

**IN THE MATTER OF AN OPPOSITION by The Governor and Company of Adventurers of England trading into Hudson's Bay, also known as the Hudson's Bay Company, to application No. 837,673 for the trade-mark FRIDAY EXPRESSIONS filed by IRIS HOSIERY INC.**

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On August 2, 1991, London Drugs Limited filed an application to register the trade-mark EXPRESSIONS based upon proposed use of the trade-mark in Canada in association with:

*“cosmetic brushes, namely retractable lip liner brushes, lip liner brushes, eyeshadow shading brushes, eyeshadow brushes, eyeliner brushes, eyebrow and eyelash brushes, blush brushes, powder brushes, contour brushes, complexion brushes; powder puffs; cotton swabs, cotton balls; cosmetic sponges; cosmetic pencil sharpeners; eyelash curlers; tweezers; cosmetics, namely lipstick, lip gloss, lip liner pencils, eyeliner pencils, nail polish, namely base coat, top coat, and nail enamel; manicure sets; nail accessories, namely false fingernails, nail glue, nail files, emery boards, nail clippers, nail buffers, nail scissors; pedicure products, namely corn and callous files, nail groomers, pumice sponges, pumice and nail brush combinations; foot lotion”.*

The present application was advertised for opposition purposes in the *Trade-marks Journal* of February 19, 1992 and the opponent, The Governor and Company of Adventurers of England trading into Hudson's Bay, also known as Hudson's Bay Company, filed a statement of opposition on June 3, 1992. The opponent requested and was granted leave pursuant to Rule 42 [now Rule 40] of the *Trade-marks Regulations* to amend its statement of opposition during the opposition proceeding. In its amended statement of opposition, the opponent alleged that the present application does not comply with Section 30 of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use its trade-mark in Canada since, as of its filing date, the applicant was or should have been aware of the prior use and registration of the trade-marks EXPRESSION and EXPRESSION & Design by the opponent's predecessor-in-title, Simpsons Limited. The opponent also alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark EXPRESSIONS is confusing with the its registered trade-marks EXPRESSION and EXPRESSION & Design, registration Nos. 292,329, 292,581 and 377,407, previously used in Canada by the opponent and its predecessor-in-title, Simpsons Limited, in association with the wares and services covered in its registrations.

The applicant filed and served a counter statement and subsequently an amended counter statement in which it asserted that its application complies with Section 30 of the *Trade-marks Act*, that its trade-mark is registrable and distinctive, and that it is the person entitled to registration of the trade-mark EXPRESSIONS. The opponent filed as its evidence the affidavits of Randall Castel, Robert A. Murray, Daniel Rosicky, Melville Edward Henderson, Sylvia Mulholland and Maria Teresita Fernando, together with certified copies of registration Nos. 292,329, 292,581 and 377,407 for the trade-marks EXPRESSION and EXPRESSION & Design. The applicant submitted as its evidence the affidavits of Jane S. Baggott and Leonard E. Marks. As evidence in reply, the opponent filed the affidavits of Alison A. Gilmour, Shirley Lai-Kwan Ling and a second affidavit of Randall Castel. Further, the opponent was granted leave pursuant to Rule 46(1) [now Rule 44(1)] of the *Trade-marks Regulations* to adduce the affidavit of Mark Jason August as further evidence in this opposition. Both parties submitted written arguments and both were represented at an oral hearing.

During the oral hearing, the issue arose as to whether the opponent's Rule 45 [now Rule 43] affidavits were strictly confined to matter in reply to the applicant's evidence. The opponent argued that the affidavits were put forward in response to the Baggott affidavit. However, even taking into consideration the possible ambiguity in the evidentiary significance of the Baggott affidavit, I do not consider the Gilmour, Ling or the second Castel affidavits to be proper reply evidence in this opposition. Rather, these affidavits ought to have been filed by the opponent as its evidence in chief pursuant to Rule 43 [now Rule 41(1)] or the opponent ought to have sought leave to file them as further evidence pursuant to Rule 46(1) [now Rule 44(1)] of the *Trade-marks Regulations*. I have therefore ignored these affidavits in determining the outcome of this opposition.

