



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 160**  
**Date of Decision: 2021-02-02**

**IN THE MATTER OF AN OPPOSITION**

**LAROSH DERMOCOSMETIC  
LABORATORIES INC.**

**Opponent**

**and**

**C. DeCicco Agencies Inc.**

**Applicant**

**1,796,684 for INTERCOSMETICS**

**Application**

[1] LAROSH DERMOCOSMETIC LABORATORIES INC. (the Opponent) opposes registration of the trademark INTERCOSMETICS (the Mark) filed by C. DeCicco Agencies Inc. (the Applicant). Filed on August 19, 2016, the application is based on use of the Mark in Canada since at least as early as 1991 with wholesale and distribution services of a wide range of personal care products and spa furniture and equipment as described in Schedule A to this decision.

[2] The Opponent alleges in its statement of opposition that: (i) the application does not conform to the requirements of sections 30(a), 30(b) and 30(i) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable pursuant to section 12(1)(b) of the Act; (iii) the Mark is not registrable pursuant to section 12(1)(d) of the Act; (iv) the Applicant is not the person entitled to registration of the Mark; and (v) the Mark is not distinctive under section 2 of

the Act. With respect to the grounds of opposition alleging confusion, the Opponent alleges that the Mark is confusing with a number of different trademarks which appear to be owned by other parties including INTERCOSMO, INTER COSMETIQUES and INTERNATIONAL COSMETICS.

[3] In this case, the Opponent meets its evidential burden with respect to a single ground of opposition; the section 12(1)(d) ground of opposition alleging confusion with three registered trademarks including INTERCOSMO for use with a number of different personal care products. As the Applicant has proven on a balance of probabilities that there is no reasonable likelihood of confusion with any of the INTERCOSMO trademarks, the opposition is rejected for the reasons that follow.

### The Record

[4] The Opponent filed a statement of opposition on October 10, 2017. The Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act). The Opponent filed the affidavit of Celina Hong, a student-at-law of its agents who obtained printouts from the Internet and Canadian Trademarks Database (Hong affidavit). The Applicant filed the affidavit of Cristina Ramirez, its President (Ramirez affidavit). Both parties filed written submissions. A hearing was not requested.

### Evidential Burden and Legal Onus

[5] The Applicant bears the legal onus of establishing that, on a balance of probabilities, 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

### Grounds of Opposition

#### *Section 12(1)(d) ground of opposition*

[6] I will first begin with the section 12(1)(d) ground of opposition.

[7] Section 12(1)(d) of the Act states that a trademark is registrable if it is not confusing with a registered trademark. The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with a number of different trademarks including the INTERCOSMO, INTERNATIONAL COSMETICS and INTER COSMETIQUES trademarks.

[8] The material date for considering this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[9] The Opponent does not allege that the trademarks INTER COSMETIQUES or INTERNATIONAL COSMETICS are registered, nor include their registration numbers in the statement of opposition or the Opponent’s evidence. The Opponent fails to meet its evidential burden with respect to this ground of opposition.

[10] The Opponent sets out the following registrations all of which are owned by Beautyge Italy S.p.A. [see *U.S.V. Pharmaceuticals of Canada Ltd. v Sherman and Ulster Ltd.*, (1974), 15 CPR (2d) 79 (TMOB) which confirms that an opponent can rely upon a third party registration in relation to section 12(1)(d) ground of opposition].

Registration No.	Trademark	Goods
TMA320,473	INTERCOSMO & Design	Soaps, perfumes, essential oils, beauty-creams for face and body, powders, lipsticks and face-rouges, eye-shadows, bath-salts, hair-lotions, hair-sprays, hair-dyes, shampoos.
TMA874,375	INTERCOSMO ESTRO	Hair care products, namely, hair care lotions, hair care preparations, hair conditioners, hair masks, hair waxes, hair gels, hair mousses, hair sprays; and hair treatments, namely, hair waving preparations.
TMA834,470	INTERCOSMO NUTRILUX	Hair care products, namely, hair care lotions, hair care preparations, hair shampoo, hair conditioners, hair masks, hair gels, hair mousses, hair sprays, hair oils; and hair treatments, namely, hair colouring preparations, hair growth preparations, hair waving preparations.

