

IN THE MATTER OF AN OPPOSITION by The Body Shop International PLC to application No. 624,506 for the trade-mark BODY COMPANY filed by K Mart Canada Limited/ K Mart Canada Limitée

On February 1, 1989, the applicant, K Mart Canada Limited/ K Mart Canada Limitée, filed an application to register the trade-mark BODY COMPANY based upon proposed use of the trade-mark in Canada in association with "ladies' stretch body wear, namely, shorts, pants, body suits and tank tops". The applicant disclaimed the right to the exclusive use of the word BODY apart from its trade-mark.

The opponent, The Body Shop International PLC, filed a statement of opposition on January 22, 1990 in which it 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 that the applicant's trade-mark is confusing with the opponent's registered trade-marks THE BODY SHOP and THE BODY SHOP & Design, registration Nos. 288,081 and 286,211 as registered and as previously used and made known in Canada in association with the wares and services covered in its registrations and in association with clothing, including sweatshirts and t-shirts.

The applicant served and filed a counter statement in which it denied the opponent's grounds of opposition.

The opponent filed at its evidence the affidavits of Griffin Thompson, Betty-Ann Franssen and Suzanne M. Conway while the applicant submitted the affidavits of Brian J. Davies, Guy Blache, William Howard Stimson, Marion J. Johnson and Linda Thibeault.

Both the applicant and the opponent filed written arguments and both were represented at an oral hearing.

The determination of the issue of confusion between the applicant's trade-mark BODY COMPANY and the opponent's trade-marks THE BODY SHOP and THE BODY SHOP & Design will effectively decide all the issues in this opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's filing date (the material date in respect of the non-entitlement grounds of opposition) or as of the date of decision (the material date in relation to the Section 12(1)(d) grounds), the Registrar must have regard to all the surrounding circumstances, including those specifically referred to in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the

applicant in respect of the issue of confusion.

The agent for the opponent submitted at the oral hearing that the opponent's strongest case is in relation to the Section 16 ground of opposition as the material date in respect of this ground is the filing date of the applicant's application. As a result, the evidence in the Blache affidavit relating to sales of the applicant's wares and the marketplace investigations undertaken by the affiants Davies, Johnson and Stimson which were conducted in April of 1991 are irrelevant with respect to this ground. Likewise, the Conway affidavit which refers to investigations conducted by the affiant in August of 1990 and the opinions expressed by Ms. Franssen in paragraph 15 of her affidavit which are based on exhibits dated in August of 1990 are irrelevant with respect to this ground.

With respect to the Section 16(3) ground, there is an initial burden on the opponent under Sections 16(5) and 17(1) of the Trade-marks Act to establish its prior use of its trade-marks THE BODY SHOP and THE BODY SHOP & Design in Canada, as well as non-abandonment of the trade-marks in this country as of the date of advertisement of the applicant's application in the Trade-marks Journal (September 20, 1989). In this regard, the Franssen affidavit establishes that the opponent's activities in Canada are carried on by its franchisees which have been recorded as registered users of the opponent's marks. Having regard to the provisions of Section 50(3) of the Trade-marks Act, the opponent's evidence establishes that the opponent has used its registered trade-marks THE BODY SHOP and THE BODY SHOP & Design in Canada in association with cosmetics, toilet preparations and products for the care of the hair and skin, as well as the operation of retail outlets selling these wares.

The opponent's registrations do not cover either t-shirts or sweatshirts, such that any activities by the Canadian franchisees relating to the sale or distribution of such wares in Canada in association with the trade-marks THE BODY SHOP and THE BODY SHOP & Design do not accrue to the opponent. As a result, the opponent has not established its prior use of its trade-marks in association with either t-shirts or sweatshirts. In any event, I have my doubts as to whether the manner of use of the opponent's marks either on t-shirts or sweatshirts constitutes trade-mark use within the scope of Section 4(1) of the Trade-marks Act. In this regard, the burden is on the opponent to establish that its use of its marks in association with t-shirts and sweatshirts constitutes trade-mark use.

In view of the above, I have concluded that the opponent has met the burden on it under Sections 16(5) and 17(1) of the Trade-marks Act in relation to its prior use of the trade-marks THE BODY SHOP and THE BODY SHOP & Design in Canada in association with cosmetics, toilet

preparations and products for the care of the skin and hair. As a result, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the filing date of the applicant's application.

