IN THE MATTER OF AN OPPOSITION by Manufacturiers De Bas De Nylon Doris Ltée/ Doris Hosiery Mills Ltd. to application No. 516,906 for the trade-mark VICTORIA'S SECRET filed by Victoria's Secret, Inc.

On February 13, 1984, the applicant, Victoria's Secret, Inc., filed an application to register the trade-mark VICTORIA'S SECRET based upon use of the trade-mark in Canada by the applicant and its predecessor-in-title, Victoria's Secret, Inc., since at least as early as 1977 in association with:

> "services associated with the operation of mail order and retail store sales of wearing apparel"

and in association with the following wares:

> "lingerie, women's and men's undergarments and nightwear, robes, caftans, and kimonos, slippers, sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes and atomizers".

The application was also based upon proposed use of the trade-mark in Canada in association with:

> "fragrances, namely, perfumes, cologne, air fresheners, sachets, scented hangers and potpourris; cosmetics and personal care products, namely, body lotions, moisturizers, soaps, shampoos, bath oils, make-up brushes, mirrors and razors"

and in association with:

> "services associated with the operation of mail order and retail store sales of sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes, atomizers, fragrances, cosmetics and personal care products".

The opponent, Manufacturiers De Bas De Nylon Doris Ltée/ Doris Hosiery Mills Ltd., filed a statement of opposition on May 1, 1985 in which it alleged that the applicant's trade-mark VICTORIA'S SECRET is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user in Canada by the opponent of the following registered trade-marks:

Trade-mark	Registration No.
SECRET PLUS	266,493
SECRET SPARE PAIR	248,327
SECRET PAIRE DE SECOURS	248,329
SECRET ELEGANTE	238,401
SECRET COLLECTION	251,580
SECRET SHEEREST COLLECTION	279,769
SECRET SILKY SUPREME	274,608
SECRET SILKY PANTY	279,703
SECRET SUPER SOX	289,872
SECRET Design	285,242

SECRET CONTROL PANTY	236,847
SECRET CONTROL TOP	236,848
SECRET ALL-DAY	235.954
SUPER SECRET	235,955
ALL-DAY SECRET	202,513
ULTRA SECRET	202,514
NUDE SECRET	202,515
BIG SECRET	195,442
GO SECRET	195,443
SHEER SECRET	208,096
TOP SECRET	195,774
SUPPORT SECRET	197,775
SECRET MOTIF	299,976
SECRET	298,736
SECRET COLOUR COLLECTION	298,725
SECRET BRIDAL COLLECTION	297,084

The applicant served and filed a counterstatement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Jack Hasen who was cross-examined on his affidavit, the transcript of the cross-examination and the undertakings furnished by the opponent forming part of the record in this opposition.

The applicant filed as its evidence the affidavit of Howard Gross who was also cross-examined on his affidavit, the transcript of his cross-examination and the undertakings furnished by the applicant forming part of the record in this opposition. The applicant also filed as part of its evidence the affidavits of Rachel Worthington, Darlene Takarski, Struss Shirk and Dori Huff. As these affiants were not made available for cross-examination pursuant to the order for cross-examination of April 14, 1989, their affidavits were deemed not to form part of the record in this opposition.

The applicant sought to maintain the Worthington, Takarski, Shirk and Huff affidavits as part of the record in this opposition by having them identified by Mr. Gross as part of his re-examination and annexing them as exhibits to the transcript of the cross-examination and re-examination of Mr.

Gross. The scope of proper re-examination in an opposition was discussed by the Opposition Board Member in Bedford Bedding & Upholstery Ltd. v. Duff, carrying on business as The Mattress King, 24 C.P.R. (3d) 326, at page 329 as follows:

In my view, the annexing of the four affidavits as exhibits to the Gross cross-examination and re-examination far exceeds the scope of proper re-examination of Mr. Gross. I therefore consider the photocopies of the four affidavits to be inadmissible evidence in this opposition.

Even if I am incorrect in excluding the four affidavits for the reasons noted above, I consider that little, if any, weight should be accorded these affidavits even if they were admissible. In particular, I would question the accuracy of the Huff affidavit in that the affiant indicates that, as of the date of her affidavit, she has been employed by the applicant for approximately six weeks and has been store manager of one of the applicant's stores for one month. On the other hand, in paragraph 7 of her affidavit, she states in part:

> 7. There are a number of ways that I know Canadian residents shop at the Victoria's Secret store in Albany, New York. For example, as Store Manager, I have over the years spoken with hundreds of Canadian customers in the Victoria's Secret store I manage, who have identified themselves as being from Canada.

Either the affidavit is incorrect as to the length of Ms. Huff's employment as store manager with the applicant or Ms. Huff swore to the contents of her affidavit without regard to what was said in it. In view of the ambiguity in the Huff affidavit, I would not be prepared to accord any weight to it even were it otherwise admissible as evidence in this opposition. Further, all four affidavits are form affidavits which are essentially identical in content but for reference to the locations and sizes of the stores managed by the affiants. On this further basis, I would not accord any weight to the content of these affidavits were they otherwise admissible.

The main issue in this opposition is whether there would be a likelihood of confusion between the applicant's trade-mark VICTORIA'S SECRET as applied to the wares and services covered in the applicant's application and one, or more, of the opponent's registered trade-marks identified in the statement of opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the

surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (F.C.A. No. A-263-89, dated June 24, 1991, yet unreported) and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (application serial No. 584,296 for the trade-mark GOURMET WORLD, decision dated July 31, 1991).

