



TRANSLATION

THE REGISTRAR OF TRADE-MARKS

Reference: 2014 TMOB 183
Date of Decision: 2014-08-26

TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Origins Natural Resources Inc. against
application No. 1,475,192 for the trade-
mark NATORIGIN Design in the name of
Laboratoires Contapharm**

Introduction

[1] Origins Natural Resources Inc. (the Opponent) opposes registration of the trade-mark NATORIGIN Design (the Mark), as illustrated below, covered by application No. 1,475,192 in the name of Laboratoires Contapharm, a simplified joint stock company (the Applicant).

The logo for NATorigin, where 'NAT' is in a bold, sans-serif font and 'origin' is in a lighter, lowercase sans-serif font. A stylized leaf icon is positioned above the 'i' in 'origin'.

[2] This application, filed on March 31, 2010, is based on the projected use of the Mark in association with the following wares:

moisturizing creams for the face and body; anti-wrinkle creams, lifting serums; moisturizing and nourishing creams for the hands and nails; mascara; cosmetic pencils; make-up removing emulsions; cleansing milks; make-up removing lotions; cleansing waters for cosmetic use.

[3] The grounds of opposition raised all concern the likelihood of confusion, within the meaning of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act), between the Mark and the nominal and figurative trade-marks that include or are composed of the word ORIGINS (the ORIGINS Marks) or the trade-name Origins, which the Opponent alleges having used previously in Canada in association with a wide variety of personal care products and in association with the retail sale of these products. The registrations held by the Opponent for the ORIGINS Marks, alleged in the introductory paragraphs of the statement of opposition, are identified in the appendix.

[4] For the following reasons, I consider it appropriate to refuse the application.

The record

[5] The statement of opposition was filed on August 12, 2011. The Applicant filed a counter statement denying each of the grounds of opposition argued.

[6] The Opponent's proof is composed of two affidavits of Lesley A. Moradian, Vice-President & Senior Trademark Counsel with the Opponent. Her first affidavit, dated February 10, 2012, was filed under Section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). Her second affidavit, dated February 27, 2013, was filed with leave of the Registrar as additional evidence pursuant to Section 44 of the Regulations. Ms. Moradian was not cross-examined by the Applicant.

[7] The Applicant's evidence consists of an affidavit, dated June 12, 2012, of Benoît Soyer, "Finance, Administration and Export Manager" with the Applicant. Mr. Soyer was not cross-examined by the Opponent.

[8] Only the Opponent filed a written argument.

[9] The two parties were represented at the hearing held in this file.

The burden incumbent on the Parties

[10] The legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. This means that if a determinate conclusion cannot be

reached once all the evidence is in, then the issue must be decided against the Applicant. However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (FCTD); *Dion Neckwear Ltd. v. Christian Dior, SA et al* (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Opponent's evidence

[11] I will review the two affidavits of Ms. Moradian. However, I will disregard any assertion by Ms. Moradian equivalent to an opinion on questions of fact and law, which is up to the Registrar to settle.

Affidavit of February 10, 2012 and its Exhibits A to G

[12] I will begin by reproducing an excerpt from paragraph 6, in which Ms. Moradian explains the essential feature of the Opponent's philosophy and marketing concept.

... An essential feature of [Origins'] philosophy and marketing concept is a commitment to protecting the well-being of the planet and its customers. Origins' products are formulated with natural and organic ingredients and 100% natural essential oils and without parabens, phthalates, propylene glycol, mineral oil, PABA, petrolatum, paraffin, DEA and animal ingredients.

[13] I summarize as follows Ms. Moradian's testimony concerning the use and the promotion in Canada of the Opponent's ORIGINS Marks [paragr. 8-13, 16 and 18].

- The ORIGINS Marks have been used continuously in Canada by the Opponent since at least 1999, in association with a complete line of personal care products, including cosmetic products, face and body care products, hair care products, and candles (sometimes collectively called "the ORIGINS Products").