### Test to determine confusion

[11] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5) of the Act. Finally, section 6(2) does not concern the confusion of the trademarks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Services, provided under the Mark, would believe that those Services were being provided by the owner of the INTERCOSMO trademarks, or that the Applicant was authorized or licensed by the owner of the INTERCOSMO trademarks.

### Inherent distinctiveness of the trademarks

[12] The INTERCOSMO trademarks have a higher degree of inherent distinctiveness than the Mark. The Mark is a coined word which includes the word cosmetic which describes a feature of the Applicant's Services, namely, that the wholesale and distributor services relate to cosmetics and similar products. In contrast, the INTERCOSMO trademarks all consist of or include the element INTERCOSMO, where the COSMO component may suggest outer space, space travel (see the definition in dictionary.com set out below). If rather than outer space or space travel, the COSMO component alludes to the word COSMETICS, it does so in a fanciful way.

a combining form meaning "world," "universe," used in the formation of compound words: cosmography; in contemporary usage, sometimes representing Russian *kosmo-*, it may mean "outer space," "space travel," or "cosmic ray": cosmonaut.

### Extent known and the length of time the trademarks have been in use

[13] This factor strongly favours the Applicant. Ms. Ramirez's affidavit provides evidence that the Mark has been used extensively for over thirty years in Canada:

- (a) The Applicant is a manufacturer and wholesale beauty supplier that offers a wide range of personal care, esthetics and spa products and has offered these services in Canada since the 1980s (para 3).
- (b) The Mark appears on indoor and outdoor signage, nametags, uniforms and receipts at the Applicant's three stores in Mississauga, Ottawa and Waterloo (Exhibit A2-C). Since the Mississauga store opened in 1984, the INTERCOSMETICS in-store locations have offered its services to over 20,000 Canadian companies in the spa industry (para 13).
- (c) The Mark appears on the INTERCOSMETICS online stores at *www.intercosmetics.ca* operated since 2004 (para 14; Exhibit F). In each of the years from 2015-2017 there were over 57,000 unique visits to the website (para 19).
- (d) Between 2013-2017, the INTERCOSMETIC Services had over \$30 Million gross revenue (para 23).

[14] In contrast, the Opponent's evidence of the use of the INTERCOSMO trademarks is relatively limited. The Opponent's evidence includes examples of the INTERCOSMO trademarks including on the *intercosmoonline.com* website (paragraphs 2-5; Exhibits 1-4) and various third party websites which sell and/or promote the sale of beauty care, hair care and salon products and services under the INTERCOSMO trademark (para 7, Exhibits 5-6). The INTERCOSMO trademark also appeared in two issues of Salon Magazine which appears to be available to Canadians. Setting aside potential hearsay issues, while this evidence may show that the registered products appeared on these websites as of the date of the printouts or archives, in the absence of any quantifiable sales information or the like or proof that Canadians accessed these websites or read Salon Magazine they are not evidence that the INTERCOSMO brand was known to a significant extent in Canada or has been used in Canada for a significant length of time.

### Nature of the goods, services, or business, and trade

[15] The registered goods and the Applicant's Services are closely related and may travel in the same or similar channels of trade. Both parties are in the business of personal care products. Further, the applied-for wholesale and distribution services reference some of the same products covered by the registrations including, for example, hair shampoos, dyes and lotions, soaps and essential oils. I find there to be less overlap between the wholesale and distribution of spa equipment and furniture as this equipment appears to be of a different nature than the personal care products in the relied upon registrations.

