

**IN THE MATTER OF AN
OPPOSITION by Manufacturiers de
Bas de Nylon Doris Ltée/ Doris
Hosiery Mills Ltd. to Application No.
785818 for the Trade-mark SECRET
SHAPERS Filed by Warnaco Inc.**

I The Proceedings

On June 22, 1995, Warnaco Inc. (the «Applicant»), filed an application, based on proposed use, to register the trade-mark SECRET SHAPERS (the «Mark») in association with camisoles, camisoles with bras, panties, slips, bodysuits, bodysuits with bras, bras, chemises and sleepwear (the “Wares”). The Application was advertised for opposition purposes on January 29, 1997, in the Trade-Marks Journal.

On July 19, 1997, Manufacturiers de bas de nylon Doris Ltée/Doris Hosiery Mills Ltd. (the “Opponent”) filed a statement of opposition that was amended subsequently raising the following grounds of opposition:

- 1) Pursuant to Paragraph 38(2)(a) of the Trade-marks Act (hereinafter referred to as the “Act”), the Opponent respectfully submits that the Application does not comply with the requirements of Section 30 in that:
 - (a) The statement of wares is not exhaustive as required by Subsection 30(a) and more particularly, the word "sleepwear" is not defined in ordinary commercial terms;
 - (b) The Applicant could not have been satisfied that it was entitled to use the Mark in Canada (Subsection 30(i)).
- 2) Pursuant to Paragraph 38(2)(b), the Opponent respectfully submits that the Mark is not registrable.
 - (a) More particularly, Paragraph 12(1)(b) prohibits the registration of a trade-mark which is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used. It is submitted that the word SHAPERS, for which no disclaimer of the right to the exclusive use thereof had been entered, falls squarely within the prohibition set forth in Paragraph 12(1)(b).

(b) In addition, Paragraph 12(1)(d) prohibits the registration of a trade-mark which is confusing with a registered trade-mark. It is submitted that the Trade-mark is confusing with the Opponent's registered trade-marks (the "Registered Trade-marks", see Annex A herein) in that the use of the Mark and the Registered Trade-Marks in the same area would be likely to lead to the inference that the wares associated with such trade-marks are manufactured, sold or offered by the same person;

3) Pursuant to Paragraph 38(2)(c), the Opponent respectfully submits that the Applicant is not the person entitled to registration.

3.1 Subsection 16(3) prohibits an applicant from securing registration of an application on the basis of proposed used for a trade-mark which, at the date of filing, was confusing with:

- a) A trade-mark previously used or made known in Canada by any other person;
- b) A trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; and
- c) A trade-name that had been previously used in Canada by any other person.

3.2 Without limiting the generality of the foregoing, it is submitted that the Applicant is not the person entitled to registration of the Trade-mark because, at the date of filing of the application, the Mark was confusing *inter alia*, with the following trade-marks and trade-names of the Opponent in that the use of the Mark and the following trade-marks and trade-names in the same area would be likely to lead to the inference that the wares associated therewith are manufactured, sold or offered by the same person:

- a) The Registered Trade-marks listed in Annex A which have been extensively used by the Opponent and/or its licensees in Canada and/or for which applications were filed prior to the filing date of the Application, namely June 22, 1995 (the "Filing Date");
- b) The trade-marks listed in Annex B herein;
- (c) The following trade-names which have been extensively used in Canada by the Opponent's licensees, namely:

(1) Secret Holdings Inc.;

(2) Secret International Legwear Inc.

3.3 In addition, the Opponent is the owner of the related trade-marks listed in Annex C herein;

4) Finally, pursuant to Paragraph 38(2)(d), the Opponent respectfully submits that for the above-mentioned reasons, *inter alia*, the Mark is not distinctive of the Applicant within the meaning of Section 2, because it does not distinguish nor is it adapted to distinguish the wares of the Applicant from the wares or services of others, and more particularly those of the Opponent.

The Applicant filed a counter statement to the opposition denying each ground of opposition raised by the Opponent. Both parties filed written submissions and an oral hearing took place.

II The Evidence

The Opponent's evidence consists of two affidavits of Jack Hasen, the Opponent's president, and the affidavits of Anne-Marie Dubé and Vivian Patsilivas. The Applicant filed the affidavits of Marion Garden and Marla May Ericksen. Ms. Garden was cross-examined and the transcript was filed together with the reply to the undertakings. The Applicant filed as additional evidence the affidavit of Darlene Carreau and two affidavits of Jennifer Leah Stecyk. The Opponent filed as reply evidence the affidavits of Susan Beaubien, Warren D. Chisling, Kenneth Verdoni, Miriam Corriveau and Donica Robillard. Mr Verdoni was cross-examined and the transcript together with the reply to the undertakings was filed into the record. The Opponent filed as additional evidence a second affidavit of Vivian Patsilivas. The Applicant requested on February 9, 2004, leave to file additional evidence in the form of a third affidavit of Ms. Stecyk, but in a decision rendered on April 19, 2004, I refused such request.

