



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2012 TMOB 62**  
**Date of Decision: 2012-03-27**

**IN THE MATTER OF AN OPPOSITION  
by The Body Shop International plc to  
application No. 1,339,475 for the trade-  
mark THE BODY DELI in the name of  
Margaret D. Skarin**

[1] On March 15, 2007, Margaret D. Skarin (the Applicant) filed an application to register the trade-mark THE BODY DELI (the Mark) on the basis of her use since November 24, 2001 in association with:

Bath, body and spa products, namely, soaps, lotions, toners, spritzers, massage oils, non-medicated sea salt for the bath and body scrub, body powder, essential oils for personal use, facial masks, cleansers, shampoos, conditioners, and moisturizer (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 17, 2007.

[3] On February 26, 2008, The Body Shop International plc (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) the application does not comply with s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) as the Applicant had not used the Mark in Canada in association with the Wares;

- (b) the Mark is not registrable, pursuant to s. 12(1)(d) of the Act, because it is confusing with the Opponent's registration No. TMA288,081 for THE BODY SHOP;
- (c) the Applicant is not the person entitled to registration of the Mark, pursuant to s. 16(1)(a) and 16(1)(c) of the Act, because at the date of alleged first use, the Mark was confusing with the Opponent's previously used trade-mark and trade-name THE BODY SHOP; and
- (d) the Mark is not distinctive, pursuant to s. 2 of the Act, since it cannot distinguish and is not adapted to distinguish the Wares from the wares and services of the Opponent.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] The Opponent filed affidavits of Deborah St. Clair and Byron Thom as its evidence. Both Ms. St. Clair and Mr. Thom were cross-examined and the transcripts and answers to undertakings filed. The Applicant filed as its evidence an affidavit of Elenita Anastacio. The Opponent filed as its reply evidence an affidavit of Winnie Chan. Ms. Chan was cross-examined and the transcript, exhibit, and answers to undertakings filed.

[6] Only the Opponent filed a written argument. Both parties attended a hearing held on March 8, 2012.

#### Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] The material dates with respect to the grounds of opposition are:

- s. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(1) of the Act - the date the application was filed; and

- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Section 30 Ground of Opposition

[9] The Opponent has alleged in its statement of opposition that the Applicant has not used the Mark in Canada in association with the Wares. The Opponent's initial burden is lighter respecting the issue of non-conformance with s. 30(b) since the facts regarding the Applicant's use are most easily known to the Applicant [*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B) at 89].

[10] The evidence of the Opponent's affiant, Deborah St. Clair, Senior Director of Franchisee Relations with The Body Shop Canada Inc. (Body Shop Canada), provides the following:

- Body Shop Canada is a wholly owned subsidiary of the Opponent and has used THE BODY SHOP mark and trade-name under license since opening its first store in Canada in 1980 (paras. 1-2, 7). Ms. St. Clair's responsibilities include the operations of Body Shop Canada's franchise partners including retail, finance, supply chain, processes and policies (St. Clair cross-examination, Q. 6).
- Ms. St. Clair has been employed by Body Shop Canada for over seventeen years (para. 1).
- As part of her job she is familiar with competitive wares and services in Canada (para. 15). However, prior to being made aware of the application through the opposition proceeding, Ms. St. Clair was not aware of the Mark (para. 15).

- After becoming aware of the subject application, Ms. St. Clair reviewed the Applicant's web-site which includes photographs and/or depictions of various cosmetic products featuring the Mark and attaches print-outs of the web-site to her affidavit (Exhibit H).

[11] While an opponent's evidential burden is lighter with respect to s. 30(b), the opponent must still adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support the issue exist [*John Labatt Ltd., supra* at 298-300]. The fact that once becoming aware of the Mark, Ms. St. Clair was able to visit the Applicant's web-site which features the Mark and advertises on-line sales, suggests that the Mark could have been in use on November 24, 2001, with Ms. St. Clair simply being unaware. Ms. St. Clair's evidence does not raise doubt as to whether the Mark was in use in Canada as of November 24, 2001. Therefore, the Opponent has not provided evidence from which I can reasonably conclude that the facts to support this ground of opposition exist. The Opponent has not met its burden in respect of this ground.

[12] The Opponent relied on the *CTV Limited v. InterMedia Vibe Holdings, LLC* (2010), 88 C.P.R. (4th) 188 (T.M.O.B.) at 196-197 case, to support its position that the evidence of Ms. St. Clair is sufficient to meet its burden. I find this case to be distinguishable for two reasons. First, in addition to the fact that the affiant in this case indicated he was familiar with television shows broadcast in Canada and was not aware of the applicant's television program, he had also reviewed a database which he said listed all television programming available in Canada and did not find a listing for it. Second, unlike the subject opposition, he was not aware of the applicant's television program at any time.

