



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

**Citation: 2013 TMOB 173**  
**Date of Decision: 2013-10-08**

**IN THE MATTER OF AN OPPOSITION  
by Johnson & Johnson to application  
No. 1,303,786 for the trade-mark CLEAN  
in the name of Fusion Brands  
International SRL**

Introduction

[1] This opposition relates to an application originally filed by Dlish Fragrance Inc. (Dlish) on June 1, 2006 to register the trade-mark CLEAN (the Mark). Since then the application has been assigned to Fusion Brands International SRL (Fusion) (Dlish and/or Fusion being referred to as the Applicant). The application has been amended and now covers the following wares:

Fragrances for personal use; scented candles; textile home furnishings and linens for the bedroom, bathroom, dining room, living room and kitchen, namely, dish towels, napkins, placemats, towels, bath mats, shower curtains, duvets, pillows, cushions, blankets, bed sheets, pillow cases, bed skirts, comforters; clothing, namely, tank tops, t-shirts, sweat shirts, sweat pants, pajamas, bathrobes and under clothing; perfume oil, eau de perfume, eau de toilette and body lotion (the Wares).

[2] The application is based on use in Canada since at least as early as 2004.

[3] The grounds of opposition raised by Johnson & Johnson (the Opponent) in an amended statement of opposition dated January 27, 2011 and still in issue are based on sections 30(a) and (b), 12(1)(d), 16(1)(a),(b) and (c), and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this

decision. I wish to point out that by way of an interlocutory decision dated March 21, 2011 the Registrar struck the ground based on section 30(i) of the Act from the statement of opposition.

[4] The first issue is to determine if the Opponent has furnished sufficient evidence to support each of its grounds of opposition. I conclude that the only ground of opposition for which the Opponent has met its initial burden is the one based on section 12(1)(d) of the Act. I also conclude that the Applicant has discharged its onus to prove that there is no likelihood of confusion with the Opponent's trade-marks except for 'body lotion' for the reasons hereinafter detailed.

#### Legal Onus and Burden of Proof

[5] There is an initial evidential burden on the Opponent to file sufficient admissible evidence from which it could reasonably be concluded that there exist enough facts to support each ground of opposition pleaded. If those facts exist, then the Applicant must show that the application complies with the provisions of the Act and the grounds of opposition raised by the Opponent should not prevent the registration of the trade-mark applied for [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

#### Ground of Opposition Summarily Dismissed

[6] As its evidence the Opponent filed only nine certificates of registration which will be identified hereinafter in the analysis of the ground of opposition based on section 12(1)(d) of the Act. This evidence is not sufficient to support the facts that must be proven to support the grounds of opposition based on sections 30(a) and (b), 16(1)(a) and (c) and distinctiveness (section 2). They are all dismissed on the basis that the Opponent failed to meet its initial burden of proof.

Ground of Opposition based on Section 16(1)(b)

[7] The material date for ground of opposition based on section 16(1)(b) is the claimed date of first use, namely 2004 (December 31, 2004) [see section 16(1) of the Act and *Spirits International BV v Distilleries Melville Ltée* (2011), 96 CPR (4th) 277 (TMOB)].

[8] The Opponent has the initial burden to prove not only that its applications were filed prior to the claimed date of first use, but also that they were pending at the date of advertisement of the present application (April 21, 2010) [see section 16(4) of the Act].

[9] In the absence of any written argument I can only presume that the Opponent is relying on the applications relating to the pleaded registrations. However none of these applications can form the basis of a ground of opposition based on section 16(1)(b) of the Act for the following reasons.

[10] With respect to registration Nos. TMA510690, TMA456607, TMA448224, TMA635006 and TMA635007, I note that while the corresponding applications were filed prior to the material date, they all matured to registration prior to April 21, 2010 and thus were no longer pending at the date of advertisement of the Mark.

[11] With respect to registrations Nos. TMA781759, TMA781757, TMA781762 and TMA781168, I note that the corresponding applications were filed after the material date (December 31, 2004).

[12] Thus none of the applications which led to the registrations pleaded in the Opponent's statement of opposition can form the basis of a ground of opposition under section 16(1)(b) of the Act. Consequently this ground of opposition is also dismissed.

Ground of Opposition based on Section 12(1)(d) of the Act

[13] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[14] The Opponent filed certified copies of nine registrations which are detailed in Schedule A.

[15] I will compare the Mark to registration TMA 510690 (the Opponent's Registered trade-mark) for the trade-mark CLEAN & CLEAR as it is a word trade-mark and I consider the Opponent's case strongest with respect to this mark. If the Opponent is not successful under this ground of opposition with this registered trade-mark, it would not achieved a better result with respect to any of the other marks (as listed in Schedule A), as they include additional words/or design components which share no similarity with the Mark.

