



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

**Citation: 2015 TMOB 56**  
**Date of Decision: 2015-03-27**

**IN THE MATTER OF AN OPPOSITION  
by Heather Ruth McDowell to application  
No. 1,478,507 for the trade-mark HONEY  
MOMENTS in the name of Laverana  
GmbH & Co. KG**

[1] On April 26, 2010, Laverana GmbH & Co. KG (the Applicant) filed an application to register the trade-mark HONEY MOMENTS (the Mark) for use with a number of personal care, pharmaceutical and cosmetic products. The application was based on the Applicant's proposed use in Canada and its registration in the European Union and use in Germany. The application was subsequently amended to delete the use and registration abroad basis and several goods including the decorative cosmetics and pharmaceutical products listed therein. The Goods (as amended) are set out below:

(1) Perfumery goods, namely liquid perfumes, perfume oils, eau de parfum, perfumed extracts for tissues and perfumes, perfumes in solid form; essential oils, namely for aromatherapy, for the treatment of acne and scars as a topical application, for use in the manufacture of scented products; cosmetics, namely face creams and lotions, skin-cleansing lotions and creams, hand and body lotions and creams; sun care preparations; footcare preparations; foot creams and lotions; exfoliants for the body, face, feet or skin; abrasive implements, namely pumice stones; non-medicated powders and lotions for foot spas; body care products, namely perfumed body sprays for cosmetic purposes, refreshing body sprays for cosmetic purposes, gels and lotions for skin care; shower gels, hair care products, namely hair gels; shampoos and hair lotions, conditioning rinses


(conditioners) for the hair, combined shampoo and conditioner, hair sprays, styling mousse; hair dyes; baby and infant care products, namely baby oils, baby body creams and lotions; bath oils, skin oils and creams; anti-wrinkle creams; massage oils; grooming products for men, namely face creams and lotions, hair lotions, hand and body creams, skin- cleansing lotions and creams; deodorants for body care; products for oral hygiene (not for medical purposes), namely mouth wash; preparations for the mouth and for cleaning the mouth, namely tooth powder, breath-freshening and mouth-freshening preparations, mouth sprays, mouth rinses, dentifrices; toothpaste; antiperspirants.

The application includes a priority claim of April 15, 2010.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 13, 2011.

[3] On December 13, 2012, Heather Ruth McDowell (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) the Applicant is not entitled to registration of the Mark, pursuant to section 16 of the *Trade-marks Act* RSC 1985, c T-13 (the Act), because use of the Mark is likely to result in confusion with the Opponent's trade-marks HONEY and HONEY & Design;
- (b) the Mark is not registrable, pursuant to section 12(1)(d) of the Act, because it is confusing with the following registrations of the Opponent:

Registration No.	Trade-mark
TMA767,134	
TMA767,075	HONEY

- (c) the Mark is not distinctive of the Applicant and is incapable of being distinctive of it;

- (d) the Applicant could not have been satisfied, under section 30(i) of the Act, of its entitlement to use the Mark since a search of the Register or a common law search would have located the Opponent's trade-marks HONEY and HONEY & Design; and
- (e) the Applicant has not used the Mark in Germany as alleged, or if the Mark was or is in use in Germany, such use was by a third party and does not comply with the requirements of section 50 of the Act.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. While the counter statement references a section 30(e) ground of opposition, there is no such ground set out in the statement of opposition.

[5] The Opponent filed as its evidence the affidavit of Elenita Anastacio. Ms. Anastacio was cross-examined and a transcript was filed. The Applicant filed as its evidence the affidavit of Sazia Aftab and a certified copy of sixteen registrations.

[6] The Applicant filed a written argument and both parties attended a hearing on November 21, 2014.

#### Material Dates

[7] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - 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) at 424];
- sections 38(2)(c)/16(2) and 16(3) – the priority filing date of the application; and
- sections 38(2)(d)/ 2 - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

## Evidential Burden and Legal Onus

[8] It is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[9] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

## Grounds which Can be Summarily Rejected

[10] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

[11] The section 30(d) ground of opposition alleges that the Applicant had not used the trademark in Germany. As the Goods filed for on the basis of section 16(2) of the Act have been deleted, the ground of opposition based on section 30(d) of the Act is no longer applicable and is rejected.

[12] The section 16 and 2 grounds are rejected because the Opponent has not met its initial evidential burden. The Opponent has not evidenced that its HONEY trade-marks were used or made known in Canada as of the applicable material dates. Although the Opponent's registrations for its trade-marks refer to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

Remaining Ground of Opposition

Section 12(1)(d) Ground of Opposition

[13] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with registration Nos. TMA767,075 and TMA767,134 for HONEY and HONEY & Design. I find that the most pertinent of these is the Opponent's trade-mark HONEY set out below. A consideration of the issue of confusion between this registration and the Mark will effectively decide the outcome of this opposition.

