



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 39
Date of Decision: 2012-02-23

**IN THE MATTER OF AN OPPOSITION
by Jaymei Enterprises Inc. to application
No. 1,232,093 for the trade-mark KAMA
SUTRA & Design in the name of Kamsut,
Inc.**

[1] On September 29, 2004, Kamsut, Inc. (the Applicant) filed an application to register the trade-mark KAMA SUTRA & Design (the Mark), which is shown below:



[2] The application's statement of wares and services reads:

wares:

(1) body oil, body cream, body powder, body massage cream, body soap, non-medicated bath salts, massage oils; massage creams; pleasure heightening balm.

(2) personal lubricants and balms.

(3) body oil, body cream, body powder, body massage cream, body soap, non-medicated bath salts, massage oils; massage creams; pleasure heightening balm;

personal lubricants; and balms, namely salves, gels and ointments for genital use for increasing sexual stimulation.

(4) clothing, namely t-shirts, lingerie, loungewear, and sleepwear.

services:

(1) retail store services, on-line retail store and wholesale store and wholesale distributorship services, featuring skin care items, personal care items, boudoir items, oils, lotions, cosmetics, massage oils, massage creams, bath gels, skin powder, body paint, perfumes, personal lubricants, analgesic balms, aromatic balms, skin moisturizers and conditioners, massage lotions, non-medicated skin care preparations, and clothing.

[3] The application is based on use of the Mark in Canada since at least as early as June 30, 1995 in association with the wares (1). The application is based on use of the Mark in Canada since at least as early as December 31, 2003 in association with the wares (2). The application is based on use and registration of the Mark abroad in association with the wares (3) and (4) and the services. In addition, the application claims a convention priority filing date of July 8, 2004 with respect to the wares (3) and (4) and the services.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 8, 2009.

[5] On June 8, 2009, Jaymei Enterprises Inc. (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

[6] In support of its opposition, the Opponent filed an affidavit of Lynda Palmer. In support of its application, the Applicant filed an affidavit of Joseph C. Bolstad. No cross-examinations were conducted.

[7] Both parties filed a written argument.

[8] On April 12, 2011, leave was granted to the Opponent to amend its statement of opposition to correct typographical errors.

[9] An oral hearing was held in which only the Applicant participated.

Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Grounds of Opposition

[11] Although the statement of opposition pleads a number of grounds of opposition, the Opponent indicated in its written argument that it now only intends to rely on one ground of opposition, namely that contrary to s. 16(2)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant is not the person entitled to registration of the Mark in association with “clothing, namely t-shirts, lingerie, loungewear, and sleepwear; retail store services, on-line retail store and wholesale store and wholesale distributorship services, featuring skin care items, personal care items, boudoir items, oils, lotions, cosmetics, massage oils, massage creams, bath gels, skin powder, body paint, perfumes, personal lubricants, analgesic balms, aromatic balms, skin moisturizers and conditioners, massage lotions, non-medicated skin care preparations, and clothing” (the Disputed Wares and Services) because the Mark is confusing with the Opponent’s trade-mark KAMA SUTRA which is the subject of a previously filed application No. 1,218,942. Application No. 1,218,942 was filed on June 2, 2004 based on proposed use of the mark in Canada. As of the material date of July 8, 2004, the statement of wares and services in application No. 1,218,942 read:

wares

candles, scented waxes and oils, candle holders, wax and oil burners; potpourri; lamps; jewelry; cups, mugs, drinking glasses, beer mugs; key chains; stickers and decals; decorative accessories for the home; plant pots; cookie tins and jars; cooking ware and utensils; tea trays; spice containers; mirrors; book marks; mouse pads; clothing, namely, lingerie, sleepwear, underwear, tee shirts, aprons; bed linens, namely sheets, pillowcases, cushions, duvets and bed covers; curtains and decorative curtain rods; table cloths; placemats; food products, namely spices, tea, chocolate syrup, maple syrup, fruit syrups, jams, jellies, honey, preserved fruits and vegetables; non-alcoholic beverages, namely carbonated beverages, fruit juices, juice

concentrates and bottled water; wine.

services

retail sale of giftware, decorative accessories for the home, chocolates, food products and clothes; restaurant services.

