



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

Citation: 2014 TMOB 22
Date of Decision: 2014-01-31

**IN THE MATTER OF AN OPPOSITION
by Gurwitch Products, L.L.C to
application No. 1,463,520 for the trade-
mark REVIVAL in the name of Groupe
Marcelle Inc.**

[1] Gurwitch Products, L.L.C. (the Opponent) brought an opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) against an application filed by Groupe Marcelle Inc. (the Applicant) for the registration of the trade-mark REVIVAL (the Mark).

[2] The application is based on proposed use of the Mark in association with “skin products, namely regeneration day cream, regeneration night cream and regeneration eye cream” (the Wares).

[3] All of the grounds of opposition are premised on allegations of confusion between the Mark and the Opponent’s trade-marks RÉ VIVE (No. TMA601,209) and RÉ VIVE. GET THE GLOW. (No. TMA680,554) registered for skin products and allegedly used in Canada in association with personal care products and cosmetics.

[4] Both parties filed evidence. The Opponent filed an affidavit of Christine Allaire and certified copies of the trade-mark registrations listed in Schedule “A” to my decision. The Applicant filed an affidavit of Francois Lafortune and certified copies of the trade-mark registrations and applications also listed in Schedule “A” to my decision.

[5] No cross-examination was conducted.

[6] Both parties filed written arguments. A hearing was not held.

[7] For the reasons that follow, the application shall be refused.

Legal Onus and Evidential Burden

[8] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

The Issues

[9] The issues to be resolved in this opposition are:

1. Is the Mark registrable as of today's date?
2. Was the Applicant the person entitled to registration of the Mark at the filing date of the application?
3. Was the Mark distinctive of the Applicant's Wares at the filing date of the statement of opposition?

Analysis of the Issues

1. Is the Mark registrable as of today's date?

[10] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-marks

RÉ VIVE (No. TMA601,209) and RÉ VIVE. GET THE GLOW. (No. TMA680,554) registered in association with skin care products.

[11] The material date for considering the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. Having exercised the Registrar's discretion, I confirm that registration Nos. TMA601,209 and TMA680,544, issued on February 3, 2004 and January 26, 2007 respectively, are extant.

[12] The statement of wares of each of the registrations reads as follows:

TMA601,209: non-medicated skin products, namely, creams, lotions, gels, toners, cleaners and peels; medicated skin products, namely, creams, lotions, gels, toners, cleaners and peels.

TMA680,544: non-medicated skin products, namely creams, lotions, gels, toners, cleaners and peels.

[13] Since the Opponent has met its evidential burden, the question becomes whether the Applicant has met its legal onus to show that the Mark is not reasonably likely to cause confusion with either one of the Opponent's pleaded registered trade-marks.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321

(SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[16] In my opinion, comparing the Mark and the registered trade-mark RÉ VIVE will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and this registered trade-mark, then it would not be likely between the Mark and the registered trade-mark RÉ VIVE. GET THE GLOW.

[17] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis by considering that factor. Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the marks.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[18] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks.

[19] The Opponent submits that the marks are almost identical in appearance and in sound because “each begins with the letters REVIV”. In terms of ideas suggested, it submits that the “trade-marks equally give off the same idea, that of renewal or regeneration”.

[20] The Applicant submits that the Mark bears little resemblance to the Opponent’s mark RÉ VIVE because:

- the Mark is a single word – an English language noun. The Opponent’s mark is a two-word coined expression that includes a French word translated into English as “live”; it is suggestive of a French phrase. The French translation of the word “revival” forming the Mark is “renouveau”, which bears no resemblance to the Opponent’s mark;

- RÉ VIVE whether properly pronounced by a French language speaker or pronounced incorrectly by an English language speaker does not sound the same as REVIVAL. The Opponent's mark has two words and different emphases; and
- the Mark is suggestive of regeneration or rejuvenation whereas the Opponent's mark suggests only some kind of relationship with life or living.

