



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

**Citation: 2015 TMOB 38
Date of Decision: 2015-02-28**

**IN THE MATTER OF AN OPPOSITION
by Sally Beauty International, Inc. to
application No. 1,476,364 for the trade-
mark IONIKA in the name of ADA
International Beauty Inc.**

[1] ADA International Beauty Inc. (the Applicant) has applied for the trade-mark IONIKA for use in association with a number of hair care preparations and curling and straightening irons. Sally Beauty International, Inc. (the Opponent) has opposed this application primarily on the basis that the IONIKA trade-mark is confusing with its registration for and previous use of the ION and NATURAL IONIC ENERGY trade-marks in association with various hair care products.

[2] For the reasons that follow, I find that this application should be refused.

Background

[3] On April 9, 2010, Kapow Beauty, LLC filed an application for the trade-mark IONIKA (the Mark) based on proposed use in association with the following Goods (as amended). The application was subsequently assigned to ADA Beauty International, LLC.

(1) Hair care and hair styling preparations, namely, shampoo, hair conditioner, hair rinses, hair lotion, hair wax, hair cream, hair colorant, hair dye, hair spray, hair gel, hair

mousse; hair bleaching preparations.

(2) Electric hair curling irons; electric hair straightening irons; electric hand-held hair styling irons.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 1, 2012.

[5] On March 22, 2012, the Opponent opposed the application on several grounds. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of one of its grounds of opposition. The remaining grounds turn on the determination of the likelihood of confusion between the Opponent's registrations for the trade-marks ION, ION SENSITIVE SCALP & design and NATURAL IONIC ENERGY and its use of these trade-marks (see sections 2 and 16 of the Act). The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[6] The Opponent's evidence consists of an affidavit of Susan J. Walker, its Vice President Marketing and a certified copy of each of its registrations. The Applicant filed as its evidence the affidavit of Zak Mayo, its Managing Director and Simone Ndiaye, a paralegal employed by the Applicant's agent. Both parties filed a written argument. The Opponent was represented at a hearing held on October 27, 2014.

Material Dates and Onus

[7] While various grounds of opposition are pleaded, the determinative issue for decision is whether the applied-for trade-mark IONIKA is confusing with the Opponent's trade-mark ION. The earliest material date to assess the issue of confusion is the date the application was filed, April 9, 2010, while the latest material date is the date of my decision [see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206-208 for a review of material dates in opposition proceedings.]

[8] Before considering the issue of confusion between the parties' marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on the

opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[9] With respect to (i) above, there is an evidential burden on the 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 the 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 the applicant to show that the application does not contravene the provisions of the Act as alleged by the opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

Section 30(i) Ground of Opposition

[10] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly rejected.

Section 12(1)(d) Ground of Opposition

[11] In support of the section 12(1)(d) ground of opposition, the Opponent relies on the following registrations:

Trade-mark	Registration No.	Goods
ION	TMA610,598	Hair care products, namely, hair shampoo and conditioner, hair moisturizing treatment, hair reconstructor treatment, hair finishing treatment, hair fixative, personal detergents for use on the hair and body, hair styling products, namely,

		hair spray, styling gel, mousse, styling lotion, styling glaze, styling spritz, volumizing spray, texturizing spray, temporary straightener, pomade. Hair coloring preparations. Electric irons for styling hair. Electric hair wavers. Electric hair rollers. Electric hot brushes; hair dryers; hair dryer attachments, namely hair piks and diffusers; and hand-held electric brush irons.
ION	TMA662,999	Hair combs and brushes.
ION SENSITIVE SCALP & design	TMA723,831	Hair care preparations.
NATURAL IONIC ENERGY	TMA718,993	Hair dryers, flat irons, electric curlers, and curling irons.

While the affidavit of Ms. Walker speaks to a “family of ION trade-marks”, as the Opponent has failed to evidence use of the ION SENSITIVE SCALP or NATURAL IONIC ENERGY trade-marks, the Opponent cannot rely on a family of marks [*McDonald’s Corp v Yogi Yogurt* (1982), 66 CPR (3d) 101 (FCTD)].

