retail sales, sampling at the sales locations, information, promotion, demonstration of food products, namely whole, crushed, ground and grated spices and fine herbs in powder, liquid, natural and/or mixed form, seasonings, condiments, marinades, dips, soups and creams in powder, solid and/or liquid form, in sachets or cans, stews in powder, solid and/or liquid form, in sachets or cans, sauces in powder, solid and/or liquid form, in sachets, or cans, pork tongues, whole and/or grated parmesan cheese, cheese curds, cheese in brine and/or salt, salted herbs, pasta, artificial and/or natural essences and extracts, namely white and brown vanilla, almond, maple, artificial smoke aroma (hickory), meat tenderizer, pepper, cinnamon, cooking salt, sea salt, table salt, low-sodium soups, low-sodium creams, low-sodium sauces, food flavourings, flavour extracts and aromas, dried herbs, flavour crystals, flavour crystals for liquid mixtures, food gelatine, maple syrup-based food products, namely syrup, butter, bread, candy, fudge, cakes, ice cream; buckwheat flour; system of concessions, franchises, kiosks, gondolas, administered by the company and/or by third parties in public places, shopping centres, bazaars, flea markets and exhibitions; operation of spice, seasoning and food product centres.

Information, promotion, demonstration, sales and advertising kiosks in public places, shopping centres, fairs, bazaars, flea markets, exhibitions for all products and services of third parties; home sales, advertising and delivery service of all products and services; service of assistance, promotion and sale of real property, publications, publicity announcements in newspapers, on television, billboards, advertising hoardings, signs attached to houses, for third parties wishing to purchase or sell their properties themselves; home-improvement stores, rental of tools for homes, gardens and nurseries, gifts, dry cleaning, furniture for the home, garden and office, swimming pools and garden accessories and accessories for cooking in the open air, bistro restaurants and bakery cafes; general store for the family and home; food store,

home food service, wholesale sales and retail stores for frozen and fast-frozen products and sales of frozen and fast-frozen products for home delivery and through telephone orders, catalogue orders using the distribution service of the Canada Post Corporation and other courier services; wholesale sales and retail stores for culinary and gastronomic specialties for home delivery and through telephone orders, catalogue orders using the distribution service of the Canada Post Corporation and other courier services; tanning studio; mortgage brokerage, insurance brokerage, real estate brokerage, business and financial brokerage service; reference and information service using data communication processes that use television or other video-style equipment to allow customers directly to receive information requested on their television sets or any other receiver installed in their homes; shopping centres containing stores and services; service of monitoring property, homes, businesses, offices and factories belonging to third parties; pet-walking, and plant-care, cleaning and household maintenance of homes and businesses, painting, paper-hanging and wall covering, carpet- and rug-laying, cleaning of carpets, floors and vertical and horizontal blinds, sanding of floors, washing of walls, ceilings, windows, store windows, closets, cleaning of upholstered furniture, hanging of draperies and vertical and horizontal blinds, stripping and upholstering of furniture; moving services; placement service for domestic or household maintenance staff, mother's helpers, childcare and healthcare workers; childcare service; service of tax returns, accounting and bookkeeping; secretarial and call-centre services, service of locating and forwarding items, not including letters, to third parties; service of harmonizing environmental elements in the home; operation of a purchasing club for products and services for third parties; service of references and directories for businesses, stores, products and services for third parties; survey, information, marketing, courses, counselling, education, training, consultation, market study, reference, information, promotion, development, solicitation, prospecting, direct marketing services by telephone, data communications, audio- and videocassettes, radio and television, door-to-door selling and by mail delivered by the Canada Post Corporation, newspapers, advertising, coupons, fax, posters, printed matter, catalogue, brochure, meetings, seminars and conferences of all products and services of third parties; development and administration of promotional programs on behalf of third parties with or without supplying products, articles or services as premiums to promote purchases of products and services of third parties; distribution of promotional samples delivered to third parties by the Canada Post Corporation; distribution of promotional samples on site at the sales points and places of business of third parties and on behalf of third parties; distribution on behalf of third parties of advertising material in single or multiple envelopes mailed in bulk or not addressed and delivered to third parties by the Canada Post Corporation; distribution of advertising premiums and bonuses, samples, catalogues and other promotional material or relating to the sale on behalf of third parties and delivered to third parties by the Canada Post Corporation; service of producing and distributing radio or television broadcasts, audio- and videocassettes to third parties; courses, seminars and lectures to introduce, educate, instruct and counsel third parties concerning any products and services; service of decorating, maintaining, managing and administering office buildings, shopping centres, apartment buildings, condominium buildings, commercial and