[16] While the Applicant provides evidence that it sells its products at wholesale because "many of the products are either in a bulk size that would be too large for personal use (for example, gallons of massage lotion) or are items that require training to use (for example, lash extension supplies)" and generally requires customers to show proof of business (Ramirez affidavit, para 5), there is no restriction in the INTERCOSMO registrations preventing the owner of this brand from doing the same thing. Furthermore, the appearance of the INTERCOSMO trademark on the Chalut Salon website suggests that the parties may target the same consumers (i.e.) salon owners.

### Degree of resemblance

[17] The degree of resemblance between trademarks will often have the greatest effect on the confusion analysis [*Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 at para 49]. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), [2006] 1 SCR 824 at para 20].

[18] I find that the trademarks at issue considered as a whole resemble each other in appearance, sound and idea suggested to a fair extent. While I acknowledge that there is a high degree of resemblance in appearance between the Mark and each of the INTERCOSMO trademarks due to the shared letters INTERCOSM, when sounded the parties' trademarks have far less of a resemblance due to the abbreviated and harsh O sound in INTERCOSMO. Further,

as a matter of first impression, given that each is a coined word and there is no evidence that consumers would understand the element COSMO to mean cosmetics, I do not find that the trademarks suggest similar ideas.

### Conclusion

[19] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark in association with the Services at a time when he or she has no more than an imperfect recollection of the INTERCOSMO trademarks used in association with the registered goods [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra*]. Section 6(2) of the Act states that there is a likelihood of confusion if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person. Confusion will also be found if consumers believe that the Applicant's Services are somehow approved, licensed or sponsored by the owner of the INTERCOSMO registrations [*Big Apple Ltd v BAB Holdings Inc* (2000), 8 CPR (4th) 252 (TMOB) at para 13].

[20] Having regard to the above, in particular the extensive and long standing use of the Applicant and limited degree of resemblance in idea suggested and as sounded, as a matter of first impression and imperfect recollection, and assessing the likelihood of confusion against each of the pleaded registrations, the balance of probabilities tips in favour of the Applicant. I do not find on a balance of probabilities that a consumer purchasing INTERCOSMETICS Services would infer that the Services were performed, sold or otherwise emanate from or were licensed, approved or sponsored by the owner of the INTERCOSMO registrations. As such, this ground of opposition is rejected.

### *Section 12(1)(b) ground of opposition*

[21] I will next consider the ground of opposition based on section 12(1)(b) of the Act. The material date for this ground of opposition is the date of filing the application [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60].

[22] The Opponent pleads that the Mark is not registrable under section 12(1)(b) of the Act in that it is clearly descriptive or deceptively misdescriptive of the character or quality of the Services since the prefix “inter” commonly means “international”, and use of the phrase “intercosmetics” or “international cosmetics” is clearly descriptive or deceptively misdescriptive of the character or quality of the Services, namely services to the cosmetics industry which are international in scope.

[23] The Opponent has made no submissions in support of the section 12(1)(b) ground of opposition. I, therefore, do not intend to engage in a lengthy analysis of this ground.

[24] In deciding the issue as to whether the Mark is clearly descriptive, the Mark must be considered as a matter of first impression within the context of the Services [*John Labatt Ltd v Carling Breweries Ltd* (1974), 18 CPR (2d) 15 at 19 (FCTD); *Ontario Teachers' Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60]. “Character” means a feature, trait or characteristic of the services and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[25] Finally, in determining whether a trademark is registrable under section 12(1)(b) of the Act, the Registrar must not only consider the evidence but also apply common sense [*Neptune SA v Attorney General of Canada* (2003) 29 CPR (4th) 497 (FCTD)]. One of the most important purposes of section 12(1)(b) is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use [*General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at 112-113].

[26] The Mark includes the word COSMETICS along with the prefix INTER-. I am prepared to take judicial notice of the following definition of inter- in *www.dictionary.com*:

inter-

a prefix occurring in loanwords from Latin, where it meant “between,” “among,” “in the midst of,” “mutually,” “reciprocally,” “together,” “during” (intercept; interest); on this model, used in the formation of compound words (intercom; interdepartmental).

