



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

**Citation: 2016 TMOB 51**  
**Date of Decision: 2016-03-30**

**Automatic Princess Holdings, LLC**

**Opponent**

**and**

**Heather Ruth McDowell**

**Applicant**

**1,556,448 for PINK & HONEY**

**Application**

[1] On December 9, 2011, Heather Ruth McDowell (the Applicant) filed an application to register the trade-mark PINK & HONEY (the Mark) on the basis of proposed use in association with various items of clothing, footwear, headwear, jewellery, cosmetics, accessories and giftware and the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet. The Goods and Services are set out in Schedule A.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 19, 2012.

[3] On May 21, 2013 Automatic Princess Holdings, LLC (the Opponent) filed a statement of opposition pleading the following grounds:

- (a) The application does not comply with section 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the Applicant's statement that she intends to use the Mark with the Goods and Services is false since the Applicant:

1. did not intend to use the Mark with all of the Goods and Services described in the application in Canada;
  2. did not intend to use the Mark, *per se*, with all of the Goods and Services described in the application in Canada;
  3. did not intend to associate the Mark with all of the Goods and Services described in the application in a manner that would constitute “use” under section 4 of the Act; or
  4. did not intend to control sufficiently the character or quality of all of the Goods and Services described in the application.
- (b) The Mark is not distinctive, under section 2 of the Act because it does not actually distinguish, the Goods and Services in association with which the Applicant proposes to use it from:
1. the services of Alexandra Joy Wig of Calgary, Alberta, which are associated with the identical trade-mark PINK & HONEY; and
  2. the goods and services of Victoria’s Secret Stores Brand Management, Inc. associated with marks consisting of or including the word PINK.

The Opponent also pleads alternative grounds of opposition based on the Applicant’s pleadings in another proceeding where Ms. McDowell has opposed American Princess Holding’s application for the trade-mark HONEY B. FLY. Prior to setting out the grounds of opposition below, American Princess Holdings states “that its HONEY B. FLY Mark can peacefully co-exist with the Applicant’s HONEY Registrations”. The Opponent then states that based solely on McDowell’s pleadings in the HONEY B. FLY opposition, it pleads as follows:

- (c) the application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied of her entitlement to use the Mark by reason of the Opponent’s prior pending HONEY B. FLY application which the Applicant knew of because she is opposing its registration; and

(d) under section 16(3)(a) and 16(3)(b) of the Act, the Applicant is not the person entitled to the registration of the Mark because at the date of filing the application, namely, December 9, 2011, it was confusing with the HONEY B. FLY trade-mark which had been previously used in Canada and was the subject of a previously filed application.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] The Opponent filed as its evidence a certified copy of (i) its application No. 1,187,510 for HONEY B. FLY and (ii) the statement of opposition against application No. 1,187,510 filed by the Applicant, and the affidavits of Patti A. Terry and Tamara Céline Winegust. Both Ms. Terry and Ms. Winegust were cross-examined on their affidavits and the transcripts and answers to under advisements were filed. The Applicant filed as its evidence the affidavit of Nathan Fan.

[6] Neither party filed a written argument. The Applicant alone attended a hearing.

#### Material Dates and Onus

[7] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3) of the Act];  
and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 at 324 (FC)].

[8] Before considering each of the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the

allegations in the statement of opposition, and (ii) the legal onus on an applicant to prove its case.

[9] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. 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 an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

#### *Analysis of the Grounds of Opposition*

[10] I will now consider each of the grounds of opposition (although not in the order in which they appear in the statement of opposition).