[21] In terms of appearance, I do not consider the marks to be almost identical as argued by the Opponent, nor do I consider that they bear little resemblance, as argued by the Applicant. As a matter of first impression, I find that there are points of similarity, i.e. the letters REVIV, as well as points of difference, i.e. one word versus two words and the acute accent.

[22] In terms of sound, I acknowledge that there are differences between the trade-marks for a French speaking consumer. However, I do not think the same is true for an English speaking consumer. Indeed, it seems fair to conclude that an English speaking consumer would pronounce the mark RÉ VIVE as the verb "revive"; there is a fair degree of resemblance between the English words "revive" and "revival". It should be remembered that a trade-mark cannot be registered when there is confusion on the part of either the average English speaking consumer, the average French speaking consumer or the average bilingual consumer [see *Pierre Fabre Medicament v SmithKline Beecham Corporation v* (2001), 11 CPR (4th) 1 (FCA)].

[23] Finally, I conclude that there is a significant similarity between the ideas suggested by the marks when considering an English speaking consumer because I am of the view that this consumer would react to the mark RÉ VIVE by thinking of the verb "revive". I also conclude that there is a significant similarity in terms of ideas suggested when considering a bilingual or French speaking consumer. Indeed, the French dictionary *Le Petit Robert* defines the word "revival" as a noun, although an anglicism, that may mean "*renaissance d'un art, d'une mode, d'un état d'esprit ► reviviscence*". Thus, while the use of the word "revival" in the French language is incorrect, it remains that the Mark in the French language brings to mind the verb "revivifier" (in English, "revivify"), that is breathing fresh life into something.

[24] In the end, I find that the section 6(5)(e) factor overall favours the Opponent.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[25] The inherent distinctiveness of the Mark is lower than that of the Opponent's mark. Indeed, given the meaning attaching to the dictionary word "revival", the Mark has a suggestive connotation when considering the Wares, which consist of *regeneration* creams.

[26] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. In this case, both parties filed evidence of use and promotion of their respective trade-marks. The evidence of record, which I review below, leads me to conclude that both trade-marks have become known to some extent in Canada. However, I am satisfied that I may infer from the Applicant's evidence that the Mark has become known in Canada to a greater extent than the Opponent's trade-mark RÉ VIVE.

[27] I review the evidence starting with the Opponent's evidence provided through the affidavit of Ms. Allaire, which includes Exhibits "A" to "O".

[28] Ms. Allaire has been employed by the Opponent since 2004. At the time of her affidavit, sworn on November 24, 2011, Ms. Allaire was the Executive Director of National Sales Canada for the product line sold under the trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW. Prior to that, she held the position of Regional Sales Manager in Canada for the RÉ VIVE and RÉ VIVE. GET THE GLOW. product line from January 2008 to July 2011.

[29] Ms. Allaire confirms the Opponent's ownership of registration Nos. TMA601,209 and TMA680,544 for the trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW respectively. This leads me to remark that footnotes to the pages of registration Nos. TMA601,209 and TMA680,544 disclose that the Opponent became the owner of these registrations further to an assignment of August 25, 2008 from Bays Brown Laboratories, Inc. The latter was the original owner of registration No. TMA680,544 and was recorded as owner of registration No. TMA601,209 further to a merger of the original owner, Bays-Brown Dermatologics, Inc. I will return to this point below.

[30] Ms. Allaire states that the Opponent sells skin care products in Canada which bear both the marks RÉ VIVE and RÉ VIVE. GET THE GLOW. on the same product and/or package. This likely explains why Ms. Allaire introduces the evidence by referencing the use and promotion of the trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW. together.

[31] Ms. Allaire's testimony about Canadian sales and advertising of skin care products in association with the trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW. may be summarized as follows:

- the products are sold at retail at Holt, Renfrew & Co., Limited (Holt Renfrew) outlets in the Provinces of Ontario, Alberta, and British Columbia;
- the Opponent's sales, in US dollars, totaled \$165,500 in 2009, \$498,000 in 2010 and \$443,500 in 2011 (as of November 24);
- the Opponent's advertising expenditures, in Canadian dollars, totaled \$6,000 in 2009, \$27,000 in 2010 and \$12,000 in 2011(as of November 24);
- most of the advertising takes place in co-operation with Holt Renfrew by way of direct mailings, pages within Holt Renfrew catalogues, and the website of Holt Renfrew at *www.holtrenfrew.com*. On occasion, the Opponent itself sent promotional information to potential or existing customers within postal code ranges relevant to Holt Renfrew's outlets; and
- in the Fall of 2009 and 2010, the Opponent promoted a travel-sized selection of its products in a special edition bag bearing the artwork of the artist Charley Harper.

