



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 126
Date of Decision: 2014-06-23

IN THE MATTER OF AN OPPOSITION
by Chanel S. de R.L. to application
No. 1,464,417 for the trade-mark EDEN
ALLURE & Tree Design in the name of
Cultural Connections LLC.

FILE RECORD

[1] On December 30, 2009, Cultural Connections LLC filed an application to register the trade-mark EDEN ALLURE & Tree Design, shown below, for use in association with the wares listed below:



Eden Allure

wares

- (1) body and beauty care cosmetics,
- (2) face creams for cosmetic use; body soaps; shampoos; lip balm.

[2] The application is based on use of the mark in Canada since December 18, 2009 on the wares denoted (1) and is based on proposed use in Canada on the wares denoted (2).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 16, 2010 and was opposed by Chanel S. de R.L. on November

16, 2010. The Registrar forwarded a copy of the statement of opposition to the applicant on November 23, 2010, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent, with the consent of the applicant, requested a six months “cooling-off” period to settle their differences, which extension was granted until February 10, 2012. However, the parties were unable to reach a settlement.

[4] The opponent’s evidence consists of the affidavits of Naomi Machado and Aleksandar Vukovic, as well as certified copies of the opponent’s Canadian trade-mark registrations for the marks ALLURE; ALLURE HOMME SPORT; and ROUGE ALLURE. The applicant’s evidence consists of the declaration of Todd Smith (sworn in the State of Florida). Both parties filed a written argument and both parties were represented at an oral hearing held on May 22, 2014.

STATEMENT OF OPPOSITION

Pleadings

[5] The opponent pleads that it is the owner of the registered marks ALLURE; ALLURE HOMME SPORT; and ROUGE ALLURE as well as the marks ALLURE SENSUELLE; ALLURE HOMME; and ALLURE HOMME ÉDITION BLANCHE, which have become well known and distinctive across Canada as marks of the opponent for use in association with perfume, lipstick and various body care products.

Grounds of Opposition

[6] Various grounds of opposition are alleged, which may, albeit loosely, be characterized as (i) “technical” grounds, based on s.30 of the *Trade-marks Act*, having to do with whether the application itself complies with content requirements, and (ii) “substantive” grounds which turn on the issue of whether the parties’ marks are confusing.

Technical Grounds

s.30(b) - Compliance

[7] The opponent alleges that the applied-for mark EDEN ALLURE & Tree Design has not in fact been used in Canada in association with the wares denoted (1), that is, body and beauty care cosmetics, since the date of first use claimed in the application, that is, December 30, 2009.

s.30(i) - Compliance

[8] The opponent alleges that the applicant could not have been satisfied that it was entitled to use the applied-for mark EDEN ALLURE & Tree Design given the opponent's prior use of its marks comprised of the term ALLURE.

Substantive Grounds

s.12(1)(d) - Registrability

[9] The opponent alleges that the applied-for EDEN ALLURE & Tree Design mark is not registrable because it is confusing with one or more of the opponent's registered marks ALLURE; ALLURE HOMME SPORT; and ROUGE ALLURE.

s.16(3)(a) - Entitlement

[10] The opponent alleges that the applicant is not entitled to use the applied-for mark EDEN ALLURE & Tree Design, in association with the wares face creams for cosmetic use; body soaps; shampoos; lip balm (i.e., the proposed use wares) because such use would cause confusion with one or more of the opponent's marks.

s.2 – Distinctiveness

[11] The opponent alleges that the applied-for mark EDEN ALLURE & Tree Design neither distinguishes nor is adapted to distinguish the applicant's wares from the wares of the opponent sold under its marks ALLURE; ALLURE HOMME SPORT; ROUGE ALLURE; ALLURE SENSUELLE; ALLURE HOMME; and ALLURE HOMME ÉDITION BLANCHE

[12] Before addressing the grounds of opposition, I will first review the evidence of record, the evidential burden on the opponent, and the legal onus on the applicant. I will then consider the grounds of opposition in the order in which they are pleaded, that is, first the technical grounds pursuant to s.30 of the *Trade-marks Act*, and then the substantive grounds pursuant to sections 12, 16, and 2.

OPPONENT'S EVIDENCE

Naomi Machado

[13] Ms. Machado identifies herself as a paralegal employed by the firm representing the opponent. In April 2012 she performed an Internet search on the parameters “ ‘eden allure’ & Canada” The first three pages of results are attached as Exhibit NM-1 to her affidavit. She then clicked on the first ten links on the first page, printouts of which comprise Exhibits NM-2 to NM-11.

[14] The exhibit material referred to above indicates that the applied-for mark is used in association with argan oil, derived from the Argan tree found in Morocco. The oil is described as being rich in anti-oxidants, fatty acids and vitamin D; it is recommended for application to skin, hair and nails.

[15] The information in Exhibit NM-8, portions of which are corroborated by other exhibit material, is as follows:

Eden Allure is the brand name of cultural connections, LLC, an American manufacturer of argan oil based natural skin, hair, and body care products.

