**TRADUCTION/TRANSLATION**

**IN THE MATTER OF THE OPPOSITION by
First Choice Haircutters Ltd. to application
No. 791486 for the registration of the trade-mark
PREMIER CHOIX and design, property of Félix Bouchard.**

On August 30, 1995, Félix Bouchard ("the Applicant") filed an application for the registration of the trade-mark PREMIER CHOIX and design ("the Trade-Mark") as illustrated hereunder:


The Applicant's application for registration was based on the use of the Trade-Mark in association with certain wares and services since September 1994 and on the proposed use of other wares and services. It was published in the October 30, 1996, issue of the *Trade-marks Journal*.

First Choice Haircutters Ltd. ("the Opponent") filed its statement of opposition on April 1, 1997. The grounds of opposition can be summarized as follows:

(a) the application for registration does not comply with paragraph 30(*b*) of the *Trade-marks Act* (the Act) because the Applicant has never used, or since September 1994, the Trade-Mark in association with the wares described in the application as "brochures, booklets of bonus coupons, gift certificates, coupons, discount coupons for advertising purposes."

(b) the application for registration does not comply with paragraph 30(*e*) of the Act because the Applicant's statement, to the effect that he intends to use the Trade-Mark in association with each of the wares

listed under item (2) of the WARES heading of the application for registration and each of the services described under item (2) of the SERVICES hearing of the application for registration, is false.

(c) The Trade-Mark is not registrable because it is confusing with the following trade-marks, thereby contravening paragraph 12(1)(*d*) of the Act:

| TRADE-MARK | REGISTRATION NO. |
|---|---|
| PREMIER CHOIX | 352,064 |
| PREMIER CHOIX and design | 352,072 |
| Premier Choix | |
| FIRST CHOICE HAIRCUTTERS | 319,476 |
| FIRST CHOICE HAIRCUTTERS and design | 307,348 |
| First Choice Hair Cutters | |

(d) The Applicant is not a person entitled to the registration of the Trade-Mark under paragraphs 16(1)(*a*) and (*c*) of the Act, for if the Applicant did use the Trade-Mark, then on the date of first use of the Trade-Mark in Canada, it was confusing with the trade-marks PREMIER CHOIX, PREMIER CHOIX and design, FIRST CHOICE HAIRCUTTERS, FIRST CHOICE HAIRCUTTERS and design, and FIRST CHOICE HAIRCUTTERS and Splash design, and with the trade-names FIRST CHOICE HAIRCUTTERS and PREMIER CHOIX, which the Opponent previously used and continues to use in association with the [TRANSLATION] operation of hair salons, franchising of hair salons; hair care products such as shampoo, hair lotion, hair colours, combs and brushes; educational, promotional,

audio and video materials in relation to such wares and services and related to hair cutting; and materials used in promoting all of those wares and services (" the Opponent's wares and services).

(e) The Applicant is not a person entitled to the registration of the Trade-Mark under paragraphs 16(3)(*a*) and (*c*) of the Act, because the Trade-Mark, on the filing date of the application for registration, was confusing with the trade-marks PREMIER CHOIX, PREMIER CHOIX and design, FIRST CHOICE HAIRCUTTERS, FIRST CHOICE HAIRCUTTERS and design, and FIRST CHOICE HAIRCUTTERS and Splash design, and the trade-names FIRST CHOICE HAIRCUTTERS and PREMIER CHOIX, which the Opponent previously used and continues to use in Canada in association with the Opponent's wares and services.

(f) The Trade-Mark is not distinctive because it does not actually distinguish, nor is it adapted so as to distinguish, the wares and services in association with which the Applicant claims to have used them or intends to use them, from the wares and services of others, and in particular, the Trade-Mark is not distinctive because of the Opponent's continuous use of the trade-marks listed in (c), (d) and (e) above.

(g) The Trade-Mark does not comply with paragraph 30(*i*) of the Act because, for the reasons set out in paragraphs (c), (d) and (e) above, the Applicant could not be satisfied, on the filing date of his application for registration, that he was entitled to use the trade-mark in Canada in association with the wares or services described in the application, nor can the Applicant now be satisfied that he is entitled to do so, since the Applicant had knowledge of the Opponent's used

> of the trade-marks and trade-names set out in those paragraphs when he filed his application.

On May 14, 1997, the Applicant submitted a counter-statement essentially denying the Opponent's grounds of opposition.

