

**IN THE MATTER OF AN OPPOSITION  
by Body Reform Canada Ltd. to application No.  
627,952 for the trade-mark THE BODY SHOP &  
Design filed by The Body Shop International Plc**

On March 21, 1989, the applicant, The Body Shop International Plc, filed an application to register the trade-mark THE BODY SHOP & Design (illustrated below) for the following wares:

(1) postcards,

(2) T-shirts and sweatshirts,

(3) deodorant, antiperspirant preparations, talcum powder, essential perfume oils, perfumes, perfume pencils, toilet water, hair care products, namely shampoo, hair cleanser, hair treatment wax, hair conditioner, rinse preparations, scalp oil, hair oil, hair lotion, hair styling preparations, hair colouring preparations, combs, non-medicated toilet preparations, cosmetics and skin care products, namely soaps, skin cleansing preparations, bath oil, bath salts, herbal bath mixes and bath additives, skin scrub mask preparations, clay mask preparations, skin cream lotions, moisturizing creams and lotions, hand creams and lotions, lip protective preparation, skin balm, foot balm, skin oil, depilatories, depilatory waxes, sun-tanning preparations, suntan creams, oils and lotions, beauty masks and facial packs, astringent preparations skin tonic preparations, massage preparations, massage lotion, shaving preparations, dentifrices, vegetable body scrubbers, sponges, emery boards, pumice stones, cotton sticks, cotton wool, toothbrushes, washcloths, toilet bags, razors, pre-packaged baskets containing a selection of cosmetics and skin care preparations, namely soaps, skin cleansing preparations, herbal bath mixes and bath additives, books, booklets and leaflets

and for the following services:

the operation of a retail store specializing in the sale of cosmetics, toilet preparations, essential perfume oils and products for the care of skin and hair.

The application is based on use in Canada since May, 1983 with the wares marked (1), use in Canada since June 13, 1986 with the wares marked (2) and on proposed use in Canada with the services and the wares marked (3). The application was advertised for opposition purposes on July 11, 1990.

**The opponent, Body Reform Canada Ltd., filed a statement of opposition on November 13, 1990, a copy of which was forwarded to the applicant on January 7, 1991. The opponent was subsequently granted leave pursuant to Rule 42 of the Trade-marks Regulations on August 14, 1992 to amend its statement of opposition. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Trade-marks Act because it is clearly descriptive of the character of the applied for wares and services. The second ground is that the application does not comply with the provisions of Section 30(b) of the Act because the applicant did not use the applied for mark since the dates claimed in the application.**

**The third ground of opposition is that the applied for trade-mark is not distinctive because it is clearly descriptive and because it has been used by third parties "...which have used [the trade-mark] with the permission of the applicant and without benefit of an approved registered user." The fourth ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the trade-mark BODY-BOUTIQUE registered under No. 182,703 in the name of Ben Weider for the following services:**

**a series of stores which would sell various products and apparatus related to physical fitness.**

**The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of John Harris. As its evidence, the applicant filed the affidavit of Betty-Ann Franssen. Only the applicant filed a written argument and no oral hearing was conducted.**

In her affidavit, Ms. Franssen identifies herself as the Vice-President of 94272 Canada Ltd. which she identifies as the applicant's main Canadian franchisee for its chain of retail stores operated under the trade-mark THE BODY SHOP. Exhibit A-2 to the Franssen affidavit is a copy of registration No. 288,081 for the applicant's trade-mark THE BODY SHOP which includes a large number of registered users. That copy was made on October 10, 1990 prior to the elimination of the registered user provisions from the Trade-marks Act. Exhibit D to the Franssen affidavit is a list of the addresses of the applicant's franchise locations in Canada. Ms. Franssen provides sales figures for THE BODY SHOP brand products in Canada for the years 1985 to 1990 totalling in excess of \$165 million.

In his affidavit, Mr. Harris identifies himself as an employee of the opponent's trade-mark agents. Appended to Mr. Harris' affidavit as Exhibits B through F are copies of name registrations filed with the Province of Ontario for several businesses that adopted the trading style The Body Shop or The Body Shoppe for such business activities as "weight loss", "aerobic studio" and "retail sale of clothing." Exhibit G to Mr. Harris' affidavit comprises copies of fifteen such registrations for the trading style The Body Shop for the sale of cosmetics and beauty products. A review of those fifteen registrations reveals that all but three of the registrants were also recorded as registered users of the applicant's registered mark THE BODY SHOP prior to the elimination of the registered user provisions of the Act.