- The ORIGINS Marks are affixed to the products and/or their packaging.
- Since 1999, the Opponent has sold products in Canada from its e-commerce website, at *www.origins.com*. In addition to being able to order products, Canadian consumers can obtain information on the products and address questions to the Opponent via the website. In 2009, the Opponent accounted for more than 58,000 specific Canadian visitors. Since 2010, Canadian visitors have totalled over 100,000 each year.
- Since 2003, the Opponent's products have also be sold at ORIGINS branded cosmetics counters in 10 The Bay stores and 13 Sephora stores.
- For the 2008 to 2011 fiscal years (July 1 to June 30), retail sales of ORIGINS Products in Canada, pertaining to one or more of the ORIGINS Marks, totalled over 7.8 million US dollars. (I conclude that Ms. Moradian's reference to total sales of 27.6 million dollars in paragraph 11 of the affidavit is the result of a transcription error, because the annual breakdown provided adds up to 7.8 million US dollars. Moreover, the Opponent refers to total sales of 7.8 million dollars in its written argument.)
- For the 2005 to 2012 fiscal years (as of the date of the affidavit), online sales of ORIGINS Products, pertaining to one or more of the ORIGINS Marks, totalled over 1.2 million Canadian dollars.
- The ORIGINS Products have been the subject of major advertising in print publications circulating both in Canada and the United States, including *Allure*, *Glamour*, *InStyle*, *Marie Claire*, *Self*, *Shape*, *Women's Health*, *Whole Living*, *Oprah*, *Real Simple* and *People* magazines.
- From 2008 to 2011, the advertising expenditures for ORIGINS Products in Canada amounted to more than US\$230,000.

- The ORIGINS Marks have benefited from major press and media coverage in Canada, particularly due to the awards presented to the Opponent for the ORIGINS Products.

[14] Among the exhibits filed as documentary evidence in support of Ms. Moradian's assertions concerning the use and promotion of the ORIGINS Marks in Canada, I note the following exhibits:

- Exhibit B: a copy of the spring 2012 order form listing the ORIGINS Products sold on the date of the affidavit and representative of the type of products sold in Canada since 1999. The prices have been blacked out, because this is confidential information [paragr. 7];
- Exhibit C: packaging of several ORIGINS Products, which are representative of the use of the ORIGINS Marks in Canada since 1999 [paragr. 10];
- Exhibit D: figures regarding the distribution in Canada of the magazines in which the ORIGINS Products were advertised for the year 2011 [paragr. 13];
- Exhibits E-1 to E-10: advertisements in the magazines *Self* (June 2011), *Women's Health* (October 2011), *People* (October 3, 2011), *Allure* (November 2011), *Shape* (December 2011), *Glamour* (December 2011), *Whole Living* (December 2011), *Real Simple* (January 2012), *Oprah* (February 2012) and *InStyle* (February 2012), which are representative of advertisements in magazines in Canada [paragr. 14];
- Exhibit F: a list of awards presented by magazines for ORIGINS Products [paragr. 18]; and
- Exhibits G-1 to G-10: copies of representative articles concerning ORIGINS Products published in *Elle Canada* (August 2008), *Toronto Star* (August 6, 2009), *Canadian Living* (November 2009), *Fashion Magazine* (summer 2010), *Fashion* (August 2010), *BEA* (March 2011), *Hello Canada*

(August 22, 2011), *Coup de Pouce* (February 2012) and *Clin d'Oeil* (March 2012) [paragr. 19].

[15] Finally, Ms. Moradian's testimony regarding the Opponent's Origins trade-name is to the effect that it is used in the operation of ORIGINS branded cosmetics counters and online sales of ORIGINS products [paragr. 5].

Affidavit of February 27, 2013 and its Exhibits A to E

[16] Ms. Moradian filed copies of her affidavits submitted within the context of proceedings pursuant to section 45 of the Act against registrations alleged by the Opponent in these proceedings. Ms. Moradian asserts that she reiterates and maintains the content of her affidavits. The proceedings in question, to which I will return, were instituted at the Applicant's request against registration Nos. TMA466,901, TMA470,749, TMA554,982, TMA617,049 and TMA671,380 for the ORIGINS nominal mark.

[17] I do not intend to review the contents of the affidavits filed as Exhibits A to E. Apart from the fact that the evidentiary burden incumbent on the Opponent within the context of proceedings pursuant to section 45 differs from its evidentiary burden in these proceedings, I consider that the evidence presented by Ms. Moradian's affidavit of February 10, 2012 (Moradian Affidavit 1) is fully sufficient to allow me to rule on the questions raised in the case at bar.

Applicant's evidence

[18] I will review Mr. Soyer's affidavit, accompanied by its Exhibits BS-1 to BS-6. However, I will disregard any assertion by Mr. Soyer equivalent to an opinion on questions of fact and law, which it is up to the Registrar to settle.