[16] I exercised my discretion to check the register and note that registration TMA510690 is extant. Therefore the Opponent has met its initial burden with respect to this ground of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[17] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)].

[18] The test under section 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 section 6(2) is whether there would be confusion of the Applicant's Wares, associated with the Mark, as wares emanating from or sponsored by or approved by the Opponent.

[19] Mr. Justice Binnie of the Supreme Court of Canada commented on the assessment of these criteria [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th)

401 and *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321]. Each factor may be assessed different weight but the most important factor is often the degree of resemblance between the marks [see *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

*Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[20] The Mark and the Opponent's Registered trade-mark are both not inherent distinctive trade-marks as they are made of common English words.

[21] The distinctiveness of a trade-mark can be enhanced through its use or promotion. The Opponent obtained the registration of the Opponent's Registered trade-mark on the basis of use since 1996. However there is no evidence of such use in the record. I can only infer a *de minimis* use of the Opponent's Registered trade-mark [see *Entre Computer Centers Inc. v. Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. I may add that there is no evidence of use of any of the other Opponent's trade-marks listed in Schedule A.

[22] The Applicant filed the affidavit of Ms. Dana Kline. She has been since March 2010 the President of Luxury Fragrances of Fusion Brands Inc., a licensee of the Applicant. She describes the Applicant as a leading manufacturer of high end cosmetic and fragrance products. She explains that the CLEAN line started with perfume and has expanded into body lotions, body and hand creams. There is no reference to any of the other Wares in her affidavit.

[23] She states that the Applicant's perfumes and related products bearing the Mark are sold in high end department stores and specialty retail stores like Sephora, Holt Renfrew and Ogilvy's. She provides the annual dollar value of the Applicant's licensee sales in Canada from 2007 to 2011 (partial) which vary from 21,000\$ to 295,000\$ (USD).

[24] Ms. Kline filed a photograph of a bottle of perfume bearing the Mark. She filed extracts of fashion magazines such as the summer 2011 issue of FASHION magazine where there is reference to the Applicant's perfume bearing the Mark. However we have no information on the

circulation figures in Canada for that magazine or for the NEW BEAUTY magazine in which the product was also advertised.

[25] From this evidence I conclude that the Applicant's Mark is more known than the Opponent's Registered trade-mark. In all, this factor favours the Applicant.

*The length of time the trade-marks have been in use*

[26] As mentioned above I can only infer a *de minimis* use of the Opponent's Registered trade-mark from the date of first use mentioned in the certificate of registration. The Applicant has shown use of the Mark since at least 2007 (December 31, 2007).

*The nature of the wares, services, or business; the nature of the trade*

[27] Under this ground of opposition I must compare the Wares as described in the application with the wares covered by the Opponent's registration [See *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble In. v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[28] The Applicant filed the affidavit of Sara Motamedi, an articling student employed by the Applicant's agent. Ms. Motamedi was instructed to attend two different retail drug stores in downtown Toronto to locate and gather physical evidence of the sale of CLEAN & CLEAR brand products of the Opponent and to attend a Sephora retail store to locate and gather physical evidence of the sale of the CLEAN brand product of the Applicant.

[29] Ms. Motamedi attended two drug stores, namely a Shoppers Drug Mart store and a Rexall store and purchased the following CLEAN & CLEAR products of the Opponent:

- A shine control facial cleanser
- A skin brightening facial scrub
- A pore perfecting cleanser
- A facial scrub

All of these products were purchased at a unit price varying from \$7.99 to \$11.99.

[30] Ms. Motamedi purchased at a Sephora store a bottle of perfume bearing the Mark at a selling price of \$74.

[31] In her affidavit Ms. Kline alleges that ‘Our CLEAN line of products would never be sold side by side with drugstore and/or grocery store brand acne cleansers and facial products.’ She also states that ‘The purchasers of our CLEAN perfume and fragrance products are teenagers and women of reasonable means that one would expect to find shopping in specialty stores and high end department stores.’ There is no reference in Ms. Kline’s allegation to ‘body lotion’ or any of the other Wares. This evidence has not been contested by the Opponent.

[32] Perfume and eau de toilette are different in nature when compared to cosmetics and skin cleansers. However there is an overlap in the nature of the wares when comparing ‘body lotion’ to ‘toiletry products for care of the skin’. As for the other Wares, there is no overlap between them and the Opponent’s wares covered by registration TMA510690.

[33] As for the nature of the trade of the parties, there is limited evidence with respect to the Applicant’s Wares except for perfumes. I may assume that there exists an overlap in the nature of the parties’ business when comparing ‘perfume, eau de toilette and body lotion’ to toiletry products as all of these products can be found in drug stores as appears from Ms. Kline’s statement reproduced above. As for the other Wares, in view of their nature, I do not believe that there is an overlap in their channels of trade.