#### Section 30(e) Ground of Opposition

[11] Section 30(e) of the Act requires that an applicant for a proposed trade-mark state that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada. In *Hunter Douglas Canada Ltd v Flexillum Inc* (1983), 78 CPR (2d) 212 at 222-223 (TMOB), Board Member Martin explains the purpose of section 30(e):

...The wording of section 29(e) [the former version of section 30(e)] of the Act is clear and was obviously intended to prevent applicants from trafficking in trade-marks. ... The provisions of the Trade-marks Act relating to proposed use applications comprise a statutory exception to the common law which dictates that trade-mark rights only accrue as a result of use. Thus, as with other statutory exceptions to the common law found in the Act ... the provisions relating to proposed use applications should be construed strictly.

[12] To meet its evidential burden with respect to this ground of opposition, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that an applicant does not have a *bona fide* intention to use the Mark in association with the Goods and

Services. The evidential burden with respect to section 30(e) is relatively light as the facts at issue may be exclusively in the possession of an applicant [*Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 at 94-95 (TMOB)]. Further, the fact that the material date is the filing date of the application does not preclude the consideration of evidence arising subsequent to that date insofar as it may indicate a situation existing as of the material date [see *Bacardi & Co v Jack Spratt Manufacturing* (1984), 1 CPR (3d) 122 at 125-126 (TMOB)].

[13] The Opponent submits the affidavit of Ms. Terry, a private investigator, in support of this ground of opposition. On December 3, 2013 she attended three HONEY stores in Toronto. Ms. Terry's evidence is that she did not see the PINK & HONEY trade-mark during her visit (paras 5, 14). Ms. Terry's evidence is that she saw the trade-marks HONEY and HONEY Design on store signage, bags, boxes and hang tags (see, for example, Exhibits B-D-1). Ms. Terry explains that she did not see the trade-marks HONEY or HONEY Design on clothing labels or on the face of clothing or accessories (paras 6;15). Ms. Terry also repeats the details of a conversation with a store employee (para 22):

Finally, I was informed by one store employee and one store manager at [one of the HONEY stores in Sherway Gardens], and do verily believe, that the HONEY store does not manufacture, design and/or produce any of its own line of wares. Nor did either the store employee or store manager mention that the HONEY store retains third parties to manufacture any products on its behalf. ...

[14] It appears that the Opponent has submitted this evidence to meet its initial burden that the Applicant does not intend to use her trade-mark in association with the Goods and Services. First, the application is based on proposed use and the Applicant is not obliged to commence use of the Mark in Canada until after the application has been allowed. Second, even if I consider that the evidence shows that the Applicant currently uses its HONEY trade-marks in association with its operation of a retail store and does not sell merchandise under these trade-marks, this is not sufficient to meet the Opponent's evidential burden, as this evidence does not result in the inference that the Applicant does not have the *bona fide* intention to sell the Goods in association with the Mark.

[15] In the absence of submissions from the Opponent in writing or at the hearing, I am left with some uncertainty as to how the evidence filed supports this ground of opposition. It may be

that the Opponent wishes me to find that as the Applicant's application for HONEY & Design filed on April 22, 2004 (see the certified copy of the statement of opposition to the application for HONEY B. FLY) claims use in association with similar goods and as Ms. Terry's evidence suggests that no such use is occurring, this is sufficient for the Opponent to meet its evidential burden. I, however, do not consider this sufficient to meet the Opponent's burden due to the almost eight year period between the filing of the applications for the HONEY & Design trade-mark and the Mark. While there may be other possible arguments the Opponent could have advanced, in the absence of submissions or supporting jurisprudence, I decline to speculate further. As I have found the Opponent has not met its evidential burden, the section 30(e) ground of opposition is rejected.

#### Section 16(3)(b) Ground of Opposition

[16] The section 16(3)(b) ground of opposition is based on the Opponent's application No. 1,187,510 for the trade-mark HONEY B. FLY for use in association with a wide range of goods and services including various clothing, accessories, cosmetics, personal care items, musical sound recordings, books, bags and services including online and retail store services featuring many of these items. The complete list of the Opponent's Goods and Services are listed in Schedule B. I have exercised my discretion to confirm that this application was filed prior to the application for the Mark and remained pending as of its advertisement. The Opponent therefore meets its initial evidential burden (see section 16(3)(b) and 16(4) of the Act).