[13] For the reasons set out above, this ground of opposition is dismissed.

Section 12(1)(d) Ground of Opposition

[14] The Opponent has pleaded that the Mark is confusing with the following registered trade-mark:

<b>Registration No.</b>	<b>Trade-mark</b>	<b>Wares and Services</b>
TMA288,081	THE BODY SHOP	<p>Wares:</p> <p>(1) Skin cleansing preparations.</p> <p>(2) Essential perfume oils; toilet water, hair care products, namely shampoo, hair cleanser, hair treatment wax, hair conditioner, rinse preparations, scalp oil, hair oil, hair lotion, hair-dressing, and hair colouring preparations; and cosmetics and skin care products, namely bathoil, herbal bath mixes, bath salts, skin scrub masks preparations, clay mask preparations, astringent preparations, skin tonic preparations, skin cream lotions, moisturizing creams, and lotions, hand creams and lotions, suntan creams, oils and lotions, lip protective preparation, skin balm, foot balm, skin oil, massage lotion, shaving cream, vegetable body scrubbers, and sponges.</p> <p>Services:</p> <p>(1) Operating a retail store specializing in the sale of cosmetics, toilet preparations, essential perfume oils, and the products for the care of skin and hair.</p>

[15] I have exercised my discretion and checked the register to confirm that this registration is extant [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[16] The test to determine the issue of confusion is set out in s. 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become

known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824 at para. 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

The criteria in s. 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

#### *Degree of Resemblance Between the Trade-marks*

[17] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece, supra* sets out that resemblance is defined as the quality of being either like or similar (para. 62) and that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para. 64). In this case, there is nothing striking or unique about the words “the body” given that the wares and services of each party relate to body care products [see, for example, *Molson Companies Ltd. v. John Labatt Ltd.* (1994), 58 C.P.R. (3d) 527 (F.C.A.)]. Therefore, I find that there is at most only a fair degree of resemblance between the marks in appearance or sound. While the first component of a mark is often considered more important for the purposes of distinction, when it is common, descriptive or suggestive, the significance of the first component decreases [*Conde Nast Publications Inc. v.*

*Union des editions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Aloette Cosmetics Inc. v. Medique Cosmetics Inc.* (2006), 51 C.P.R. (4th) 196 (T.M.O.B.) at 203-204].

[18] Furthermore, I find that there is only a slight degree of resemblance between the ideas suggested by each mark. BODY SHOP is a double entendre consisting of an every day expression used in a creative way to suggest that the products are for the repair or improvement of the body [see *Canadian Oxford Dictionary (2nd ed)* at Exhibit B to the Thom affidavit ; *Body Shop International plc v. Bodyline Cosmetics Ltd.* (1995), 61 C.P.R. (3d) 400 (T.M.O.B.) at 403]. By way of contrast, the Mark does not suggest the same thing since DELI has a very specific meaning as set forth in the affidavit of Byron Thom, a summer student employed by the Opponent's agent. The dictionary definitions provided indicate that the word DELI is short for delicatessen which is defined as a place selling cooked meats, cheeses, and delicacies or such foods collectively [see, for example, the excerpts from the *The Concise Oxford Dictionary (7th ed)* and *Canadian Oxford Dictionary (2nd ed)* at Exhibit B to the Thom affidavit]. Furthermore, the photos of delis attached to the Thom affidavit show a very particular format whereby food is displayed by type under glass. As such, the Mark does not suggest the same idea as that of the mark THE BODY SHOP rather it suggests an array of specialty products on display and available for the body, in much the same way a delicatessen displays a variety of foods, including fine foods.

[19] In its written submissions and at the hearing, the Opponent argued that the marks resemble each other because DELI and SHOP both describe retail establishments and that a DELI is a type of SHOP. I do not find this reasoning persuasive as any resemblance occurring because a deli is a type of shop would not be apparent as a matter of first impression.

[20] Given the differences in appearance, sound and meanings between THE BODY DELI and THE BODY SHOP when considered as a whole, as a matter of first impression, the marks cannot be said to be similar.

#### *Remaining Section 6(5)(e) Factors*

[21] In *Masterpiece*, Rothstein J. stated at para. 49 that:

... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar...