[19] Mr. Soyer explains that the Applicant works in the field of care and cosmetics products, particularly for sensitive skin and eyes. "Since 1981, the Applicant has developed and produced, on account of Essilor International (Compagnie Générale d'Optique), which markets a line of contact lens maintenance solutions. It also develops a line of care and make-up products for sensitive or allergic skin and eyes and for the wearing of contact lenses." [paragr. 4].

[20] Mr. Soyer explains that the Applicant has also developed a line of natural care products containing 97% or more ingredients of natural origin and that it has marketed its Mark since the second quarter of 2009 [paragr. 5]. He specifies that the products associated with the Mark are sold in about ten countries and that the Applicant has obtained registrations in various countries without encountering opposition, including opposition from the Opponent [paragr. 6-7].

[21] I summarize as follows Mr. Soyer's testimony concerning the use and the promotion of the Mark in Canada [paragr. 9-14].

- The Mark has been used in Canada since April 22, 2010 by the Applicant itself or through its Canadian distributor, Distribution Yvon Dupuis (the Distributor).
- The Mark is always affixed to the containers in which the wares are sold. These wares are offered and sold to retailers via the Distributor's website at *www.d-y-d.org*.
- Between 2010 and 2012, the Applicant realized annual sales in Canada of 5,000 € to 10,000 € for the sale of wares associated with the Mark.
- The Distributor regularly promotes and advertises the wares associated with the Mark via its website.
- The Applicant also promotes the wares associated with the Mark via its websites *www.contapharm.com* and *natorigin.fr*.

[22] The following exhibits were filed by Mr. Soyer in support of his assertions concerning the use and promotion of the Mark in Canada:

- Exhibit BS-2: a sample of invoices for the years 2010 to 2012 for products sold under the Mark in Canada [paragr. 10]. I note these invoices originate from the Applicant and are addressed to the Distributor;
- Exhibit BS-3: photos of certain containers in which the wares are sold, representative of the use of the Mark in Canada [paragr. 11]; and

- Exhibits BS-4 and BS-5: excerpts from the Distributor's website and excerpts from the Applicant's websites.

[23] Mr. Soyer concludes his affidavit by filing excerpts from the website *www.thebay.com* [TRANSLATION] "showing the prices of various products of the Opponent". He [TRANSLATION] "recognizes that the ORIGINS mark products fall within a significantly higher price range" than the products associated with the Mark [paragr. 16 and Exhibit BS-6].

Examination of the questions

[24] The grounds of opposition, which concern the likelihood of confusion between the Mark and the ORIGINS Marks or the Origins trade-name of the Opponent, raise the following questions:

1. Is the Mark registrable?
2. Was the Applicant the person entitled to registration of the Mark on the filing date of the application?
3. Was the Mark distinctive of the Applicant's wares on the filing date of the statement of opposition?

[25] I will examine these questions in turn.

1. Is the Mark registrable?

[26] This question arises from the ground of opposition alleging the Mark is not registrable pursuant to paragraph 12(1)(d) of the Act, because it is confusing with the ORIGINS Marks which are the object of the registrations identified in the appendix.

[27] The relevant date for the examination of this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[28] After exercising the discretionary power of the Registrar to confirm that each of the 17 registrations alleged by the Opponent is in good standing, I find that registration No. TMA494,567 for the ORIGINS SALT RUB trade-mark has been expunged. Therefore, to the extent it concerns confusion with this registration, the ground of opposition based on paragraph 12(1)(d) is rejected because the Opponent has not discharged the evidentiary burden incumbent on it.

[29] However, the Opponent has discharged its evidentiary burden regarding its 16 other registrations, because each remains in good standing, including registrations Nos. TMA466,901, TMA470,749, TMA554,982, TMA617,049 and TMA671,380, which were the object of decisions issued by the Registrar on August 18, 2014 within the context of the Section 45 proceedings¹. Indeed, because the time limit to appeal the Registrar's decisions has not expired, these decisions are not final. [See, by analogy, *Spirits International BV v. Distilleries Melville Limitée*, 2011 TMOB 186 (CanLII) at paragr. 104]

[30] The test for confusion is that of first impression and imperfect recollection. According to section 6(2) of the Act, the use of a trade-mark creates confusion with another trade-mark when the use of both trade-marks in the same region would be likely to give the impression that the wares related to these trade-marks are manufactured, sold, leased or rented or that the services related to these trade-marks are leased or executed, by the same person, whether or not these wares or these services are in the same general category.