As for the opponent's first ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). Furthermore, the issue is to be determined from the point of view of an everyday user of the wares and services. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

Without the benefit of a written argument from the opponent, it is difficult to know what position it wished to advance in respect of its first ground. From a review of the Harris affidavit, it appears that the opponent may have wanted to submit that numerous companies had used the words The Body Shop or The Body Shoppe in businesses that relate to the human body and that therefore those words comprise an apt phrase to describe such businesses. However, as noted above, almost all of the fifteen registrations included in Exhibit G to the Harris affidavit are franchisees of the applicant and licensees of its mark THE BODY SHOP. As for Exhibits B through F to the Harris affidavit, I am not prepared to infer from the existence of five business name registrations that any of the names has received more than token use. In any event, those five registrations cover businesses different from those of the applicant and would therefore not have been particularly relevant to the issue at hand, in any event.

The only other evidence of note provided by the Harris affidavit respecting the first ground is Exhibit A comprising definitions from The Compact Edition of the Oxford English Dictionary for the words "body" and "shop." A review of those definitions indicates that the trade-mark THE BODY SHOP when used with the applicant's wares and services might suggest that the applicant operates a retail store or shop that sells wares for the human body. A review of other dictionaries reveals, however, that the words "body shop" refer to a shop where automotive bodies are made or repaired. Thus, the trade-mark THE BODY SHOP might also be viewed as a clever 'double entendre' when used with cosmetics-related wares and services. In either case, however, those words do not clearly describe the character of such wares and services. It therefore follows that the applied for trade-mark THE BODY SHOP & Design is also not clearly descriptive and the first ground of opposition is unsuccessful.

As for the opponent's second ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting

its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89.

In its statement of opposition, the opponent alleges that insofar as the applicant claims to have used its trade-mark THE BODY SHOP & Design for wares, such use includes use by third parties who have used the mark with the applicant's permission and without the benefit of an approved registered user. Even if such an allegation is true, it would not now support a ground of non-compliance with Section 30(b) in view of the elimination of the registered user provisions from the Act. The second ground is therefore also unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 13, 1990): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Insofar as the third ground is based on an allegation that the applicant's trade-mark is clearly descriptive of the character of the applied for wares and services, it is unsuccessful in view of my conclusion respecting the first ground of opposition. As for the second aspect of the third ground, it is again difficult to know what position the opponent wishes to take in view of its failure to file a written argument. It would appear that the opponent's original position may have been that there has been licensed use of the applicant's applied for mark but outside the provisions of the registered user provisions. As discussed, such an argument is now moot in view of the elimination of those provisions from the Act. The third ground is therefore also unsuccessful.

As for the fourth ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

Although the opponent's mark is not clearly descriptive, it nevertheless is not an inherently strong mark. As noted at page 559 of the decision in Body Shop International PLC v. K Mart Canada Ltd. (1992), 46 C.P.R.(3d) 556 (T.M.O.B.), the opponent's trade-mark THE BODY SHOP possesses at least some measure of inherent distinctiveness. Since the applied for mark also contains some minor design matter, the applied for mark is inherently somewhat stronger than the word mark alone. Although the applicant has evidenced extensive use of the word mark THE BODY SHOP, it has not evidenced the extent to which the applied for design mark has been used. Thus, I must conclude that the applied for mark has not become known in Canada to any great extent.

The registered trade-mark BODY-BOUTIQUE also possesses some measure of inherent distinctiveness in relation to the registered wares although it, too, is not an inherently strong mark. There being no evidence of use of the registered mark, I must conclude that it has not become known at all in Canada.

In view of the absence of evidence of use of the registered mark, the length of time the marks have been in use is not a material circumstance in the present case. The applicant's wares and services are different from the opponent's. In the absence of evidence on point from the opponent, presumably the trades of the parties are also different.

**As for Section 6(5)(e) of the Act, the marks at issue bear some similarity in sounding and appearance. Insofar as both marks suggest a retail outlet dealing with goods for use with the human body, there is some resemblance in the ideas suggested by the marks. The applicant's mark, however, also suggests the operation of an automotive body repair shop which is an idea that bears no resemblance to that suggested by the registered mark BODY-BOUTIQUE.**

**It may be that the opponent also wished to rely on the Harris corporate search results as an additional surrounding circumstance in the present case. Again, without the benefit of a written argument from the opponent, it is difficult to know. In any event, as discussed, almost all of the name registrations included in Exhibit G to the Harris affidavit were effected by licensees of the applicant. As also discussed, the other name registrations located by Mr. Harris cover different businesses from the applicant and, in any event, are insufficient in number to allow me to infer that any are in active use.**

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of both marks, the absence of any use of the registered mark and the differences between the wares, services and trades of the parties, I find that the applicant has satisfied the onus on it to show that its applied for mark is not confusing with the registered mark BODY-BOUTIQUE. The fourth ground is therefore also unsuccessful.**

**In view of the above, I reject the opponent's opposition.**

**DATED AT HULL, QUEBEC, THIS 31<sup>ST</sup> DAY OF AUGUST 1994.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**