



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

**Citation: 2013 TMOB 7**  
**Date of Decision: 2013-01-11**

**IN THE MATTER OF AN OPPOSITION  
by Guerlain Société Anonyme to  
application No. 1,417,586 for the trade-  
mark KISS KISS BRONZE BRONZE in  
the name of Australian Gold, Inc.**

[1] On November 7, 2008, Australian Gold, Inc. (the Applicant) filed an application to register the trade-mark KISS KISS BRONZE BRONZE (the Mark) based on use in Canada since at least as early as November 3, 2008 in association with the wares “non-medicated skin tanning preparations sold exclusively in indoor tanning salons”, as amended by way of a revised application accepted on August 15, 2011 (the Wares). The application claims a priority filing date of May 13, 2008 based on United States application No. 77/472811.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 2, 2009.

[3] On January 26, 2010, Guerlain Société Anonyme (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with section 30(b) of the Act because:
  - i. at the time of filing the application for the Mark, the Applicant had not used the Mark in association with the Wares and as a result the claimed date of first use is false; and/or

ii. the alleged use (which is denied) of the Mark in association with the Wares has been discontinued.

- pursuant to sections 38(2)(a) and 30(b) and (h) of the Act, the mark for which the Applicant alleges use is not the Mark but rather a different mark.
- pursuant to sections 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark in Canada having regard to the allegations in the statement of opposition including the Applicant's knowledge of the Opponent's rights, of the fact that any use of the Mark would be illegal for violating the Opponent's rights, of the fact that any use of the Mark would depreciate the value of the goodwill attached to the Opponent's marks contrary to section 22 of the Act and would be contrary to section 7(b) of the Act.
- Pursuant to sections 38(2)(b) and 12(1)(d) – the Mark is not registrable due to confusion with the Opponent's registered trade-marks (the Opponent's KISSKISS Marks):

i. KISSKISS Design, TMA462,354, shown below; and

KISSKISS

ii. KISS-KISS, TMA247,324.

- Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant was not entitled to registration of the Mark because at the claimed date of first use, as well as at any material date, the Mark was confusing with the Opponent's KISSKISS Marks previously used or made known in Canada by the Opponent, its predecessors-in-title or for its benefit by licensees for various products, namely personal care products, perfume and cosmetics.
- Contrary to sections 38(2)(c) and the introductory paragraph of section 16(1) of the Act, the Applicant is not entitled to registration of the Mark because the application does not comply with section 30 of the Act, the Mark is not a used one but a proposed one, use of the Mark has been discontinued, the Mark is not registrable because it does not function as a trade-mark as it is not intended to distinguish the Wares from those of others and the Mark is purely functional or decorative.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Wares and cannot be so distinctive as it does not distinguish the Wares from the wares or services of others, including those of the Opponent.

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

[5] In support of its opposition, the Opponent filed an affidavit of Sandrine Briatte, the Director of Marketing of Guerlain Canada Ltée, the Opponent's Canadian distributor and subsidiary, as well as certified copies of the Opponent's registrations (TMA247,324 for KISS-KISS and TMA462,354 for KISSKISS DESIGN).

[6] In support of its application, the Applicant filed a statutory declaration of Susan Phemster, the Senior Brand Manager of Australian Gold LLC, the Applicant's licensee; the affidavit of Lesley Gallivan, a trade-mark searcher employed by the Applicant's agent and a certified copy of the affidavit of Sandrine Briatte dated October 7, 2010 in respect of Canadian trade-mark registration TMA462,354 for KISSKISS Design held in the name of the Opponent.

[7] Both parties filed written arguments. An oral hearing was held at which only the Applicant was represented.

#### Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]
- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## Section 30 Grounds of Opposition

### *Non-compliance with section 30(b) of the Act*

[10] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b) of the Act because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[11] The Opponent may rely on the Applicant's evidence to meet its initial burden in relation to this ground [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD), and *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. However, the Opponent is under an obligation to show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), aff'd 11 CPR (4th) 489 (FCTD)].