industrial buildings; services of purchasing, selling, exchanging, leasing, consulting and investment relating to real property; decoration of buildings, training and consultation service concerning the marketing of real property; establishment and brokerage of franchised operations, management of market studies for the location of franchises, negotiation of leases for franchised operations, design, construction, decoration and arrangement of retail sales outlets; consultation service concerning franchises; negotiation and preparation of franchises and related agreements; services of creating networks of independent distributors for the sale and promotion of any products and services of third parties; wholesale and retail sale, promotion and distribution of all products of third parties; real property brokerage services; organization of fairs and exhibitions; property valuation service; interior decoration service, property construction contractor, landscaping service, advertising agency, travel agency, operation of hardware, construction materials and home decoration stores; lamination and framing service; training in the operation of franchised establishments through lectures, seminars, courses and workshops; maintenance and supervision of franchises and related support services for the operation of franchised businesses; service of organizing, administering, managing, training, sales, sponsorship, whether of a network of independent distributors or otherwise, for all products and services and for payments of discounts, bonuses, royalties and fees to such a network, training, education and learning institute and school; centre providing assistance, training and technical and professional assistance for businesses; clothing stores for men, women and children; toy and game stores; book, music and video stores; development of exclusive sales and marketing plans and programs and financial programs for third parties; development of exclusive sales and marketing plans and programs and financial programs for networks of independent distributors.

The ground of opposition raised in the Opponent's statement of opposition may be summarized as follows:

- (A) The Opponent bases its opposition on the provisions of paragraph 38(2)(a) of the *Trade-marks Act* ("the Act") in that the application for registration of the Trade-mark does not comply with the requirements of section 30 of the Act because the Applicant could not have been satisfied that he was entitled to use the Trade-mark in connection with the Wares because the Applicant was or should have been familiar with the Opponent's trade-marks listed below because the wares, which are described below, sold in connection with the Opponent's trade-marks were distributed in more than 70 sales outlets in Canada as of the date on which the application was filed.
- (B) The Opponent bases its opposition on the provisions of paragraph 38(2)(b) of the Act in that the Trade-mark was not registrable in light of the provisions of

paragraphs 7(b) and 12(1)(d) of the Act because the Applicant's use of the Trade-mark constituted unfair competition by drawing the attention of the public to his goods in such a way as to cause confusion in Canada with the registered trade-marks and business name of the Opponent.

(C) The Opponent bases its opposition on the provisions of paragraph 38(2)(c) of the Act, in that the Applicant is not the person entitled to registration of the trade-mark in light of subsection 16(3) of the Act concerning registration of the Trade-mark on the basis of projected use since as of the date on which the application for registration of the Trade-mark was filed, namely August 30, 1995, it was confusing with the Opponent's trade-marks, described below, previously used in Canada by the Opponent or by its authorized users, as well as with the name of the Opponent's business used in Canada since 1983.

(D) The Opponent bases its opposition on the provisions of paragraph 38(2)(d) of the Act, in that the Trade-mark is not distinctive because it is not really capable of distinguishing the wares of the Applicant, as listed in his application for registration.

