

**IN THE MATTER OF AN OPPOSITION
by Lise Watier Cosmétiques Inc. to
application No. 1178168 for the trade-mark
TEINT DE NEIGE filed by Lorenzo
Villoresi**

On May 15, 2003, Lorenzo Villoresi (the “Applicant”) filed an application for the registration of the trade-mark TEINT DE NEIGE (the “Mark”) based on use of the Mark in Canada since at least as early as May 2003 in association with the following wares: “eau de toilette, liquid perfumes, body lotion, bath foam, soap” (the “Claimed Used Wares”) and proposed use of the Mark in Canada in association with the following wares: “perfumed bath oils, body oils” (the “Proposed Use Wares”).

The application was advertised for opposition purposes in the Trade-marks Journal issue of February 18, 2004.

On July 19, 2004, Lise Watier Cosmétiques Inc. (the “Opponent”) filed a statement of opposition against the application. The grounds of opposition, as last amended on January 25, 2007, can be summarized as follows:

1. The application does not conform to the requirements of s. 30(b) or 30(e) of the *Trade-marks Act* (R.S.C. 1985, c. T-13, as amended) (the “Act”), in that, despite the fact that it was filed May 15, 2003, it does not specify the precise date from which the Applicant so used the Mark in association with the Claimed Used Wares. According to Section II.7.1.2 of the Trade-marks Examination Manual, applicants must provide the day, the month, and the year of first use of the mark when the use claim relates to the month in which the application was filed. When only the month and year are named, the last day of the month will be regarded as the effective date for the purpose of determining entitlement in cases of confusion. In the present case, the effective claimed date of first use of the Mark is May 31, 2003. Since the application was filed on May 15, 2003, the application should have been based on proposed use in Canada;

2. The Applicant has not used the Mark in association with the Claimed Used Wares since May 31, 2003 and the application is therefore contrary to s. 30(b) of the Act;
3. The Applicant has and had, at all material times, no intention to use the Mark in association with the Proposed Used Wares in Canada and the application is therefore contrary to s. 30(i) of the Act;
4. The Mark is not registrable because it is confusing with the trade-mark NEIGES registered by the Opponent on October 2, 1992 under No. TMA403,155 for use in association with the same goods and is, therefore, contrary to s. 12(1)(d) of the Act;
5. The Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(a) of the Act because the Mark is confusing with the Opponent's trade-mark NEIGES that had been previously used in Canada since at least as early as June 1992 in association with the same or similar goods; and
6. Contrary to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive because it does not actually distinguish the goods in association with which it is used or proposed to be used by the Applicant from the goods of the Opponent nor is it adapted so to distinguish them.

By counter statement dated December 17, 2004, the Applicant denied each and every one of the allegations made in the statement of opposition.

In support of its opposition, the Opponent filed the affidavit of Serge Rocheleau, President and Chief Executive Officer of the Opponent. In support of its application, the Applicant filed the affidavits of Aldo Da Rosa, the sole proprietor of Euroscents, an Ontario company which is the Canadian distributor for the Applicant, Gay Owens and Eileen Castellano (trade-mark searchers with the law firm representing the Opponent in this proceeding) as well as two affidavits of Sharon Ho (an articling student with the same law firm). As these two latter affidavits of Ms. Ho were sworn the very same date, I will refer to the affidavit attaching Exhibits "A" and "B" as the "first Ho affidavit" and the one attaching Exhibits "A", "B" and "C" as the "second Ho affidavit".

Each party filed a written argument and was represented at an oral hearing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Analysis

The first three grounds of opposition turn on the issue of use of the Mark, be it the date of first use of the Mark or the Applicant's intention to use the Mark having regard to the requirements of s. 30 of the Act. The last three grounds of opposition turn on the issue of the likelihood of confusion between the Mark and the Opponent's mark. I will address the issue of confusion first and the s. 30 grounds of opposition thereafter.

As I consider the s. 12(1)(d) ground of opposition to present the Opponent's strongest case and as in the circumstances of this case, it does not make any difference which material date is selected, I will assess the likelihood of confusion in the context of that ground. A determination of the issue of confusion under that ground will effectively decide the outcome of the s. 16(1)(a) and s. 2 grounds of opposition.