[31] In deciding whether these trade-marks create confusion, the registrar must take into account all circumstances in the case, specifically those listed in section 6(5) of the Act, i.e. 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 of wares, services or business; d) the nature of the trade; 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

¹ *Laboratoires Contapharm v. Origins Natural Resources Inc.* 2014 TMOB 164 (TMA466,901 - should be amended) *Laboratoires Contapharm v. Origins Natural Resources Inc.* 2014 TMOB 165 (TMA470,749 - should be maintained) *Laboratoires Contapharm v. Origins Natural Resources Inc.* 2014 TMOB 166 (TMA554,982 - should be maintained) *Laboratoires Contapharm v. Origins Natural Resources Inc.* 2014 TMOB 168 (TMA617,049 - should be amended) *Laboratoires Contapharm v. Origins Natural Resources Inc.* 2014 TMOB 167 (TMA671,380 - should be amended)

different weight will be given to each of these factors in a context-specific assessment. [See *Mattel, Inc. v. 3894207 Canada Inc* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) for an advanced examination of the general principles governing the test for confusion.]

[32] At this time, I note my opinion that the Opponent's documentary evidence showing the use of the word ORIGINS in combination with the representation of two trees is acceptable as proof of use of the ORIGINS nominal trade-mark, despite the Applicant's representations to the contrary [see *Canada (Registrar of Trade-marks) v. Cie International pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 (F.C.A.); and *Nightingale Interloc Ltd v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (TMOB)].

[33] Moreover, I consider that the strongest case for the Opponent is based on the comparison of the Mark with the ORIGINS nominal trade-mark of registration No. TMA466,901 (the ORIGINS Mark). Since the Registrar's decision whereby the statement of the registration should be amended to remove essential oils is not final, the ORIGINS Mark is currently registered in association with the following wares:

[TRANSLATION]

soaps, body lotions and body powders; lip cosmetics and make-up, namely lipstick, lip gloss and lip pencil, facial cosmetics and make-up, namely facial make-up, pressed powder, loose powder and rouge, and eye make-up, namely eye shadow, mascara and eyebrow pencil,, facial and body moisturizers and nourishing and repairing care, namely facial and body gels, facial cleansers, tonics and exfoliants, toilet soap, bath oils, bath powder, essential oils, bath additives; tanning products, namely creams and lotions to promote natural and artificial tanning ; skin creams and lotions ; sun care products , namely sun screens and creams and lotions to relieve sunburn .

[34] I will therefore gear my analysis to the question arising from the ground of opposition based on paragraph 12(1)(d) of the Act on the likelihood of confusion between the Mark and the ORIGINS Mark.

[35] In the *Masterpiece* decision, *supra*, the Supreme Court of Canada ruled that the degree of resemblance between the marks, even though this is the last factor listed in subsection 6(5) of the

Act, is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the Court decided to begin its analysis by examining this factor. Therefore, I will examine the factors set out in subsection 6(5), beginning with the degree of resemblance between the marks.

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

[36] Examining the degree of resemblance, the Supreme Court of Canada writes in the *Masterpiece* decision, at paragraph 62: "Resemblance is defined as the quality of being either like or similar [between objects of the same kind presenting identical features] under the definition of "resemblance" [...]. In paragraph 64, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[37] In the present case, I agree with the Applicant that the presence of the prefix "NAT" in the Mark results in phonetic differences between the subject marks. However, since the Opponent has correctly submitted that I can automatically study the dictionary definitions, I note that the online version of the *Canadian Oxford Dictionary*, (2nd ed.) indicates that "NAT" corresponds to an abbreviation of the word "natural". To the extent that the wares marketed under the protection of the Mark are composed 97% or more of ingredients of *natural* origin, I find it difficult to conceive how the Applicant can maintain, as it did at the hearing, that no specific connotation is attached to the prefix "NAT" within the context of the Mark and that this does not suggest any specific idea. On the contrary, I agree with the Opponent that the Mark suggests the idea of products of natural origin.