<b>Registration No.</b>	<b>Trade-mark</b>	<b>Wares and Services</b>
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TMA767,075	HONEY	<p><b><u>WARES:</u></b>            (1) Clothing, namely, trousers, jeans, sweat pants, yoga pants, active wear, pants, sweaters, sweatshirts, polo shirts, shirts, skirts, blouses, dresses, hosiery, jackets, blazers, coats, ski jackets, down filled jackets, fur jackets, wool coats, shorts, bathing suits, loungewear; lingerie; footwear, namely, shoes, sandals, boots, slippers; men's, women's and children's shoes made of leather, suede or silk, namely pumps, high heels, dress shoes of any kind, sneakers, running shoes, basketball shoes, golf shoes, training shoes, court shoes, track shoes, beach shoes, namely sandals, flip flops and thongs; headwear, namely, hats, caps, bandannas, headbands, visors; jewellery; fashion accessories, namely, scarves, shawls, purses, gloves, watches; hair accessories, namely, combs, brushes, hair bands made of cloth or plastic, barrettes, scrunchies, ponytail holders, hair clips, hair pins, and hair ornaments; belts, sunglasses; cosmetics, namely foundation made of liquid or powder, face creams, blush, eye shadow, eye liner, mascara, lipstick, lip gloss, lip liner, make-up bags sold empty; giftware, namely, lamps, trays, vases; ornaments and figurines made from ceramic, chinaware,</p>
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glass, porcelain; candy dishes.

**SERVICES:**

(1) Retail store services, namely, the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet.

[14] I have exercised my discretion and checked the register to confirm that this registration is extant [*Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[15] 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 trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

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] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

### *Inherent Distinctiveness*

[16] At the hearing both parties argued that the HONEY and HONEY MOMENTS trade-marks were inherently distinctive as there is no evidence that honey is an ingredient found in the goods of either party. That being so, I still decline to find that either the HONEY or HONEY MOMENTS trade-marks have a high degree of inherent distinctiveness since the word “honey” has a laudatory connotation being a term of endearment and/or indicating something sweet or sweetness [see, for example, the definition of honey in the dictionary *Canadian Oxford Dictionary* (1998 ed); see *Tradall SA v Devil’s Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 which confirms that I may take judicial notice of dictionary definitions]. Trade-marks with laudatory connotations are typically considered weak trade-marks [*Perfection Foods Ltd v Hiram Walker & Sons Ltd* (1998), 21 CPR (3d) 136 at 138 (TMOB)].

### *Degree of Resemblance*

[17] The first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)]. In *Masterpiece, supra*, the Supreme Court of Canada advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-marks that is particularly striking or unique [para 64]. In that case, at issue was the trade-name used by Masterpiece, Inc, MASTERPIECE, and its trade-marks MASTERPIECE THE ART OF LIVING and MASTERPIECE THE ART OF RETIREMENT LIVING, versus Alavida’s trade-mark - MASTERPIECE LIVING. Mr. Justice Rothstein reasoned that MASTERPIECE was the striking or unique aspect of each trade-name/trade-mark which led to a finding of confusion. It must be observed, however, that in these trade-marks there is no striking element other than MASTERPIECE; rather the remaining words are suggestive of retirement residences. In this case, I do not consider either of the components HONEY or MOMENTS to be particularly striking as they are ordinary English words. Rather, the striking and unique aspect of the Mark is the fact that it consists of a unitary phrase HONEY MOMENTS which is comprised of two components which typically do not appear together.

[18] The Opponent submits that there is a significant degree of resemblance between the trade-marks because the Mark incorporates the whole of its HONEY trade-mark as its first

component. Further, the Opponent submits that consumers would understand that MOMENT suggests the time when or after you use HONEY brand products.

[19] I agree with the Applicant that, when the Mark is considered as a whole, the suffix MOMENTS diminishes the degree of resemblance in sound and appearance between the parties' respective trade-marks. Further, I agree with the Applicant that the trade-marks are distinguishable in terms of ideas suggested. The Mark is suggestive of a sweet or delightful time which is not an idea suggested by the Opponent's trade-mark. With respect to the Opponent's submissions that a consumer is likely to think that HONEY MOMENTS indicates the time when a HONEY brand product is used, in the absence of evidence of use of the Opponent's trade-mark, I find that a Canadian consumer is unlikely to think this as there is no evidence that any consumers have been exposed to the Opponent's brand HONEY.