Issue of confusion – s. 12(1)(d) ground of opposition

The Opponent has provided through the Rocheleau affidavit, a printout from the Canadian Intellectual Property Office's trade-mark database pertaining to the Opponent's registered trade-mark NEIGES. I have exercised my discretion to review the register of trade-marks and confirm the details of this registration. As it is in good standing, the Opponent's initial burden with respect to this ground of opposition has been satisfied.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark.

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.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 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 the trade-marks have 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. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

Both of the parties' marks are inherently distinctive; they neither describe nor suggest the character or quality of their associated wares.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Opponent contends that the history of use set forth by Mr. Rocheleau's evidence leads to the conclusion that the mark NEIGES has a high degree of distinctiveness and has become well-known in Canada as opposed to the evidence of use of the Mark set out by the

Applicant, which only shows limited sales of the Claimed Used Wares. While I agree with the Opponent that its trade-mark NEIGES has deeper roots and has become known at least to some extent in Canada, I agree with the Applicant that the Opponent's evidence of use is deficient in many aspects and does not enable me to conclude that the mark NEIGES has become well-known in Canada. An overview of the Opponent's evidence will show why I say so.

Mr. Rocheleau first provides a brief history of the Opponent. He states that the beloved Québec television personality Lise Watier founded l'Institut Lise Watier in 1968, which became a destination for women seeking to achieve self-fulfillment. The constant search for the best quality products for her clientele led Lise Watier to launch her own line and in 1972, the Opponent was born. Today, the Opponent is located in a new 60,000 square foot head office in Montréal, Québec. Its European subsidiary in Paris coordinates the company's European sales and marketing efforts.

Mr. Rocheleau then goes over the sales of the "NEIGES Products" since 1992. He states that these products have enjoyed a strong presence in the Canadian cosmetic industry since 1992, when the NEIGES trade-mark was first used in Canada in association with perfume, eau de toilette, cologne, body lotion, personal care soaps, bath powder, deodorants, candles and potpourri (that is the precise wares covered by the Opponent's registration No. TMA403,155). He further states that the Opponent has also expanded the variety of products used in association with the NEIGES trade-mark to include bath and shower gel, body veil softening, milk bath, alcohol-free perfumed mist, powder snow, perfumed deodorant, perfumed body cream, effervescent bath pebbles, solid perfume, body mist, body gel, after-shave, relaxing gel for tired legs and cooling liquid talc. Mr. Rocheleau has attached to his affidavit as Exhibit "B", what he describes as representative examples of packaging in which NEIGES Products have been sold over the last 10 years.

Mr. Rocheleau states that the Opponent sells NEIGES Products throughout Canada. Its main customers are large national chains such as The Bay, Sears, and Shoppers Drug Mart. It also has smaller customers throughout Canada such as London Drugs, Uniprix, Pharmasave, Les Ailes de la Mode, etc. Select speciality perfume shops also sell NEIGES Products such as Enchanté

Perfumes & Cosmetics, Couture Parfums et Cosmétiques, and Maison Fragrance. Mr. Rocheleau further states that the Opponent also sells NEIGES Products internationally in North America, Europe, Asia, and the Middle-East through prestigious international chains.

Mr. Rocheleau then provides the total gross retail value of the Opponent's NEIGES Products sold in Canada, and exported internationally over the last five years, which have been in excess of 48 million Canadian dollars. However, as stressed by the Applicant, the figures provided relate to global sales only and are not specific to Canada such that the affidavit fails to establish precisely the extent of sales of NEIGES Products in Canada. In addition, it is unclear which of the NEIGES Products are represented in the figures provided, and to what extent. The majority of the evidence presented in Mr. Rocheleau affidavit relates to the collective group of NEIGES Products, without further specificity and supporting evidence of use.

Similar deficiencies characterize Mr. Rocheleau's evidence of advertising and promotion of the NEIGES trade-mark.