[38] Ultimately, I subscribe to the Opponent's position that in the case at bar, the prefix "NAT" is not the most striking factor of the Mark. I also subscribe to the Opponent's position that even if the Mark is formed by the word NATORIGIN, the elements "NAT" and "origin" are perceived as two words, given the different fonts.

[39] All in all, I consider there is necessarily a degree of resemblance between the trade-marks in question in that the most striking element of the Mark is the "origin" element, which is

practically identical to the ORIGINS Mark, even though it ends with the letter "s". Indeed, with all due respect for the Applicant, I consider it unreasonable to claim, as it did at the hearing, that the letter "s" in the ORIGINS Mark has a significant impact, when one considers the degree of resemblance between the subject marks.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[40] Although I agree with the Opponent that the Mark suggests the idea of products of natural origin, I accept that the Mark considered as a whole is not devoid of inherent distinctiveness.

[41] I also accept that the ORIGINS Mark possesses an inherent distinctiveness regarding the wares associated with it. However, to the extent that "origin" is a commonly used dictionary word in English, the Opponent has not convinced me that the ORIGINS Mark benefits from an inherent distinctiveness much greater than that of the Mark. However, following my review of the evidence filed by the parties, I agree with the Opponent that the extent to which the ORIGINS Mark has become known in Canada clearly favours it.

[42] In this regard, it is sufficient to recall that the sale of the wares associated with the Mark generated annual revenue of 5,000 € to 10,000 € for the years 2010 to 2012 [paragr. 10 of the Soyer affidavit]. On the other hand, according to the Opponent's evidence, the retail sales of ORIGINS Products in Canada totalled over 7.8 million US dollars for the 2008 to 2011 fiscal years and online sales to Canadian consumers for the 2005 to 2012 fiscal years totalled more than 1.2 million Canadian dollars [paragr. 11-12 of Moradian Affidavit 1].

[43] I also recall that the Opponent provided factual information regarding the number of Canadians who have visited its website since 2009 (over 58,000 in 2009 and over 100,000 each year since 2010) [paragr. 16 of Moradian Affidavit 1]. It also provided factual information concerning the advertising expenditures for ORIGINS Products in Canada from 2008 to 2011 (over US\$230,000) [paragr. 13 of Moradian Affidavit 1] and advertising specimens for the years 2011 and 2012 [paragr. 14 and Exhibits E-1 to E-10 of Moradian Affidavit 1]. No factual information of this nature was provided by the Applicant.

[44] All in all, my overall assessment of this first factor, which is a combination of the inherent and acquired distinctiveness of the marks in question, favours the Opponent, given that its mark enjoys a far more significant acquired distinctiveness than the Mark.

The period during which the trade-marks have been in use

[45] It is unnecessary to discuss this factor at length, because the evidence clearly shows that it favours the Opponent.

Nature of the wares, services or business

[46] For the analysis of the question arising from the ground of opposition raised pursuant to paragraph 12(1)(d) of the Act, the statements of wares of the application for registration under opposition and the statements of wares or services of the Opponent's registrations must be considered for the assessment of the factor set out in paragraph 6(5)(c) of the Act [see *Mr. Submarine Ltd v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); and *Miss Universe, Inc. v. Bohna*, (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[47] During the hearing, the Applicant submitted that there are distinctions between the nature of the wares associated with the subject marks. According to my understanding of the oral representations, the Applicant claims that the wares associated with the Mark are distinguished from those registered in association with the ORIGINS Mark due to:

- (i) the specialized nature of its wares, which are care and make-up products *for sensitive skin and eyes* [paragr. 4 of the Soyer affidavit]; and
- (ii) the fact that the Opponent's products fall within a [TRANSLATION] "significantly higher" price range than the products associated with the Mark [paragr. 16 of the Soyer affidavit].

[48] In response to these representations, the Opponent rightly points out:

- (i) that the statement of wares of the application for registration does not contain any restriction on the nature of the wares; and

- (ii) that none of the evidence presented by the Applicant provides factual information regarding the prices of the wares associated with the Mark.

[49] Regarding the argument based on the price of the wares, I consider it sufficient to recall that the Supreme Court of Canada confirmed in the *Masterpiece* decision, *supra*, that the first impression of consumers remains central to the analysis of confusion, even if the wares are costly.

[50] The Applicant's argument based on the "specialized" nature of the wares did not convince me that they are distinct from the wares covered by Registration No. TMA466,901. Regardless of whether the wares associated with the subject marks are intended for sensitive skin or eyes, the nature of the wares is the same.