[12] In the present case, the Opponent has not filed any evidence directed to the section 30(b) ground of opposition; instead it makes submissions interpreting the Applicant's evidence in an attempt to meet its evidential burden.

[13] The application alleges use of the Mark in association with the Wares since at least as early as November 3, 2008. Ms. Phemster provides evidence regarding the activities of Australian Gold LLC, the Applicant's licensee (the Licensee). She makes the sworn statement that the Licensee manufactures the products sold under the Mark under a license from the Applicant. Ms. Phemster confirms that the Applicant exercises control over the character and quality of the Wares sold under the Mark (paragraph 1). In the absence of cross-examination or conflicting evidence, I have no reason to doubt Ms. Phemster's sworn statements on this point.

[14] Ms. Phemster states that the Mark is applied to the Licensee's products together with the house mark, AUSTRALIAN GOLD ®. Ms. Phemster states that the Licensee has been applying the Mark to indoor tanning products which have been sold internationally (including in Canada) since at least July 2008 (paragraphs 3, 15).

[15] In its written argument, the Opponent submits that Ms. Phemster has failed to provide any evidence showing how the Mark is displayed on the products. This is true. However, for the purposes of determining whether the Opponent has met its burden under section 30(b) by relying on the Applicant's evidence, the Opponent must establish that the Applicant's evidence is clearly inconsistent with the claimed date of first use.

[16] Despite the fact that the Applicant has not provided any examples of the way in which the Mark is displayed on the Wares, Ms. Phemster does make a sworn statement that the Mark is applied to the Wares along with the AUSTRALIAN GOLD ® trade-mark. Furthermore, while she does not provide any sales figures for the Wares, Ms. Phemster does make the sworn statement that the Licensee has been selling the Wares in Canada since at least July 2008. In the absence of cross-examination or conflicting evidence, I have no reason to doubt Ms. Phemster's sworn statements.

[17] Based on the foregoing, I find that the evidence is not clearly inconsistent with the claimed date of first use and as a result the Opponent has failed to meet its evidential burden. Accordingly, the ground of opposition based on section 30(b) of the Act is dismissed.

*Non-compliance with Section 30(b) and (h) of the Act*

[18] The Opponent also alleges that the application does not comply with sections 30(b) and (h) on the basis that the mark for which use has been alleged by the Applicant is not the Mark but rather a different mark.

[19] I note that the Opponent has not provided any further facts, evidence or argument in support of the allegation that the mark as used by the Applicant is not the Mark as applied for. With respect to the section 30(b) portion, I find that the Opponent has failed to meet its evidential burden.

[20] With respect to section 30(h) portion, I note that section 30(h) is irrelevant since the application is for a word mark, not a design mark. Accordingly, the section 30(h) portion is improperly pleaded.

[21] Based on the foregoing, these grounds of opposition are dismissed.

*Non-compliance with section 30(i) of the Act*

[22] Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. The jurisprudence suggests that non-compliance with section 30(i) can be found in one of two circumstances. The first circumstance is where there are exceptional circumstances such as bad faith which render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 369]. In this case, there is no evidence of bad faith on the part of the Applicant. The second circumstance is where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act*, RSC 1985, c C-42; *Food and Drugs Act*, RSC 1985, c F-27; or *Canada Post Corporation Act*, RSC 1985, c C-10 [see *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[23] Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of section 22 is a valid ground of opposition [*Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FCTD) at paras 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at paras. 46, 63-68], it would have no chance of success. The same is true with respect to the allegation of the use being contrary to section 7(b) of the Act. Accordingly, this ground of opposition is dismissed.

Non-registrability Ground – Section 12(1)(d) of the Act

[24] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the Register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and note that both registrations were recently the subject of section 45 proceedings. Decisions in relation to the section 45 proceedings were rendered on

October 5, 2012 and dispatched to the parties October 15, 2012. The Registrar maintained registration No. TMA247,324 in its entirety (i.e. for “lip-gloss”) and amended registration No. TMA462,354 so that it is now registered only for “cosmétiques, nommément: rouge à lèvres”. Given that the registrations remain extant, the Opponent has satisfied its evidential burden.