[27] Given the variety of words that “inter” may indicate, I do not find that the Opponent has met its evidential burden with respect to its allegation that consumers would find the Mark clearly



descriptive or deceptively misdescriptive of Services which are international in scope. This ground of opposition is therefore rejected.

*Section 16(1)(a) ground of opposition*

[28] The section 16(1)(a) ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark as it is confusing with the INTERCOSMO trademarks, INTER COSMETIQUES trademark and the INTERNATIONAL COSMETICS trademark all of which the Opponent alleges have been previously used or made known in Canada. First, in view of section 17(1) of the Act, an opponent may not rely upon use or making known of a trademark by third parties in challenging an applicant's entitlement to registration. Second, even if the Opponent owned one or more of the pleaded trademarks, the Opponent fails to meet its evidential burden to show use or making known of any of its trademarks prior to the material date of December 31, 1991 [section 16(1)(a) of the Act]. Accordingly, this ground of opposition is rejected.

*Section 16(1)(b) ground of opposition*

[29] The Opponent alleges that the Applicant is not the person entitled to registration pursuant to section 16(1)(b) of the Act, because the Mark is confusing with the previously filed applications for the INTERCOSMO trademarks. This ground of opposition fails because section 16(4) of the Act requires that applications relied upon be pending as of the advertisement date of the opposed application. As each of the relied-upon marks was registered prior to the advertisement date, the Opponent fails to meet its evidential burden [*Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v Kmart Canada Ltd.* (1997), 76 CPR (3d) 526 (TMOB) at 528]. This ground of opposition is therefore rejected.

*Section 2 grounds of opposition*

[30] The Opponent alleges that the Mark is not distinctive because it is clearly descriptive or deceptively misdescriptive. However, for the reasons outlined above with respect to the section 12(1)(b) ground of opposition, I do not find that the Opponent has met its evidential burden with

respect to its allegation that Mark is clearly descriptive or deceptively misdescriptive. Consequently, this prong of the non-distinctiveness ground of opposition is rejected.

[31] The Opponent also alleges that the Mark is not distinctive of the Applicant's Services due to the use of the INTERCOSMO, INTER COSMETIQUES and INTERNATIONAL COSMETICS trademarks.

[32] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services from those of others throughout Canada, there is also an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, one or more of the relied upon trademarks had become known sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657].

[33] With respect to the INTERCOSMO trademarks, the Opponent's evidence includes printouts of archived versions of the *intercosmoonline.com* website, a google.ca search for "intercosmo" and third party websites which sell or promote the INTERCOSMO brand (several of which indicate Canada including the Chalut website which includes several store addresses in Quebec and listings for various INTERCOSMO hair products on its website), and two Salon Magazine issues which include advertisements for INTERCOSMO. Assuming for the purposes of this decision that the Opponent's evidence is sufficient to meet its burden, I find that the Applicant had met its legal onus of proving that the Mark is distinctive for the same reasons as set out with respect to the section 12(1)(d) ground of opposition.

[34] With respect to the INTERNATIONAL COSMETICS trademark, the Opponent's evidence includes a google.ca search of the term "International Cosmetics" and printouts of the *www.intlcosmetics.com* website including a Canadian page. These pages explain that International Cosmetics provides expertise in regulatory compliance for cosmetic and chemical industries including the following topics with respect to Canada – DIN Application, Label / Claim Review, Natural Health Product Applications and Cosmetic Notifications (Exhibits 19-20).

[35] With respect to the INTER COSMETIQUES trademark, the Opponent provides printouts of the [www.intercosmetiques.ca](http://www.intercosmetiques.ca) website including archived versions of the website which describe INTER COSMETIQUES as a private label skin care products manufacturer (Exhibit 14).