The relevant evidence can be summarized as follows. The Opponent is one of the largest manufacturers of hosiery and pantyhose in Canada. It is the owner of the trade-mark SECRET, certificate of registration number 298,735. The application that matured to such registration was filed on August 2, 1966 based on proposed use in association with ladies' hosiery.

The Opponent filed representative samples of packaging (exhibits JH-5 to JH-21) on which appears the trade-mark SECRET alone or as part of or in combination with another trade-mark. The Opponent failed to state the date of first use of each of these samples. There are invoices (exhibit JH-23), from September 1993 up to October 1996 (the affidavit was signed in August 1997), illustrating the sale of wares bearing various trade-marks comprising the word SECRET.

The question that must be addressed at this stage is: Do the packaging and advertising combined with the invoices filed establishes use, during such period, of the Opponent's registered trade-marks. There have been invoices and packaging filed to establish the sale of the following products:

JH-5: SECRET: pantyhose, trousers, socks, tights, foot lets, gloves, wash bags, knee highs, leggings, bicycle shorts and ankle highs.

JH-6: SECRET COLOURS: pantyhose

JH-7: SECRET CONTROL TOP: pantyhose.

JH-9: SECRET SHEER ACTIVITY: pantyhose.

JH-10: SECRET SHEEREST: pantyhose.

JH-11: SECRET SILKY: pantyhose and stockings.

JH-12: SECRET SO SHEER L'INVISIBLE: pantyhose, knee-highs and tight highs.

JH-13: SECRET SO SLIM: pantyhose and tights.

JH-19 and JH-28: JOUR A JOUR SECRET ALL-DAY : pantyhose and tights.

I deliberately omitted the other packaging as there is no invoice filed to evidence use of the trade-marks appearing on such packaging. In *Warnaco Inc. v. Manufacturiers de Bas de Nylon Doris Ltée. (2002), 28 C.P.R. (4th) 401 (TMOB)* Hearing Officer Jill W. Bradbury dealt with this issue and concluded in the following terms:

“The applicant has not provided sales or promotional figures broken down by its various SECRET marks. It has provided copies of representative packaging for various products but a review of these materials raises the question of whether it is using the trade-mark SECRET on its own or as part of a combination mark. By and large, it appears to me that the applicant's packaging shows use of SECRET. For example, the exhibit that allegedly shows use of SECRET COLOURS displays the three words COULEURS SECRET COULEURS on three separate lines with the word SECRET being displayed in a much bolder script with ® appearing immediately after it. I consider this to be use of SECRET, with the word COULEURS being perceived simply as the English translation of the word COULEURS and both COLOURS and COULEURS indicating that the hosiery in question are coloured. The words that appear on packaging for other alleged members of the SECRET family of marks are likely to be interpreted as use of the

trade-mark SECRET plus another trade-mark because the word SECRET appears on a separate line in a very different script with ® appearing immediately after it (see for example the packaging for SECRET MOTIF). One of these two interpretations applies to the packaging for the following alleged trade-marks SECRET CONTROL TOP, SECRET SHEEREST, SECRET SO SHEER L'INVISIBLE, SECRET SO SOFT TRES DOUX, SECRET SO SLIM, JOUR A JOUR SECRET ALL DAY, SUPERSHEER SECRET SUPERFIN, SECRET SHEER ACTIVITY (which also displays ® after SHEER ACTIVITY), SECRET SILKY, SECRET SO SOFT; SECRET SPARE PAIR (SPARE PAIR also having its own ®), SECRET UP LIFT, SECRET ULTRA, and SIGNATURE BY/PAR SECRET. In other words, I see no evidence of use of any of these combination marks. I would also point out that the applicant has not indicated whether its various individual trade-marks were used before the dates material in this opposition. In addition, the majority of the packaging submitted is for pantyhose/hosiery.”

The packaging identified above correspond to the description of the packaging filed in *Warnaco Inc.*. I have no reason to adopt a different view.

The products listed above are sold in retail stores such as the Bay, Zellers, Wal-Mart, and Eaton. Sales and advertising figures are mentioned in paragraphs 12 and 15 of Hasen’s affidavit but there is no breakdown for each trade-mark. Therefore the only conclusion I can draw from this evidence is that the trade-mark SECRET has been extensively used in Canada by the Opponent since at least 1993 in association with pantyhose.

Even though there are affidavits filed in the record by authorized representatives of Secret Holdings Inc. and Secret International Legwear Inc., there is no evidence of use of such trade names in association with hosiery, intimate apparel, sleepwear, undergarments or lingerie.