[32] The documentary evidence furnished by Ms. Allaire includes:

- a blank product purchase order form used by Holt Renfrew [Exhibit "D"];
- a selection of invoices issued by the Opponent to Holt Renfrew between July 2009 and April 2011 [Exhibit "E"];
- copy of an advertisement in a Holt Renfrew catalogue in the Spring of 2011, which is typical of advertisements in Holt Renfrew catalogues [Exhibit "F"];

- image of the special edition bag, and accompanying products, promoted in the Fall of 2009 [Exhibit “G”]; image of the special edition bag, and its accompanying box, promoted in the Fall of 2010 [Exhibits “I” and “J”];
- scripts of promotional information that appear on Holt Renfrew’s website during the Fall of 2010 and the Spring of 2011 [Exhibits “H” and “K”];
- a two-sided card advertisement, known as a “mailer”, prepared and distributed in co-operation with Holt Renfrew [Exhibits “L” and “M”]. Five thousand copies of this mailer were distributed in August 2009; and
- images of packaging for the skin care products [Exhibit “O”].

[33] To conclude my review of the Allaire affidavit, I wish to address submissions found in paragraph 77 of the Applicant’s written argument, which reads:

Further, none of the promotional materials or packaging provided in the Opponent’s affidavit associated the marks RÉ VIVE and RÉ VIVE. GET THE GLOW. with the Opponent, but only with Holt Renfrew, an individual identified as Dr. Gregory Bays Brown and an entity identified as Bays Brown Laboratories Inc. No evidence of a license was provided by the Opponent. Applicant submits that there is no evidence that the asserted marks identify the Opponent as the source of the wares sold under the marks RÉ VIVE and RÉ VIVE. GET THE GLOW.

[34] The Applicant seems to argue that the evidence does not establish that the use of the trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW. can be attributed to the Opponent because it does not meet the requirements of section 50 of the Act concerning the use of a mark under licence.

[35] With due respect, there is no reasonable basis for the Applicant suggesting that there is a requirement for a retailer, such as Holt Renfrew, to be a licensee of the Opponent.

[36] In addition, while a more complete picture of the relationship between the Opponent and Dr. Gregory Bays Brown or Bay Brown Laboratories Inc. could have been elicited by the cross-examination of Ms. Allaire, the Applicant elected to forgo cross-examination. Further, as previously indicated, it appears that Bay Brown Laboratories, Inc. was the Opponent’s predecessor-in-title. In any event, a reasonable reading of the Allaire affidavit in its entirety leads me to conclude that the provisions of section 50 of the Act are not relevant in this case.

[37] For one thing, according to my perusal of the exhibits to the Allaire affidavit, the references to Dr. Gregory Bays Brown appear only on promotional materials, not on packaging. I infer from the promotional material filed as Exhibit “M” that Dr. Bays Brown is the founder of Bays-Brown Dermatologics, Inc. Further, I infer from the evidence that the references to Bays Brown Laboratories Inc. on packaging shown by images in Exhibit “O” are references to the Opponent’s predecessor-in-title. Alternatively, I infer from the evidence that these are references to the entity acting as the distributor of the products. Indeed, in all instances I have noted the mention “Dist.” before the name Bays Brown Laboratories Inc. on packaging. The use of a trade-mark in Canada by a distributor amounts to use by the holder of the trade-mark [see *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD)].

[38] I now turn to the review of the evidence provided by the Applicant through the affidavit of Mr. Lafortune, which includes Exhibits “A” to “U”.