The first ground of opposition set forth in the amended statement of opposition is based on Section 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied that it was entitled to use the trade-mark EXPRESSIONS in Canada in association with the wares covered in the present application in that, as of the applicant's filing date, the applicant was or should have been aware of the use and registration by the opponent and its predecessor-in-title, Simpsons Limited, of the EXPRESSION and EXPRESSION & Design trade-marks in Canada. While the legal burden is upon the applicant to show that its application complies with Section 30(i)

of the *Trade-marks Act*, there is an initial evidentiary burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. As no evidence has been filed by the opponent in support of its allegations that the applicant could not have been satisfied that it was entitled to use the trade-mark EXPRESSIONS in Canada, it has failed to meet the evidentiary burden upon it in respect of this ground. In any event, and even had the applicant been aware of the opponent's EXPRESSION and EXPRESSION & Design trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark EXPRESSIONS in Canada on the basis *inter alia* that its mark is not confusing with the opponent's trade-marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at pg. 155].

The determination of the issue of confusion between the applicant's trade-mark EXPRESSIONS and the opponent's trade-marks EXPRESSION and EXPRESSION & Design will resolve all of the remaining grounds of opposition. With respect to the Section 12(1)(d) ground, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)] while the material dates in relation to the non-entitlement and non-distinctiveness grounds of opposition are, respectively, the applicant's filing date [August 2, 1991] and the date of opposition [June 3, 1992]. Furthermore, in assessing 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*. Also, 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 inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark EXPRESSIONS is inherently distinctive as applied to the wares covered in the present application. Likewise, the opponent's trade-marks EXPRESSION and EXPRESSION & Design are

inherently distinctive as applied to the wares and services covered in its trade-mark registration Nos. 292,329 and 292,581. However, the opponent's registered trade-mark EXPRESSION [registration No. 377,408] as applied to periodical publications is somewhat suggestive, thus lessening the measure of inherent distinctiveness of the opponent's trade-mark as applied to these wares.

The applicant's trade-mark has become known to a minor extent in Canada with the sale through its drug and general merchandise stores of approximately 53,000 items bearing the trade-mark EXPRESSIONS. On the other hand, the opponent's trade-mark EXPRESSION has become known in Canada in association with footwear and clothing, as well as the operation in The Bay and Simpsons department stores of a fashion section specializing in the sale of *inter alia* clothing and personal care products. However, the opponent's evidence certainly does not substantiate its submission that its EXPRESSION trade-mark has become either well known or famous in association with any of its wares or services. Indeed, apart from approximately \$5,900,000 in sales and 'anticipated sales' of EXPRESSION shoes and ladies' clothing from 1991 to 1993 and the operation of its EXPRESSION boutiques in its Hudson's Bay and Simpsons department stores, the opponent has adduced relatively little evidence which would point to it having established any significant reputation in Canada in association with its trade-mark. Further, the opponent's trade-mark EXPRESSION has only become known to a very minor extent in association with periodical publications. In this regard, the Murray affidavit indicates that since 1990 the trade-mark EXPRESSION has only served to identify a section of *Canadian Living* magazine, and appears in issues of the magazine six times a year.

While the opponent's evidence does not substantiate its position that its trade-mark EXPRESSION is famous, I am satisfied that the extent to which the trade-marks at issue have become known clearly favours the opponent in this opposition. Likewise, the length of use of the trade-marks of the parties weighs in the opponent's favour. In this regard, the applicant commenced using its trade-mark EXPRESSIONS in Canada in 1990 while the opponent's predecessor-in-title, Simpsons Limited, commenced using the trade-mark EXPRESSION in Canada in 1975 when it began operating a section of the Simpsons department store under the trade-mark.

Considering the degree of resemblance between the trade-marks at issue, the applicant's trade-mark EXPRESSIONS and the opponent's trade-mark EXPRESSION and EXPRESSION & Design are very similar in appearance and sounding, as well as in the ideas suggested. As a result, the only remaining criteria which the Registrar must consider under Section 6(5) of the Act, apart from any additional surrounding circumstances, are the nature of the wares and services of the parties and their respective channels of trade. In this regard, I consider there to be little similarity between the applicant's "*cosmetic brushes, namely retractable lip liner brushes, lip liner brushes, eyeshadow shading brushes, eyeshadow brushes, eyeliner brushes, eyebrow and eyelash brushes, blush brushes, powder brushes, contour brushes, complexion brushes; powder puffs; cotton swabs, cotton balls; cosmetic sponges; cosmetic pencil sharpeners; eyelash curlers; tweezers; cosmetics, namely lipstick, lip gloss, lip liner pencils, eyeliner pencils, nail polish, namely base coat, top coat, and nail enamel; manicure sets; nail accessories, namely false fingernails, nail glue, nail files, emery boards, nail clippers, nail buffers, nail scissors; pedicure products, namely corn and callous files, nail groomers, pumice sponges, pumice and nail brush combinations; foot lotions*" and the opponent's clothing, headwear, shoes, jewellery, periodical publications and its services relating to the operation of a fashion shop specializing in the sale of clothing, headwear and shoes.