The Opponent’s evidence contains also some dictionary meanings of the words: sleep, wear, night, clothes, garment, lingerie and intimate; and what the terms sleepwear and intimate apparel mean in the industry. Finally there is evidence of the state of the Register to establish the ownership of the Opponent’s trade-marks listed in its statement of opposition. The Applicant has filed evidence to show that eleven (11) of the registrations listed in Annex A have been cancelled on either October 29 or November 3rd, 1999. The Opponent alleged to have filed a statement of opposition against application numbers 785803, 683402, 767010, 757062, 759330 and 638401 to demonstrate that it

has been vigilant in its efforts to protect and enforce its rights in its family of trade-marks that comprise the word SECRET.

Ms. Garden is a representative of Warnaco Canada, the Applicant's licensee. In her affidavit she defined "Intimate Apparel" as panties, bodysuits with bras, camisoles with bras and chemises with bras. As pointed out by the Opponent's agent, the term sleepwear is not mentioned in such list of wares of the defined term Intimate Apparel. As such whenever the affiant is referring to Intimate Apparel as a defined term, I shall not include sleepwear. One of the consequences of such determination is that there is no evidence of use of the Mark in association with sleepwear.

In September 1995 the Applicant launched a new line of women's Intimate Apparel in association with the Mark. Sales figures of such wares for the period of September 1995 to May 1998 were provided. The Wares are sold in stores such as The Bay and Sears.

Ms. Garden has filed hangtags, samples of advertisement, price lists and catalogues to establish the Applicant's use of the Mark since September 1995. The word OLGA is often written on one line and the words SECRET SHAPERS on another line. Sometimes the word OLGA is written on white background while the words SECRET SHAPERS are written on black background. I do consider such use as use of two trade-marks: the Mark and the trade-mark OLGA. The Board reached a similar conclusion in *Warnaco Inc.* supra

Ms. Ericksen is in the business of fitness training. She states that since August 1995 she has been receiving a catalogue published by Victoria Secret in which are illustrated amongst others bras and panties. She filed as an exhibit the 1997 fall catalogue. She has a Victoria Secret credit card, and filed a photocopy of it as an exhibit to her affidavit. She also produced a copy of an order form to purchase products from Victoria Secret. Finally she filed a photocopy of a bra and panties that she ordered from Victoria Secret's catalogue.

Ms. Carreau visited a Marks & Spencer store in Ottawa and purchased a camisole bearing the trade-mark SECRET SUPPORT filed as an exhibit.

In reply evidence, the Opponent filed the affidavit of Ms. Beaubien wherein she stated having sent a cease and desist letter on behalf of the Opponent to Marks & Spencer with respect to its use of the trade-mark SECRET SUPPORT as well as the response in which she was informed that the store would be closing. Warren D. Chisling filed a copy of an article published in the Globe and Mail in which it is mentioned that the Marks & Spencer's stores would be closing.

Mr. Verdoni is the president of Doris Intimates Inc, which sells intimate apparel in Canada in association with the trade-mark SECRET as per the terms of a license agreement with the Opponent. He defines "intimate apparel" as clothing worn next to the body. He states, and it has not been contradicted, that it is commonly accepted in the industry that such term includes hosiery, lingerie, undergarments and sleepwear. He stated during his cross-examination that hosiery and lingerie could overlap.

The affidavit of V. Patsilivas and the two additional affidavits signed by Jennifer Leah Stecyk relate to the state of the Register.

III The law

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial burden is met, it shifts to the Applicant who then must prove, on a balance of probabilities, that the particular grounds of opposition should not prevent registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, (1984) 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, (1990) 30 C.P.R. (3d) 293].

The material time for considering the issues of non-compliance with Section 30 of the Act is the Filing Date. [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, (1984) 3 C.P.R. (3d) 469, at p. 475]

The material time for considering the issue of non-entitlement based on Subsection 16(3) of the Act

is also the Filing Date [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the statement of opposition (July 19, 1997) while registrability under Subsection 12(1)(d) of the Act must be assessed as of the date of the Registrar's decision. [See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 at 424 (F.C.A.)]

With respect to the first portion of the first ground of opposition, the term sleepwear is mentioned in the *Trade-marks Examination Wares and Services Manual, 1996* as an acceptable identification of wares. The Opposition Board however is not bound by its content. (See *Oracle Service Networks Corporation v. Oracle Corporation, application no 746841, June 29, 1999*) The Opponent failed to present sufficient evidence that would enable me to conclude that sleepwear is not an ordinary commercial term. The Opponent's representative, during his cross-examination, stated that in the industry the term "intimate apparel" includes hosiery, lingerie, undergarments and sleepwear and that "lingerie" and "intimate apparel" are coterminous and include both undergarments and sleepwear. These statements may have an incidence on the nature of the parties' respective wares and their potential overlap but fall short from establishing that "sleepwear" is not an ordinary commercial term. I therefore dismiss ground of opposition 1 a) described above.

Ground of opposition 1 b) is also dismissed as the Opponent failed to allege that the Applicant's Mark would be confusing with its Registered Trade-marks and in any event failed to file any evidence to prove that the Applicant was aware that it was not entitled to register the Mark.