It was founded in Orlando, FL in 2007. It currently has customers worldwide.

The Eden Allure brand includes premium skin, hair, and body care products, and its formulas utilize natural and organic ingredients and 100% Pure Moroccan Argan Oil that is Fair Trade certified.

Eden Allure's original product is pure Moroccan argan oil. Although they mix it with other products, the pure oil is the most popular seller. . .

Other products in the Eden Allure skin care line include soaps and shampoos.

Aleksandar Vukovic

[16] Mr. Vukovic identifies himself as a trade-mark searcher employed by the firm representing the opponent. In April 2012 he performed a search of the trade-marks register to locate active Canadian trade-mark registrations and applications comprised of the component ALLURE, or variations thereof, in International Classes 3 and 5 (which include the parties' wares). The results of his search are attached as Exhibit AV-1 to his affidavit, and summarized at paragraph 8 of his affidavit:

The State of the Register search uncovered twelve (12) trade-mark registrations and/or pending applications, only four (4) of which pertain to a trade-mark consisting of the word ALLURE, alone or in combination. Three (3) of such ALLURE trade-marks are owned by the Opponent while the remaining trade-mark pertains to the application at issue owned by the Applicant.

APPLICANT'S EVIDENCE

Todd Smith

[17] Mr. Smith identifies himself as the owner of the applicant company. His affidavit serves to introduce into evidence the exhibit material listed below:

Exhibit A – dictionary entry for the word “allure”

The word “allure,” as a verb, means “to be attractive or tempting;” as a noun it means “fascination, charm, appeal.”

Exhibit B – samples of product packaging for wares sold under the mark EDEN ALLURE & Tree Design

Exhibit B consists of a single photocopy of a photograph showing (i) argan oil sold in a spray bottle and (ii) a “Beauty Bar” being sold in what appears to be a rectangular paper container.

Exhibits C to F – invoices issued to Canada

Each exhibit consists of a single invoice for argan oil, apparently shipped from Orlando, Florida to two different Canadian locations, namely, Woodbridge, Ontario and Camrose, Alberta. The largest order is for 1,080 units sized 2.2 fl. oz. (at a cost of \$6.60 per unit) while the smallest order is for 48 units, for two different sizes namely, 1 fl. oz. and 2.2 fl. oz. The earliest ship date is November 2009 while the latest is July 2012.

LEGAL ONUS AND EVIDENTIAL BURDEN

[18] As mentioned earlier, before considering the grounds of opposition, it is necessary to review (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[19] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

First Ground of Opposition – s.30(b)

[20] Section 30(b) requires the applicant to state, in the case of a mark that has been used in Canada, the date from which the applicant has used the mark in association with the wares specified in the application. The opponent's evidential burden with respect to a

ground of opposition based on s.30(b) is relatively light because the opponent has less access to information than the applicant regarding the date of first use of the applied-for mark, and regarding what products were sold under the applied-for mark. In the instant case, the opponent is relying on “ambiguities” in the Smith affidavit, and on Ms. Machado evidence, to meet its evidential burden.

[21] Mr. Smith makes no declarative statements in his affidavit other than describing the exhibits he is attaching. His evidence is, in my view, less “ambiguous” than it is remarkably laconic. At best, the exhibit material supports use of the applied-for mark in Canada as of November 2009, however, such use is solely in association with argan oil.

[22] Ms. Machado’s evidence indicates that the applicant has two lines of products, namely (1) a skin care line including soaps and shampoos, where argan oil is a constituent, and (2) argan oil (as referenced in Exhibits C – F of Mr. Smith’s affidavit). Thus, it is not at all clear that argan oil is a “body and beauty care cosmetic” rather than a separate product different from the applicant’s line of skin care products. It is therefore not clear whether the applicant has in fact used its mark in Canada with any “body and beauty care cosmetic” product. The lacunae in Mr. Smith’s evidence concerning products other than argan oil, taken together with Ms. Machado’s evidence, are sufficient to put compliance with s.30(b) into issue: see *Corporativo de Marcas GJB, SA de CV v. Bacardi & Company Ltd.*, 2014 FC 323 at paragraphs 30-38 (CanLII).

[23] The legal onus therefore falls on the applicant to show, on the usual civil balance of probabilities standard, that the applicant has in fact used its mark with the wares specified in the application since the claimed date of first use December 30, 2009. On this issue, all of the pertinent evidence of record is to be assessed according to the normal criteria, that is, taking onto consideration “its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, and whether it has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence:” see *Corporativo de Marcas GJB*, above.

[24] Considering that Ms. Machado’s evidence has at least some probative value, and that the applicant might reasonably have been expected to provide at least some evidence concerning its use of the applied-for mark in Canada in association with body and beauty care cosmetics (particularly in reply to Ms. Machado’s evidence, as of right pursuant to s. 43 of the *Trade-marks Regulations*), I find that the applicant has not satisfied the legal onus on it to show compliance with s.30(b). The application is therefore rejected with respect to the wares “body and beauty care cosmetics.”

