

**IN THE MATTER OF AN OPPOSITION
by Bliss World LLC to application
no. 1151208 for the trade-mark
BEAUTY & BLISS filed by
Menorah Management Investments Inc.**

On August 29, 2002, Menorah Management Investments Inc. filed an application to register the trade-mark BEAUTY & BLISS, based on proposed use in Canada, in association with

skin care products, namely, facial skin cream, body lotion, hand cream, fragrances, cosmetic products namely, lipstick, eyeshadow, nail enamel, blusher, face foundation, concealers, mascara, eyeliner, eye defining pencils, lip pencils, lip gloss, lip balm, shimmers

The application disclaims the right to the exclusive use of the word BEAUTY apart from the mark as a whole.

The subject application was advertised in the *Trade-marks Journal* issue dated December 31, 2003, and was opposed by Bliss World LLC on May 31, 2004. The Registrar forwarded a copy of the statement of opposition to the applicant, as required by Section 38(4) of the *Trade-marks Act*, on June 10, 2004. The applicant responded by filing and serving a counter statement.

The opponent's evidence consists of the affidavit of Elizabeth Corrigan, Vice President Supply Chain for the opponent company; and certified copies of Canadian trade-mark registrations for the marks BLISS, BLISSLABS and BLISSOUT standing in the name of the opponent. The marks BLISS and BLISSLABS cover a variety of cosmetic and personal care

products including shampoo, hair dyes, make-up remover, eye shadow, lipstick, deodorant and the like. The mark BLISSOUT covers the following services:

mail order catalogue services featuring cosmetics and beauty treatment products;
catalogue store services featuring jewelry, clothing, cosmetics, healthcare and spa products.

The opponent refers to its above mentioned marks BLISS, BLISSLABS and BLISSOUT as its “Bliss Marks” and I will do likewise.

The applicant elected not to file any evidence. Both parties submitted a written argument and both parties were represented at an oral hearing.

STATEMENT OF OPPOSITION

The first ground of opposition, pursuant to Section 12(1)(d) of the *Trade-marks Act*, alleges that the applied for mark BEAUTY & BLISS is not registrable because it is confusing with one or more of the opponent’s above mentioned registered marks.

The second, third and fourth grounds of opposition, pursuant to Section 16(3), allege that the applicant is not the person entitled to register the mark BEAUTY & BLISS because, at the filing date of application, the applied for mark was confusing with (i) the opponent’s above mentioned marks, and the opponent’s marks BLISS SPA and BLISSMILES, previously used and/or made known in Canada by the opponent (ii) the opponent’s trade-names BLISS WORLD, BLISS SPA, BLISSWORLD.COM and BLISS previously used and/or made known in Canada

(iii) the opponent's trade-mark application no.1015050 for the mark BLISS covering cosmetics and personal care products

The fifth ground alleges that the applied for mark is not distinctive of the applicant's wares in view of the opponent's prior use and/or making known of its above mentioned family of trade-marks and trade-names.

The last ground alleges non-compliance with Section 30(i) because the applicant could not have been satisfied that it was entitled to the use the mark BEAUTY & BLISS in view of the opponent's prior use and/or making known of its above mentioned family of trade-marks and trade-names.

OPPONENT'S EVIDENCE

Ms. Corrigan's affidavit evidence may be summarized as follows. The opponent is headquartered in New York City where it operates day spas and also manufactures, distributes and sells a variety of personal care and cosmetic products. The opponent owns trade-mark registrations for its Bliss Marks in more than fifty countries around the world including the U.S.A., the EU, Switzerland, Japan and Brazil. The Bliss Marks were first used in the U.S.A. in July 1996. The opponent owns and operates three day spas in New York City, one in London, England (operating since November 2001) and a fifth spa opening in San Francisco in July 2005. The opponent's wares and services are available for sale at the opponent's spas and the wares are also available for purchase from international retailers such as Bloomingdales, Harrod's, Neiman

Marcus and Saks. Bliss Marks products are advertised and offered for sale online at www.blissworld.com (launched August 1998) and by mail order catalogue (launched July 1996). The catalogue is entitled BLISSOUT and prominently features the opponent's Bliss Marks. The mark BLISSCERTIFICATES has been used since July 1996 in association with gift certificates which are redeemable for the opponent's products and services.