The Opponent, in the first portion of the second ground of opposition, is alleging that the word SHAPERS, for which no disclaimer of the right to the exclusive use thereof had been entered, falls squarely within the prohibition set forth in Subsection 12(1)(b). The Mark however must be viewed as a whole. Moreover in *Sunny Crunch Foods Ltd. v. Registrar Of Trade-Marks (1982)*, 63 C.P.R. (2d) 201 Mr. Justice Mahoney cited pertinent portion of the Registrar's decision before making his own comments:

“...and as for his second ground, that the presence of the word "granola" without a disclaimer renders the trade mark offensive under the provisions of s. 12(1)(b) of the Act, that too has not been and cannot be supported. On the one hand, as pointed out above, failure to disclaim does not provide a basis for opposition, while on the other hand, applicant's mark as a totality has not been shown to be either clearly descriptive or deceptively misdescriptive.

The opposition is rejected under the authority of s. 37(8) of the Trade Marks Act.

The appellant did not amend its disclaimer statement within the time provided. The opponent, who did not intervene in this appeal, did not appeal the decision rejecting its opposition within the time limited for such appeal. In a letter he expressly characterized as a reflection of his views, rather than a decision, the respondent, who considered himself then *functus officio*, took the position that the chairman of the opposition board had been entitled to require the disclaimer. In the result the trade mark applied for has not been registered.

The grounds on which an opposition may be based are enumerated in s-s. 37(2) of the Trade Marks Act, R.S.C. 1970, c. T-10. That a disclaimer should be required is not among them.”

Therefore ground of opposition 2 a) is dismissed as the Mark, when viewed as a whole, is not clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the Wares.

I shall now examine the issue of confusion between the Mark and the Opponent's registered trade-marks. The burden of proof lies on the Applicant who must convince the Registrar, on the balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-marks at the abovementioned relevant date. [See *Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53 and *Christian Dior, S.A. v. Dion Neckwear Ltd [2002] 3 C.F.405*]

In order to determine whether trade-marks are confusing, Subsection 6(5) of the Act lists some of the surrounding circumstances that the Registrar must consider:

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- ii) The length of time the trade-marks or trade names have been in use;

- iii) The nature of the wares, services, or business;
- iv) The nature of the trade; and
- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

It has been established that the criteria listed in Subsection 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See *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.)]. Mr. Justice Cattanach described the test of confusion in the following words 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.»

Mr. Justice Décarie enunciated the test to determine the likelihood of confusion in the following way in *Miss Universe Inc. v. Bohna (1994)*, [1995] 1 F.C. 613 (F.C.A.):

«To decide whether the use of a trade-mark or of a trade-name causes confusion with another trade-mark or another trade-name, the Court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague

recollection of that other mark or name⁵*ftnote⁵ See *Coca-Cola Co. v. Pepsi-Cola Co.* (1942), 2 D.L.R. 657 (P.C.), at p. 661, Lord Russell of Killowen. , the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class.»

For the purpose of this analysis of the criteria listed under Section 6(5) of the Act I shall first compare the Mark with the Opponent's trade-mark SECRET as I consider that to be the Opponent's strongest case.

i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known.

I adopt the position taken by the Registrar in *Warnaco Inc, op. cit.*, wherein the Hearing Officer addressed this issue in the following terms:

“The applicant's trade-mark [SECRET] is inherently distinctive. (...)

I consider the mark SECRET SHAPERS to be slightly less inherently distinctive than the mark SECRET since SECRET SHAPERS suggest that the wares will shape the user's body without anyone knowing.”

There have been sales since September 1993 of over \$195,000,000 of hosiery products bearing the Opponent's trade-mark SECRET and in excess of \$3,500,000 was spent in advertising. Therefore the Opponent's trade-mark SECRET has become known in Canada.

The Applicant has used the Mark since at least September 1995 and its sales are less impressive than the Opponent's sales. As such the Applicant's Mark is less known than the Opponent's trade-mark SECRET. This factor favours the Opponent.

- ii) The length of time the trade-marks or trade names have been in use;

This factor also favours the Opponent as it has established use of its registered trade-mark SECRET since at least September 1993 while use of the Mark by the Applicant goes back to September 1995.