#### *Extent Known and Length of Time in Use*

[20] In the absence of evidence of use of either party's trade-marks, these factors do not favour either party. While a declaration of use has been filed with respect to the Opponent's registration for the trade-mark HONEY, this only entitles me to assume de minimis use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. De minimis use does not support a conclusion that the marks have become known to any significant extent, nor that the marks have necessarily been used continuously since the date stated.

#### *Nature of the Goods, Services and Trade*

[21] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services as defined in the application for the Mark and in the Opponent's registration that govern the assessment of the likelihood of confusion [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[22] The Opponent's registered goods include clothing, footwear, headwear, jewellery, fashion accessories, hair accessories, cosmetics, giftware and the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet. The Goods include perfumery goods,



essential oils, body care products, cosmetics, namely, face creams and lotions, hair care products, hair dyes, baby and infant care products, and oral hygiene products. This factor favours the Opponent since similar to its cosmetics many of the Goods appear to target similar consumers (those that are interested in improving their appearance). As the nature of goods is the same, in the absence of relevant evidence from the Applicant, it is reasonable to infer that the channels of trade would be identical or very similar.

*State of the Register Evidence*

[23] The Applicant filed as part of its evidence an affidavit of Sazia Aftab, a legal assistant employed by the agent for the Applicant. Ms. Aftab’s affidavit attaches the results of a search she performed for active registered trade-marks including HONEY as well as particulars of the marks identified (Exhibits A and B). The Applicant also filed a certified copy of a number of registrations including HONEY. Of the trade-mark registrations included in the Applicant’s evidence the following include HONEY as a dominant element and are for use with cosmetics, personal care products, hair care products and the like:

Trade-mark	Owner	Goods and Services
A TOUCH OF HONEY (TMA595,003)	Thentiz International Inc.	Cosmetic products, namely, foot lotion, conditioning cream, moisturizing cream, cleanser, face and skin toner, tonics and refreshers, face cream, skin protection cream, foundation and base cream, skin cream, hair shampoo.
SPRING HONEY (TMA170,342)	The Procter & Gamble Company	Cosmetics and toilet preparations.
HONEY I’M STRONG (TMA841,182)	The Procter & Gamble Company	Hair care preparations
BEELINE HONEY (TMA748,751)	The Procter & Gamble Company	Hair colour
HAPPY HONEY	The Procter &	Hair tinting, dyeing and coloring preparations.

Trade-mark	Owner	Goods and Services
(TMA143,976)	Gamble Company	
HONEY DO (TMA766,763)	Victoria's Secret Stores Brand Management, Inc.	Personal care products, namely, lip gloss; makeup; body lotions; body creams; body sprays; body washes; scented body spray; body glitter.
NATURAL HONEY (TMA329,528)	The Colomer Group Spain, S.L.	Body and beauty care preparations, namely, skin and face moisturizer.
NATURAL HONEY (TMA249,122)	The Colomer Group Spain, S.L.	Permanent wave curling lotions and neutralizers and shampoo.
TOASTED HONEY (TMA547,379)	California Tan, Inc.	Skin care products, namely: bath gels, lotions, and bath and scented oils, scented body sprays, bath foam, skin cleansers; moisturizers; sunscreens; bath/body products, namely: skin tanning creams and sun tan preparations in the nature of foams, gels, lotions, oils, mousses, cleansers, sprays, mists and creams; and creme gels for use in tanning.
HONEY DIPP (TMA796,527)	Honey Dipp Inc.	<p><b><u>GOODS:</u></b></p> <p>(1) Body care products, namely, skin care preparations, lip care preparations, and soaps.</p> <p>(2) Sponges, namely, bath sponges; pumice stones; loofah mitts, bath puffs, soap dishes, soap bags, and bath slippers.</p> <p>(3) Candles.</p> <p>(4) Brushes, namely, bath brushes, manicure brushes, foot brushes, and body scrubbing brushes.</p> <p><b><u>SERVICES:</u></b></p> <p>(1) Sales, namely, wholesale, retail, and online sales of pumice stones, loofah mitts, bath puffs, soap dishes, soap bags, bath sponges, bath slippers, and candles, and of body care products, namely, skin care preparations, lip care preparations, and soaps</p> <p>(2) Sales, namely, wholesale, retail, and online sales, of brushes, namely, bath brushes, manicure brushes, foot brushes, and body scrubbing brushes.</p>

Trade-mark	Owner	Goods and Services
HONEY BUNNY BUZZ BALM (TMA741,331)	Wolfe Honey Company Inc.	Lip balm

[24] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Ms. Aftab’s searches have identified 10 trade-marks standing in the name of seven owners including HONEY as a dominant component. While I agree with the Opponent that the state of the register evidence is insufficient to find that HONEY prefixed marks have been commonly adopted, I am prepared to find that the evidence results in the inference that the Opponent does not have a monopoly over the use of the component HONEY in the personal care products sector. As such, this factor slightly favours the Applicant.