The Opponent tendered in evidence the affidavit of John Wissent dated December 15, 1997, and certified copies of registrations Nos. 352064, 352072, 319476 and 307348. The Applicant tendered the affidavit of Raymond Gorsky.

On June 17, 1999, the Applicant filed an amended application for registration, from which the list of wares and services is reproduced in the appendix.

None of the parties filed written arguments. Only the Opponent was represented at the hearing.

Mr. Wissent has been Vice-President and legal counsel of the Opponent since September 1996 and an employee of the Opponent since January 1989. The Opponent was incorporated on July 15, 1980, as Superclips Ltd., and changed its business name to First Choice Haircutters Ltd. on November 23, 1983. It does business as First Choice Haircutters in Canada and as Premier Choix in Quebec, and its field is the franchising and operation of hair salons. In 1980, it operated two locations by itself or through its franchisees; by October 1997, that figure had increased to 257 locations in Canada and the United States, 210 of which were in Canada, specifically British Columbia, Alberta, Ontario, Quebec, New Brunswick, Nova Scotia, Prince Edward Island and Newfoundland.

The affiant goes on to explain that the First Choice Haircutters names and the FIRST CHOICE HAIRCUTTERS and FIRST CHOICE HAIRCUTTERS and design trade-marks ("the FIRST CHOICE name and marks") have been abundantly used and given considerable media exposure by the Opponent throughout English-speaking

Canada, as have the name Premier Choix and the trade-marks PREMIER CHOIX and PREMIER CHOIX and design ("the PREMIER CHOIX name and marks") in Quebec. When the use was through franchisees, the Opponent controlled the character and quality of the services provided in association with the FIRST CHOICE and PREMIER CHOIX names and marks. These control mechanisms were set out in the franchise agreements and the trade-mark licences with licensees. Notices placed in consumers' view, inside the locations, clearly stated that the franchisees were using the marks in accordance with the terms and conditions of a licence agreement.

Since 1993, the annual sales of the Opponent and its franchisees from the operation of these businesses have exceeded $40 million. Unfortunately, the Opponent did not indicate how much of this is attributable to operations in Canada. The Opponent estimates that since 1993, more than $1,900,000 has been spent annually to promote its operations and those of its franchisees. The Opponent estimates that more than 3,500,000 consumers have benefited from its services each year since 1993. Here as well, the Opponent has not indicated the proportion of these customers that is attributable to its operations in Canada. However, it should be noted that most of its locations are in Canada.

Exhibit C to Mr. Wissent's affidavit consists of photographs of indoor and outdoor signs bearing the PREMIER CHOIX name and marks. In 1993, the Opponent operated 12 such establishments in Quebec by itself or through its franchisees. On December 15, 1997, the Opponent was still using PREMIER CHOIX name and mark through a franchisee located in Gatineau.

Mr. Wissent alleges that the Opponent has used and continues to use the PREMIER CHOIX and FIRST CHOICE names and marks in Canada in association with the following wares and services:

[TRANSLATION]

> operation of hair salons, franchising of hair salons; hair care products such as shampoo, hair lotion, hair colours, combs and brushes; educational, promotional, audio and video materials in relation to such wares and services and related to hair cutting; and materials used in promoting all of those wares and services.

He produced in a bundle, as Exhibit D, samples of business cards, discount coupons, response cards, envelopes, stationery, business hours signs, stickers, balloons and buttons bearing the PREMIER CHOIX and FIRST CHOICE trade-marks.

Exhibit E to his affidavit consists of sample documents bearing the trade-mark FIRST CHOICE. These include pamphlets to promote the franchising of the Opponent's commercial activities, a learning manual for franchisees, a business diagram and a franchise application form.

Photos of shampoo bottles bearing the trade-marks PREMIER CHOIX and design, and FIRST CHOICE and design, were produced as Exhibit F to his affidavit. Lastly, Mr. Wissent produced, as Exhibit G to his affidavit, the cover page of the instruction manual for franchisees and a copy of a certificate attesting that the holder has taken a course of instruction on haircutting, all bearing the trade-mark FIRST CHOICE and Splash design.

Raymond Gorsky states that he has a business relationship with the Applicant. He consulted LE PETIT ROBERT dictionary of the French language at the Laval municipal library and produced the relevant excerpts, namely the definitions of the words PREMIER and CHOIX. He alleges that the words are in the public domain.