Mr. Rocheleau states that tens of thousands of samples of NEIGES Products are regularly given to consumers annually to promote product awareness and loyalty. He further states that the Opponent also advertises the NEIGES Products every month at the retail level, using in-store flyers for its main retailers such as The Bay and Sears, Shoppers Drug Mart, Pharmaprix, Jean Coutu, Uniprix and London Drugs. Mr. Rocheleau has attached to his affidavit as Exhibits "C" and "D", copies of what he describes as representative examples of advertisements placed in Canadian magazines and in-store flyers used over the last ten years. As stressed by the Applicant, there is no indication of when these particular materials were distributed in Canada aside from the bald assertion that they are representative of those appearing over the last ten years.

Mr. Rocheleau further states that the Opponent advertises in major Canadian cities such as Montréal, Toronto and Vancouver by way of advertisements placed on billboards throughout these cities. Again, this statement of Mr. Rocheleau is not substantiated by evidence. He also states that the Opponent's website www.lisewatier.com, which features NEIGES Products, as per

the excerpts attached to his affidavit, attracts 187,000 individual visits annually. As stressed by the Applicant, there is no indication of how many of these visitors are from Canada or how many of these even note the existence of the trade-mark NEIGES. He also states that 50,000 customers receive quarterly e-mail newsletters. Again, there is no indication of how many of these customers are from Canada.

As for the sales figures discussed above, the advertising and promotion expenditures provided by Mr. Rocheleau for the years 2000 to 2005, which have been in excess of 4 million Canadian dollars, refer to the total value of these expenditures only and are not specific to Canada. There is also no indication of the amount spent on marketing and promoting the NEIGES trade-mark and NEIGES Products in particular.

The Opponent contends that a fair reading of both the Opponent and the Applicant's evidence in the record leads to the inference that a fair amount of these significant sales and advertising and promotion expenditures occurred in Canada. The Opponent contends that the Applicant itself has acknowledged the fact that the Rocheleau affidavit attests to significant sales and marketing/promotional figures globally in paragraph 67 of its written argument and that the second affidavit of Sharon Ho points to the fact that there are over 350 locations in Canada where the Opponent's products are sold. The Applicant argues that the listing of outlets attached to this second affidavit of Ms. Ho is not specific to the NEIGES Products as it is taken from the Opponent's website that pertains to the Opponent's products globally. While it is true that the said listing is not specific to the NEIGES Products, the fact is that the names of the chains of outlets and speciality perfume shops identified in the said listing (e.g. The Bay, Sears, Shoppers Drug Mart, Couture Parfums & Cosmetics, Enchanté Perfumes & Cosmetics, etc.) match the ones mentioned above by Mr. Rocheleau. I also note that the second Ho affidavit attaches printouts from the websites of the Enchanté Perfumes & Cosmetics and Couture Parfums & Cosmetics outlets that expressly offer for sale the Opponent's NEIGES perfume, eau de toilette, deodorant, and body cream and corroborate Mr. Rocheleau's statements of use. I further note that on one of the excerpts taken from the Opponent's website www.lisewatier.com attached to Mr. Rocheleau's affidavit, the NEIGES perfume or eau de toilette is described as follows: "A national favorite in Canada, Neiges has been Québec's *best selling fragrance every year since*"

(my emphasis). I find surprising that the Opponent elected not to file evidence to substantiate that point. As indicated above, many of Mr. Rocheleau's statements lack specificity or are not corroborated by probative evidence. That said, I would not go as far as concluding like the Applicant that the Rocheleau affidavit is of limited significance and ought not to be afforded much weight. I am prepared to accept that a fair reading of the evidence in the record enables me to conclude that the NEIGES trade-mark has become known at least to some extent in Canada.

Turning to the Applicant's evidence of use of the Mark, Mr. Da Ros states in his affidavit that Euroscents has been the Canadian distributor for the Applicant since the fall of 2003. To this effect, Mr. Da Ros has attached to his affidavit a sample invoice dated September 18, 2003 showing the sale of TEINT DE NEIGE eau de toilette and perfume from the Applicant to Euroscents for distribution in Canada.