[39] Mr. Lafortune is the Applicant’s Vice President of Marketing. At the time of his affidavit sworn March 29, 2012, Mr. Lafortune had been in his position since April 4, 2011; he had been employed by the Applicant for 11 months and had over 15 years of experience in the cosmetics industry.

[40] Mr. Lafortune provides information about the percentage of the Canadian cosmetics market held by the Applicant, including the ranking of the cosmetics products sold under the Applicant’s house brands ANNABELLE and MARCELLE. A graphical representation produced by the Nielsen Company, a market research company, along with Nielsen rankings are provided as Exhibits “A” to “D” to the affidavit. While the admissibility of this evidence has been challenged by the Opponent on the basis that it is hearsay, I find it is not necessary to deal with this issue because nothing in my decision turns on these percentages and rankings.

[41] Insofar as the Mark is concerned, Mr. Lafortune testifies that it has been continuously used in Canada in association with the Wares, which are manufactured by the Applicant, since 2010; the Mark is featured on the Wares themselves and associated packaging.

[42] Mr. Lafortune’s testimony concerning the sales and advertising in Canada of the Wares associated with the Mark may be summarized as follows:

- the Wares are sold at retail across Canada, including in pharmacies, department stores and grocery stores;
- the Applicant invested over \$450,000 in 2010-2011 and over \$250,000 in 2011-2012 to promote and market the REVIVAL products; and
- the Wares are advertised on the Applicant's website, at in-store displays, and in print magazines. Mr. Lafortune specifically identifies the French and English editions of the magazine *Chatelaine* and the magazines *More*, *Zoomer* and *Vita*. He also provides the average monthly circulations of these magazines as reported by the publishers. These circulation figures constitute hearsay evidence. However, I am prepared to take judicial notice that the magazine *Chatelaine* has a certain circulation in Canada.

[43] I reproduce hereafter paragraph 8 of the affidavit of Mr. Lafortune, which pertains to the value and volume of sales of the Wares associated with the Mark.

Attached as Exhibit "G" is a spreadsheet generated by the Nielsen Company showing the sales of skin products in Canada, including regeneration day creams, regeneration night creams, and regeneration eye creams, bearing the [Mark] for the 52 week period ending January 14, 2012. This document is partially redacted to remove information the applicant considers confidential. Total dollar sales for products in Canada bearing the [Mark] was over \$2.5 million. Total unit sales for products in Canada bearing the [Mark] was 177,829 units.

[44] I find that the source of the value and volume of sales introduced into evidence is somewhat unclear. It could be that Mr. Lafortune's testimony is based on data generated by the Nielsen Company. However, it could be that Mr. Lafortune's testimony is based on data generated by the Applicant and provided by the Applicant to the Nielsen Company for the purposes of the previously mentioned market research. In any event, contrary to the Nielsen rankings, the Opponent did not specifically challenge the admissibility of Exhibit "G". Also, the Opponent elected not to cross-examine Mr. Lafortune. Further, even if the data has been generated by the Nielsen Company, it seems reasonable to conclude that in view of his function Mr. Lafortune is in a position to have knowledge of the value and volume of sales of the Wares associated with the Mark. In the end, I find that the sales information as introduced into evidence by Mr. Lafortune can be fairly considered.

[45] Finally, the documentary evidence furnished by Mr. Lafortune includes:

- copy of the first sales invoice dated July 26, 2010 [Exhibit “E”];
- photographs of skin products sold under the Mark [Exhibit “F”];
- a sample of partially redacted invoices from August 2010 issued to Canadian retailers [Exhibit “H”];
- print-outs of advertisements on the Applicant’s website [Exhibit “I”];
- photographs of in-store displays [Exhibits “J”, “K” and “L”]; and
- media plan for advertisements in magazines, including *Chatelaine*, from September 2010 to June 2011 and in both the English and French editions of *Chatelaine* from September 2011 to June 2012 [Exhibits “M” and “N”]; print advertising provided for publication in magazines [Exhibits “O” to “T”]; and advertisements taken from magazines [Exhibit “U”].