*Broad Scope of Protection Afforded to Word Marks*

[25] The Opponent submits that its registration for the trade-mark HONEY is entitled to a broad scope of protection since it is a word mark and that if the Applicant is granted a registration for the Mark nothing would prevent the Applicant from using the Mark in a confusing form (ie) with a significant emphasis on the word HONEY.

[26] The Opponent draws my attention to the *Masterpiece, supra* and *Mr Submarine, supra* decisions in support of its arguments. I am also aware of the recently released *Les Restaurants La Pizzaiolle Inc v Pizzaziolo Restaurants Inc*, 2015 FC 240 (FC) decision which discusses how the *Masterpiece* and *Mr Submarine* cases direct confusion between two trade-marks to be assessed. At paragraph 61, LeBlanc J sets out the following principles:

- i. The trade-mark on an application for registration may consist either of one word or a

group of words serving as a mark, or it may be a design, or it may be a word or group of words accompanied by a design; the applicant may, but is not obliged to, identify a colour as being characteristic of the mark for which registration is being sought (*Masterpiece*, above at para 54);

- ii. The expression “degree of resemblance” from paragraph 6(5)(e) means that there may be a likelihood of confusion not only in the appearance of similar competing marks but also among marks with some differences (*Masterpiece*, above, at para 62);
- iii. Given that the registration of a trade-mark confers, under section 19 of the Act, exclusive rights upon its owner, the issue is whether the trade-mark for which registration is being sought creates confusion with a registered word mark must be examined keeping in mind not only the current use of the registered mark but also the likelihood of confusion arising from the use of this mark which is nonetheless permitted by the registration; the current use of registered word mark does not therefore limit the rights of its owner because the registration of the mark grants the owner the right to use the words that constitute the mark in any size and with any style of lettering, colour or design; (*Masterpiece*, above, at paras 55-57; *Mr. Submarine Ltd v Amandista Investment Ltd*, [1988] 3 FC 91 (FCA), [1987] FCJ No 1123 (QL) at pages 102-103).
- iv. Therefore, an analysis of the likelihood of confusion that only takes into account limited use of a registered word mark would be incorrect in law, as it should not replace an examination of other potential uses within the registration; thus, a subsequent use, that is within the scope of a registration, of a registered word mark that is the same or very similar to a competing mark, will show how that registered mark may be used in a way that is confusing with an existing mark (*Masterpiece*, above, at paras 58-59).

[27] While I agree with the Opponent that word marks are entitled to a broad scope of protection and that there is no inherent restriction on how the Mark may appear once registered (for example, with respect to size, style of lettering, colours or design features) (*Masterpiece* para 55, *Pizzaiolo* at para 66), this principle does not extend so far as to automatically result in a likelihood of confusion. The state of the register evidence confirms that the Opponent does not have a monopoly for the component HONEY.

[28] The focus on the potential uses of the Mark where the HONEY component is emphasized over the MOMENTS component suggests an analysis that focuses on the discrete parts of the trade-mark as opposed to the trade-marks as a whole [*Compagnie Générale des Établissements Michelin v Sailun Co, Ltd*, 2014 TMOB 32 (CanLII) at paras 27-31]. Further, it ignores the fact that such an emphasis would not impact the degree of resemblance as sounded or in idea

suggested. Finally, unlike in the *Masterpiece* case, the second component of the Mark, MOMENTS, is not suggestive of the Goods.

[29] As such, the fact that word marks are afforded a broad scope of protection only slightly favours the Opponent.

*Potential for Brand Extension is not a Relevant Surrounding Circumstance*

[30] At the hearing, the Opponent pointed to its registration for HONEY Design and application for PINK & HONEY for use with clothing, footwear, headwear, cosmetics and retail store services and suggested that brand extension may be a relevant surrounding circumstance in this case (Anastacio affidavit, Exhibit B). As the Opponent has not filed any evidence of reputation of its trade-marks, this is not a relevant surrounding circumstance.

*Deletion of Goods does not Lead to an Adverse Inference*

[31] The amendment of the application to delete the decorative cosmetic products listed therein does not impact my assessment of confusion with respect to the application as it stands now. The fact of the deletion is not a relevant surrounding circumstance.

*Conclusion*

[32] Taking into consideration all of the relevant factors, I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark HONEY. While the parties' goods overlap and that their channels of trade may be the same, given the limited ambit of protection afforded to the Opponent's laudatory trade-mark, the state of the register evidence and as there is no evidence of the Opponent's use of the trade-mark HONEY, the difference in the parties' trade-marks in appearance, sound and idea suggested is sufficient to rule in favour of the Applicant. The section 12(1)(d) ground of opposition is rejected.

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office