

IN THE MATTER OF AN OPPOSITION by Soapberry Shop Inc. to application No. 767,311 for the trade-mark Tulip & Octagon Design filed by U L Canada Inc.

On October 28, 1994, the applicant, U L Canada Inc., filed an application to register the trade-mark Tulip & Octagon Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with “Facial cleansers, moisturizers, and acne treatment products for the skin, namely blemish solution, blemish cream, blemish spot mask, and cleansing cloth.”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 8, 1995 and the opponent, Soapberry Shop Inc., filed a statement of opposition on April 9, 1996, a copy of which was forwarded to the applicant on May 3, 1996. In its statement of opposition, the opponent alleged that the applicant’s trade-mark Tulip & Octagon Design is not registrable and not distinctive, that the applicant is not the person entitled to its registration, and that the present application is contrary to Subsection 30(i) of the *Trade-marks Act*, in view of the registration and prior use by the opponent of its registered design trade-mark, registration No. 345,973, covering the following wares:

“Natural skin, hair, body and bath preparations, namely tonics, lotions, creams, oils, gels, cleansers, facial masks, toners, scented waters, moisturizers, shampoos, conditioners and soaps, cosmetics, namely eyeshadows, blushers, lipsticks, mascara, face powders, foundations and make-up pencils, toiletries, namely perfumes, deodorants, shaving creams and talcum powders, and accessories, namely sponges, massage mitts, scalp massagers, pumice stones, emery boards, cosmetic bags, cosmetic brushes, hair twisters, hair combs and hair brushes”

as well as the following services:

“Retail store services specializing in the sale of skin and beauty products.”

A representation of the opponent’s registered design trade-mark is set out below.

Registration No. 345,973

The applicant served and filed a counter statement in which it effectively denied the allegations set forth in the statement of opposition. Neither party submitted evidence or written argument and neither party requested an oral hearing.

As no evidence has been submitted by the opponent in this opposition, the opponent has failed to meet the burden upon it under Subsections 16(5) and 17(1) of the *Trade-marks Act* of showing its prior use of its design trade-mark in this country, as well as establishing that it had not abandoned its mark as of the date of advertisement of the applicant's application in the *Trade-marks Journal*. I have therefore dismissed the non-entitlement ground of opposition. As well, the opponent has not met the evidential burden upon it in respect of its ground relating to the alleged non-distinctiveness of the applicant's mark and its Subsection 30(i) ground, both of which I have also dismissed.

The only remaining ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's trade-mark Tulip & Octagon Design and its registered design trade-mark, registration No. 345,973. In a situation where an opponent is relying on the existence of a registered trade-mark but has filed no evidence of such, the Registrar has the discretion to check the register in order to confirm the existence of the registration [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410]. In doing so, I noted that the opponent's registered design trade-mark is still in force and covers the wares and services identified above.

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark Tulip & Octagon Design and the opponent's registered design trade-mark within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Subsection 6(5) of the *Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision, the material date in relation to the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)].

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark Tulip & Octagon Design as applied to facial cleansers, moisturizers, and acne treatment products for the skin, namely blemish solution, blemish cream, blemish spot mask, and cleansing cloth and the opponent's registered design trade-mark as applied to the wares and services covered in its registration are inherently distinctive. As no evidence has been adduced by either party relating to use of their respective trade-marks, neither the extent to which the trade-marks have become known nor the length of time the trade-marks at issue have been in use are relevant surrounding circumstances in assessing the issue of confusion in this opposition.

The wares of the parties overlap in that the present application covers "facial cleansers, moisturizers" and the opponent's registration covers cleansers and moisturizers. Further, the channels of trade associated with the wares of the parties would appear to overlap.

As for the degree of resemblance between the trade-marks at issue, there is no similarity either in sounding or in the ideas suggested by the two design marks and, in my view, the marks bear little, if any, similarity in appearance.

As there is little similarity in appearance and no similarity in sounding or in the ideas suggested by the trade-marks at issue, I have concluded that there would be no reasonable likelihood

of confusion between the applicant's Octagon & Tulip Design and the opponent's registered design trade-mark. I have therefore rejected the Paragraph 12(1)(d) ground of opposition.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition in view of the provisions of Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 30th DAY OF APRIL, 1998.

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