[12] The material date for considering this issue 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)]. I have exercised the Registrar’s discretion to confirm that these registrations are in good standing as of today’s date and, as such, the Opponent has met its burden [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 at 411-412 (TMOB)]. I will focus my analysis on the likelihood of confusion between the Mark and the Opponent’s registration Nos. TMA610,598 and TMA662,999 for the trade-mark ION as I consider these marks most closely resemble the applied-for mark IONIKA.

[13] There is a likelihood of confusion 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 (section 6(2) of the Act). In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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.

[14] These criteria 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

[15] The *Canadian Oxford Dictionary* defines ion as “an atom, molecule, or group that has lost one or more electrons ... or gained one or more electrons...” and ionic “of, relating to, or using ions” [*Tradall SA v Devil’s Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions].

[16] The description of the Applicant’s IONIKA styling iron states that its precision engineered 1 1/3 inch floating plates infuse more negative ions to seal in healthy moisture, making your hair shine like never before (Mayo, Exhibit 4). Further, the Applicant’s evidence is that ions are beneficial in hair care (see, for example, the product descriptions in the Nidaye Exhibits SN-2). As the Goods are hair care preparations and appliances and the Mark is almost identical to the dictionary word ionic, the Mark is suggestive of products which have or result in the creation of ions.

[17] In view of the dictionary definition, I find that the Opponent’s ION trade-mark also suggests that the associated hair care preparations, combs and brushes, have ions or result in the creation of ions.

[18] This factor favours neither party as both parties’ trade-marks are suggestive of products which have or result in the creation of ions.

extent of use and length of time in use

[19] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. These factors favour the Opponent as its ION trade-mark appears to be used more extensively and for a longer period of time than the Mark.

[20] The Opponent's ION trade-mark appears directly on products and product packaging (Walker affidavit, Exhibits D and E). The Opponent's invoices and sales figures reference sales of ION brand shampoo, conditioner, hair moisturizing treatment, and gel since 2006 (Walker affidavit, Exhibits B). The Opponent's affiant, Ms. Walker, explains that between the years 2009-2012 the Opponent has sold over \$5 Million CDN in association with goods with its registered trade-marks and has spent over \$90,000 on the promotion of its trade-marks (Walker affidavit, paras 5,9). Such extensive use increases the ambit of protection to be afforded to the Opponent's ION trade-mark [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)].

[21] In contrast, the Mark has appeared directly on products and/or on product packaging of brushes, straightening and curling irons and hair dryers since 2010 (Mayo affidavit, para 10, ZN-5). Between 2010-2012 approximately 75,000 units were sold (Mayo affidavit, para 11), representing over \$500,000 in sales (Mayo affidavit, para 12).

degree of resemblance

[22] The Mark resembles the Opponent's trade-mark ION to a fair degree visually and as sounded since it incorporates the whole of the Opponent's ION trade-mark. Underscoring the resemblance is the fact that it is the first part of the Mark which is identical to the Opponent's trade-mark ION [*Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. Further, I find that both parties' marks suggest the same idea, namely that the associated hair care products contain ions or result in the creation of ions which improve the appearance of hair. This factor therefore also favours the Opponent.

nature of goods, business and trade

[23] While the Opponent's goods are sold in its 164 Sally Beauty retail stores and on-line (Walker affidavit, paras 2,3,12) and the Applicant's goods are sold at Winners stores (Mayo affidavit, para 8), this factor favours the Opponent. The nature of the goods is identical. The nature of trade is also identical since both parties appear to target the same consumer [*Precision Door & Gate Service Ltd v Precision Holdings of Brevard, Inc*, 2012 FC 496 at para 35]. Finally, although the channels of trade are different at present as there is no restriction in the statement of goods this does not favour the Applicant.

state of the Register and marketplace

[24] Ms. Ndiaye's affidavit includes the results of searches for trade-mark applications and registrations including ION covering hair and cosmetic products (Ndiaye affidavit, Exhibit SN-1). Ms. Ndiaye also attaches printouts of the results for searches for ION or ION* in the beauty department of *www.amazon.com* (Ndiaye affidavit, Exhibit SN-2) and the results of searches to show whether the trade-marks in Exhibit SN-1 are in use in Canada (Ndiaye affidavit, Exhibit SN-3).