- iii) The nature of the wares, services, or business;

The application covers "camisoles, camisoles with bras, panties, slips, bodysuits, bodysuits with bras, bras, chemises and sleepwear", that are various items of lingerie, undergarments or sleepwear. The Opponent argues that the Applicant's Wares are considered the same or very similar to the wares contained in the Opponent's registrations, namely: pantyhose and hosiery. In *Manufacturiers de Bas de nylon Doris Ltée/Doris Hosiery Mills Ltd. v. Victoria's Secret, Inc. (1992)*, 39 C.P.R. (3d) 131 the former chairman of the Opposition Board, Mr. Gary Partington discussed such interrelationship in the following terms at page 137:

“However, in Webster's New Collegiate Dictionary, "panty hose" are defined as being a "one-piece undergarment for women that consists of hosiery combined with panties". Thus, the opponent's panty-hose arguably fall within the scope of the wares defined in the applicant's application as "women's undergarments". Likewise, the applicant's application covers "lingerie" which is defined in Webster's Third New International Dictionary as "intimate feminine apparel (as nightwear and underwear)" and which, therefore, could arguably include ladies' panty-hose or stockings in that panty-hose are a type of underwear or undergarment. In any event, it would certainly appear that panty-hose and stockings are closely related to, if not overlapping with, the applicant's wares defined as women's undergarments and lingerie.”

During her cross-examination, Ms. Garden, the Applicant's representative stated: "lingerie is referred to in the industry as intimate apparel. You have intimate apparel in sleepwear." Mr. Verdoni stated that hosiery and lingerie might overlap. Moreover in *Warnaco Inc., op. cit.*, Hearing Officer Jill W. Bradbury concluded that the Wares overlap with underwear, undergarments and lingerie.

The Applicant argues that the Opponent has accepted a distinction between the Wares and hosiery sufficient to negate the likelihood of confusion. The Applicant referred to various contentious proceedings related to the VICTORIA'S SECRET trade-marks. There cannot be any issue estoppel argued against the Opponent as the parties in those proceedings were not the same as in this opposition proceeding and the trade-marks in issue were different.

I therefore conclude that there is at least a potential overlap in the nature of the parties' respective wares and as such this factor also favours the Opponent.

- iv) The nature of the trade.

As appears from the summary of the evidence hereinabove, there is an overlap in the channels of trade. This factor is also favoring the Opponent.

- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

The Mark includes in its entirety the Opponent's registered trade-mark SECRET. It has been determined that the first word of a trade-mark is important when comparing the respective trade-marks for the purpose of distinction. [See *Conde Nast Publications Inc. v. Union des Editions*

Modernes (1979), 46 C.P.R. (2d) 183] Moreover the second word of the Mark is suggestive of the character of the Wares and does not serve to distinguish the Mark from the Opponent's trade-mark SECRET. This factor is also in favour of the Opponent.

vi) Additional surrounding circumstances

The Opponent has cited the following extract of *McDonald's Corporation et al. v. Yogi Yogurt Ltd. et al. (1982), 66 C.P.R. (2d) 101 (F.C.T.D.) at p. 112-113*:

"When trade-marks which have common characteristics are registered in the name of one owner (...) that circumstance gives rise to the presumption that such marks form a series of marks used by the one owner and the registration of such marks is tantamount to a single registration combined of those several marks [...] The fact of the registration of trade-marks giving rise to the presumption of a series of marks existing is a most material consideration which the Registrar of Trade-marks must take into account upon an application for registration of a mark embodying the common characteristics." (My underlines)

to support its contention that the existence of a family of trade-marks must be an additional surrounding circumstances to be taken into consideration in this file. However, Mr. Justice Cattanach further on in his judgment added at page 114:

"While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family." (My underlines)

As such, there must be evidence of use of the Registered Trade-marks owned by the Opponent to enable it to argue the existence of a family of trade-marks comprising the word SECRET. As mentioned herein above, there is no proper evidence of continuous use of the Opponent's registered trade-marks. Therefore, I conclude that the Opponent cannot claim the benefit of the existence of a family of trade-marks.

As additional surrounding circumstances, the Applicant argues that there were other trade-marks on the Register comprising the word SECRET, namely VICTORIA'S SECRET and SECRET SLIMMERS, registered in association with similar wares. The Opponent took various steps to protect its rights in its family of trade-marks. It acquired the rights in the trade-mark SECRET SLIMMERS and is involved in litigation with the owner of the trade-marks VICTORIA SECRET. The Opponent sent a cease and desist letter to Marks & Spencer with respect to its use of the trade-mark SECRET SUPPORT. There has been uncontradicted evidence that such stores would be closing and the Applicant failed to file evidence of continuous use of such trade-mark by Marks & Spencer subsequent to its response to the cease and desist letter. Moreover the Applicant has failed to establish the existence of other marks comprising the word SECRET owned by various entities such that one could conclude that traders in the intimate apparel and lingerie industry commonly use the word SECRET.

IV Conclusion

From this analysis of the evidence, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark SECRET when used in association with the Wares. I reach this conclusion based on the following:

- a) The Opponent's trade-mark SECRET is known in Canada;
- b) The Opponent has used its trade-mark for a longer period of time than the Applicant has used the Mark;

- c) The wares overlap;
- d) The channels of trade are similar;
- e) There is some degree of resemblance between the Mark and The Opponent's trade-mark SECRET.