With respect to the issue of the channels of trade, both parties made submissions at the oral hearing as to the relevance of the Federal Court decision in *S.C. Johnson & Son, Inc. v. Esprit de Corp. et al*, 13 C.P.R. (3d) 235 to the present opposition. In the *S.C. Johnson & Son, Inc.* case, an application to register the trade-mark ESPRIT in association with "*personal care products, namely, hair shampoos, hair conditioners, cosmetic and toilet preparations, more specifically, hair care preparations*" was opposed on the basis that the trade-mark was confusing with the registered trade-marks ESPRIT and ESPRIT DE CORPS covering clothing. In the decision of the Opposition Board reported at 3 C.P.R. (3d) 451, the Hearing Officer refused the application under Section 12(1)(d) of the *Trade-marks Act* and that decision was appealed to the Federal Court.

In allowing the appeal, Mr. Justice Cullen concluded that, in view of the state of the register evidence before him, the opponent's trade-marks were inherently weak marks and were therefore not entitled to a range of protection beyond the wares for which they were registered and used, that

is, clothing. As well, Cullen, J. relied upon expert opinion evidence which had been submitted on appeal in finding that “designer” and “signature” trade-marks such as GIVENCHY, CHANEL, RALPH LAUREN and CHRISTIAN DIOR which are applied to both clothing and cosmetics are rarely used in association with hair care products, the wares covered in the applicant’s application in the ESPRIT case. As a result, the learned trial judge concluded that the Hearing Officer had erred in taking judicial notice that cosmetics and clothing were part of the fashion industry.

In the present opposition, the opponent’s EXPRESSION trade-mark is inherently distinctive and is therefore entitled to a broader ambit of protection than was accorded the opponent’s marks in the ESPRIT case. Moreover, no expert evidence has been adduced in the present opposition relating to the channels of trade associated with the wares and services of the parties. Further, while the opponent’s registrations cover clothing, the applicant’s application does not cover hair care products. As a result, I consider the ESPRIT decision to be of limited relevance to a consideration of the issue of confusion between the trade-marks at issue in this opposition.

The opponent adduced the Fernando and Rosicky affidavits in an attempt to show that the channels of trade of the parties are closely related. The Fernando affidavit introduces into evidence the results of computer searches conducted by Ms. Fernando of trade-mark registrations and pending applications covering both cosmetics and clothing. However, the results of the searches indicate that there are 895 active trade-mark registrations in Canada as of the date of the searches covering both cosmetics and related goods, and clothing. However, the affiant has not provided a list of the trade-marks or their owners. Further, there is no way of determining from the Fernando affidavit whether the vast majority of the trade-marks are designer or signature marks or, indeed, whether the marks stand in the name of a limited number of registrants. Having regard to these deficiencies in the results of the searches conducted by Ms. Fernando, I am not prepared to accord much weight to this evidence. On the other hand, the Rosicky affidavit does show that cosmetics, personal care products and clothing are offered for sale in close proximity to each other in various areas of the opponent’s department store visited by the affiant, as well as in other similar department stores which Mr. Rosicky visited. As the applicant’s application specifically cover cosmetics, as well as a number of personal care products such as cosmetic brushes of various kinds, cosmetic sponges, powder puffs,

nail accessories and pedicure products, the Rosicky affidavit does provide some evidence of a potential overlap in the channels of trade of the parties.

In his affidavit, Leonard E. Marks, Vice-President, General merchandising and Pharmacy of the applicant, states that the trade-mark EXPRESSIONS is an in-house brand of the applicant, such that wares bearing the trade-mark EXPRESSIONS are only sold through its forty-one London drug and general merchandise stores. However, the present application does not include any restriction in the statement of wares which limit the channels of trade associated with its wares to being sold only through the applicant's stores. As a result, and should the applicant's application proceed to registration, the applicant would be accorded the right to the exclusive use of the trade-mark EXPRESSIONS in respect of those channels of trade which would normally be associated with the wares covered in the present application.

Having regard to the degree of resemblance between the trade-marks at issue and considering that the opponent's evidence does point to there being a potential overlap in the channels of trade associated with the wares covered in the applicant's application and the opponent's registrations which include clothing, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion between its trade-mark and the opponent's registered trade-marks EXPRESSION and EXPRESSION & Design. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act*.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to s. 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 16<sup>th</sup> DAY OF OCTOBER, 1996.

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