

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. 687,113 for the trade-mark EXPRESSIONS filed by London Drugs Limited

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 “*hair dryers, shower caps, mirrors, cosmetic bags, hair accessories and hair preparations*”. The applicant subsequently amended its application to cover: “*hair dryers, shower caps, mirrors, cosmetic bags and hair accessories*”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of November 13, 1991 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 March 11, 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 view of the registration and prior user

by the opponent of its registered trade-marks EXPRESSION and EXPRESSION & Design, registration Nos. 292,329 and 292,581. Further, the opponent alleged that the applicant is not the person entitled to registration and the applicant's trade-mark is not distinctive in that the trade-mark EXPRESSIONS was confusing as of the filing date of the present application with the opponent's trade-mark EXPRESSION, previously used in Canada by the opponent and its predecessor-in-title, Simpsons Limited, in association with periodical publications, and in respect of which an application for registration had been previously filed in Canada by Simpsons Limited.

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.

At 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 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 its 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 [June 19, 1990] and the date of opposition [March 11, 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 “*hair dryers, shower caps, mirrors, cosmetic bags and hair accessories*”. 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 registrations. However, the opponent’s trade-mark EXPRESSION 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 some extent in Canada with the sale through its drug and general merchandise stores of approximately 60,000 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 measure of a 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-marks 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 "*hair dryers, shower caps, mirrors, cosmetic bags and hair accessories*" 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 applicability 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 this 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 either hair care preparations or cosmetics. 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 Rosicky affidavit in an attempt to show that the channels of trade of the parties are closely related. In particular, the opponent has relied upon the Rosicky affidavit to demonstrate that cosmetics, personal care products and clothing are offered for sale in close proximity to each other in the opponent's department store visited by the affiant, as well as in other similar department stores. However, the applicant's application does not cover cosmetics and I would not characterize any of the applicant's wares as being personal care products. As a result, the Rosicky affidavit is of little relevance to the channels of trade of the parties in this opposition. Likewise, the results of the state of the register search undertaken by Ms. Fernando of trade-marks covering both cosmetics and clothing are of little relevance as the applicant's application does not cover cosmetics.

In view of the above, I find there to be no overlap in the channels of trade associated with the applicant's wares and the opponent's clothing, jewellery and shoes. Further, I do not consider that "*hair dryers, shower caps, mirrors, cosmetic bags and hair accessories*" would be sold in a fashion boutique which specializes in the sale of *inter alia* clothing, cosmetics and personal care preparations. As well, I do not consider there to be any potential overlap in the channels of trade associated with the applicant's wares and the opponent's periodical publications.

Having regard to the differences in the wares and services of the parties and their respective channels of trade, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion between its trade-mark EXPRESSIONS and the opponent's EXPRESSION trade-marks. As a result, I have rejected the Sections 12(1)(d) and 16 grounds, as well as the non-distinctiveness ground of opposition.

Having rejected each of the grounds of opposition, and having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to s. 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 16th DAY OF OCTOBER, 1996.

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