The Opponent alleges in its statement of opposition that it is the owner of the following registered trade-marks:

DANS UN JARDIN	TMA 264127
DANS UN JARDIN, PARFUMERIE & DESSIN	TMA 442508
DANS UN JARDIN	TMA 369781
DANS UN JARDIN ET DESSIN	TMA 378925
LA BEAUTÉ DANS UN JARDIN	TMA 364098

(hereinafter referred to together as the "Opponent's trade-marks") all used in Canada by itself or by the legal entities that preceded it or by an authorized user in connection with the following wares and services, among others:

[TRANSLATION]

WARES: Perfumes, toothpaste, creams, lotions and soaps for the hands, body and face, astringent preparations for the face and body, moisturizers, sun-protection and tanning preparations, powders for the face and body, lipstick, eyebrow pencils, eyelash pencils, make-up, eyelash make-up, clay face-masks,

dry softening oils, gels for the face and around the eyes, powders, essential oils used in the process of manufacturing perfumes and cosmetics, bath salts, bath foams, bath oils, milks for the body, deodorants, before- and after-shave lotions, shower gels, hair dyes, hair lotions, hair rinses, hair conditioner preparations, shampoos, soap, eau de cologne, toilet water, fragrances, infusions, boxes for infusions, ribbons, cosmetic kits, paper and plastic bags and boxes of various sizes (hereinafter referred to as the “Opponent’s wares”).

SERVICES : Operation of stores specializing in the sale of articles for the bath and perfume products (hereinafter referred to as the “Opponent’s services”).

On March 6, 1997, the Applicant filed a counter statement of opposition in which he denies each and every one of the grounds of opposition set out above.

Pursuant to Rule 41, the Opponent filed the affidavits of Jean-Claude Gagnon, Francine Raymond, Myriam Nadeau and Marjolaine Gagnon and a certificate of renewal for the trade-mark DANS UN JARDIN, registration number TMA 264127; a photocopy, signed [TRANSLATION] “true copy” by the then-agents of the Opponent, a certificate of authenticity of registration certificate number TMA 264127 and of registration certificate number TMA 442508 for the trade-mark DANS UN JARDIN, PARFUMERIE & DESSIN; and the original of a notice issued by the trade-marks assignment section dated February 16, 1996, confirming that the Opponent was registered as the owner of the Opponent’s trade-marks.

On May 27, 1999, the Applicant filed an amended application for registration of the Trade-mark and it was accepted by the Registrar on July 8, 1999. The amendments affected the description of certain services and were designed to settle an opposition filed by the Canada Post Corporation. It is important to note that the Wares still appear in the amended application for registration. The Opponent did not therefore amend its statement of opposition.

There is in the record a catalogue entitled “catalogue classique 1995-1996”, which is not attached to any of the above-mentioned affidavits. Furthermore, none of these affidavits refers to the catalogue. I accordingly exclude this document from the evidence in the record since it was not filed in accordance with the rules of evidence set out in Rule 41 [see *Rogers Broadcasting Ltd. v.*

*Chum Limited (1990), 34 C.P.R. (3d) 102, and Hebdo Science v. John Labatt Ltd. (1989), 22 C.P.R. (3d) 378*]. In any event, this catalogue could not have been very useful to the Opponent because it could not be used to establish the use of the Opponent's trade-marks in connection with the Opponent's wares because this evidence must meet the requirements set out in section 4(1) of the Act. In fact, the appearance of a trade-mark on advertising material cannot constitute evidence of use of the trade-mark in connection with the wares [see *Clairol International Corp. v. Thomas Supply & Equipement Co. Ltd. (1968), 55 C.P.R. 176*]. Evidence of use of a trade-mark in connection with wares must be adduced by showing that the trade-mark appeared on the wares or their packaging at the time the ownership of the said wares was transferred. [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc. (1980), 53 C.P.R. (2d) 62*.]

The Applicant filed the affidavit of Raymond Gorsy. None of the deponents was examined. The parties filed written arguments. The Applicant requested a hearing and notice to this effect dated August 30, 2003, was sent to the parties. Only the Opponent was present at the hearing by means of a conference call.

Jean-Claude Gagnon described himself as the President of the Opponent and President and CEO of Parfumeries dans un jardin Canada Inc. ("Parfumerie"), a subsidiary of the Opponent. He alleged that the Opponent's Trade-marks have always been used by the Opponent, the legal entities that preceded it or by its authorized users to identify the Opponent's wares and this has been the case since at least or as early as November 1986. This statement is a finding of law and is accordingly inadmissible in evidence. [See *Conde Nast Publications Inc. v. Union des Éditions Modernes (1979), 46 C.P.R. (2d) 183*.]