[51] Ultimately, I conclude that the wares associated with the Mark, as identified in the statement of wares of the application for registration, either are identical or at least overlap the following wares covered by Registration No. TMA466,901:

[TRANSLATION]

" [...] body lotions and powders; lip cosmetics and make-up, namely lipstick, lip gloss and lip pencil, facial cosmetics and make-up, namely facial make-up, pressed powder, loose powder and rouge, and eye make-up, namely eye shadow, mascara and eyebrow pencil, facial and body moisturizers and nourishing and repairing products, namely facial and body gels, facial cleansers, tonics and exfoliants [...]. "

[52] Therefore, the factor set out in paragraph 6(5)(c) of the Act favours the Opponent.

Nature of the trade

[53] Once again, the statements of wares of the application for registration under opposition and the statements of wares or services of the registrations must be considered for the assessment of the factor set out in paragraph 6(5)(d) of the Act. However, these statements must be examined with the perspective of determining the likely nature of the business or the nature of the trade envisioned by the parties, and not all the trades the wording could encompass. This was reiterated recently in the *Bridgestone Corporation v. Campagnolo SRL*, 2014 F.C. 37, when the Court declared the following at paragraphs 55 and 56:

[55] Further clarification was given recently by the Federal Court of Appeal in *Movenpick Holdings AG v. Exxon Mobil Corp*, 2013 FCA 6, at para 6, where the Court cited with approval the Registrar's comments: "The parties' respective statements of services must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording (see *McDonald's Corp v. Coffee Hut Stores Ltd.* (1994), 55 C.P.R. (3d) 463 (FCTD)). "

[56] I consider that the Registrar followed the instructions of the Court of Appeal in accounting for all the foreseeable and usual commercial channels through which the products could be sold, instead of all the hypothetical channels.

[54] The Applicant's representations regarding distinctions between the nature of the trade of the parties are not necessarily without merit. According to the Opponent's evidence, its products have been sold in Canada via its website, since 1999, and at the ORIGINS branded cosmetic counters it has operated at The Bay and Sephora stores, since 2003 [paragr. 8-9 of Moradian Affidavit 1]. In the current state of affairs, I conceive that it seems unlikely that the wares associated with the Mark are sold in the same trade niches as the products associated with the ORIGINS Mark.

[55] This having been said, I am not prepared to conclude that the nature of the trade is a factor that favours the Applicant, as it claims, for the following reasons.

[56] On the one hand, I consider it reasonable to conclude that the wares associated with the Mark are intended for the same clientele as the wares associated with the ORIGINS Mark, in particular, a female clientele wishing to obtain cosmetic products or body care products.

[57] On the other hand, the Applicant's evidence regarding the nature of its trade is limited to an assertion by Mr. Soyer, according to which the wares associated with the Mark [TRANSLATION] "are offered for sale to retailers on the [Distributor's] website" [paragr. 12 of the Soyer affidavit]. In the absence of factual information on these retailers, which I could have taken into account for the purposes of my assessment of the likelihood of confusion, I am not prepared to conclude that there is no overlap in the nature of the trade. Indeed, even though I I conceive that it is unlikely that the wares associated with the Mark are sold at the ORIGINS branded cosmetics counters operated by the Opponent in The Bay stores, there is no evidence

allowing me to conclude that the Applicant's wares could not be found in stores retailing products, such as cosmetic or body care products, in The Bay stores, for example.

Additional circumstances of the case at bar

[58] The Opponent submits that its evidence establishes that it holds a family of marks that include or are composed of the word ORIGINS. It also submits that the evidence in the record shows that, in addition to using the colour green for the packaging of their respective products, this colour reflecting nature, the two parties promote their products as being composed mainly of natural ingredients. The Opponent submits that this evidence provides additional circumstances that support its position.

[59] In the final analysis, I do not see the necessity of discussing the additional circumstances invoked by the Opponent to settle the question under consideration in its favour.

Conclusion on the likelihood of confusion

[60] As indicated above, the test for confusion consists in asking whether an individual with an imperfect recollection of the Opponent's ORIGINS mark could conclude, on the basis of a first impression, that the wares associated with the Mark come from the same source or are otherwise related to or associated with the Opponent's wares.