[17] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v*

*Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

#### *Inherent Distinctiveness*

[18] The Applicant filed as its evidence the affidavit of Mr. Fan, an associate with its agent. His evidence shows that the word HONEY may be a thick, sweet substance made by bees, used to address someone you love or something that is very good (see, for example, Fan affidavit, Exhibit C – Merriam-Webster definition of honey). While the component HONEY alone may suggest the substance honey or have some laudatory connotations, when I consider the Mark and the Opponent’s trade-mark as a whole I find that both trade-marks are inherently distinctive. There is no evidence that either of the phrases PINK & HONEY or HONEY B. FLY bear any relation to the Goods and Services or the Opponent’s Goods and Services.

#### *Extent Known and Length of Time in Use*

[19] There is no evidence that either the Mark or the Opponent’s trade-mark HONEY B. FLY have been used in Canada or are known to any extent.

#### *Nature of the Goods and Services and Trade*

[20] The Applicant’s clothing, footwear, headwear, jewellery, fashion accessories, belts, sunglasses, and cosmetics and retail store services featuring these items are identical to or

significantly overlap with the Opponent's Goods and Services. While the Opponent's evidence in the affidavit of Ms. Terry appears to show that the Applicant operates HONEY stores, as neither the application, nor the Opponent's registration contain any restrictions, given the identical and highly overlapping nature of the parties' goods and services, I infer that there is the potential for the nature of the parties' trades to overlap as well.

*Degree of Resemblance Between the Trade-marks*

[21] The Supreme Court of Canada advises in *Masterpiece, supra* that the preferable approach for considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking and unique" (para 64). In the present case, the most striking part of the Mark is the combination of two seemingly unrelated words which consumers would not expect to see together. The most striking feature of the Opponent's trade-mark is that it suggests a honey bee which flies. The trade-marks considered as a whole have only a limited degree of resemblance in appearance and sound due to the HONEY component in each trade-mark. Further, the ideas suggested by the trade-mark cannot be said to overlap. Therefore, this factor favours the Applicant.

*Applicant's Opposition to Application No. 1,187,510 for HONEY B. FLY*

[22] The Opponent has filed as part of its evidence a certified copy of a statement of opposition filed by the Applicant in the present case against the Opponent's application No. 1,187,510 for HONEY B. FLY. The statement of opposition includes the following allegation (para 1(d)):

Any use in Canada of [the HONEY B. FLY] trade-mark in association with the wares and services claimed is likely to result in confusion as between the [HONEY B. FLY] trade-mark and the Opponent's marks [HONEY & Design and HONEY] contrary to sections 6, 16(1)(a) and (b) and 16(3)(a) and (b) of the Trade-marks Act.

[23] At the outset, I note that the statement of opposition does not reference the trade-mark PINK & HONEY. Even if I found the filing of an opposition against the HONEY B. FLY trade-mark based on the HONEY and HONEY & Design trade-marks to contradict the Applicant's position that the trade-mark PINK & HONEY is not confusing with the trade-mark



HONEY B. FLY, I would not find this to be a relevant surrounding circumstance. In *Molson Breweries v Labatt Brewing Co* (1996), 68 CPR (3d) 202 at 212-213 (FCTD), where one party argued that a prior inconsistent position taken by the other party was a relevant surrounding circumstance in assessing the likelihood of confusion, the Court said: “In my view, this circumstance is not relevant in determining whether the two trade-marks at issue are confusing. Regardless of the previous positions taken by *Labatt*, I must come to a determination as to confusion that is in accordance with the law and relevant jurisprudence.”

### *Conclusion*

[24] I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the trade-marks are sufficient to make confusion unlikely. Confusion is unlikely in situations where trade-marks share common features but also feature dominant differences [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)].