[22] I find that both parties' marks have a similar degree of inherent distinctiveness. While I agree that the other s. 6(5) factors favour the Opponent, these factors are not sufficient to result in a likelihood of confusion. While the parties' wares are the same and THE BODY SHOP mark is well known as evidenced by the significant sales of over \$90 million per year (St. Clair affidavit, para. 9), over 115 stores located on prominent retail streets and in large shopping malls in Canada (paras. 5, 10), annual advertising expenditures of over \$500,000 since 2001 (para. 14) and long standing use in Canada since 1980 (para. 7), these factors are not sufficient to overcome the lack of similarity between the marks.

*Evidence of Third Party Use of BODY*

[23] The Applicant filed as its evidence an affidavit of Elenita Anastacio, a trade-mark searcher employed by its agent. As Exhibit B Ms. Anastacio attaches some of the results of a preliminary Nuans search. I note that the Applicant did not make submissions on which of the trade-names identified were relevant. A review of a sampling of the results indicates that Exhibit B is of limited relevance as most entries appear to relate to automobile body shops or entities in the health and fitness field. As I have found this exhibit to be of very limited relevance, it is not necessary for me to consider the evidence of the Opponent's affiant Winnie Chan who performed investigations to determine whether some of the trade-names located were in use. Likewise, the domain name search attached as Exhibit C to Ms. Anastacio's affidavit which states that there are 136,894 domain names consisting of or including BODY is not relevant as there is no indication of how many of the corresponding web-sites are active and accessed by Canadians.

[24] Exhibits A and D to Ms. Anastacio's affidavit include particulars of various trade-mark applications and registrations including BODY. Of the trade-mark registrations attached to Ms. Anastacio's affidavit, well over 20 include BODY as a dominant element and are for use in association with body care products such as BATH & BODY WORKS (TMA580,337); BODY & EARTH (TMA464,430); BODY AMERICA (TMA712,830); BODY CANDY



(TMA657,474); BODY FITNESS (TMA524,547); BODY GELATO (TMA649,600) and BODY BISTRO (TMA660,529).

[25] The Opponent argues that in determining the scope of protection to be afforded to THE BODY SHOP mark, the only relevant trade-marks and trade-names are those combining the words BODY or THE BODY with a word denoting a type of retail establishment and covering cosmetics and body care products. While I agree that these would be the most relevant trade-marks/trade-names, the fact that BODY is a common dominant element for trade-marks covering body care and related products will influence the degree to which consumers pay attention to the second component of each parties' trade-mark which reduces the likelihood of confusion [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.T.D.) at 359-361; *Bodyline Cosmetics, supra*; *RPM, A Partnership v. American Biltrite Intellectual Properties*; (2011), 92 C.P.R. (4th) 329 (T.M.O.B.) at para. 44]. Based on the state of the register, I am prepared to infer that BODY is commonly used as a dominant trade-mark component in the parties' field of interest and customers are accustomed to seeing this component.

#### *Previous Decisions Involving the Opponent*

[26] The parties raised several prior decisions of the Registrar concerning THE BODY SHOP mark. I do not intend to address these submissions since each case is to be decided on its own facts and the present case is distinguishable from each of the prior decisions on the basis of the marks or the wares/ services at issue.

#### *Conclusion*

[27] In view of the weakness of THE BODY, even though THE BODY SHOP mark has been extensively used it is not worthy of a broad scope of protection. Therefore, small differences will suffice to distinguish the Mark from the Opponent's mark. In *Molson, supra*, the Federal Court of Appeal explained:

In the present case, the appellant claims that the words "golden" and "gold" have been extensively used and advertised in relation to Molson's products so as to acquire some distinctiveness which makes them worthy of a broad protection. In our view, although

it is true that these words were widely used by the appellant over a considerable period of time, one should not lose sight of the fact that the words are merely descriptive.

*In Office Cleaning Services, Ltd. v. Westminster Window and General Cleaners, Ltd.*, Lord Simonds clearly established the inherent limits to the use of a descriptive word as the basis for a claim of distinctiveness of a trade mark and alleged confusion between it and other marks:

The Court will undoubtedly take into consideration long user (*sic*) of a descriptive name but will not forget that, since it is descriptive, small differences may suffice.

...It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade-name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade-name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered. ...

Therefore, in view of the differences in the parties' marks in appearance, sound and ideas suggested and the state of the register evidence with respect to BODY in association with body care products, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and THE BODY SHOP mark.

#### Remaining Grounds of Opposition

[28] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's THE BODY SHOP mark and trade-name. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the date of first use alleged in the application and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-mark and trade-name of the Opponent and the Mark. While the Opponent has met its initial burden, the Applicant has also met its burden because there is no likelihood of confusion for the reasons set out in the discussion of the s. 12(1)(d) ground.

Disposition

[29] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office