He expressed the view that the use of the Trade-mark in connection with the Wares, which are of the same kind as the Opponent's wares, may be confusing with the Opponent's trade-marks. Once again this is a finding in law that is inadmissible in evidence. The Registrar must determine from the evidence included in the record whether there is a risk of confusion between the Trade-mark and the Opponent's trade-marks in connection with the Wares.

Mr. Gagnon alleged that Parfumeries was a network of 54 perfume stores across Canada, primarily in Quebec. He alleged that the name DANS UN JARDIN had become very well known in Canada and was a sign of extraordinary quality and service to customers in the area of sales of perfume, bath and body-care products. There was no evidence concerning sales figures, spending on advertising or any other relevant evidence to support this allegation.

Ms. Raymond is the Senior Vice-President, Franchisee Services, of Parfumeries and she has worked for this company since 1983. Her affidavit contained identical allegations to those of Mr. Gagnon concerning the use of the Opponent's trade-marks, the extent to which the name DANS UN JARDIN is known and the confusion with the Opponent's trade-marks that could be caused by the use of the Trade-mark. For the reasons that I expressed earlier concerning Mr. Gagnon's affidavit, I find that this evidence is inadmissible. She stated that she had personal knowledge of the use of the Opponent's trade-marks although she did not file relevant evidence in support of this allegation.

Myriam Nadeau described herself as the franchisee and owner of two Parfumeries dans un Jardin. She said that she was a user of the Opponent's trade-marks authorized by the Opponent. She alleged that the Opponent's trade-marks had been used by her since June 1988. There is no evidence that the Opponent's trade-marks appear on the Opponent's wares or their packaging when ownership of the said wares is transferred. Her affidavit also contained the same allegations as are found in Mr. Gagnon's affidavit concerning the extent to which the name DANS UN JARDIN is known and the confusion with the Opponent's trade-marks that could be caused by the use of the Trade-mark. This evidence is also inadmissible for the reasons stated above.

Me. Marjolaine Gagnon is a lawyer with the firm that acted as the Opponent's agent at the time the affidavit was signed. She attached to it a copy [TRANSLATION] "certified true" by her firm, which is standard practice in Quebec, of a photocopy of a certificate of authenticity of certificate of registration number TMA 264127, for the trade-mark DANS UN JARDIN, and of certificate of registration number TMA 442508 for the trade-mark DANS UN JARDIN, PARFUMERIE & DESSIN. This was a case where the exhibits to an affidavit were not certified by the commissioner for oaths when the deponent swore the statement. I accept this evidence since it



does not cause any harm to the Applicant. [See *Time Inc. v. Moisescu* (1990), 31 C.P.R. (3d) 255.] Furthermore, the Registrar can check the state of the register to confirm the existence of the registrations of the trade-marks relied upon by the Opponent to support the ground of opposition based on paragraph 12(1)(d) of the Act. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410.]

Raymond Gorsy described himself as a trade-marks manager in a business relationship with the Applicant. He consulted the dictionary *Le Robert, dictionnaire de la langue française*, and filed relevant extracts concerning the word JARDIN. He alleged that he could not find any resemblance between the Trade-mark and the Opponent's trade-marks. For the reasons stated above, this statement is a finding of law that is inadmissible in evidence.

He alleged that the Opponent was attempting to acquire a monopoly over the word JARDIN when it was a word in the dictionary and therefore in the public domain.

The relevant date for analyzing the different grounds of opposition varies according to the ground of opposition in question. Thus, for the grounds of opposition based on section 30 of the Act, the relevant date is that on which the application was filed (August 30, 1995) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263]. For the ground of opposition based on paragraph 12(1)(d) of the Act, the relevant date is the date of the decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (CAF)]. Where the ground of opposition is based on subsection 16(3) of the Act, the date on which the application for registration is filed is the benchmark, as indicated in the said section (August 30, 1995). Finally, the relevant date for considering the ground of opposition based on the Trade-mark's lack of distinctiveness is generally recognized as being the date on which the opposition is filed (December 30, 1996). [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at page 130, and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.*, *op. cit.*]

In proceedings relating to an opposition to the registration of a trade-mark, the Opponent must adduce sufficient evidence concerning the grounds of opposition on which it relies to make it clear

that there are facts supporting the grounds of opposition. If this is done, the onus of proof shifts to the Applicant, who must satisfy the Registrar that the grounds of opposition should not prevent the registration of his trade-mark [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, and *John Labatt Ltd. v. Molson Companies Limited*, (1990), 30 C.P.R. (3d) 293].