### *Grounds of Opposition Which Can Summarily Be Dismissed*

#### Section 30(i)

[25] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[26] The Opponent alleges that the Applicant could not have satisfied of her entitlement to use the Mark because she knew of the Opponent’s HONEY B. FLY application and opposed it.

[27] The mere fact that the Applicant opposed the Opponent’s application for HONEY B. FLY on the basis of its HONEY trade-marks does not preclude the Applicant from making the statement. There is no evidence of record that the Applicant has taken the position that the trade-marks HONEY B. FLY and PINK & HONEY are confusing. Even if the Applicant had taken the position given that it had opposed the application for the trade-mark HONEY B. FLY, the

Applicant may have reason to believe that it was entitled to use the Mark in association with the Goods and Services.

Section 16(3)(a)

[28] The section 16(3)(a) ground of opposition is rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-mark HONEY B. FLY was used in Canada as of the date of filing the application.

Section 2 - Distinctiveness

[29] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of May 21, 2013 one or more the trade-marks set out in the statement of opposition, were known to some extent, and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[30] The ground of opposition alleging that the Mark is not distinctive as a result of the use of the trade-marks consisting of or including PINK by Victoria's Secret Stores Brand Management, Inc. is rejected because the Opponent has not met its initial evidential burden. The Opponent has not evidenced that any such trade-mark was used or known in Canada as of the applicable material date.

[31] The ground of opposition alleging that the Mark is not distinctive as a result of the use of the trade-mark PINK & HONEY by Alexandra Joy Wig of Calgary, Alberta is also rejected. While the Opponent's evidence in the affidavit of Ms. Winegust is that this trade-mark appears on the website *pinkandhoney.com* (Exhibit A), on the Facebook page *www.facebook.com/PinkandHoney/info* (Exhibit B) and that the owner, Alexa, told Ms. Winegust that she had been in business for three years (para 6), none of the evidence in Ms. Winegust's affidavit shows that the PINK & HONEY trade-mark of Alexandra Joy Wig was known to some extent in Canada and its reputation in Canada was substantial, sufficient or significant. As such, the Opponent's evidence is insufficient to meet its evidential burden.

Disposition

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## **Schedule A (the Goods and Services)**

### **GOODS:**

(1) Clothing, namely, trousers, jeans, sweat pants, yoga pants, active wear, pants, sweaters, sweatshirts, polo shirts, shirts, skirts, blouses, dresses, hosiery, jackets, blazers, coats, ski jackets, down filled jackets, fur jackets, wool coats, shorts, bathing suits, loungewear; lingerie; footwear, namely, shoes, sandals, boots, slippers; men's, women's and children's shoes made of leather, suede or silk; pumps, high heels, dress shoes of any kind, sneakers, running shoes, basketball shoes, golf shoes, training shoes, court shoes, track shoes, beach shoes, namely sandals, flip flops and thongs; headwear, namely, hats, caps, bandannas, headbands, visors; jewellery; fashion accessories, namely, scarves, shawls, purses, gloves, watches; hair accessories; combs, brushes, hair bands made of cloth or plastic, barrettes, scrunchies, ponytail holders, hair clips, hair pins, and hair ornaments; belts, sunglasses; cosmetics; foundation made of liquid or powder, face creams, blush, eye shadow, eye liner, mascara, lipstick, lip gloss, lip liner, make-up bags sold empty; giftware, namely, lamps, trays, vases; ornaments and figurines made from ceramic, chinaware, glass, porcelain; candy dishes.

### **SERVICES:**

(1) Retail store services, namely, the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet.