[61] In view of my analysis of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there is no risk of confusion between the Mark and the ORIGINS Mark (TMA466,901). Therefore, I do not see the necessity of deciding where a likelihood of confusion exists between the Mark and each of the other ORIGINS Marks that are the object of registrations still in force.

[62] Therefore, the ground of opposition based on paragraph 12(1)(d) of the Act is granted, to the extent it is based on registration No. TMA466,901.

2. Was the Applicant the person entitled to registration of the Mark on the filing date of the application?

[63] This question arises from the grounds of opposition alleging that the Applicant is not the person entitled to registration of the Mark pursuant to paragraphs 16(3)(a) and (c) of the Act, because on the filing date of the application, the Mark was confusing with

- (i) the ORIGINS marks previously used in Canada by the Opponent in association with the wares or services covered by the corresponding registrations [paragraph 16(3)(a) of the Act]; and
- (ii) the Origins trade-name previously used in Canada by the Opponent [paragraph 16(3)(c) of the Act].

[64] On the one hand, I believe it is sufficient to consider the ground of opposition raised pursuant to paragraph 16(3)(a) of the Act for the analysis of the question under consideration. Therefore, I will not consider the ground of opposition raised pursuant to paragraph 16(3)(c) of the Act.

[65] On the other hand, it is still my opinion that comparing the Mark with the ORIGINS Mark allows an effective ruling on the ground of opposition.

[66] Following my review of Moradian Affidavit 1, I conclude the Opponent has discharged its evidentiary burden that it used the ORIGINS Mark in Canada in association with cosmetic products and facial and body care products before March 31, 2010 and that it had not abandoned the ORIGINS Mark on the date of announcement of the application, i.e. March 16, 2011 [see subsection 16(5) of the Act].

[67] Since the difference in the relevant date has no impact on my previous assessment of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there was no risk of confusion between the Mark and the ORIGINS Mark as of March 31, 2010.

[68] Therefore, the ground of opposition based on paragraph 16(3)(a) of the Act is granted, to the extent it is based on the likelihood of confusion with the ORIGINS Mark previously used in Canada by the Opponent in association with cosmetic products and facial and body care products.

3. Was the Mark distinctive of the Applicant's wares on the filing date of the statement of opposition?

[69] This question arises from the ground of opposition alleging that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish the Applicant's wares from the wares and services associated with the ORIGINS Marks and the Opponents Origins trade-name.

[70] Following my review of Moradian Affidavit 1, I conclude that the Opponent has discharged its initial evidentiary burden that on the date of the statement of opposition, namely August 12, 2011, its ORIGINS Mark had acquired a sufficient reputation to deny the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer v. Stargate Connections Inc* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[71] Since the difference in the relevant date has no impact on my previous examination of the circumstances of the case at bar, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there was no risk of confusion between the Mark and the Opponent's ORIGINS Mark as of August 12, 2011.

[72] Therefore, the ground of opposition based on non-distinctiveness, within the meaning of section 2 of the Act, is granted to the extent it is based on the likelihood of confusion with the ORIGINS Mark used in Canada by the Opponent in association with cosmetic products and facial and body care products.

Decision

[73] In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse the application, pursuant to subsection 38(8) of the Act.


Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office
Certified true translation

Traduction certifiée conforme
Arnold Bennett, trad.

Appendix

ORIGINS Marks - Registrations alleged by the Opponent

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Date</u>
ORIGINS	TMA466,901	December 2, 1996
ORIGINS	TMA470,749	February 11, 1997
ORIGINS	TMA554,982	December 4, 2001
ORIGINS	TMA671,380	August 29, 2006
ORIGINS	TMA617,049	August 29, 2004
	TMA545,862	May 30, 2001
	TMA671,402	August 29, 2006
	TMA471,740	February 26, 1997
ORIGINS GINGER SOUFFLÉ	TMA673,547	September 27, 2006
ORIGINS GINZING	TMA770,247	June 21, 2010
ORIGINS MAKE A DIFFERENCE	TMA685,094	March 30, 2007
ORIGINS MATTE STICKS	TMA466,024	November 13, 1996
	TMA726,255	October 16, 2008
ORIGINS SALT RUB	TMA494,567	May 14, 1998
ORIGINS TOTALLY PURE	TMA757,051	January 13, 2010

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Date</u>
ORIGINS ZERO OIL	TMA464,552	October 25, 1996
	TMA770,351	June 21, 2010