



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

**Citation: 2010 TMOB 186**  
**Date of Decision: 2010-10-27**

**IN THE MATTER OF AN OPPOSITION  
by Avon Products, Inc. to application  
No. 1,193,234 for the trade-mark  
MesmorEyes in the name of Farleyco  
Marketing Inc.**

The Pleadings

[1] On October 9, 2003 Farleyco Marketing Inc. (the Applicant) filed an application to register the trade-mark MesmorEyes (the Mark), application number 1,193,234, based on proposed use in Canada in association with:

Eye beauty products, namely fashion lashes, individual lashes, eyelash curlers, eye makeup remover pads, eyebrow depilatories, eyebrow colorants, lash colorants, lash thickeners (the Wares).

[2] The application was advertised on September 29, 2004 in the *Trade-marks Journal* for opposition purposes. Avon Products, Inc. (the Opponent) filed a statement of opposition on February 28, 2005 which was subsequently amended. The Applicant filed a counter statement on April 18, 2005 denying all grounds of opposition pleaded in the amended statement of opposition listed below.

[3] The Opponent filed the affidavit of Dominique Lebel while the Applicant filed the affidavit of Patricia Farley-Pope, who was cross-examined and the transcript was filed in the record. The Opponent filed as reply evidence the affidavit of Micheal Ryan.

[4] Both parties filed written arguments and were represented at an oral hearing.

### The Grounds of Opposition

[5] The grounds of opposition pleaded in the amended statement of opposition are:

1. The application does not comply with the provisions of s. 30(e) of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act) in that the Applicant, by itself or through a licensee, or by itself and through a licensee, did not have a bona fide intention to use the Mark as at the date of filing of the application, nor does it have a bona fide intention to use the Mark in Canada in association with any or all of the applied for wares;
2. The application does not comply with the provisions of s. 30(i) the Act in that the Applicant could not state that it was satisfied that it was entitled to the use the Mark in Canada in association with the Wares since at the filing date of the application the Applicant had, or ought to have had, prior knowledge of the Opponent's trade-mark MESMERIZE (registration number TMA442,464) and the Opponent's prior and continued use of the Opponent's trade-marks MESMERIZE, MESMERIZE FOR MEN and MESMERIZE FOR HER (collectively referred to as the Opponent's MESMERIZE Trade-marks);
3. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent's previously registered trade-marks MESMERIZE, registration number TMA442,464 and MESMERIZE FOR MEN, registration number TMA635,139;
4. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because at all material times, the Mark was confusing with the Opponent's previously used MESMERIZE Trade-marks;
5. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(b) of the Act because at all material times, the Mark was confusing with the Opponent's trade-mark MESMERIZE, for which an application for registration had been previously filed in Canada by the Opponent under application No. 701,873 on March 30, 1992. The Opponent's application for MESMERIZE registered on May 5, 1995 under TMA442,464 and was not abandoned as of September 29, 2004, the date of advertisement of the Mark;
6. The Mark is not distinctive since the Mark does not actually distinguish, nor was it adapted to distinguish, nor is it capable of distinguishing the Wares from the wares of others and more particularly from the wares of the Opponent in association with which the latter has used and is still using the Opponent's MESMERIZE Trade-marks in Canada. The Opponent states, and the fact is, that

by reason of the Opponent's MESMERIZE Trade-marks, which have been continuously used in Canada, the Mark cannot serve to distinguish the Applicant.

Preliminary Issue

[6] An unusual situation occurred during the process of this opposition. As mentioned previously the Opponent filed the affidavit of Ms. Lebel, Director Legal and Corporate Affairs of Avon Canada Inc., the Opponent's Canadian Subsidiary. The Registrar issued an order for her cross-examination. By letter dated August 30, 2006 the Applicant informed the Registrar that Ms. Lebel was unavailable for her cross-examination, being on leave at that time, and that the parties had agreed that a "new affiant", Colleen Leithman, Secretary of Avon Canada Inc. since 1997, would adopt the sworn statements of Ms. Lebel and would be cross-examined on her behalf.

[7] On October 4, 2006 Ms. Leithman was "cross-examined" by the Applicant. At the beginning of the cross-examination counsel for the Opponent made the following statement:

The actual Affidavit which is before the Witness was sworn by Dominique Lebel on November 14, 2005.

The Witness, Colleen Leithman, is adopting as truthful the statements contained in that Affidavit as her own. She is in fact Legal Counsel for Avon and the Secretary of Avon Canada, and has been so since January 1997.

[8] Subsequent to these opening remarks the Opponent's counsel confirmed that he was relying on Ms. Leithman's adoption of Ms. Lebel's affidavit, as if it was the evidence of the Opponent in this proceeding and as if originally sworn by Ms. Leithman.