I may add that there is also a likelihood of confusion between the Mark and the Opponent's registered trade-mark SECRET SLIMMERS. There might be no evidence of use of the trade-mark SECRET SLIMMERS but the wares covered by such registration overlap with the Wares, the channels of trade would appear to be similar and the degree of resemblance would be stronger than with the Opponent's trade-mark SECRET as the idea suggested by the parties respective trade-marks is similar, namely that the consumer who would wear the parties respective products would improve her silhouette.

I therefore maintain ground of opposition 2b) described above.

The main issue in assessing the entitlement and distinctiveness grounds of opposition is the likelihood of confusion between the Mark and the Opponent's trade-mark SECRET.

The difference in the relevant dates when analysing those grounds of opposition, namely the Filing Date and the filing date of the statement of opposition respectively as opposed to the date of the decision when analysing the second ground of opposition, does not have an impact on my analysis of the likelihood of confusion between the Mark and the Opponent's registered trade-mark SECRET. The Opponent has established that it did not abandon its use of the trade-mark SECRET at the date of advertisement of the Applicant's application (January 29, 1997). [See Subsection 16(5) of the Act] As such I would also maintain grounds of opposition 3.2 a) and 3.2 b) but not 3 c) as there is no clear evidence of prior use of the trade names cited by the Opponent under such sub-paragraph.

For the same reasons outlined above on the likelihood of confusion between the Mark and the Opponent's registered trade-marks SECRET and SECRET SLIMMERS, I would maintain the fourth

ground of opposition as the Mark is not adapted to distinguish the Wares from the Opponent's wares.

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of Subsection 63(3) of the Act, I refuse the application to register the Mark, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 9th DAY OF DECEMBER 2004.

Jean Carrière,
Member,

Trade-marks Opposition Board

ANNEX A

- 1) The trade-mark SECRET ALL-DAY, registered under number TMA 478,681 with respect to the following wares: "Clothing, namely socks, stockings, lingerie, undergarments, knee highs and tights";
- 2) The trade-mark SECRET ACTIVE SLIMMERS, registered under number TMA 478,269 with respect to the following wares: "Clothing, namely hosiery, pantyhose and undergarments";
- 3) The trade-mark HER CHOICE BY SECRET, registered under number TMA 478,262 with respect to the following wares: "Activewear, namely exercise tights, leggings, exercise leotards, sweat pants, sweat shirts, T-shirts; underwear".
- 4) The trade-mark SECRET UP LIFT, registered under number TMA 477,978 with respect to the following wares: "Pantyhose and panties";
- 5) the trade-mark JR. SECRETS, registered under number TMA 476,020 with respect to the following wares: "Girls' underwear and sleepwear";
- 6) the trade-mark HER SECRETS, registered under number TMA 475,612 with respect to the following wares: "Ladies' lingerie, namely, bras, panties, and daywear, namely, slips, camisoles, teddies and loungewear, namely, robes, tops and bottoms not intended as streetwear; sleepwear";
- 7) the trade-mark SECRET SO SLIM, registered under number TMA 450,919 with respect to the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";
- 8) the trade-mark SECRET FOR HIM POUR LUI & Design, registered under number TMA 449,621 with respect to the following wares: "Clothing, namely socks and underwear for men";
- 9) the trade-mark SECRET FOR HIM, registered under number TMA 448,331 with respect to the following wares: "Clothing, namely socks and underwear for men"
- 10) the trade-mark JOUR À JOUR SECRET, registered under number TMA 444,724 with respect to the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";
- 11) the trade-mark HER CHOICE BY SECRET, registered under number TMA 444,050 with respect to the following wares: "Clothing, namely panty hose, trousers socks, knee highs, socks, thigh highs and stockings";

- 12) the trade-mark Q SECRET & Design, registered under number TMA 437,959 with respect to the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";
- 13) the trade-mark SECRET FRAICHEUR D'ÉTÉ, registered under number TMA 407,291 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 14) the trade-mark SECRET SUMMER COOL, registered under number TMA 407,290 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 15) the trade-mark SIGNATURE BY/PAR SECRET, registered under number TMA 389,221 with respect to the following wares: "Ladies' and men's hosiery";
- 16) the trade-mark SECRET-KIDS, registered under number TMA 387,178 with respect to the following wares: "Children's pantyhose, hosiery, tights and socks";
- 17) the trade-mark SECRET, registered under number TMA 372,467 with respect to the following wares: "Footwear, namely shoes, boots, slippers and sandals";
- 18) the trade-mark SUPERSHEER SECRET SUPERFIN, registered under number TMA 369,065 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 19) the trade-mark SECRET SWEATER SHEERS, registered under number TMA 362,859 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 20) the trade-mark SECRET TEXTURE TRICOT, registered under number TMA 362,858 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 21) the trade-mark SECRET SILKY, registered under number TMA 361,546 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 22) the trade-mark SECRET SOIRÉE, registered under number TMA 356,152 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 23) the trade-mark SECRET ULTRA SHEER, registered under number TMA 347,260 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";