[25] I must now assess whether the Applicant has met its legal burden.

[26] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[27] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

*Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[28] The Mark is made up of the common dictionary words KISS and BRONZE. The word KISS has some inherent distinctiveness by virtue of the fact that it has no clear meaning with respect to the Wares. By contrast the word BRONZE is suggestive of the Wares which relate to tanning, or “bronzing” one’s skin.

[29] The word KISS is highly suggestive of the nature of the Opponent’s lipstick and lip gloss wares. The Opponent’s trade-mark KISSKISS Design also possesses some design features in the form of stylized text. However, these design features do not increase the inherent distinctive in any significant way.

[30] The Opponent submits that its marks possess inherent distinctiveness by virtue of the duplication of the word KISS. I am of the view that the simple duplication of a word, particularly a word which is highly suggestive of the associated wares, is likely not sufficient to create inherent distinctiveness in a trade-mark. However, I need not make a finding on this issue since both parties' marks possess the same duplication and thus any inherent distinctiveness created by such duplication would favour both parties equally.

[31] Based on the foregoing, I assess the inherent distinctiveness of the Mark as being slightly higher than the Opponent's KISSKISS Marks by virtue of the fact that the word KISS has no meaning with respect to the Wares.

[32] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[33] As discussed above in the section 30(b) ground of opposition, while I am satisfied that the Applicant has applied the Mark to the Wares which have been sold in Canada since at least July 2008, the Applicant has not provided any evidence showing how the Mark is displayed on the Wares or their packaging, nor any sales figures or advertising expenditures. In the absence of any evidence of this nature I am unable to determine the extent to which the Mark has become known.

[34] In her affidavit Ms. Briatte makes the sworn statement that the Opponent adopted the KISSKISS Marks in 1977, however, I note that the supporting documentary evidence adduced dates back only to 2004.

[35] Unlike the Applicant, the Opponent has provided a photograph of the KISSKISS Marks displayed on lipstick and lip gloss products and their associated packaging (Briatte affidavit, Exhibit 1). While the Opponent has not provided summary sales figures or advertising expenditures, Ms. Briatte does provide sample invoices for sales of lipstick and lip gloss products sold in association with the KISSKISS Marks in Canada from 2005-2008 (Exhibit 3) as well as samples of advertising and promotional materials for the same wares (Exhibits 4-6 and 8) over the same time period.



[36] In terms of media coverage, the Opponent submits that its KISSKISS products are regularly and continually covered in media all over the world, including in Canada, particularly in women's fashion magazines. In support of this statement, Ms. Briatte attaches to her affidavit extracts from media coverage reports for 2005-2007 providing data regarding printed publications distributed and circulated in Canada where the Opponent's KISSKISS wares were advertised or commented on along with samples of pages from these printed publications (Exhibit 4). The Opponent also submits that its lipstick and lip gloss wares have won prizes, including one issued by Chatelaine Magazine in 2007 (Exhibit 7).

[37] The Opponent provides sample advertisements distributed by the Opponent at its retail points of sale for its lipstick and lip gloss sold under the KISSKISS Marks for 2004, 2009, 2010 (Exhibit 5) as well as photographs taken at points of sale from 2004 – 2008 (Exhibit 6). The KISSKISS Marks are featured prominently in the advertisements and the displays. Ms. Briatte also attaches to her affidavit materials printed from the Opponent's website, *www.guerlain.com* which she states is accessible to Canadians and on which she states the Opponent has advertised its KISSKISS wares from at least 2002 – 2010 (Exhibit 8).

[38] Based on a review of the Opponent's evidence as a whole I am satisfied that the KISSKISS Marks have become known to some extent by virtue of the Opponent's sale and promotion in Canada of lipstick and lip gloss since at least 2004.

*Section 6(5)(b) – the length of time each has been in use*

[39] Based on the evidence of record, I am satisfied that the Opponent's KISSKISS Marks have been in use for longer than the Mark.

*Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade*

[40] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[41] The parties' wares all belong to the general category of "personal care products"; however the exact nature of the parties' wares differs. As will be discussed further in the

following paragraphs, the evidence establishes that the parties' wares and channels of trade are distinct.

[42] The Applicant submits that indoor tanning preparations like the Wares are typically offered as complementary products to the tanning services offered to customers of tanning salons and are used during indoor tanning sessions (paragraphs 7-14). The Wares are purchased by customers of tanning salons from trained tanning consultants in such salons (paragraphs 7-14).

[43] The Applicant provides evidence regarding the unique nature of indoor tanning products (paragraphs 7-14). Ms. Phemster, who has worked in the indoor tanning industry for more than 15 years, states that whereas outdoor sun tanning products have an SPF (sun protective factor) rating, indoor tanning products are designed not to have an SPF effect as it would defeat the purpose of indoor tanning where a user is seeking exposure to UV rays in a tanning bed (paragraphs 7-14). Ms. Phemster states that the Wares include "a blend containing two/dual bronzing agents to assist a user in obtaining darker, faster and longer color" (paragraph 5).

[44] Ms. Phemster states that indoor tanning products are regulated differently by government agencies and are subject to different regulations and labeling requirements than outdoor SPF products (paragraph 9). Ms. Phemster states that the result of this is that indoor tanning preparations are not considered in the tanning industry to be "cosmetics" as that term is ordinarily understood (paragraph 9). As a corollary, Ms. Phemster states that consumers would not typically encounter indoor tanning products like the Wares in locations where products typically understood as "cosmetics" would be sold (paragraph 9).

[45] In further support of its submission that the nature of the parties' wares and channels of trade differ, the Applicant has specifically identified the channels of trade through which the Wares travel in the application itself. The specification of the Wares includes the limitation that the Wares are "sold exclusively in indoor tanning salons". The evidence supports this as well. Ms. Phemster states that the KISS KISS BRONZE BRONZE products are marketed and displayed in tanning salons as part of the complete AUSTRALIAN GOLD ® line of products (paragraph 3). Ms. Phemster states that Australian Gold LLC's products sold under the Mark are typically marketed in indoor tanning salons to customers by trained tanning experts (paragraph

4). The products are sold with a suggested retail price of approximately \$30/bottle in Canada (paragraph 4).

[46] The evidence supports a finding that Opponent's channels of trade differ from the Applicant's. In her affidavit, Ms. Briatte states that the Opponent's KISSKISS wares are distributed in Canada by its Canadian distributor/subsidiary which operates as Guerlain (Canada) Ltée and Guerlain Canada (paragraph 9). She states that the wares sold under the KISSKISS mark are sold primarily in Guerlain boutiques operated by the Opponent, in the cosmetic departments of department stores and in certain pharmacies specializing in cosmetic and beauty products (e.g. the Bay, Sears, Shoppers Drug Mart, Pharmaprix) (paragraph 11). Ms. Briatte states that the Opponent's KISSKISS wares have also been sold since at least 2007 on the Sears website at *www.sears.ca* (paragraph 12). Ms. Briatte explains that customers can buy goods from this website and have them shipped to Canadian addresses (paragraph 12). Ms. Briatte attaches to her affidavit material printed from the *www.sears.ca* website which she states is representative of the way in which the Opponent's KISSKISS wares have been advertised on the website since at least 2007 (paragraph 12, Exhibit 2). I note that there is no evidence that the Opponent's KISSKISS wares would be sold in indoor tanning salons.

[47] As further support for the distinction between the parties' channels of trade I note that in her affidavit, Ms. Phemster states that the Licensee requires that each of its distributors agree to sell the Wares only to persons or entities whose primary business activity is operating a tanning salon. The agreement also prohibits distributors from selling the products to any individual or entity, including a tanning salon, who intends to sell the products on the Internet or to drug stores, grocery stores or other retail, wholesale or discount stores or outlets, flea markets, shopping malls, etc. (paragraph 11).

[48] The Applicant submits that the parties' wares have different uses, are directed to different consumers, have different intended purposes and different methods of use and are not competitive or complementary wares.