Mr. Da Ros states that Euroscents has sold TEINT DE NEIGE eau de toilette and perfume exclusively to niche retailers selling upscale fragrances and cosmetics. These niche retailers are Mirella Parfums & Cosmetics and Putti Profumeria, both located in Toronto, Edward Carriere Spa in Winnipeg, Carmela Profumeria in Edmonton and The Perfume Shoppe in Vancouver. Mr. Da Ros has attached to his affidavit a few sample invoices for the sale of TEINT DE NEIGE eau de toilette and perfume to these retailers dated between October 22, 2003 and December 12, 2005. I note that the first Ho affidavit further evidences the sale of TEINT DE NEIGE eau de toilette by Mirella Parfums & Cosmetics as it includes as Exhibits "A" and "B", a copy of a digital photograph of a 100 ml bottle of TEINT DE NEIGE eau de toilette purchased on March 7, 2006 by Ms. Ho, together with a copy of the invoice for that purchase.

I agree with the Opponent that the Applicant's evidence of use only shows limited sales of the Applicant's eau de toilette and perfume. It is also totally silent as to the remaining wares identified above as the Claimed Used Wares, namely the wares "body lotion, bath foam and soap", and the Proposed Use Wares. In the absence of any conclusive information concerning the volume or value of the Applicant's sales, I can assume no more than a minimal reputation for the Mark.

To conclude, the overall consideration of this first factor favours the Opponent.

(b) the length of time the trade-marks have been in use

The Opponent's NEIGES trade-mark registration shows that a declaration of use of the mark was filed with the Canadian Trade-marks Office on June 11, 1992. As for the Mark, the application claims use of the Mark since at least as early as May 2003 in association with the Claimed Used Wares and proposed use of the Mark in Canada in association with the Proposed Use Wares.

In the absence of supporting evidence of use, the date of first use claimed in the Opponent's registration can establish no more than "de minimis" use and cannot give rise to an inference of significant or continuing use of the mark.

While the Opponent has failed to provide direct evidence of use going back to 1992, the evidence in the record nonetheless establishes that the trade-mark NEIGES has been used for a longer period of time than has the Mark. The overall consideration of this second factor thus favours the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the type of wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)].

As stressed by the Opponent, the parties' trade-marks are for use in association with identical or closely overlapping wares such as perfumes, eau de toilette, and related toiletries. The Applicant contends for its part that while there is some overlap between the parties' wares, the likelihood of confusion is reduced where the wares in question are expensive and are sold in dissimilar establishments.

More particularly, the Opponent contends that Exhibits “A” and “B” to the first Ho affidavit show that a bottle of 100 ml of TEINT DE NEIGE eau de toilette costs \$140.00. By contrast, it is apparent from Exhibit “D” to the Rocheleau affidavit that a bottle of NEIGES eau de toilette retails for far less. The Opponent contends that the TEINT DE NEIGE products are sold in high end speciality perfumes boutiques in Ontario, Manitoba, Alberta, and British Columbia while NEIGES products are predominantly sold in drugstores and chains of outlets as evidenced by the second Ho affidavit.

While not without merit, the Opponent’s contentions do not convince me in the present case.

Ms. Ho filed two affidavits. Her first affidavit pertains to her purchase of a 100 ml bottle of TEINT DE NEIGE eau de toilette on March 7, 2006. Her second affidavit pertains to computer searches conducted on the websites www.lisewatier.com, www.coutureparfum.ca and www.enchanteperfumes.com. As stressed by the Opponent, Ms. Ho is silent as to why she printed the pages she chose, what searches she conducted to choose the pages, what the goal in searching these pages was, and what the purpose of the affidavit is. Regardless, Ms. Ho’s evidence shows that the channels of trade for perfumes can overlap.

As evidenced by the web pages extracted from the Enchanté Perfume website attached as Exhibit “C” to the second Ho affidavit, Enchanté Perfumes offers for sale a wide variety of fragrances under numerous brands and prices, including “top ten fragrances” and “rare fragrances”. For example, a 100 ml bottle of NEIGES eau de toilette details at \$69.00, whereas 100 ml bottles of TABU and TRUSSARDI eau de toilette detail at \$40.00 and \$119.00 respectively. The same comment applies to the Couture Parfums website as per the web pages attached as Exhibit “B” to the second Ho affidavit wherein Couture Parfums describes itself as Canada’s largest independent perfumery retailer specializing in the sale of “today’s most popular fragrances as well as the classics and hard-to-find fragrances”. While the Applicant has not provided much evidence as to the nature of its channels of trade, I agree with the Opponent’s contention that it is fair to assume that the Applicant could expand the sale and distribution of the TEINT DE NEIGE products beyond the five alleged niche retailers mentioned above. There is nothing to restrict the

parties from potentially selling in the same location at some point in the future, as exemplified by the Enchanté Perfumes' excerpts which include both expensive and rare fragrances on the one hand and relatively modest price fragrances on the other.