*The degree of resemblance*

[34] There is some similarity between the Mark and the Opponent's Registered trade-mark as they share the common element 'CLEAN', which is the first component of the Opponent's trade-mark CLEAN & CLEAR. On the other hand, as pointed out by the Applicant in its written argument, the presence of the additional elements '& CLEAR' creates a different idea than the one suggested by the Mark. In fact CLEAN & CLEAR, when used in association with the type of products covered by the Opponent's registration, namely toiletry products for care of the skin, gives the idea that these products will cleanse the body and skin and leave it clear of blemishes.

[35] In her affidavit Ms. Kline made the following statement:

3. Our CLEAN line of fragrance products was created out of a desire by the former owner of the company to create a perfume that captured the scent of being 'shower fresh'. The fragrance is simple and extraordinary. (...)

[36] Firstly this is hearsay evidence. Secondly the idea suggested by a trade-mark comes from the meaning of the words comprising the trade-mark when used in association with a specific product. However I agree with the Applicant that when the word 'clean' is used in association with perfumes, the idea suggested is 'fresh'.

*Additional Surrounding Circumstances*

*i) State of the Register*

[37] The Applicant has submitted, through the affidavit of Mary P. Noonan, state of the register evidence. Ms. Noonan is a trade-mark searcher employed by the Applicant's agents firm. She was asked to conduct a search on a computerized database of the register of all active applications which are advertised and allowed, as well as registrations for trade-marks in International Class 3 that include the words CLEAN, CLEANS, CLEANER and phonetic variations of these words which are of record in association with personal care products. She located and filed a list of 225 active marks with an extended preview showing particulars of each citation.



[38] It is obvious from Ms. Noonan's affidavit that the word CLEAN is a common element of trade-marks registered in association with cosmetic and toiletry products. However this is not a case where the Applicant is trying to register a trade-mark by adding an element to an opponent's trade-mark in an attempt to distinguish it. Here, the Applicant's Mark is one of the components of the Opponent's Registered trade-mark, although a common element on the register.

*ii) Absence of Confusion*

[39] Ms. Kline states in her affidavit:

10. Since its debut in the Canadian market, we have not been made aware of any instance of confusion between the CLEAN line of fragrance products and the drugstore products of Johnston (sic) & Johnson. We expect there has not been and will never be any confusion based on the very different nature of these products, the difference in their associated price point and the purpose and target purchasers for each.

[40] Ms. Kline uses the term 'we' without identifying on behalf of whom she is speaking: the Applicant and/or the Applicant's licensee. Moreover she does not provide any information on the steps she took personally to be able to make such statement. Also there is no information as to whether the Opponent itself had not been informed of any instances of confusion. Finally we have no information on the extent of the Opponent's sales in Canada. There is evidence of the sale of only four (4) products bearing the Opponent's trade-mark CLEAN & CLEAR [see the affidavit of Ms. Motamedi]. All of these factors mitigate the impact of Ms. Kline's statement.

*Conclusion*

[41] I conclude that the Applicant has discharged its burden to prove that there is no likelihood of confusion between the Mark and the Opponent's trade-mark CLEAN & CLEAR when used in association with:

scented candles; textile home furnishings and linens for the bedroom, bathroom, dining room, living room and kitchen, namely, dish towels, napkins, placemats, towels, bath mats, shower curtains, duvets, pillows, cushions, blankets, bed sheets, pillow cases, bed skirts, comforters; clothing, namely, tank tops, t-shirts, sweat shirts, sweat pants, pajamas, bathrobes and under clothing.

as those wares have no similarity whatsoever with the Opponent's wares covered by registration TMA510690.

[42] As for 'fragrances for personal use; perfume oil, eau de perfume, eau de toilette' I conclude that there exists enough of a difference in the nature of those wares when compared to cosmetics and the toiletry products for the care of the skin listed in the aforesaid Opponent's registration. I am well aware of the fact that the Mark is one of the components of the Opponent's Registered trade-mark but that component, namely the word 'CLEAN' is a common element of many trade-marks on the register in association with personal care products. Therefore the Opponent's Registered trade-mark cannot be considered as a strong trade-mark. It can only benefit from a narrow scope of protection.

[43] However in so far as 'body lotion' is concerned, the Applicant has not shown that there exists enough of a difference in the nature of those wares when compared to toiletry products for the care of the skin. I believe that the average consumer with an imperfect recollection of the Opponent's Registered trade-mark will think that body lotion bearing the Mark would originate from the Opponent.

[44] I would therefore maintain this ground of opposition only in so far as 'body lotion' is concerned.

