

**IN THE MATTER OF AN
OPPOSITION by Scott Paper
Company and Scott Paper Limited to
application No. 744,798 for the trade-
mark SCOTT' S YOUNG 'N FREE
filed by Lander Co. Canada Limited**

On January 6, 1994, the applicant, Lander Co. Canada Limited, filed an application to register the trade-mark SCOTT' S YOUNG 'N FREE for shampoos, bath oils, baby oils and talcum powder based on use since at least as early as November 22, 1979. During prosecution, the applicant disclaimed the right to the exclusive use of the word SCOTT' S apart from the trade-mark, at the Examiner' s request. The application was advertised for opposition purposes on October 5, 1994.

The opponents, Scott Paper Company and Scott Paper Limited, filed a joint Statement of Opposition on March 13, 1995. The first ground of opposition is that the trade-mark is not registrable pursuant to Paragraph 12(1)(d) of the *Trade-marks Act* because it is confusing with 32 registered trade-marks that include the component SCOTT. The second ground is that the applicant is not the person entitled to registration of the trade-mark in view of the provisions of Section 16 of the *Act* because at the alleged date of first use the mark was confusing with the trade-mark SCOTT, various trade-marks that include the component SCOTT and certain trade-names, all previously used by the opponents. The third ground is that the applicant' s mark is not distinctive and the fourth ground is that the application is not in compliance with Section 30 because the applicant had not used its mark with each of the applied for wares as of November 22, 1979.

The applicant filed and served a counterstatement denying the opponents' allegations. In addition, the applicant relied in its counterstatement on the

existence of 109 marks that include the component SCOT or SCOTT.

The opponent filed as its evidence the affidavit of Stephen Dilworth, a trade-mark searcher. He introduces copies of 44 marks on the Canadian Trade-marks Register which include the formative SCOT or SCOTT and which are owned by Scott Paper Company. Of these, the vast majority cover various paper products. However, there are two registrations which are more relevant with respect to these proceedings: registration No. 243,717 for SCOTT, which covers baby-lotion impregnated cleansing cloths for use on infants; and registration No. 377,051 for SCOTT & S Design, which covers soaps and soap dispensers. Registration No. 243,717 was registered in 1980 based on use and registration in the United States of America. Registration No. 377,051 was registered in 1990 on the basis of a declaration of use filed October 1, 1990.

The applicant filed as its evidence the affidavit of Sandra M. Ward, a secretary. She provides the results of a search that she conducted to locate marks on the Trade-marks Register which include SCOT or SCOTT and which are not owned by the Scott Paper Company. Although there are 109 such marks, the vast majority of these are for wares or services unrelated to those in issue here. In addition, many of the applications and registrations are no longer in good standing. The most relevant of the marks introduced by Ms. Ward are: Nfld. Registration No. 2497 for SCOTT' S LINIMENT and Man and Fish Design, which covers a liniment for skin; Nfld. Registration No. 2498 for SCOTT' S OINTMENT and Man and Fish Design, which covers an ointment for skin; and the applicant' s registration No. 243,637 for SCOTT' S YOUNG 'N FREE, which covers shampoos, bath oils, baby oils and talcum powder. Registration No. 243,637 issued to registration April 18, 1980 based on a declaration of use filed November 22, 1979.

No reply evidence was filed and no cross-examinations were held. Only the

applicant filed a written argument. An oral hearing was not held.

The opponents have not evidenced the use of any marks. Accordingly, they have not met the evidentiary burden under Section 16. The Section 16 ground of opposition therefore fails.

There is also an initial evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b). As there is no evidence on this point, that ground of opposition also fails.

The remaining grounds of opposition turn on the issue of confusion. The material date with respect to Paragraph 12(1)(d) is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)]. The material date with respect to non-distinctiveness is the date of filing of the opposition. However, in the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

I will consider the likelihood of confusion between the applicant's mark and each of the opponents' marks SCOTT (registration No. 243,717) and SCOTT & S Design (registration No. 377,051). As these are the most pertinent of the opponents' marks, if there is no likelihood of confusion with either of them then it follows that there is no likelihood of confusion with any of the remaining marks.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: the inherent distinctiveness of

the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each factor may vary, depending on the circumstances [*Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

The trade-mark SCOTT is not very inherently distinctive because the word SCOTT is both a first name and a surname. The trade-mark SCOTT & S Design has a greater degree of inherent distinctiveness but marks comprising initials are generally not considered to be inherently strong marks. The applicant's mark SCOTT'S YOUNG 'N FREE has the most inherent distinctiveness.

There is no evidence of any of the marks having been promoted or used. The applicant's application claims that its mark has been used since at least November 22, 1979. Registration No. 243,717 for SCOTT issued based solely on use and registration abroad. Registration No. 377,051 for SCOTT & S Design issued from an application filed in 1988 based solely on proposed use. Accordingly, the length of time the marks have been in use favours the applicant.

The wares of the parties are related in that the opponents' cleansing cloths (and possibly its soap) and the applicant's shampoo are both used to clean parts of the human body. Nevertheless, such products might not be sold side-by-side. However, both the opponents' baby-lotion impregnated cleansing cloths for use on infants and the applicant's baby oil are for use on babies/infants and it seems fairly likely that such wares might be sold side-by-side.

Any similarity between the trade-marks in issue arises through the common use of SCOTT. While the first component of a mark is often considered more important for the purpose of distinction, when a word is a common word, it is entitled to a narrower range of protection than an invented or unique word [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. Moreover, when considering the degree of resemblance between two marks, one must consider the marks in their totalities.

Another surrounding circumstance to be considered is the state of the Register. The case law makes it clear that state of the Register evidence is only relevant to the extent that one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205].

Inferences about the state of the marketplace can only be drawn from state of the Register evidence where there are large numbers of relevant registrations [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992). 43 C.P.R. (3d) 349]. In the present case, I am not according the state of the Register evidence much weight as there are significant differences between most of the wares of the registered marks and the wares of the opponents and the applicant that are in issue.

The applicant has submitted in its written argument that Mr. Dilworth's state of the Register evidence is inadmissible as unreliable hearsay. I need not rule on this point because whether or not Mr. Dilworth's evidence is admissible, the registrations which he introduces would have been considered by me to the extent that they were relied on in the statement of opposition [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada LtJe v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

I find that there is no likelihood of confusion between any of the opponent's trade-marks and the applicant's trade-mark as applied to shampoos, bath oils, and talcum powder as of any of the material dates, primarily in view of both the weakness of each of the opponents' marks and the differences between the parties' wares. However, I do not believe that the applicant has met the onus on it to demonstrate that there is no reasonable likelihood of confusion between SCOTT baby-lotion impregnated cleansing cloths for use on infants and SCOTT'S YOUNG 'N FREE baby oil. These products are very closely related and would share the same channels of trade, potentially being sold side-by-side. I am therefore issuing a split decision, under the authority set out in *Produits MJnagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I reject the opponents' opposition with respect to the wares shampoos, bath oils, and talcum powder and refuse the application with respect to baby oils in view of the provisions of Subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 10th DAY OF MARCH, 1999.

**Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board**