- 24) the trade-mark SECRET ULTRA DIAPHANE, registered under number TMA 341,914 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 25) the trade-mark SECRET SHEEREST, registered under number TMA 340,714 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 26) the trade-mark SECRET ULTRA, registered under number TMA 338,864 with respect to the following wares: "Ladies' hosiery";
- 27) the trade-mark SECRET COLOURS, registered under number TMA 338,319 with respect to the following wares: "Ladies' hosiery";
- 28) the trade-mark SECRET SHEER ACTIVITY, registered under number TMA 338,202 with respect to the following wares: "Ladies' pantyhose";
- 29) the trade-mark SECRET FASHION WARDROBE, registered under number TMA 334,463 with respect to the following wares: "Ladies' pantyhose";
- 30) the trade-mark SECRET ALL NUDE, registered under number TMA 320,972 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 31) the trade-mark SECRET INTERNATIONAL, registered under number TMA 308,613 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 32) the trade-mark SECRET FASHION COLLECTION, registered under number TMA 303,433 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 33) the trade-mark SECRET NEW LOOK, registered under number TMA 303,183 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 34) the trade-mark SECRET INGREDIENT & Design, registered under number TMA 301,965 with respect to the following wares: "Men's, women's and children's activewear, namely: shirts, sweaters, jackets, pants, jeans, jogging suits, sweat suits, underwear, blouses, T-shirts, skirts, dresses, gloves, belts, and hats";
- 35) the trade-mark SECRET MOTIF, registered under number TMA 299,976 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";
- 36) the trade-mark SECRET, registered under number TMA 298,736 with respect to the following wares: "(1) Ladies' hosiery, men's and ladies' socks and stockings, sports socks, dress socks and knee socks. (2) Children's socks and stockings;
- 37) the trade-mark SECRET COLOUR COLLECTION, registered under number TMA 298,725 with respect to the following wares: "Ladies' pantyhose and ladies' hosiery";

- 38) the trade-mark SECRET BRIDAL COLLECTION, registered under number TMA 297,084 with respect to the following wares: "Ladies' pantyhose";
- 39) the trade-mark SECRET SUPER SOX, registered under number TMA 289,872 with respect to the following wares: "Men's, women's and children's socks".
- 40) the trade-mark SECRET & Design, registered under number TMA 285,242 with respect to the following wares: "(1) Ladies' pantyhose. (2) Men's and ladies' socks and stockings. (3) Children's socks and stockings";
- 41) the trade-mark SECRET SHEEREST COLLECTION, registered under number TMA 279,769 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 42) the trade-mark SECRET SILKY PANTY, registered under number TMA 279,703 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 43) the trade-mark SECRET SILKY SUPREME, registered under number TMA 274,608 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 44) the trade-mark SECRET PLUS, registered under number TMA 266,493 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 45) the trade-mark SECRET COLLECTION, registered under number TMA 251,580 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 46) the trade-mark SECRET PAIRE DE SECOURS, registered under number TMA 248,329 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 47) the trade-mark SECRET SPARE PAIR, registered under number TMA 248,327 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 48) the trade-mark SECRET ÉLÉGANTE, registered under number TMA 238,401 with respect to the following wares: "Ladies' hosiery";
- 49) the trade-mark SECRET CONTROL TOP, registered under number TMA 236,848 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 50) the trade-mark SECRET CONTROL PANTY, registered under number TMA 236,847 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 51) the trade-mark SUPER SECRET, registered under number TMA 235,955 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";

- 52) the trade-mark SECRET ALL-DAY, registered under number TMA 235,954 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 53) the trade-mark SHEER SECRET, registered under number TMA 208,096 with respect to the following wares: "Ladies' hosiery";
- 54) the trade-mark NUDE SECRET, registered under number TMA 202,515 with respect to the following wares: "Ladies' hosiery";
- 55) the trade-mark ULTRA SECRET, registered under number TMA 202,514 with respect to the following wares: "Ladies' hosiery";
- 56) the trade-mark SUPPORT SECRET, registered under number TMA 195,775 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 57) the trade-mark TOP SECRET, registered under number TMA 195,774 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 58) the trade-mark GO SECRET, registered under number TMA 195,443 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 59) the trade-mark BIG SECRET, registered under number TMA 195,442 with respect to the following wares: "Ladies' panty hose and ladies' hosiery";
- 60) the trade-mark SECRET, registered under number TMA 151,062 with respect to the following wares: "Ladies' hosiery";
- 61) the trade-mark SECRET SLIMMERS, registered under number TMA 146,454 with respect to the following wares: "Women's underwear and undergarments, namely, panties and girdles".