[46] To sum up my analysis of the section 6(5)(a) factor, I find that the inherent distinctiveness of the Opponent’s trade-mark RÉ VIVE is greater than that of the Mark. However, I find that the Mark has become known to a greater extent than that of the Opponent’s trade-mark RÉ VIVE.

[47] In the end, I find that the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the trade-marks, does not significantly favour either party.

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

[48] While the application was filed on December 18, 2009 based on proposed use, the Applicant has provided evidence of use of the Mark in Canada since July 26, 2010.

[49] Registration No. TMA601,209 claims use of the trade-mark RÉ VIVE in Canada since at least as early as March 2000. Ms. Allaire does not assert that the trade-mark RÉ VIVE has been continuously used in Canada since the date of first use claimed in the registration, nor does the Opponent’s evidence establish continuous use of the mark Canada since that date. As per my review of the Allaire affidavit, the Opponent provided evidence of use that dates back only to July 2009.

[50] Ultimately, even though the Opponent's use pre-dates the Applicant's, I find that the section 6(5)(b) factor does not significantly favour the Opponent.

The nature of the wares and the nature of the trade

[51] It is the statement of wares in the application for the Mark and the statement of wares in the Opponent's registration No. TMA601,209 that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[52] Considering the nature of the wares, I agree with the Opponent that the Wares and its registered wares are either identical or overlapping. This does not seem to be debated by the Applicant. As I understand the Applicant's submissions, it rather contends that the evidence shows differences in price and target clientele sufficient to avoid a likelihood of confusion when considering the nature of the wares. In that regard, the Applicant submits the following:

- its evidence shows suggested *retail prices* between \$20.95 and \$34.95 [Exhibit "I" to the Lafortune affidavit]. By comparison the Opponent's evidence shows, among others, *wholesale prices* ranging from \$42.50 to \$200 [Exhibit "E" to the Allaire affidavit]; and
- the Wares are generally openly displayed within *mass market* retail establishments and can be obtained by consumers without assistance [Exhibits "J", "K", and "L" to the Lafortune affidavit]. By contrast, the Opponent's evidence shows that it targets the *high end market*. Its skin products are likely to be the subject of a request by consumers and will be purchased with the assistance of a sales representative [Exhibit M to the Allaire affidavit].

[53] I disagree with the Applicant's contention based on differences in price and target clientele. Whether or not the Applicant rightly argues that the Opponent's skin products cannot be purchased without assistance, the fact that consumers may seek assistance of a sales representative does not reduce the likelihood of confusion [see by way of analogy *Henkel Kommanditgesellschaft Auf Aktien v Super Dragon Import Export Inc* (1984), 2 CPR (3d) 361

(FCTD); aff'd (1986), 12 CPR (3d) 110 (FCA), where it was found that the fact that consumers may seek assistance of specialized personnel to obtain information on how to use a product does not reduce the likelihood of confusion]. Moreover, the Supreme Court of Canada confirmed in *Masterpiece* that the first impression of consumers is the focus of the confusion analysis, even when wares are expensive.

[54] Likewise, the Applicant contends that the differences between the channels of trade are significant enough to preclude any likelihood of confusion. In that regard, the Applicant submits the following:

- the Wares are sold through a number of mass market retailers such as Jean Coutu, Loblaws, Overweita, Pharmaprix, Rexall Pharma Plus, Shoppers Drug Mart and Zellers [para. 9 of the Lafortune affidavit]. By contrast, the Opponent has an exclusive relationship with the high end retailer Holt Renfrew; and
- the Wares are advertised to a broad demographic through widely circulated print publications and in-store displays in the mass market retailers that sell the Wares. By contrast, the Opponent and its single retailer target a narrow and specific demographic with focussed advertising by direct mailings, pages within Holt Renfrew catalogues, or on the website of Holt Renfrew.