He argues that the trade-mark PREMIER CHOIX, registration certificate No. 352064, is not registrable under the Act because it is descriptive of the quality of the wares and services described therein. I can immediately dispose of this argument. The Registrar does not have the jurisdiction to determine the validity of a registered trade-mark [see ***Bacardi & Company Limited v. Havana Club S.A., T-1181-01***]. Lastly, he argues

that the wares and services associated with the Trade-Mark are different from those associated with the Opponent's trade-mark.

The relevant dates for assessing the different grounds of opposition vary depending on the specific ground alleged. For the grounds based on section 30 of the Act, the relevant date is the filing date of the application (August 30, 1995) [see ***Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co. (1999), 1 C.P.R. (4th) 263***]. For the ground of opposition based on paragraph 12(1)(*d*) of the Act, the material date is the date of my decision [*see* ***Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)***]. When the ground of opposition is based on subsection 16(3) of the Act, the date on which the application for registration was filed (August 30, 1995) is the reference date stipulated in that provision. If the ground of opposition is based on subsection 16(1) of the Act, that provision stipulates that the date of first use of the Trade-Mark (September 1994) is the reference date. Lastly, it is generally recognized that the filing date of the opposition (April 1, 1997) is the relevant date for assessing a ground of opposition alleging the lack of distinctiveness of a Trade-Mark [see ***Andres Wines Ltd. and E&J Gallo Winery (1975), 25 C.P.R. (2d) 126 (F.C.A.)*** at 130 and ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., supra***].

In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning his grounds of opposition to clearly show there are facts supporting those grounds. If this is accomplished, the burden of proof shifts to the Applicant, who must satisfy the Registrar that the grounds of opposition should not prevent his trade-mark from being registered [see ***Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982), 61 C.P.R. (2d) 53, Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325*** and ***John Labatt Ltd. v. Molson Companies Limited (1990), 30 C.P.R. (3d) 293***].

Based on the evidence summarized above, it appears that the Opponent has not discharged its initial burden of proof regarding grounds of opposition (a), (b) and (g) set out above. Those grounds are therefore dismissed.

The question whether the Trade-Mark is confusing with the Opponent's trade-marks or business name is the key element of the other grounds of opposition before me (grounds (c) through (f) and ground (h), described above). To determine whether the use of the Trade-Mark is likely to create confusion with the Opponent's trade-marks, I must follow the steps prescribed by section 6 of the Act, which provides:

> **6.** (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.
>
> (2) The 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.
>
> (3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.
>
> (4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.
>
> (5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including
>
> (*a*) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
>
> (*b*) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

The list of circumstances in section 6(5) of the Act is not exhaustive, and it is not necessary to give each criterion equal weight [see for example ***Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R. (3d) 483 (F.C.T.D.)*** and ***Gainers Inc. v. Marchildon (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)***]. The Honourable Mr. Justice Cattanach described the confusion test as follows in ***Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975), 25 C.P.R. (2d) 1:***

> To determine whether two trade marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.
>
> In considering the similarity of trade marks it has been held repeatedly that it is not the proper approach to set the marks side by side and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression. I therefore propose to examine the two marks here in dispute not for the purpose of determining similarities and differences but rather to assess the attitude of the average reasonable purchaser of the wares as a matter of first impression.

(a) The distinctiveness of the trade-marks and trade-names and extent to which they have been made known

The Trade-Mark is at least suggestive of the wares and services listed, since it suggests that they would be the consumer's first choice. This makes the trade-mark very weak [see ***Les Vins Brights Ltée v. Maximum Nutrition Ltd. (1985), 3 C.P.R. (3d) 367***]. The same observation applies to the aforementioned trade-marks of the Opponent.

However, the Opponent has shown that the trade-marks PREMIER CHOIX and FIRST CHOICE have been used in Canada since at least as early as 1993, and thus, I can conclude from the evidence in the record that they are known in Canada in association with the operation of hair salons by itself or its franchisees, and with the sale of hair products. The Applicant has not proven the use of the Trade-Mark in association with the wares or services listed above. This factor therefore favours the Opponent.

(b) The period during which the trade-marks or trade-names have been in use

The Applicant has produced no evidence of the use of the Trade-Mark that meet the criteria in section 4 of the Act. In addition, the Opponent has proven the use of its trade-name and trade-marks since at least as early as 1993. This situation favours the Opponent.