Second Ground of Opposition - s.30(i)

[25] Section 30(i) requires a statement in the application that the applicant is satisfied that it is entitled to use the applied-for mark in Canada.

[26] I have read the second ground in the context of the statement of opposition as a whole and find that it is insufficiently pleaded. In this regard, the allegation that the parties’ marks are confusing does not, by itself, support a s.30(i) ground of opposition. Section 30(i) is not a “catch all clause” but it can be used as a ground of opposition if, for example, fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221.

[27] As there are no material facts pleaded which, if proven, could result in the success of the s.30(i) ground of opposition, the second ground is rejected.

Third, Fourth and Fifth Grounds of Opposition – s.12(1)(d); s.16(3)(a); and s.2

Main Issue for Decision

[28] The underlying and determinative issue for decision with respect to the substantive grounds of opposition is whether the applied-for mark EDEN ALLURE & Tree Design is confusing with the opponent’s mark ALLURE.

[29] The earliest material date to consider the issue of confusion is the date of filing the application, June 17, 2009, with respect to the s.16(3)(a) ground, while the latest material date is the date of my decision, with respect to the s.12(1)(d) ground: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD). In the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

When Are Trade-marks Confusing?

[30] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[31] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether purchasers of the applicant's wares sold under the mark EDEN ALLURE & Tree Design would believe that those wares were produced or authorized or licensed by the opponent who sells similar products under the mark ALLURE. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

Test for Confusion

[32] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This

list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

First Factor - Inherent and Acquired Distinctiveness

[33] In my view, the opponent's mark ALLURE possesses a fair degree of inherent distinctiveness. Although it is a dictionary word, it is not generally employed in everyday speech. Further, Mr. Vukovic's state of the register evidence implies that few, if any, traders other than the opponent has adopted the term ALLURE as a trade-mark for cosmetic and body care products. I recognize, however, that the term ALLURE does have a somewhat laudatory connotation in relation to the opponent's perfume, lipstick and body care products, which connotation lessens its inherent distinctiveness. Similarly, the applied-for mark EDEN ALLURE & Tree Design possesses a fair degree of inherent distinctiveness, owing mainly to the component ALLURE. In this regard, the tree design feature is not particularly distinctive, and the component EDEN would be perceived as a Biblical reference. The tree design together with the component EDEN might be perceived as a reference to the famed tree of the Garden of Eden. The applied-for mark as a whole has a somewhat laudatory connotation in relation to the applicant's products, owing to the components EDEN (suggesting "purity" or "bliss") and ALLURE, which connotations lessen its inherent distinctiveness.

[34] Neither party has evidenced that the marks in issue have acquired any distinctiveness in Canada. Therefore the first factor, which is a combination of inherent and acquired distinctiveness, favours neither party to any significant extent.

Second Factor - Length of Time the Marks have been in Use

[35] Neither party has evidenced meaningful use of its mark(s) in Canada. The second factor therefore favours neither party.

Third and Fourth Factors - The Nature of the Parties' Wares and Trades

[36] As far as I am able to determine from the evidence of record, the natures of the parties' wares are similar and would be used for similar purposes. I would expect that the parties' wares would be sold in relative proximity through the same types of retail outlets. The third and fourth factors therefore favour the opponent.

Fifth Factor – Degree of Resemblance

[37] In my view, the parties' marks resemble each other to a fair degree. In this regard, the applicant has incorporated the entirety of the opponent's mark ALLURE into its mark EDEN ALLURE & Tree Design. While the component ALLURE is not the most dominant component of the applied-for mark EDEN ALLURE & Tree Design, it nevertheless remains a dominant component of the mark.

[38] The marks in issue resemble each other most in ideas suggested, that is, the idea of something "attractive or tempting" The marks also resemble each other to a fair degree in sounding as the applied-for mark would be sounded as "eden allure." The parties' marks are visually more different than alike, nevertheless, the component ALLURE remains a dominant visual component of the applied-for mark. Consequently, the last factor in s.6(5) favours the opponent to some extent.

[39] As noted earlier, the degree of resemblance between the parties' marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties' wares (or services) and the parties' channels of trade are the same: see *Reynolds Consumer Products Inc. v. P.R.S. Mediterranean Ltd.* (2013)111 CPR (4th) 155 (FCA) at paras. 26 -30.

Other Surrounding Circumstances

[40] I would add that, at the oral hearing, counsel for the opponent placed emphasis on the opponent's "family of marks," consisting of the opponent's registered trade-marks, as a circumstance favouring the opponent. I have not had regard to those submissions as there is no evidence to show that the opponent has in fact used its "family of marks" in the marketplace. Without such marketplace use, the opponent is not in a position to assert any advantage.

DISPOSITION

[41] Having regard to the above I find that, at all material times, the balance of probabilities between finding that there is no reasonable likelihood of confusion, and finding that there is reasonable likelihood of confusion, falls slightly in favour of the opponent. If I am wrong in so finding, then I find that the balance of probabilities is even. As the legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, in either case I must find against the applicant. The subject application is therefore refused.

[42] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office