[55] Again, I disagree with the Applicant's contention. For one thing, whether or not the Applicant rightly argues that the Opponent targets the high end market, the consumers of the wares are ultimately the same, that is, Canadian consumers in general. Further both parties sell their skin products in retail establishments. I agree with the Opponent that it is not necessary to prove that the parties' wares are, or have in the past, been sold in the same places. Rather one may look at whether the wares could eventually be sold in the same places and the parties are entitled to do so [see *Everex Systems Inc v Everdata Computer Inc* (1992), 44 CPR (3d) 175 at 182 (FCTD)]. Although the RÉ VIVE skin products are only sold in Holt Renfrew locations, absent restriction in the statement of wares of the Opponent's registration, there is nothing at this time to prevent this situation changing.

[56] In the end, I conclude that the section 6(5)(c) and (d) factors significantly favour the Opponent.

Additional surrounding circumstances

[57] The Applicant's submissions advance the state of the register evidence and the absence of actual instances of confusion as additional surrounding circumstances supporting a finding of no likelihood of confusion. For the reasons that follow, I disagree with the Applicant that these are relevant additional surrounding circumstances in this case.

State of the register

[58] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[59] The state of the register evidence has been adduced by the Applicant through certified copies of trade-mark registrations/applications [see Schedule "A" to this decision]. This is an acceptable form of evidence [see section 54 of the Act]. Further, since the Opponent cites *Ocean Fisheries Ltd v Collage Communicators Ltd* (1990), 34 CPR (3d) 352 (TMOB) in support of its contention that it is "insufficient to submit register/application pages", I note that the state of the register evidence in that case was filed by way of an affidavit that was found deficient in several respects. In other words, I disagree with the Opponent's suggestion that the state of the register evidence has not been properly introduced by the Applicant. Also, in view of the Applicant's written argument, it is apparent that the Opponent's written submissions about the Applicant's failure to explain the purposes of this evidence and "the search parameters" are no longer applicable.

[60] Indeed, the Applicant submits in its written argument that its evidence shows common adoption and use in Canada of third party trade-marks including the element "vive" for beauty and grooming products. In that regard, the Applicant specifically points to the trade-marks

REVIVE (TMA172,723), L'OREAL VIVE (TMA475,212), VIVÉCLAT (TMA477,829), VIVESCENCE (TMA641,101) and REVIVE & RESTORE (1,497,256).

[61] As indicated above, inferences about the state of the marketplace can only be drawn when a significant number of pertinent *registrations* are located. Thus, I am disregarding the *application* cited by the Applicant. Even though I accept that the four registrations specifically cited by the Applicant are relevant when considering the wares at issue, it is too few registrations for me to draw any inference favourable to the Applicant. In other words, I cannot conclude that the state of the register for trade-marks including the element “vive” in the field of beauty and grooming products effectively dilutes the scope of protection to which the Opponent’s mark RÉ VIVE is entitled, as argued by the Applicant.

[62] Given the Applicant’s submissions, I presume that it did not cite the trade-marks REVISAGE & Design (TMA535,067), REVITA-HAIR (TMA605,104), REVITACILS (TMA658,496) and REVITALIZE REJUVENATE RENEW (TMA695,240) because they do not include the element “vive”. That being said, except for the trade-mark REVISAGE & Design, which is not associated with relevant wares, when considering the issue of confusion between the Mark and the Opponent’s mark, one could argue that third party trade-marks including the element “REVI” should be taken into consideration in assessing the state of the register evidence. Even if I do so, I am still left with only four registered trade-marks, namely REVIVE (TMA172,723), REVITA-HAIR (TMA605,104), REVITACILS (TMA658,496) and REVITALIZE REJUVENATE RENEW (TMA695,240). Again, it is too few registrations for me to draw any inference favourable to the Applicant.

[63] Accordingly, whether I consider the registered trade-marks comprising the element “vive”, as only and specifically argued by the Applicant in support of its case, or the registered trade-marks comprising the element “revi”, I conclude that the state of the register is not a relevant surrounding circumstance.

Absence of actual instances of confusion

[64] An opponent needs not to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. Absence of evidence of confusion does not

relieve an applicant from its burden of proof. Nevertheless, an adverse inference may be drawn from the lack of evidence of actual instances confusion when there is evidence of extensive concurrent use of the marks [see *Mattel Inc, supra* at page 347].