ANNEX B

-The trade-mark SECRET FIT for which an application was filed on April 10, 1995 under number 779,994 in association with the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, knee highs, tights, shoes, slippers, panties, underwear and active wear, namely exercise tights, leggings, leotards, sweat pants, sweat shirts, T-shirts, shorts, exercise tops";

-The trade-mark SECRET SO SHEER L'INVISIBLE for which an application was filed on March 8, 1993 under number 724,073 in association with the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";

-The trade-mark SECRET TRÈS DOUX for which an application was filed on January 26, 1993 under number 721,439 in association with the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";

-The trade-mark SECRET SO SOFT for which an application was filed on January 26, 1993 under number 721,438 in association with the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";

-The trade-mark SECRET SO SOFT TRÈS DOUX for which an application was filed on November 27, 1992 under number 717,786 in association with the following wares: "Clothing, namely hosiery, socks, stockings, panty hose, lingerie, undergarments, knee highs and tights";

ANNEX C

- (1) The trade-mark SECRET LIFT for which an application was filed on May 26, 1997 under number 846,069 for the following wares: "Men's, ladies and children's hosiery, namely panty hose, thigh highs, knee highs, ankle highs, tights, socks and stockings, sports socks, dress socks and knee socks";
- (2) The trade-mark SECRET MEDI-SUPPORT for which an application was filed on April 30, 1997 under number 843,834 for the following wares: "Graduated compression medical hosiery for men and women, namely panthyose, socks, stockings and kneehights";
- (3) The trade-mark HER CHOICE BY SECRET for which an application was filed on March 24, 1996 under number 840,251 for the following wares: "Headwear, namely, earmuffs; woven and leather gloves; scarves; umbrellas";
- (4) The trade-mark LITTLE SECRETS for which an application was filed on March 5, 1997 under number 838,447 for the following wares: " Children's and infant's underwear, namely briefs and undershirts";
- (5) The trade-mark HER CHOICE/SON CHOIX BY/PAR SECRET for which an application was filed on March 5, 1997 under number 838,445 for the following wares: "Headwear, namely, earmuffs; woven and leather gloves; scarves; umbrellas";
- (6) The trade-mark SECRET for which an application was filed on March 5, 1997 under number 838,438 for the following wares: "Headwear, namely, earmuffs; woven and leather gloves; scarves; umbrellas";
- (7) The trade-mark SECRET TONE-UP for which an application was filed on November 18, 1996 under number 829,097 for the following wares: "Underwear, namely: bras, panties, slips, bodyliners, bodystockings, garter belts, g-strings, thongs, teddies, chemises, camisoles; pantyhose and hosiery";
- (8) The trade-mark SECRET for which an application was filed on November 1,1996 under number 827,511 for the following wares: "(1) Woven and knitted headwear including earmuffs; woven and leather gloves, and umbrellas";
- (9) The trade-mark HER CHOICE/SON CHOIX BY/PAR SECRET for which an application was filed on November 1, 1996 under number 827,508 for the following wares: "(1) Woven and knitted headwear including earmuffs; woven and leather gloves, and umbrellas";

(10) The trade-mark HER CHOICE BY SECRET for which an application was filed on November 1, 1996 under number 827,509 for the following wares: "(1) Woven and knitted headwear including earmuffs; woven and leather gloves, and umbrellas";

(11) The trade-mark SECRET VIRTUAL SKIN/VOILE DE PEAU for which an application was filed on September 9, 1996 under number 822,742 for the following wares: "Ladies hosiery, namely: thigh high's, knee high's and pantyhose";

(12) The trade-mark HER CHOICE/SON CHOIX BY/PAR SECRET for which an application was filed on August 9, 1996 under number 820,254 for the following wares: "(1) Activewear, namely exercise tights, leggings exercise leotards, sweat pants, sweat shirts, T- shirts, underwear; and knitwear, namely hats, mitts, gloves and scarves";

(13) The trade-mark HER CHOICE/SON CHOIX BY/PAR SECRET, for which an application was filed on August 14, 1996 under number 820,253 for the following wares: "(1) Panty hose, socks, thigh highs and stocking. (2) Trouser socks, ankle highs and knee highs";

(14) The trade-mark SECRET for which an application was filed on July 26, 1996 under number 819,113 for the following wares: "Knitwear, namely, hats, mitts, gloves and scarves";

(15) The trade-mark HER CHOICE BY SECRET for which an application was filed on July 26, 1996 under number 819,112 for the following wares: "Knitwear, namely, hats, mitts, gloves and scarves".

(16) The trade-mark SECRET NO-SEAM for which an application was filed on May 13, 1996 under number 812,441 for the following wares: "Ladies' panty hose and ladies' hosiery";

(17) The trade-mark SECRET ACTIVE SHEERS for which an application was filed on March 12, 1996 under number 806,920 for the following wares: "Clothing, namely hosiery, pantyhose and undergarments";

(18) The trade-mark SECRET for which an application was filed on October 11, 1995 under number 794,644 for the following wares: "Underwear, undergarments and lingerie".