The overall consideration of these third and fourth factors thus favours the Opponent.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

As discussed above, the test for confusion is a matter of first impression. As stated by Mr. Justice Deneault in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (Fed. T.D.), at 369, the trade-marks should be looked at in their totality and assessed for their effect on the average consumer as a whole:

“The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole”.

The Mark is made up of the French expression “TEINT DE NEIGE”, which suggests the idea of skin as white as snow. The Opponent's mark is made up of the French dictionary word “NEIGE” in the plural form - that is “NEIGES”, which may suggest the idea of freshly fallen snow or the magic of winter.

While the Mark is preceded by the words “TEINT” and “DE”, which serve to distinguish it to some extent from the Opponent's mark visually, phonetically and conceptually, the Opponent's mark is reprised in almost its entirety into the Mark. The common element between the parties' marks, namely the word “NEIGE”, further dominates the marks in issue as the words “TEINT” and “DE” directly refer to the word “NEIGE”.

That is, I find that the parties' marks in their entireties resemble each other as much as they differ from each other. This brings me to consider the additional surrounding circumstances put forward by the Applicant in this case.

Additional surrounding circumstances

State of the register

The Applicant has filed through the Owens and Castellano affidavits, the results of computer-assisted state of the register searches that were conducted to locate active trade-mark registrations and applications that include the word "NEIGE" or its English translation "SNOW" for wares relating to personal care products, including perfume, body lotions and bath products.

These searches revealed the following:

- BLANC NEIGE (reg. No. TMA553,581) in association with [TRANSLATION]"Make-up products namely compressed powders";
- ILLUNEIGE (reg. No. TMA632,825) in association with "Soaps, (...) perfume, eau de cologne, eau de parfum, eau de toilette", etc.;
- IVORY NEIGE (reg. Nos. TMA125,294 and TMA382,729) in association with "Soaps" and "Sudsing cleaners, cleansers and detergents";
- LA NEIGE AMORE & Design (reg. No. TMA655,755) in association with "Cosmetic creams for the face, (...) lotions for cosmetic purposes, essential oils for cosmetic purposes", etc.;
- HAZELINE SNOW (reg. No. TMA426,910) in association with "Toilet preparations, namely beauty creams, face creams", etc.;
- IVORY SNOW (reg. Nos. UCA01938 and UCA50700) in association with "Soap"; and
- SNOW CLOSE TO HOME (reg. No. TMA444,519) in association with "Products used in personal care and hygiene, namely tanning oils, soaps, and toothbrushes", etc.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and 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 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

In the present case, there are only nine registrations in the name of six different owners that may, arguably, be considered pertinent. Given the limited numbers, and let alone the fact that the Applicant had to expand the scope of its searches so as to include the English translation of the word “NEIGE”, I am reluctant to make any significant inferences about the state of the marketplace. It may be that a couple of these third party marks are in active use. However, in the absence of evidence of actual use of such marks in the marketplace, it is difficult to infer that the element “NEIGE” is commonly used in the parties’ field.

Association with the name “Lise Watier”

The Applicant contends that use by the Opponent of its trade-mark NEIGES in conjunction with, and in close proximity to, the name “Lise Watier”, serves to further distinguish the Opponent’s trade-mark from the Mark. I disagree with the Applicant’s approach. Such approach would be suitable in a passing off action, but not when considering a s. 12(1)(d) ground of opposition. As stated by Board Member Herzig in *Corby Distilleries Ltd. v. Wellington County Brewery Ltd.* (1993) 52 C.P.R. (3d) 429: “It is the effect of the trade-marks, and not of the bottles or labels, that must be considered...Neither the bottle nor the label is part of the trade-mark.”