The opponent's Bliss Marks products have been sold into Canada since March 1997. From March 1997 until 2002, such sales were through the opponent's website and catalogue. Since 2003 the products have also been sold through retail outlets in Canada including Sephora, Holt Renfrew, and Lux Inc. Sales in Canada of the opponent's wares bearing the Bliss Marks have been in excess of \$100,000 annually for 2003 and 2004.

The opponent's wares and services sold under its Bliss Marks have been the subject of articles and have been advertised since at least as early as August 1998 in several publications circulating in Canada including Canadian Living, Town & Country, Elle, Family Circle, and Self.

MAIN ISSUE

The main issue in this proceeding is whether the applied for mark BEAUTY& BLISS is confusing with one or more of the opponent's Bliss Marks (i) at the material date which is the date of my decision with respect to the first ground of opposition, and (ii) at the material date which is the filing date of the subject application in respect of the second, third and fourth grounds of opposition.

Legal Onus and Test for Confusion

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark BEAUTY & BLISS and one or more of the opponent's marks BLISS, BLISSLABS, and BLISSOUT. The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

The test for confusion is one of first impression and imperfect recollection. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5) of the *Act* namely: 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; the degree of resemblance in appearance or the sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

Consideration of Section 6(5) Factors

The opponent's Bliss Marks possess relatively low degrees of inherent distinctiveness since the marks are somewhat laudatory or at least suggest that the opponent's wares and services will bring about a feeling of happiness and well being. Similarly, the applied for mark possesses a relatively low degree of inherent distinctiveness for the additional reason that the term BEAUTY is descriptive of the intended effects of the applicant's wares. At the material date which is the date of my decision, the opponent's Bliss Marks acquired some reputation in Canada mostly through sales of the opponent's wares through Canadian retailers beginning in 2003. However, I am also prepared to find that the opponent's marks acquired at least some reputation in Canada beginning in about 1997 through spill-over advertising via magazines emanating from the United States. There is no evidence that the applicant began to use its mark and therefore the applicant cannot claim any acquired distinctiveness for its mark BEAUTY & BLISS. The length of time that the parties' marks have been in use in Canada favours the opponent since Bliss Marks products have been sold into Canada since 1997.

The parties' wares are essentially the same consisting of cosmetics, perfumery and toiletries. The applicant argues at paragraph 27 of its written submission that "the Applicant intends to pitch the [applicant's] Wares to different customers in different settings with different channels of distribution." However, the applicant has not submitted any evidence to support its assertion and in the absence of such evidence, I must assume that the parties will target the same consumer group and would market their wares through the same or overlapping channels of trade.

The opponent's submissions with respect to the degree of resemblance between the parties' marks is found at page 11 of its written argument, shown below:

I am in substantial agreement with the opponent's above submissions.

At page 13 of its written argument the opponent cites as a relevant surrounding circumstance that it has used a series of marks in Canada most notably BLISS, BLISSLABS and BLISSOUT:

Again, I am in substantial agreement with the opponent's above submissions.

Conclusions

Having regard to the foregoing, I find that the applicant has not met the legal onus on it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark BEAUTY & BLISS and the opponent's Bliss Marks. The first ground of opposition is therefore successful.

The considerations with respect to part (i), above, of the grounds of opposition alleging that the applicant is not entitled to registration are essentially the same as those discussed in respect of registrability, except that the material date for the considerations is the date of filing of the application, that is, August 29, 2002. As alluded to earlier, the opponent cannot claim more than a minimal reputation for its mark prior to 2003, that is, before sales through Canadian retailers commenced. Consequently, the opponent cannot rely on the factor of acquired distinctiveness to support the issue of confusion. However, considering the other factors that still weigh in the opponent's favour, I find that the probability of a reasonable likelihood of confusion between the parties' marks is evenly balanced with the probability of no reasonable likelihood of confusion. As I am unable to reach a determinate conclusion, the issue of confusion must be decided against the applicant.

As I have found for the opponent in respect of the first and second grounds of opposition, it is not necessary to consider the remaining grounds. However, I likely would have ruled against the applicant on the remaining grounds on the basis that I was unable to reach a determinate

conclusion.

DISPOSITION

In view of the above, the subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 15th DAY OF JULY, 2008.

Myer Herzig,
Member,
Trade-marks Opposition Board