From the evidence summarized above, it appears that the Opponent has not discharged its initial onus of proof with respect to grounds of opposition (A) and (C) described above. In fact, there is no evidence in the record concerning the Applicant's knowledge of the Opponent's trade-marks and of the use of the Opponent's trade-marks at the time it filed its application for registration of the Trade-Mark. These grounds of opposition are therefore rejected.

The Opponent raised as a ground of opposition the fact that the Trade-mark is not registrable in light of the provisions of paragraphs 7(b) and 12(1)(d) of the Act. The grounds of opposition are listed in subsection 38(2) of the Act. The "non-registrability" of a trade-mark refers to the prohibitions contained in sections 9 to 15 of the Act inclusive. [See *Minerva Beauty Supplies Ltd. v. Lucky Ltd.*, (1993), 49 C.P.R. (3d) 409, and *Massimo De Berardimis et al v. Decaria Hair Studio Ltd.*, (1984), 2 C.P.R. (3d) 319.] Paragraph 7(b) of the Act is a codification of the civil remedy for the tort of substitution better known as "passing off". [See *Ray Plastics Ltd. v. Dustbane Products Ltd.* (1990), 33 C.P.R. (3d) 219 et *Big Sisters Association of Ontario v. Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177.] In the circumstances, the Opponent cannot refer to section 7 of the Act in opposition proceedings in order to maintain that the Trade-mark is not registrable within the meaning of paragraph 38(2)(b) of the Act. [See *Cuprinol Ltd. v. J.S.Tait & Co. Ltd.*, (1974), 19 C.P.R. (2d) 176.] However, we must still consider this ground of opposition in light of the provisions of paragraph 12(1)(d) of the Act.

To determine whether the use of the Trade-mark is likely to cause confusion with the Opponent's trade-marks, I must follow the procedure set out in section 6 of the Act, which reads as follows:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances

described in this section.

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

(b) the length of time the trade-marks or trade-names have been in use;

(c) the nature of the wares, services or business;

(d) the nature of the trade; and

(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

It is clearly established that the list of circumstances in section 6(5) of the Act is not complete and that it is not necessary to give the same weight to each of these tests [see, for example, *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. The Honourable Cattanach J. described the confusion test

as follows in *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975)*, 25 C.P.R. (2d) 1:

To determine whether two trade-marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade-Marks or the Judge must assess the normal attitudes and reactions of such persons.

In considering the similarity of trade-marks it has been held repeatedly that it is not the proper approach to set the marks side by side and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression. I therefore propose to examine the two marks here in dispute not for the purpose of determining similarities and differences but rather to assess the attitude of the average reasonable purchaser of the wares as a matter of first impression.

In light of these principles, I shall review the circumstances listed in subsection 6(5) of the Act.

i            inherent distinctiveness of the trade-marks

The word part of the parties' trade-marks has essentially the same degree of distinctiveness. However, the Opponent's trade-marks DANS UN JARDIN, PARFUMERIE & DESSIN TMA 442508 and DANS UN JARDIN ET DESSIN TMA 378925 have a certain inherent distinctiveness as a result of the graphic part.

ii           length of time the trade-marks have been in use

As indicated above, there is no evidence of the use of the Opponent's trade-marks in the record. The Applicant did not adduce any evidence of the use of his trade-mark in connection with any wares or services described in his amended application for registration.

iii nature of the wares or services

There is a connection between the Applicant's Wares and the Opponent's wares. Furthermore, the following wares that appear in the Applicant's amended application for registration are also closely related to the Opponent's wares:

Soap, all-purpose cleansers in liquid or powder form, paper laundry bags, waterless hand cleanser, deodorants, food flavourings, mouthwash, combs, paper bags, assorted vinyl bags and metal boxes.