With respect to the inherent distinctiveness of the trade-marks at issue (Section 6(5)(a)), both the applicant's trade-mark BODY COMPANY as applied to articles of clothing and the opponent's trade-marks THE BODY SHOP and THE BODY SHOP & Design as applied to cosmetics, toiletries, and skin care and hair care products possess at least some measure of inherent distinctiveness.

The extent to which the trade-marks at issue had become known (Section 6(5)(a)) clearly favours the opponent. As of the filing date of the applicant's application, the applicant's trade-mark BODY COMPANY had not become known to any extent in Canada whereas the opponent's trade-marks had become relatively well known in Canada in association with skin care and hair care products, cosmetics and toiletries, as well as with the operation of retail outlets selling these wares to the public. In particular, from 1984 to 1988, sales of the opponent's wares in Canada bearing its trade-marks exceeded \$54,000,000. Likewise, the length of time that the trade-marks at issue have been in use (Section 6(5)(b)) favours the opponent in this opposition.

Under Section 6(5)(c) and (d) of the Trade-marks Act, regard must be had to the nature of the wares and services of the parties, and the respective channels of trade associated with those wares and services. Thus, the Registrar must consider those wares covered in the applicant's application and the wares and services in association with which the opponent has established its prior use of its trade-marks in Canada. In this regard, there is no similarity whatsoever between the applicant's ladies' stretch body wear and the opponent's toiletries, cosmetics, skin care and hair care products and its operation of retail store specializing in the sale of such wares.

Unlike a ground of opposition based on Section 12(1)(d), the Registrar, in assessing the issue of confusion with respect to a non-entitlement or non-distinctiveness ground of opposition, must have regard only to the channels of trade actually evidenced. On the other hand, the Registrar must also consider those channels of trade which the average consumer would normally consider as being associated with the wares covered in the applicant's application. In the present case, there is no limitation as to any potential channels of trade associated with the wares covered in the applicant's application and I must therefore consider those trade channels which the average consumer would consider as being normally associated with ladies' stretch body wear. However, the average consumer would not consider that the normal channels of trade associated with ladies' body wear

would include the sale of such wares in stores specializing in the sale of toiletries, cosmetics, skin care and hair care products, the actual channels of trade associated with the opponent's wares and services. As a result, there appears to be no similarity in the channels of trade associated with the wares and services of the parties.

The trade-marks BODY COMPANY and THE BODY SHOP and THE BODY SHOP & Design bear some similarity in appearance and sounding. Further, the idea suggested by the applicant's trade-mark BODY COMPANY is rather vague but could include the operation of a business or company involved in the sale of either clothing or personal care products. On the other hand, the opponent's trade-mark THE BODY SHOP as a matter of immediate impression suggests the idea of the operation of an automotive body repair shop. As a result, the ideas suggested by the trade-marks at issue differ.

In view of the above, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in relation to the Section 16(3) ground which I have therefore rejected.

To the extent that the opponent has relied upon its prior use of its trade-marks in respect of its non-distinctiveness ground, the above conclusion in respect of the issue of confusion is still applicable even though the material date for assessing this ground is as of the date of opposition (January 22, 1990). I have therefore also rejected this ground.

The opponent has also alleged that the applicant's trade-mark is not registrable in view of the provisions of section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark is confusing with the opponent's registered trade-marks. The material date in respect of this ground is as of the date of my decision, such that the affidavits of Conway, Johnson, Stimson and Davies are relevant evidence in assessing the issue of confusion. Further, in considering the opponent's wares covered in its registrations, regard must be had to the normal channels of trade which the average Canadian consumer would consider as being associated with those wares.

The above comments in relation to the inherent distinctiveness of the trade-marks at issue remain applicable. However, as of the date of this decision, the opponent has shown that its trade-marks have become known to an even greater extent in Canada with sales in 1989 alone exceeding \$45,000,000. On the other hand, the Blache affidavit establishes that the applicant has commenced use of its trade-mark BODY COMPANY in Canada in association with clothing, with sales between

August 1989 and March 1991 in Canada being approximately \$3,800,000. Likewise, Mr. Blache notes that the applicant's BODY COMPANY clothing has been advertised in the applicant's flyers in 1989 and 1990. As a result, the applicant's trade-mark BODY COMPANY has also become known in Canada in association with clothing. Nevertheless, the extent to which the trade-marks have become known (Section 6(5)(a)) and the length of time the marks have been in use (Section 6(5)(b)) still weigh in the opponent's favour.