[12] The Opponent has met its initial burden with respect to this ground of opposition because application No. 1,218,942 was filed before the convention priority filing date of the Applicant's application and was pending when the application was advertised, as required by s. 16.

Before proceeding, I will acknowledge that the Applicant has pointed out that it opposed the application on which the Opponent relies pleading confusion between the parties' marks and was successful in part [see *Kamsut, Inc. v. Jaymei Enterprises Inc.* 2010 TMOB 196]. The Applicant also pointed out that it unsuccessfully applied to expunge the Opponent's registration No. TMA587,731 for KAMA SUTRA for chocolates etc. on the basis of confusion with the Applicant's KAMA SUTRA mark [see *Kamsut, Inc. v. Jaymei Enterprises Inc.* (2009), 75 C.P.R. (4th) 247 (F.C.)].

Likelihood of Confusion under s. 16(2)(b)

[13] 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. The test for confusion is one of first impression and imperfect recollection

[14] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)]

inherent distinctiveness of the marks

[15] The common feature of the two marks, KAMA SUTRA, is defined in *The Canadian Oxford Dictionary* as “an ancient Sanskrit treatise on the art of erotic love”. Although KAMA SUTRA is the dominant feature of both marks, the Applicant’s Mark is slightly more inherently distinctive than the Opponent’s mark due to the Mark’s design features.

the extent to which each mark has become known

[16] The evidence does not show that the Opponent’s mark has become known. There is however evidence that the Applicant’s Mark has become known. In particular, Mr. Bolstad, the Applicant’s President, attests that in each year from 2001 to 2008 the Applicant spent at least \$75,000 (US) advertising products “using the KAMA SUTRA and KAMA SUTRA & Design trade-marks in Canada” by print, magazine, radio, television, Internet, direct mailing, sponsorships, promotional contests, trade shows and in-store promotions. As Exhibit E, he provides representative print advertising materials and the Mark is visible in the majority of these materials. As Exhibit F, he provides a sample brochure and as Exhibit G he provides representative printouts from the Applicant’s website *www.kamasutra.com*; the Mark is clearly visible on the brochure and on many of the website pages. As Exhibit H, Mr. Bolstad provides representative invoices concerning sales of wares bearing the Mark to Canadian recipients. Mr. Bolstad also provides the Applicant’s annual “retail sales in Canada of goods bearing the KAMA SUTRA and KAMA SUTRA & Design trade-marks” for 2001 - 2008 (through 15/09); as of the material date of July 8, 2004, such sales exceeded two million dollars. I note that representative packaging and labels have been provided as Exhibit D and these all display the Mark. Mr. Bolstad attests that they bear the KAMA SUTRA and KAMA SUTRA & Design trade-marks, but presumably this is because use of KAMA SUTRA & Design also qualifies as use of KAMA SUTRA. Regarding Mr. Bolstad’s references elsewhere to the KAMA SUTRA mark, as opposed to KAMA SUTRA & Design, I note that he has evidenced that the Applicant owns registration No. TMA277,453 for KAMA SUTRA for wares that are similar or related to the wares listed in the present application as wares (1) to (3). Of course, the fact that the Applicant owns such registration does not give it the automatic right to the registration of the Mark [see *Mister Coffee*

& Services Inc. v. Mr. Coffee, Inc. (1999), 3 C.P.R. (4th) 405 (T.M.O.B.) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

[17] Based on the foregoing, I find that the Applicant's mark is more known in Canada than is the Opponent's mark. However, I note that none of Mr. Bolstad's exhibits relate to clothing. In addition, I do not see any evidence of "retail store services" as opposed to "on-line retail store services", nor of "wholesale store and wholesale distributorship services". In other words, the evidence only shows that the Mark has become known in Canada in association with wares of the type listed in wares (1) to (3) and not with the Disputed Wares and Services, with the possible exception of on-line retail store services. Regarding the on-line retail store services, I note that Mr. Bolstad attested that the Applicant's website was at all times accessible in Canada; he did not however attest that it was accessed by anyone in Canada and I do not see clothing for sale on the website pages that he provided.

the length of time the marks have been in use

[18] It is not evident that the Applicant has commenced use of the Mark in Canada in association with the Disputed Wares and Services. However, the Applicant has shown continuous use of the Mark since 2000 in association with wares in the nature of those covered by its application but not contested by the Opponent.