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark VICTORIA'S SECRET and the opponent's trade-marks comprising or including the element SECRET are inherently distinctive when considered in their entireties even though a number of the opponent's marks include descriptive elements which have been disclaimed by the opponent.

The opponent's evidence establishes that its registered trade-mark SECRET, as well as a number of the opponent's other SECRET related trade-marks, have become well known in Canada in association with panty hose and ladies' hosiery. In this regard, the Hasen affidavit establishes that the opponent sold in excess of 4,600,000 dozen panty hose and hosiery in Canada in association with its trade-mark SECRET and its related SECRET trade-marks for the years 1980 to 1985 alone. The applicant's evidence establishes that its trade-mark VICTORIA'S SECRET has become known to some extent in Canada through its mail order service and the distribution of its catalogues provided to Canadian customers, as well as its sales to Canadian customers in its retail outlets located in the United States of America in close proximity to the Canadian border. However, the opponent's evidence does not indicate the extent to which its mark has become known in association with the various specific wares identified in its application, nor does it indicate the extent to which its trade-mark has become known to Canadians shopping in its VICTORIA'S SECRET shops located in the United States.

The length of time that the trade-marks at issue have been in use favours the opponent in this opposition in that the opponent has used its registered trade-mark SECRET in Canada in association with stockings, panty hose and hosiery since 1967 whereas the applicant has claimed use of its mark in this country in association with the operation of its VICTORIA'S SECRET mail order service, as

well as in association with the wares sold through the mail order service, since 1977.

The opponent's panty hose, tights stockings and hosiery differ specifically from most of the wares and services covered in the applicant's application. 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.

To the extent that the above wares of the parties are overlapping or are closely related, I consider that the channels of trade associated with these wares could potentially overlap. While the applicant submitted that its wares are sold through its VICTORIA'S SECRET shops in the United States of America, the present trade-mark application does not limit the applicant's statement of wares to any specific channel of trade. However, it is the potential channels of trade which the average consumer would consider as being associated with the wares covered in an applicant's application, rather than the applicant's present channels of trade, which must be considered when determining whether an applicant's trade-mark is confusing with a registered trade-mark of an opponent. In this regard, it is the wares as described in the applicant's application which determine the scope of the monopoly which will be accorded the applicant should its application proceed to registration. I would also note the following comments of the Member of the Opposition Board in Avon Park Fashions Inc. v. Avon Canada Inc., 30 C.P.R. (3d) 550 , at pg. 554:

As for the degree of resemblance between the trade-marks at issue, I consider their to be a fair degree of similarity between the applicant's trade-mark VICTORIA'S SECRET and the opponent's registered trade-mark SECRET in both appearance and sounding. I would also note that the applicant has included the entirety of the applicant's registered trade-mark SECRET in its VICTORIA'S SECRET trade-mark.

As a further surrounding circumstance, the opponent has established the existence of a family of trade-marks including the mark SECRET although all of the opponent's trade-marks have been used only in association with panty hose, tights, hosiery or stockings.

As yet a further surrounding circumstance, the applicant sought to rely upon the transcript of the Hasen cross-examination to establish that the trade-marks SECRET SLIMMERS has been used in Canada by Sears. While Mr. Hasen does indicate that he is aware of the trade-mark SECRET SLIMMERS, it is clear from the transcript of his cross-examination that Mr. Hasen has not indicated the wares in association with which the trade-mark has been used in this country although the undertakings furnished by the opponent reveal that the trade-mark SECRET SLIMMERS is registered in association with girdles and panties. Further, Mr. Hasen indicates that he is aware that a company called Precious Secret produces maternity clothing in Canada. On the other hand, the opponent's evidence confirms that it had taken steps to oppose the registration of other trade-marks including the word SECRET or has initiated Section 45 proceedings or has undertaken other steps to protect its rights in Canada in its trade-marks comprising or including the mark SECRET.

In view of the above, I have concluded that the applicant has failed to discharge the legal burden upon it in respect of the issue of confusion between its trade-mark VICTORIA'S SECRET as applied to lingerie and women's undergarments and the opponent's registered trade-mark SECRET. On the other hand, I do not consider that there would be any reasonable likelihood of confusion between the applicant's trade-mark VICTORIA'S SECRET and any of the opponent's registered trade-marks as applied to the remaining wares and services covered in the applicant's application. In this regard, I would note the finding of the Federal Court, Trial Division in respect of there being authority to render a split decision in Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH, 10 C.P.R. (3d) 492.

I reject the opponent's opposition to registration of the trade-mark VICTORIA'S SECRET in relation to

"women's nightwear, men's undergarments and nightwear, robes, caftans, and kimonos, slippers, sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes and atomizers"

"fragrances, namely, perfumes, cologne, air fresheners, sachets, scented hangers and potpourris; cosmetics and personal care products, namely, body lotions, moisturizers, soaps, shampoos, bath oils, make-up brushes, mirrors and razors"

"services associated with the operation of mail order and retail store sales of wearing apparel"

"services associated with the operation of mail order and retail store sales of sachets, lingerie bags, hanging bags, hangers, candles, soaps, cosmetic brushes, atomizers, fragrances, cosmetics and personal care products"

and otherwise refuse the applicant's application in respect of "lingerie, women's undergarments" in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF OCTOBER 1991.

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