[25] I do not consider the evidence from *www.amazon.com* to be strong evidence regarding the use of third party ION trade-marks in the Canadian marketplace. There is no evidence that any of these goods have been sold in Canada, purchased by Canadians or are otherwise known to Canadians.

[26] Of the trade-mark registrations and allowed applications attached to Ms. Ndiaye's affidavit at Exhibit SN-1, six include ION or IONIC as a dominant element, stand in the name of five different owners and are for use in association with products for hair: ION SHINE (TMA669,883); MAGIC IONIC (1,507,943) BIO IONIC (TMA575,522); IONZYME (TMA634,248); IONZYME FOCUS (1,460,184) and IONIC BREEZE (TMA656,965). There are at least 5 other trade-marks for other beauty products including ION or IONIC in the name of different owners such as ION2 COMPLEX (TMA781,191); ION FUSION MIX (1,483,411); IONYX (TMA751,795); ION (1,531,255); and IONIC WHITE (TMA724,658). Ms. Ndiaye's evidence, however, shows one of these products as being available in Canada (see Exhibit SN-3

for a printout advertising the ION SHINE hair brush). The Opponent submitted at the hearing that only the registrations in the hair care field were relevant as this was the field that both parties' marks covered.

[27] State of the Register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*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)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Further, the marks comprising the common elements should be in fairly extensive use in the market in which the marks under consideration are being used or will be used [*Kellogg Salada, supra* at 359]. As only five registrations were located in the hair care field and only one of the marks was confirmed as being in use means that I cannot infer that Canadian customers are accustomed to see numerous trade-marks consisting of or containing ION in the hair care field such that they can distinguish them.

prior registration

[28] The Applicant provides a certified copy of registration No. TMA818,733 for the trade-mark IONIKA design (Zak Mayo affidavit, Exhibit ZN-7). I do not consider this registration to be relevant as it does not give the Applicant the automatic right to obtain a further registration no matter how closely the application is related to it [*American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB) at 576; *Courtyard Restaurant Inc v Marriott Worldwide Corp*; 2006 CarswellNat 5371 (TMOB) at para 58].

conclusion re likelihood of confusion

[29] 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 IONIKA trade-mark on the Applicant's hair care products at a time when he or she has no more than an imperfect recollection of the Opponent's ION trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[30] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I arrive at the conclusion that the probabilities of confusion between the Mark and the Opponent's trade-mark ION are evenly balanced between a finding of confusion and of no confusion. The Applicant has therefore not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the ION trade-mark. While I have had regard to the fact that the ION trade-mark is a weak mark, its ambit of protection has been increased by virtue of the Opponent's use. The Applicant has incorporated the Opponent's mark in its entirety as the first portion of its word mark, the goods of the parties are identical and the Opponent's use is greater than that of the Applicant, all of which favour a likelihood of confusion. The section 12(1)(d) ground of opposition therefore succeeds.

Section 2 Ground of Opposition

[31] The section 2 ground of opposition also turns on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's ION trade-mark. The material dates for assessing the likelihood of confusion in respect of non-distinctiveness is the date of opposition. In my view, the difference in the material date does not have any significant impact on my findings on the issue of confusion between the Mark and the Opponent's ION trade-mark. The section 2 ground of opposition therefore succeeds.

Section 16 Ground of Opposition

[32] Having already refused the application under two grounds, I will not discuss the remaining ground of opposition

Disposition

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

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