[19] The application for KAMA SUTRA that the Opponent is relying upon is based on proposed use, but the Opponent has provided a certified copy of registration No. TMA587,731 that it also owns for KAMA SUTRA, which claims use since at least 1994 in association with chocolates, candies, etc. However, there is no evidence showing that the Opponent has made ongoing use of KAMA SUTRA in association with any wares or services.

the nature of the wares, services, business and trade

[20] Although the two trade-mark applications at issue cover a number of disparate wares, both parties' applications include clothing and retail sale/store services in their statements of wares and services.

[21] There is no evidence of the Opponent's channels of trade but Mr. Bolstad has evidenced that the Applicant's wares "are sold in Canada through specialty retail stores, direct sales, department stores and drug stores and Internet sales on [the Applicant's] online store at www.kamasutra.com". Mr. Bolstad further attests that the Applicant's wares are sold through more than 1000 retail outlets in Canada including Shoppers Drug Mart, the Bay and Zellers and are also "available in the mini-bar areas of rooms, gift stores, spas and romance packages in major hotel chains across Canada including but not limited to, The Pan Pacific, Executive Hotel, Sutton Place and Hotel Le Soleil." Mr. Bolstad states that the Applicant's wares "are generally referred to as romantic giftware and aim at providing consumers a joyful experience of intimacy and tenderness, to promote physically and emotionally healthier human beings." At the oral hearing, the Applicant's agent referred to the Applicant's wares as love-making aids or sexual stimulants.

the degree of resemblance between the marks

[22] The dominant portion of each mark is the term KAMA SUTRA and the marks are identical when sounded. The ideas suggested by each mark are the same. However, visually there are differences between the marks due to the design features of the Mark.

conclusion re s. 16(2)(b) ground

[23] Having considered all of the surrounding circumstances and in particular the fact that the Applicant has no reputation in association with clothing, I find that there is a reasonable likelihood of confusion between KAMA SUTRA clothing and KAMA SUTRA & Design clothing. The opposition therefore succeeds with respect to the wares "clothing, namely t-shirts, lingerie, loungewear, and sleepwear."

[24] Although the Opponent did not contest the non-clothing wares in the Applicant's application, it did contest the services with respect to both clothing and non-clothing wares. I consider it appropriate to only find the opposition successful with respect to the services to the extent that they cover clothing. If confusion is not likely between the parties' marks as applied to their non-clothing wares, then it seems unlikely that confusion would arise if both parties' marks were associated with stores selling their respective non-clothing wares, particularly bearing in

mind that the Applicant alone has demonstrated that its trade-mark has acquired a reputation. Therefore, only the word “clothing” should be removed from the Applicant’s statement of services.

Disposition

[25] Pursuant to the authority delegated to me under s. 63(3) of the Act, I am refusing the application only in part, pursuant to s. 38(8) of the Act; the statement of wares and services of the application will be restricted to:

wares:

(1) body oil, body cream, body powder, body massage cream, body soap, non-medicated bath salts, massage oils; massage creams; pleasure heightening balm.

(2) personal lubricants and balms.

(3) body oil, body cream, body powder, body massage cream, body soap, non-medicated bath salts, massage oils; massage creams; pleasure heightening balm; personal lubricants; and balms, namely salves, gels and ointments for genital use for increasing sexual stimulation.

services:

(1) retail store services, on-line retail store and wholesale store and wholesale distributorship services, featuring skin care items, personal care items, boudoir items, oils, lotions, cosmetics, massage oils, massage creams, bath gels, skin powder, body paint, perfumes, personal lubricants, analgesic balms, aromatic balms, skin moisturizers and conditioners, massage lotions, and non-medicated skin care preparations.

Jill W. Bradbury
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Trade-marks Opposition Board
Canadian Intellectual Property Office