(c) The nature of the wares, services or businesses

There is an overlap between the following wares and services listed in the Applicant's application for registration ―

> Publications, namely: brochures, pamphlets, guides, folders, circulars, catalogues, envelopes, printed and/or non-printed advertising envelopes, communiqués, newsletters, booklets of bonus coupons, gift certificates, coupons, discount coupons for advertising purposes. Publications, namely: magazines, newspapers, journals, brochures, images, books, pamphlets, manuals, guides, folders, communiqués, newsletters, gift coupon booklets, gift certificates, discount coupons for advertising purposes, instruction manuals, software used as a means of communication among franchisees, franchisers, merchants, contractors, self-employed persons; courses,

> seminars and conferences on audio and video cassettes, software packages and software; toiletries: namely, aftershave, eau de cologne, cream rinse, cream, hair colouring, hair styling products, namely: hair spray, hair lotion, shampoo, cream rinse, hair brushes, combs, pre-shave lotion, shaving cream, manicure tools; services related to establishing and brokering franchise operations, directing market studies for locating franchises, negotiating leases for franchised businesses, design, construction, fitting out, decoration of retail outlets; consulting service relating to franchises; negotiation and preparation of franchises and related agreements; training service relating to the operation of franchised businesses through conferences, seminars, courses and workshops; maintenance and supervision of franchises and support services relating to the operation of franchised businesses ("the related wares and services")

— and the Opponent's wares and services. For the related wares and services, this situation once again militates in the Opponent's favour.

(d) The nature of the trade

The record contains no evidence tendered by the Applicant regarding the nature of its business or commercial activities. It is difficult, if not impossible, to speculate on this subject by reason of the great variety of wares and services listed in his application for registration. The long list of wares and services in that application contains no restrictions as to the nature of the trade, and we can therefore presume that it covers all types of trades that could offer the related wares and services [see ***William H. Kaufman Inc. v. North American Design Workshop Inc. (1995), 61 C.P.R. (3d) 259***]. One must presume that there is an overlap between the parties' commercial activities, and this favours the Opponent.

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

The sound and ideas suggested by the Trade-Mark are identical to those of the Opponent's PREMIER CHOIX name and marks. The idea suggested by the Opponent's

FIRST CHOICE name and marks is also identical to the one suggested by the Trade-Mark.

In light of this analysis, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the Trade-Mark is unlikely to create confusion with the PREMIER CHOIX and PREMIER CHOIX and design trade-marks and trade-names, in the mind of a consumer with an imperfect recollection, when used in association with the related wares and services.

Given my findings regarding the likelihood of confusion between the Trade-Mark and the PREMIER CHOIX name and marks when used in association with the related wares and services, I must conclude that the Trade-Mark is not distinctive within the meaning of section 2 of the Act because it is not adapted to distinguish the related wares and services from the Opponent's wares and services.

Thus, the grounds of opposition set out in paragraphs (c), (d), (e) and (f), in relation to the trade-name PREMIER CHOIX and the trade-marks PREMIER CHOIX and PREMIER CHOIX and design (registration certificates 352064 and 352072) are allowed in part and, by reason of the powers delegated to me by the Registrar of Trade-Marks under subsection 63(3) of the Act and the principles enunciated in ***Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH, 10 C.P.R. (3d) 482***, I refuse the Applicant's application for registration in relation to the following wares and services:

> Publications, namely: brochures, pamphlets, guides, folders, circulars, catalogues, envelopes, printed and/or non-printed advertising envelopes, communiqués, newsletters, booklets of bonus coupons, gift certificates, coupons, discount coupons for advertising purposes. Publications, namely: magazines, newspapers, journals, comics, brochures, images, books, pamphlets, manuals, guides, folders, communiqués, newsletters, gift coupon booklets, gift certificates, discount coupons for advertising purposes, instruction manuals; software used as a means of communication among franchisees, franchisers, merchants, contractors, self-employed persons; courses, seminars and conferences on audio and video cassettes, software packages and software; toiletries: namely, aftershave, eau de cologne, cream rinse, cream, hair colouring, hair styling

products, namely: hair spray, hair lotion, shampoo, cream rinse, hair brushes, combs, pre-shave lotion, shaving cream, manicure tools; services related to establishing and brokering franchise operations, directing market studies for locating franchises, negotiating leases for franchised businesses, design, construction, fitting out, decoration of retail outlets; consulting service relating to franchises; negotiation and preparation of franchises and related agreements; training service relating to the operation of franchised businesses through conferences, seminars, courses and workshops; maintenance and supervision of franchises and support services relating to the operation of franchised businesses.

The whole in accordance with section 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 3RD DAY OF FEBRUARY 2004.

Jean Carrière

Member

Trade Marks Opposition Board