## **Schedule B (the Opponent's Goods and Services)**

### **GOODS:**

(1) Cosmetics, namely, cosmetic creams for skin care, skin care preparations, astringents for the face and for the skin for cosmetic purposes, body oil, face make-up, lip make-up, cheek make-up, face powder, face glitter, lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye treatments in the form of gels, eye treatments in the form of balms, eye highlighter, masks, namely, beauty masks, facial masks, gel eye masks, skin moisturizer masks, cleansers, namely, cleansing bars, cleansing lotions and creams, pore cleansing masks, medicated acne cleansing preparations, skin toners, skin clarifiers, exfoliating skin scrubs, lotions, gels and creams, foundation make-up, blusher, compacts, namely, powder compacts and powder compact refills, mirror compacts, make-up remover, nail polish, nail strengtheners, and nail polish remover, cosmetic preparations for skin tanning, self-tanning preparations, bubble bath, perfumery, fragrances for personal use, personal care items, namely, body lotions, skin soaps, body washes, skin creams, skin lotions, bath oils, bath salts and potpourri; musical sound recordings, video recordings, DVDs, downloadable sound recordings, downloadable video recordings, all featuring music and musical performances; video game software, mouse pads, downloadable ring tones, sunglasses and eyewear, namely, eyeglasses, eyeglass frames, eyeglass cases; jewelry, costume jewelry, watches, clocks and watch cases; booklets and books featuring information on a musical performer, musical sound recordings, video recordings and DVDs featuring musical performances; printed materials, namely, stationery, address books, souvenir books and programs featuring photographs, biographical information, tour dates and other personal information about musical concerts, live musical performances and recording artists, school and desk supplies, namely, notebooks, glue, tape, pencil boxes, pencils, pens, bookmarks, bookends, personal planners, book covers, loose-leaf dividers, pencil bags, file folders, envelopes, erasers, markers, calendars, note pads, notebook filler paper, composition books and loose leaf binders, membership cards indicating fan club membership, newsletters featuring information on a musical performer, live musical performances, tour dates for musical performances and other information in the field of music and entertainment, posters; all purpose sports bags, handbags, beach bags, cosmetics bags sold empty, tote bags, travel bags, backpacks; leather items, namely, wallets, small accessories, namely, key chains, coin purses, credit card holders; clothing, namely, T-shirts, halter tops, tank tops, warm-up suits, body suits, sweatshirts, long sleeve jerseys, bathing suits, jean shorts, skirts, footwear, namely, athletic footwear, athletic shoes, beach footwear, boots, flip flops, sandals, shoes, slippers, headwear, namely, hats, caps, berets, headbands, bandanas and ear muffs, belts, fashion accessories, namely, scarves, socks, gloves, hosiery

(2) Mouse pads; printed materials, namely, stationary, digital newsletters featuring information on a musical performer, live musical performances, tour dates for musical performances and other information in the field of music and entertainment; clothing, namely, T-shirts

### **SERVICES:**

(1) Online retail store services and retail store services featuring pre-recorded compact discs, DVDs, video tapes, cosmetics, personal care items, books, printed materials, school and stationery supplies, bags, clothing, fashion accessories and merchandise; streaming of audio and visual material on the Internet; providing on-line chatrooms for the transmission of messages

among computer users concerning music and musical performers, musical performances and musical fan clubs; entertainment services in the nature of live musical performances; fan clubs; providing an on-line website featuring music, musical entertainment, musical performance information, and musical ring tones

(2) Internet services, namely, streaming of audio and visual material; providing on-line chatrooms for the transmission of messages among computer users concerning music and musical performers, musical performances and musical fan clubs; fan clubs; providing an on-line website featuring music, musical entertainment, musical performance information, and musical ring tones

(3) On-line retail store services featuring clothing; streaming of audio and visual material on the Internet; providing on-line chatrooms for the transmission of messages among computer users concerning music and musical performers, musical performances and musical fan clubs; fan clubs; providing an on-line website featuring music, musical entertainment, musical performance information

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2015-11-16

Appearances

No One Appearing

For the Opponent

Nathan Fan

For the Applicant

Agents of Record

Bereskin & Parr LLP/S.E.N.C.R.L.,  
S.R.L

For the Opponent

Sim & McBurney

For the Applicant