As noted above, the applicant's clothing differs from the opponent's cosmetics, toiletries and skin care and hair care products, as well as differing from the opponent's services relating to the operation of stores specializing in the sale of such wares (Section 6(5)(c)). With respect to the channels of trade (Section 6(5)(d)) which one would normally associate with the wares of the parties, I do not consider there to be any overlapping between the opponent's toiletries, cosmetics, skin care and hair care products and the applicant's clothing. In particular, the average consumer would normally expect ladies' stretch body wear to be sold in clothing stores, in sporting goods stores or in the sporting goods and clothing sections of a department-type store. On the other hand, cosmetics, toiletries, skin care and hair care products would normally be sold in drug stores, stores specializing in cosmetics, toiletries, hair and skin care products, or in the cosmetic or skin care product sections of department-type stores. Further, the average consumer would not normally expect clothing to be sold in retail stores specializing in the sale of cosmetics, toiletries and products for the care of the skin and hair, such that there would be no potential overlap in the channels of trade associated with the applicant's clothing and the opponent's services.

The comments noted above in relation to the degree of resemblance between the trade-marks at issue (Section 6(5)(e)) are equally applicable to the Section 12(1)(d) ground.

As a further surrounding circumstance in respect of the issue of confusion, the opponent has relied upon the fact that it has sold t-shirts and sweatshirts in its stores in Canada. However, as noted above, the sale of such wares in Canada by the opponent's franchisees does not constitute use of the marks THE BODY SHOP or THE BODY SHOP & Design which would accrue to the opponent. Further, I doubt that the sale by the opponent's franchisees of t-shirts and sweatshirts bearing the mark THE BODY SHOP & Design across the back (exhibits H-1 and H-2 to the Franssen affidavit) constitutes trade-mark use within the scope of Section 4(1) of the Act as such sales appear to be essentially promotional in nature. Further, I do not consider that the sale of t-shirts and sweatshirts are a natural extension of the wares covered in the opponent's registrations.

As a further surrounding circumstance, the opponent has relied upon paragraph 15 of the Franssen affidavit which points to the fact that certain "designer" marks such as CALVIN KLEIN, ALFRED SUNG and LIZ CLAIBORNE have been associated with both clothing and cosmetics and toiletries in the marketplace. However, as pointed out by Mr. Justice Cullen in S.C. Johnson & Son, Inc. v. Esprit de Corps. et al, 13 C.P.R. (3d) 235, at page 245 as follows:

"It is conceded by the applicant that clothing and cosmetics are closely associated in the top echelon or high fashion level where the same designer trade marks are used in wares of both industries. This type of trade mark used in both industries is a "designer" or "signature" mark containing the personal name of a well-known clothing designer. Most Canadian consumers are familiar with the names Pierre Cardan, Givenchy, Ralph Lauren, to name but a few.

The applicant states: "these 'designer' or 'signature' marks are not only applied to fragrances and cosmetic products, but to all kind of clothing accessories such as jewellery, shoes, belts, furs and to other wares such as chocolates, car interiors, wallpaper and household furnishings and accessories". I agree. It seems to me obvious that any person or corporation seeking a trade mark on any ware of any class using one of these "designer" or "signature" marks could not expect to succeed."

and at page 248 as follows:

"I accept that trade marks have been granted to cross-over items but for reasons discussed earlier that is due to the "designer" or "signature" nature of the mark."

Having regard to the observations of the learned trial judge, I do not consider that the views of Ms. Franssen as set forth in paragraph 15 of her affidavit are of any relevance in the present opposition proceeding.

In view of the above, I have concluded that the applicant has discharged the legal burden upon it in respect of the issue of confusion between its trade-mark BODY COMPANY and the registered trade-marks THE BODY SHOP and THE BODY SHOP & Design. As a result, I reject the opponent's Section 12(1)(d) grounds of opposition.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30TH DAY OF OCTOBER 1992.

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