The connection between the Opponent's services and the services listed below should also be noted:

Wholesale and retail business of flavour extracts and aromas.

iv nature of the trade

It is difficult to extrapolate concerning the nature of the Applicant's trade because of the wide array of wares and services listed in his application for registration. There is no evidence of the use of the Applicant's Trade-mark or commercial activities in connection with the Trade-mark. I must accordingly refer to the list of wares and services set out in the amended application for registration and determine whether there is any similarity between the nature of the Opponent's business and the commercial activities described in the amended application for registration [see *Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3* and *Miss Universe Inc. v. Dale Bohna (1984), 58 C.P.R. (3d) 381*]. This similarity was confirmed in the previous paragraph.

v degree of resemblance between the trade-marks

The word JARDINIÈRE is defined in the dictionary *le petit Robert dictionnaire de la langue française* as follows:

[TRANSLATION]

1. Furniture holding or containing a vessel in which ornamental plants or indoor flowers can be grown. Wooden, cement, plastic or brick container in which house plants or shrubs can be grown.
2. Dish consisting of a mixture of cooked spring vegetables (essentially carrots and peas).

...

Adj. 1. Relating to gardens.

...

There is a certain phonetic similarity between the Trade-mark and the word JARDIN, which is the distinctive part of the Opponent's trade-mark DANS UN JARDIN. Furthermore, the word JARDINIÈRE means "relating to gardens". There is accordingly a resemblance in terms of the idea suggested by the Trade-mark and the Opponent's trade-mark DANS UN JARDIN.

Given our analysis of the circumstances listed above in light of the evidence included in the record by the parties, I find that the Applicant did not discharge his onus of establishing on a balance of probabilities that there is no risk of confusion in the average consumer with an imperfect memory between the Trade-mark and the trade-marks DANS UN JARDIN TMA 264127, DANS UN JARDIN, PARFUMERIE & DESSIN TMA 442508, DANS UN JARDIN TMA 369781 and DANS UN JARDIN ET DESSIN TMA 378925 in respect of the wares and services listed below.

Because of my conclusions concerning the risk of confusion between the Trade-mark and the Opponent's trade-marks, I should conclude that the Trade-mark is not distinctive within the meaning of section 2 of the Act because it is not actually able to distinguish the wares and services listed below from the Opponent's wares and services.

Thus, the grounds of opposition based on sections 12(1)(d) and 2 of the Act are accepted in part and, because of the powers delegated to me by the Registrar of Trade-marks under the provisions of section 63(3) of the Act and applying the principles set out in *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH 10 C.P.R. (3d) 482*, I dismiss the Applicant's application for registration with respect to the following wares and services:

WARES: toiletries namely after-shave lotions, eaux de cologne, cream rinses, creams, deodorants, face make-up, namely false eyelashes, cheek rouge, talc, anti-wrinkle cream, eyebrow pencils, lip contour, eye-contour make-up, hair colouring, hairdressing products, namely fixing lotion, hair lotion, shampoo, cream rinses, eye shadow, mascara, soap, skin cleansers, nail polish, toothpaste, mouthwash, sun and tanning creams and lotions, toilet soap, skin lotions, nail brushes, hair brushes, combs, astringents, moisturizers, perfumes, essential oils, foam bath, hand cream, face cream, before-shave lotion, toilet water, hand and body lotions, body cream, lip balm, shaving cream, breath fresheners, manicure kits, cosmetic bags, make-up kits, sponges, travel kits, lipstick, anti-perspirants, atomizers, foundation make-up, make-up brushes, devices and containers for diffusing essential oils, pumice stone, liquid soap, cleansing cream, moisturizing cream, fragrances, aromatic dried plants and flowers to dispel odours, soap, all-purpose cleansers in liquid or powder form, paper laundry bags, waterless hand cleanser, deodorants, food flavourings, mouthwash, combs, paper bags, assorted vinyl bags and metal boxes.

SERVICES: Wholesale and retail business of flavour extracts and aromas,

all in accordance with the provisions of section 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 6th DAY OF NOVEMBER 2003.

Jean Carrière

Member

Trade-marks Opposition Tribunal