

IN THE MATTER OF AN OPPOSITION by Estee Lauder Cosmetics  
Ltd. to application No. 572,754 for the trade-mark EAU DE SPORT  
filed by Jean Patou Inc.

On November 12, 1986, the applicant, Jean Patou Inc., filed an application to register the trade-mark EAU DE SPORT based upon use of the trade-mark in Canada in association with "perfumes, colognes and eau de toilette" since at least as early as 1970. The applicant disclaimed the right to the exclusive use of the word EAU apart from its trade-mark.

The opponent, Estee Lauder Cosmetics Ltd., filed a statement of opposition in which it alleged that the applicant's trade-mark EAU DE SPORT is not registrable and not distinctive in that the trade-mark EAU DE SPORT is clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the applicant's perfumes, colognes and eau de toilette.

The applicant served and filed a counterstatement in which it in effect denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavits of Melinda Faier, Yolanda Williams, Laura Prince and Andrew Bonar while the applicant elected not to file any evidence in support of its application.

Both parties filed written arguments and the applicant alone was represented at an oral hearing.

The issue as to whether the applicant's trade-mark EAU DE SPORT is clearly descriptive of the applicant's wares must be considered from the point of view of the average consumer or user of those wares. Further, in determining whether a trade-mark is clearly descriptive of the character or quality of the wares associated with it, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression (see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks, 40 C.P.R. (2d) 25, at pgs. 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks, 2 C.P.R. (3d) 183, at pg. 186).

The relevant date for considering the ground of opposition based on Section 12(1)(b) is as of the filing date of the applicant's application (November 12, 1986). In this regard, reference may be made to the decisions in Oshawa Group Ltd. v. Registrar of Trade Marks, 46 C.P.R. (2d) 145, at

pg. 147 and Carling Breweries Limited v. Molson Companies Limited et al, 1 C.P.R. (3d) 191, at pg. 195. Also, the material date with respect to the issue of distinctiveness is as of the date of opposition (June 24, 1988). While I am mindful of the decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 (F.C.A.), I consider that decision to be authority for the proposition that the material date for considering a Section 12(1)(d) ground of opposition is the date of my decision. I do not, however, consider the Park Avenue decision to be authority for the proposition that the material time for any ground relating to the registrability of a trade-mark, including a Section 12(1)(b) ground, is the date of decision. Indeed, such a position would appear to be directly in conflict with the express wording of Section 12(2) of the Trade-marks Act which provides that a trade-mark which is not registrable by virtue of Section 12(1)(b) is registrable if it has been so used in Canada as to have become distinctive as of the date of filing of an application for its registration.

While the legal burden is on the applicant to establish the registrability and distinctiveness of its trade-mark, there is an evidential burden on the opponent in respect of both of its grounds of opposition to adduce sufficient evidence which, if believed, would support the truth of the allegations set forth in the statement of opposition relating to the alleged non-registrability and non-distinctiveness of the trade-mark EAU DE SPORT. It is therefore necessary in the present case to consider the opponent's evidence in order to determine whether the opponent has met the evidential burden upon it.

The Prince affidavit relates to a document obtained by the affiant in the May 1989 edition of Domino magazine. As the publication is dated subsequent to the material dates in this proceeding, I have ignored it for the purposes of deciding the outcome of this opposition.

The Faier affidavit introduces into evidence the results of a computerized search conducted by the affiant of databases containing articles appearing in newspapers, magazines, periodicals, trade journals, and the like published in the United States of America. However, there is no evidence from which it can be inferred that Canadians were aware of the contents of any of the articles identified in the search conducted by Ms. Faier. Accordingly, the results of Ms. Faier's search are of no relevance to the issues in this opposition.

The Bonar affidavit introduces into evidence a photocopy of an article appearing in the July 21, 1981 edition of The Globe & Mail newspaper. This article refers to the "Lacoste Sports Line

from Jean Patou" and therefore the reference to "eau de sport" appears to be a reference to the applicant's wares. To the extent that the opponent has relied upon this excerpt to establish the existence of the reference to "eau de sport" as opposed to the truth of the contents of the article, I consider it admissible in this opposition (see Subramanian v. Public Prosecutor, [1956] 1 W.L.R. 965). However, the existence of one instance where the applicant's mark may have been used in a generic manner does not establish that the applicant's trade-mark is either descriptive or generic. As a result, this article by itself is insufficient to meet the opponent's evidential burden in respect of its grounds of opposition.

The opponent's final affidavit is that of Yolanda Williams, Administration Manager of the opponent. The Williams affidavit establishes that the opponent sold in Canada a sport spray fragrance from 1976 to 1987, as well as a sport perfume and after-sports body moisturizer from 1976 to 1986. Annexed to the affidavit is a photocopy of the front and base panels of a bottle of the sport spray marketed under the name and description ESTEE LAUDER ALLIAGE sport spray. While the Williams affidavit may point to the opponent's use of the word "sport" in a descriptive manner in respect of its perfume and related wares, it does not provide any evidence as to the perception of the average Canadian consumer of the trade-mark EAU DE SPORT when considered in its entirety as applied to the wares covered in the applicant's application.

Having regard to the above, I have concluded that the opponent has not met the evidential burden upon it in respect of its Section 12(1)(b) ground of opposition. As a result, I have rejected the opponent's grounds of opposition relating to the registrability and distinctiveness of the applicant's trade-mark EAU DE SPORT.

In view of the above, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31<sup>ST</sup> DAY OF DECEMBER 1991.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.