[65] The evidence leads me to conclude that the Mark and the mark RÉ VIVE have co-existed on the marketplace since July 2010. Thus, as of today's date, the trade-marks would have coexisted on the marketplace for a period of three and a half years.

[66] That being said, the exhibits to the Lafortune affidavit show that the Mark has always appeared together with, but in less prominent letters than, the Applicant's house brand MARCELLE. Also, the Mark has been displayed either below or in close proximity to the Applicant's house brand. However, since the application does not impose any restrictions on the Applicant in using the Mark, nothing would prevent future use of the Mark without the house brand MARCELLE.

[67] In the end, I am of the view that the Mark as used is likely to have been perceived as a secondary mark, which mitigates against the probabilities of confusion with the Opponent's Mark. Thus, I find it would not be proper to afford any significance to the absence of evidence of actual confusion in this case.

Conclusion on the likelihood of confusion

[68] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances of this case, in particular the degree of resemblance between the trade-marks, the nature of the wares and the nature of the trade, I am not satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark and the registered trade-mark RÉ VIVE (TMA601,209).

[69] Since I accept the section 12(1)(d) ground of opposition based on registration No. TMA601,209 for the trade-mark RÉ VIVE, I am not considering the ground of opposition based on registration No. TMA680,554 for the trade-mark RÉ VIVE. GET THE GLOW.

2. Was the Applicant the person entitled to registration of the Mark at the filing date of the application?

[70] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of confusion with the Opponent's trade-marks RÉ VIVE and RÉ VIVE. GET THE GLOW. alleged to have been previously used in Canada in association with personal care products and cosmetics.

[71] Once again, I find that comparing the Mark with the Opponent's mark RÉ VIVE effectively decides this ground of opposition. Further, I am satisfied that the Opponent has discharged its evidential burden of showing that its mark RÉ VIVE was used in Canada before the filing date of the application, namely December 18, 2009, in association with personal care products, especially skin care products, and had not been abandoned at the date of advertisement of the application, namely June 2, 2010 [see section 16(5) of the Act].

[72] In my view assessing each of the section 6(5) factors as of the December 18, 2009 rather than as of today's date does not impact my previous analysis of the surrounding circumstances of this case. In fact, to the extent that the evidence of use and promotion of the Mark is not relevant because it postdates the relevant material date, the Opponent's case is even stronger under the section 16(3)(a) ground of opposition than under the section 12(1)(d) ground of opposition. Thus, I conclude that the Applicant has not discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the trade-mark RÉ VIVE as of the December 18, 2009.

[73] Accordingly, the section 16(3)(a) ground of opposition is successful to the extent that it is based upon confusion with the trade-mark RÉ VIVE previously used in Canada by the Opponent in association with personal care products.

3. Was the Mark distinctive of the Applicant's Wares at the filing date of the statement of opposition?

[74] Since I have already accepted the opposition under two grounds, I will not address this last issue except to say that it arises from the ground of opposition alleging that the Mark is not distinctive within the meaning of section 2 of the Act.

Disposition

[75] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.



Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

CERTIFIED COPIES OF TRADE-MARK REGISTRATIONS FILED BY THE OPPONENT

<u>Trade-mark</u>	<u>Registration No.</u>
RE VIVE W/RECOMBINAGE	TMA566,305
RÉ VIVE	TMA601,209
RÉ VIVE. GET THE GLOW.	TMA680,544

CERTIFIED COPIES OF TRADE-MARK REGISTRATIONS AND APPLICATIONS FILED BY THE APPLICANT

<u>Trade-mark</u>	<u>Registration/Application No.</u>
REVIVE	TMA172,723
L'OREAL VIVE	TMA475,212
VIVÉCLAT	TMA477,829
	TMA535,067
Revita-Hair	TMA605,104
VIVESCENCE	TMA641,010
REVITACILS	TMA658,496
REVITALIZE REJUVENATE RENEW	TMA695,240
REVIVE & RESTORE	1,497,256
	1,552,310