Coexistence of the marks in the marketplace

The Applicant, relying on one of the statements made by Mr. Da Ros in his affidavit, according to whom none of his customers have expressed confusion between the TEINT DE NEIGE products of the Applicant and the NEIGES products of the Opponent, contends that the coexistence of the parties’ trade-marks in the marketplace without evidence of actual confusion

is another relevant circumstance. However, the absence of actual confusion is not surprising given that the Applicant's products have been restricted so far to only five speciality perfumes boutiques that do not sell the Opponent's products. Thus, I am not prepared to draw from such coexistence a significant negative inference as to the likelihood of confusion between the marks in issue.

Conclusion re: likelihood of confusion

As indicated above, the Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. The presence of an onus 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.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. While most of the factors considered above do favour the Opponent, the weight to be attributed to these factors varies. In view of my conclusions above, I find that the balance of probabilities is evenly balanced between finding that (i) there is no reasonable likelihood of confusion as to the source of the parties' wares particularly in view of the differences existing between the marks in issue and (ii) there is a reasonable likelihood of confusion as to the source of the parties' wares particularly in view of the overlap existing between the parties' wares and channels of trade and the fact that both marks, despite their differences, are made up of the dominant element NEIGE. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' wares in the consumer's mind, I must find against the Applicant.

As indicated above, my conclusions concerning the s. 12(1)(d) ground of opposition are equally applicable to the s. 16(1)(a) and s. 2 grounds of opposition that also turn on the issue of the likelihood of confusion between the Mark and the Opponent's mark. Given the evidence in the record, I am satisfied that the Opponent has also discharged the initial burden upon it with respect to these two other grounds of opposition. Accordingly, the s. 16(1)(a) and s. 2 grounds of opposition succeed.

Section 30 grounds of opposition

As indicated above, the Opponent contends that the application does not comply with the requirements of s. 30(b) of the Act, as the Applicant has not used the Mark in Canada in association with the Claimed Used Wares since the claimed date of first use of the Mark, that is “since at least as early as May 2003”.

The relevant date for considering the circumstances in regard to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. The Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its application [see *Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. The Opponent's evidential burden is lighter respecting the issue of non-conformance with s. 30(b) of the Act, because such facts are more readily available to the Applicant than to the Opponent [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)].

As per my review above of the evidence in the record, the Applicant's only evidence of use of the Mark consists in the Da Ros affidavit according to which Euroscents has been the Canadian distributor for the Applicant since the fall of 2003 and has, since that time, imported and distributed TEINT DE NEIGE eau de toilette and perfume, and the second Ho affidavit evidencing the purchase of a 100 ml bottle of TEINT DE NEIGE eau de toilette on March 7, 2006.

While the Da Ros affidavit is not necessarily inconsistent with the fact that the Applicant, by itself and/or through a licensee or other distributor, may have commenced use of the Mark in Canada in association with the Claimed Used Wares since the claimed date of first use, I find that the Applicant's own evidence of use of the Mark raises more questions than it provides evidence of continuous use of the Mark in the normal course of trade to the date of filing of the application. It is tenuous and vague in that it is totally silent as to the use of the Mark that

occurred between the claimed date of first use of May 2003 and the appointment of Euroscents as distributor for the Applicant in the fall of 2003. It is also totally silent as to the Claimed Used Wares “body lotion”, “bath foam” and “soap”.

In view of all of the foregoing, the Opponent has satisfied the evidential burden on it to establish that the application does not conform to s. 30(b) of the Act. The Applicant having failed to establish on the balance of probabilities that its application complies with s. 30(b) of the Act, the s. 30(b) ground of opposition therefore succeeds.

However, the evidence in the record is not inconsistent with the Applicant’s intention to use the Mark in association with the Proposed Used Wares in Canada. Accordingly, the Opponent has not satisfied the evidential burden on it to establish the third ground of opposition identified above, which ground would, in any event, have been more properly pleaded under a ground of opposition based on non-conformance with s. 30(e) of the Act rather than s. 30(i).

As I have already found in favour of the Opponent under more than one ground, it is not necessary for me to address the remaining ground of opposition, namely the one identified above as the first ground of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT Montréal, Québec, THIS 4th DAY OF May 2009.

Annie Robitaille
Member
Trade-marks Opposition Board