[36] While Ms. Hong's evidence results in an inference that a number of Canadians may have come into contact with the International Cosmetics or INTER COSMETIQUES trademarks, taken as a whole it is not sufficient to show that either of these trademarks has a reputation in Canada which is substantial, significant or sufficient to negate the distinctiveness of the Mark. As such, the Opponent has not met its evidential burden with respect to the pleaded INTERNATIONAL COSMETICS or INTER COSMETIQUES trademarks.

[37] For the reasons in paragraphs 32-36, this ground of opposition is rejected.

#### *Sections 30(a), 30(b) and 30(i) Grounds of Opposition*

[38] The Opponent alleges that the application does not conform to the requirements of section 30(a) of the Act as it does not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under section 30(a) is a light one and may be met simply through argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd.* (1984), 1 CPR (3d) 101 (TMOB) at 104; *Air Miles International Trading B.V. v Deutsche Lufthansa AG* (2010), 89 CPR (4th) 230 (TMOB) at para 30]. In this case, the Opponent has not filed any evidence nor made any submissions with respect to this ground of opposition. Furthermore, the *Goods and Services Manual*, which sets out a representative list of acceptable goods and services includes the following analogous acceptable services "wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies" [see *Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 at para 29 (TMOB) which confirms that the Registrar may exercise his to discretion to check it]. The section 30(a) ground of opposition is therefore rejected.

[39] In its section 30(b) ground of opposition, the Opponent alleges that the Applicant has not used the Mark in Canada since the date claimed. However, there is no evidence which puts the claim of use since 1991 in issue. Consequently, the Opponent does not meet its initial evidential

burden for this ground and it is rejected [*Labatt Brewing Co Ltd v Molson Breweries, A Partnership*, 1996 CanLII 17947, 68 CPR (3d) 216 (FCTD)].

[40] The Opponent alleges that the Applicant could not make the statement it is entitled to use the Mark in view of confusion with the INTERCOMSO, INTERNATIONAL COSMETICS and INTER COSMETIQUES trademarks. The jurisprudence suggests that non-compliance with section 30(i) can be found where there are exceptional circumstances such as bad faith which render the applicant's statement untrue [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB), at 369 ]. With respect to the section 30(i) ground of opposition, the Opponent has submitted no such evidence nor made any submissions with respect to this ground of opposition. Accordingly, this ground of opposition is rejected.

#### Disposition

[41] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

Agents of Record

Miller Thomson LLP

For the Opponent

McMillan LLP

For the Applicant

## SCHEDULE A

(1) Wholesale sales and distribution services for skin care preparations, namely creams, serums, masks, illuminating emulsions, cleansing foams and milks, toners, peeling preparations, moisturizers, and skin packs; personal care products, namely soaps; depilatory preparations; sun tan preparations for use before, during, or after exposure to the sun; skin care products, namely cleansing creams, milks and oils, tonic lotions, essential oils, face and body creams and lotions, beauty masks; make-up for the face, eyes and lips in the form of sticks, liquids and powders, colour preparations, blushers, pencils, and mascara; preparations to be used before, during or after a bath namely salts, powders, foam baths, and oils; manicure and pedicure preparations, namely nail polish, nail polish remover, ridge filler, false nails and glues, creams, and sprays; preparations for the hair, namely shampoos, dyes, lotions, creams, and setting and styling preparations; dermal regulators, skin care preparations namely exfoliating and refining preparations, honey treatment and yeast treatment; intensive liposome complexes; aromatherapy, anodyne, emollient and therapeutic products, namely gels, clays, mud; spa equipment, namely facial equipment, body equipment, non-surgical facelift machines, microdermabrasion equipment, facial steamers, electrolysis machines, medical pulsed light devices; spa furniture, namely manicure tables, chairs and stools, pedicure footspas, pedicure furniture, trolleys and display units, treatment lounges, massage therapy and spa tables, showers and specialized tables, reception desks, professional lamps and magnifying lamps; spa supplies and accessories, namely alcohol, tweezers and skin tools, face brushes and sponges, body gloves and loofahs, spatulas, jars, bowls and mirrors