[49] The Opponent's evidence demonstrates that its business is not restricted to lipstick and lip gloss in that the Opponent also sells self-tanning products, albeit not in association with the KISSKISS Marks. Specifically, Ms. Briatte states that since at least 1984, the Opponent has sold

all over the world, including in Canada, a number of products under the name TERRACOTTA that include bronzing powders and self/instant tanning products in the form of balms, sprays and gels (paragraph 18). Ms. Briatte attaches to her affidavit a selection of pages printed from the Opponent's websites *www.guerlain.com* and *www.terracotta-guerlain.com* advertising the Opponent's products sold under the TERRACOTTA trade-mark (Exhibit 9). Ms. Briatte states that the materials from the Opponent's websites are representative of the way in which the Opponent's TERRACOTTA products have been sold by the Opponent since 1984 (paragraph 18).

[50] While the evidence shows that the Opponent's business also includes the sale of self-tanning products, I note that the registrations for the KISSKISS Marks upon which the section 12(1)(d) ground of opposition is based do not cover such products.

[51] Based on the evidence of record, I am satisfied that there is no overlap in the nature of the parties' wares or channels of trade.

*Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[52] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2) 145, conf 60 CPR (2d) 70 (FCTD)]. This principle was recently upheld by the Supreme Court of Canada in *Masterpiece, supra*.

[53] “Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction.” [see *K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD) at 527] In the present case, the first portion of the Mark is essentially identical to the entirety of the Opponent's KISSKISS mark.

[54] In terms of ideas suggested, however, I agree with the Applicant that there are differences between them. Specifically, at the oral hearing the Applicant submitted that in the context of the Opponent's wares the mark KISSKISS suggests “lips” whereas the Mark, which includes the

words BRONZE BRONZE and is used in association with tanning products, suggests “sunkissed” that is, the idea of being tanned or touched by the sun. I agree. As a result, I find that there are differences between the parties’ marks in terms of ideas suggested.

*Additional Surrounding Circumstance – State of the Register and Marketplace Evidence*

[55] Ms. Gallivan provides state of the register and state of the marketplace evidence. On January 11, 2011 Ms. Gallivan searched the Canadian Intellectual Property Office Trade-marks Database for trade-marks incorporating the word KISS for use in association with “cosmetics, including lipstick and personal care products”. Ms. Gallivan attaches to her affidavit copies of particulars of the registrations and allowed applications that turned up from her search (Exhibit A). Ms. Gallivan’s search turned up approximately 65 relevant registrations and allowed applications for trade-marks incorporating the word KISS in association with cosmetics, including lipstick and personal care products.

[56] When analyzing the relevance of state of the register evidence, it must be noted that such evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 C.P.R. (3d) 349 (FCA)] or where evidence of use of the marks in the marketplace.

[57] I am satisfied that the presence of over 60 relevant marks on the Register is sufficient to enable me to make the inference that at least some of these are in use in the Canadian marketplace. Furthermore, I have been given state of the marketplace evidence in the form of the results of Ms. Gallivan’s attempts to purchase cosmetic products sold under trade-marks incorporating the word KISS in the Canadian marketplace. Specifically, Ms. Gallivan states that on and around January 28, 2011 she attended at various online and physical retail, pharmacy and department stores looking for products similar to those of the Opponent’s sold under trade-marks containing or comprising the word KISS.

[58] Ms. Gallivan made the following purchases:

- a. Blinc Kiss Me Mascara, found on the website for the retail beauty store Sephora. Ms. Gallivan attaches printouts from the Sephora website, including a portion which shows that this product can be sold to Canadian customers (Exhibits C-E).
- b. Clinique Double the Kisses holiday set, containing lipstick, lip gloss and makeup bag, also found on the Sephora website (Exhibit F).
- c. Philosophy Kiss Me lip balm, also found on the Sephora website (Exhibit G).
- d. KISS & STAY lip gloss and COCOA BUTTER KISS body spray, purchased at Zellers department store at Bayshore Shopping Centre in Nepean, Ontario (Exhibit H, I, J).
- e. Cake Kiss lip butter, purchased at Sephora at the Rideau Centre in Ottawa, Ontario (Exhibits K, L).
- f. LISE WATIER SENSATIONAL KISS exfoliating lip balm, LISE WATIER LIP KISS CRAYON GLOSS lip gloss, DIOR DIORKISS plumping lip gloss and Benefit CALIFORNIA KISSIN' lip shine purchased at Shoppers Drug Mart, drug store in Ottawa, Ontario (Exhibits M-Q).
- g. N.Y.C. KISS GLOSS lip gloss and KISS EVERLASTING FRENCH artificial nails purchased at PharmaPlus drug store at Billings Bridge Shopping Centre in Ottawa, Ontario (Exhibits R-T).

[59] The Opponent submits that it is relevant to note that none of the marks found on the Register included the duplication of the word KISS like the Opponent's KISSKISS Marks.

[60] While it is true that none of the marks found in Ms. Gallivan's search featured the duplication of the word KISS as is found in the Mark and the Opponent's KISSKISS Marks, based on a review of Ms. Gallivan's affidavit as a whole I am prepared to find that the word KISS is a common word in the cosmetics and personal care products industry, particularly in relation to lip products like lipstick and lip gloss. Under the circumstances, I find that I am able to presume that consumers have become accustomed to seeing trade-marks incorporating the word KISS such that the word has become common to the cosmetics and personal care products industry. This finding serves to diminish the ambit of protection which can be accorded to the Opponent's KISSKISS Marks.

[61] Based on the foregoing, I find that this serves as a relevant surrounding circumstance in support of the Applicant's position. As a result, I find that small differences between the parties' marks will thus serve to distinguish them.

*Additional Surrounding Circumstance – OHIM Decision*

[58] In its written argument, the Opponent raises as an additional surrounding circumstance the fact that the likelihood of confusion between the parties' marks has already been acknowledged in another jurisdiction, namely in OHIM who accepted an opposition and refused registration for the Mark in OHIM.

[62] In its written argument the Opponent submits that the facts in the present opposition are very similar, if not identical, to those in the OHIM proceeding and also the test for determining a likelihood of confusion as between the marks is also very similar.

[63] At the oral hearing, the Applicant submitted that the legal framework followed by OHIM differs from that followed by the Registrar and thus decisions therefrom have no precedential value. In particular, the Applicant submits that OHIM follows the Nice Classification system and does not consider channels of trade when assessing the likelihood of confusion.

[64] I note that foreign jurisprudence is not binding on the Registrar. This is particularly true in the present case where no evidence has been provided regarding the applicable law in the foreign jurisdiction. Based on the foregoing, I find that the decision from OHIM has no precedential value and thus this does not form a relevant surrounding circumstance supporting the Opponent's position.

*Conclusion*

[65] In applying the test for confusion I have considered it as a matter of first impression and imperfect recollection. While I acknowledge that the Mark essentially incorporates the whole of the Opponent's trade-mark KISS-KISS, I find that the relevance of this is diminished by virtue of the fact that the evidence supports a finding that trade-marks incorporating the word KISS are frequently used in association with cosmetics and personal care products. Furthermore the word KISS is highly suggestive of the Opponent's lip products.

[66] Having considered all of the surrounding circumstances, in particular the difference in the parties' channels of trade and the fact that the word KISS is common to the cosmetics and personal care products trade (particularly in association with lip products), I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's KISSKISS Marks.

[67] Having regard to the foregoing, I dismiss the ground of opposition based on section 12(1)(d) of the Act.

### Non-entitlement Grounds

#### *Introductory Portion of Section 16(1) of the Act*

[68] The Opponent alleges that the Applicant is not entitled to registration of the Mark since contrary to the introductory paragraph of section 16(1) of the Act the application does not comply with the requirements of section 30 of the Act; the Mark is not a used one but a proposed one; use of the Mark has been discontinued; the Mark is not registrable because it does not function as a trade-mark as it is not intended to distinguish the Wares from those of others and the Mark is purely functional or decorative.