#### Disposition

[45] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition in so far as the following wares are concerned:

Fragrances for personal use; scented candles; textile home furnishings and linens for the bedroom, bathroom, dining room, living room and kitchen, namely, dish towels, napkins, placemats, towels, bath mats, shower curtains, duvets, pillows, cushions, blankets, bed sheets, pillow cases, bed skirts, comforters; clothing, namely, tank tops, t-shirts, sweat shirts, sweat pants, pajamas, bathrobes and under clothing; perfume oil, eau de perfume, eau de toilette.

but refuse the application for 'body lotion';

pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule A

The relevant grounds of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the application does not contain a statement in ordinary commercial terms of the Wares;
2. The application does not comply with the requirements of section 30(b) of the Act in that the Applicant or its predecessor in title has not used the Mark in association with each of the Wares in Canada since the claimed date of first use;
3. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the following Opponent's registered trade-marks:

TMA510690 for CLEAN & CLEAR in association with cosmetic and toiletry products for care of the skin, namely soaps, moisturizers, facial cleansers, astringents, blemish fighting sticks, pads and creams;

TMA456607 for CLEAN & CLEAR & Design as illustrated hereinafter in association with cosmetics and toiletries, namely soaps, moisturizers, facial cleansers, astringents, blemish fighting sticks and pads:



TMA448224 for JOHNSON'S CLEAN & CLEAR in association with cosmetics and toiletries, namely soaps, moisturizers, facial cleansers, astringents, blemish fighting sticks and pads;

TMA635006 for CLEAN & CLEAR ADVANTAGE in association with acne cleanser, acne spot treatment and acne clearing lotion;

TMA635007 for CLEAN & CLEAR AND UNDER CONTROL in association with skin cleansers; astringents; body wash; skin moisturizers, creams and lotions; cosmetic facial and body cleansing wipes; nose strips for the treatment of blackheads, acne patches, acne treatment preparations, medicated skin moisturizers and cleansers; and cosmetic blotting sheets;

TMA456607 for CLEAN & CLEAR & Design as illustrated hereinafter in association with full line of cosmetics and toiletries, namely, skin cleanser; non-medicated astringents; body wash; skin moisturizers; creams and cosmetic facial and body cleansing wipes; Nose strips for the treatment of blackheads, acne patches, acne treatment preparations, medicated astringents, medicated skin moisturizers and skin cleansers; Disposable wipes not impregnated with chemicals or compounds for use as cosmetic blotting sheets for absorbing facial oil:



TMA781757 for CLEAN & CLEAR & Design as illustrated hereinafter in association with Full line of cosmetics and toiletries, namely, skin cleanser; non-medicated astringents; body wash; skin moisturizers; creams and cosmetic facial and body cleansing wipes; Nose strips for the treatment of blackheads, acne patches, acne treatment preparations, medicated astringents, medicated skin moisturizers and skin cleansers; Disposable wipes not impregnated with chemicals or compounds for use as cosmetic blotting sheets for absorbing facial oil:



TMA781762 for CLEAN & CLEAR & Design as illustrated hereinafter in association with full line of cosmetics and toiletries, namely, skin cleanser; non-medicated astringents; body wash; skin moisturizers; creams and cosmetic facial and body cleansing wipes; Nose strips for the treatment of blackheads, acne patches, acne treatment preparations, medicated astringents, medicated skin moisturizers and skin cleansers; Disposable wipes not impregnated with chemicals or compounds for use as cosmetic blotting sheets for absorbing facial oil:



TMA781168 for CLEAN & CLEAR & Design as illustrated hereinafter in association with Full line of cosmetics and toiletries, namely, skin cleanser; non-medicated astringents; body wash; skin moisturizers; creams and cosmetic facial and body cleansing wipes; Nose strips for the treatment of blackheads, acne patches, acne treatment preparations, medicated astringents, medicated skin moisturizers and skin

cleansers; Disposable wipes not impregnated with chemicals or compounds for use as cosmetic blotting sheets for absorbing facial oil:



4. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(a) of the Act in that at the date of first use of the Mark, the latter was confusing with the Opponent's CLEAN & CLEAR trade-marks listed above that had been previously used and made known in Canada by the Opponent in association with the wares described above;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(b) of the Act in that at the filing date of the application, the Mark was confusing with the Opponent's CLEAN & CLEAR trade-marks listed above in respect of which applications for registration had been previously filed in Canada by the Opponent in association with the wares described above;
6. The Applicant is not the person entitled to the registration of the Mark pursuant to sections 16(1)(c) in that at the filing date of the application, the Mark was confusing with the trade name Clean & Clear that had been previously used and made known in Canada by the Opponent in association with the wares described above;
7. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive within the meaning of section 2 in that it does not actually distinguish the Wares of the Applicant from the wares and services of others, namely the Opponent's wares sold in association with the Opponent's trade-marks listed above nor is the Mark adapted so as to distinguish the Applicant's Wares.