[69] The introductory paragraph of section 16(1) of the Act does not form the basis of a ground of opposition as defined in section 38(2) of the Act since section 16(1) of the Act as a whole relates to the entitlement grounds of opposition. Accordingly, I dismiss this ground of opposition based solely upon the introductory paragraph of section 16(1) of the Act.

#### *Section 16(1)(a) of the Act*

[70] As a preliminary matter, I note that in its counter statement, the Applicant objected to this ground of opposition on the basis that it was not properly pleaded. Specifically, the Applicant alleged that the ground of opposition failed to identify the Opponent's alleged predecessors in title. According to *Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA), I must assess the sufficiency of the pleadings in association with the evidence. Based on a review of the pleadings in association with the evidence, I am satisfied that the Applicant knew the case it was required to meet. I am therefore satisfied that this ground has been sufficiently pleaded.



[71] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's KISSKISS Marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on section 16(1)(a) of the Act was used in Canada prior to the claimed date of first use for the Mark (November 3, 2008) and had not been abandoned at the date of advertisement of the application for the Mark (September 2, 2009) [section 16(5) of the Act].

[72] The Opponent claims prior use of the KISSKISS Marks in association with various products namely personal care products, perfume and cosmetics; however, as noted above in the section 12(1)(d) ground of opposition, the evidence only shows use of the KISSKISS Marks in association with lipstick and lip gloss.

[73] As discussed in the analysis of the section 12(1)(d) ground of opposition, the Opponent has provided evidence that its business also includes the sale of self-tanning products. However, as noted above, these products are not sold in association with the KISSKISS Marks, as pleaded, but rather in association with the trade-mark TERRACOTTA. As a result, the evidence of sales of self-tanning products by the Opponent is not relevant to the analysis of the ground of opposition based on section 16(1) of the Act.

[74] As discussed further in the analysis of the section 12(1)(d) ground of opposition, the Opponent has succeeded in establishing use of its KISSKISS Marks prior to the claimed date of first use for the Mark (November 3, 2008). The Opponent must also establish non-abandonment of the KISSKISS Marks as of the advertisement date for the application for the Mark (September 2, 2009).

[75] At the oral hearing, the Applicant submitted that the evidence does not show non-abandonment of the KISSKISS Marks as of September 2, 2009; rather, the evidence shows use only from 2005 – 2008. I disagree. I note that Ms. Briatte provides evidence of advertisements for its KISSKISS lipsticks provided by the Opponent to its various retailers, including one entitled "Lips consultation Fall 2009" suggesting that the KISSKISS Marks had not been abandoned at the relevant date.

[76] Based on the foregoing, I am satisfied that the Opponent has met its evidential burden with respect to lipstick and lip gloss. I must now assess whether the Applicant has met its legal onus.

[77] The difference in material dates is significant only to the extent that the state of the marketplace evidence post-dates the material date for this ground of opposition. The state of the register evidence is still relevant, however, as a significant number of the over 60 relevant entries were on the Register at the earlier material date for this ground of opposition. For the same reasons as identified above in the analysis of the section 12(1)(d) ground of opposition, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks. Accordingly, the non-entitlement ground of opposition based on section 16(1)(a) is therefore dismissed.

#### Non-distinctiveness Ground – section 38(2)(d) of the Act

[78] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[79] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its KISSKISS Marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[80] As discussed more fully in the analysis of the section 12(1)(d) and 16(1) grounds of opposition, the Opponent was successful in establishing that its trade-marks had become known to some extent in association with lipstick and lip gloss as of the date of filing the statement of opposition and as a result the Opponent has met its evidential burden.

[81] The difference in material dates is significant only to the extent that the state of the marketplace evidence post-dates the material date for this ground of opposition. The state of the

register evidence is still relevant, however, as a significant number of the over 60 relevant entries were on the Register at the earlier material date for this ground of opposition. For the same reasons as identified above in the analysis of the section 12(1)(d) ground of opposition, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks. Accordingly, the non-distinctiveness ground is also dismissed.

#### Disposition

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

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office