[9] Normally, when a witness is no longer available, the party will seek permission to file as additional evidence an affidavit of another witness, usually identical to the previous one filed, and that the order of the Registrar for the cross-examination of the previous deponent applies to the substituted deponent. The affidavit of the previous deponent is then returned to the party who filed it, the whole in accordance with the provisions of rule 44(5) of the *Trade-marks Regulations*.

[10] In our fact scenario there is no affidavit filed by Ms. Leithman and the affidavit executed by Ms. Lebel is still part of the record. I raised the issue at the opening of the hearing and asked the parties, who agreed to proceed in this fashion, if in fact I could accept as part of the record the affidavit of Ms. Lebel as well as the transcript of the “cross-examination “ of Ms. Leithman. I invited the parties to file supplemental written arguments on this issue and both supported the course of action the parties took.

[11] The Opponent has brought to my attention a decision of the Prothonotary of the Federal Court in *Nedship Bank N.V. v. “Zoodotis” (The) (2000)*, 2000 CarswellNat 1238 wherein a similar situation occurred in a proceeding relating to ship sale priorities determination.

[12] The Practice Notice in Trade-mark Opposition Proceedings in effect as of March 31, 2009 under chapter VI entitled “Evidence” mentions that “If the parties are in agreement that a particular form of evidence should be accepted, the Registrar will generally accept it.” In the present situation the parties have agreed that Ms. Leithman would adopt all the statements made by Ms. Lebel in her affidavit and that she would be cross-examined as if she was the person who executed the affidavit signed by Ms. Lebel.

[13] In the absence of an objection on the part of the Applicant to proceed in this fashion and since the parties have treated the file as if those parts of the evidence were part thereto, even though the situation is quite unique, I consider the transcript of the cross-examination of Ms. Leithman and the affidavit of Ms. Lebel to form part of the record.

#### Burden of Proof in Trade-marks Opposition Proceedings

[14] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram &*

*Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

### Relevant dates

[15] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: The filing date of the application (October 9, 2003);
- The registrability of the Mark under s. 12(1)(d) of the Act: The date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)];
- Entitlement to the registration of the Mark, where the application is based on proposed use: The filing date of the application (October 9, 2003) [see s. 16(3) of the Act];
- Distinctiveness of the Mark: The filing date of the statement of opposition (February 28, 2005) is generally accepted to be the relevant date [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

### Grounds of Opposition Summarily Dismissed

[16] The Opponent has an initial evidential burden when alleging non-compliance with the provisions of s. 30(e) of the Act. There are two arguments put forward by the Opponent with respect to this ground opposition. Firstly, the Opponent argues the evidence shows that, two years after launching its line of products under the Mark, the Applicant has yet introduced the following wares in association with the Mark: eye

makeup remover pad, eyebrow depilatory product, eyebrow colorant product, lash colorant product, nor lash thickener product. Secondly there has been a decline in the sales of the Wares over recent years. Thus the Applicant has decided to go private label to satisfy the demands of its clientele.

[17] As for the first argument, the application has been filed on the basis of proposed use. The fact that the Applicant has not yet introduced some of the Wares on the market does not mean that it has no intention to use the Mark in association with those wares. As for the second argument, despite the fact that the sales of products bearing the Mark has declined, there remains sales of over \$181, 000 during a portion of 2007, the affidavit of Ms. Farley-Pope having been executed in October 2007. I do not associate the volume of those sales with an intention not to use the Mark. The first ground of opposition is therefore dismissed.

[18] With respect to the second ground of opposition, the Applicant has provided the statement required by s. 30(i) of the Act that it is satisfied that it is entitled to use the trade-mark in Canada in association with the Wares. To substantiate this ground of opposition, the Opponent argues that the evidence shows that the Opponent has used extensively its trade-mark MESMERIZE since at least as early as 1995 and such trade-mark was registered on May 5, 1995 and therefore available for public viewing on the Canadian Intellectual Property Office on-line database. Finally, the Opponent submits that the Applicant was aware of the Opponent but did not concern itself with what it was selling through its catalogues or on-line.

[19] The fact that the Applicant was aware of the Opponent (as opposed to the Opponent's products) does not mean that the Applicant could not have been satisfied that it was entitled to register the Mark in Canada in association with the Wares. In fact during her cross-examination, Ms. Farley-Pope, the Applicant's President, stated that she was not aware of the Opponent's products nor the content of its catalogues and website until after this opposition proceeding began. Even if it was aware of the Opponent's products and the Opponent's registration for the trade-mark MESMERIZE, the Applicant could

still state, in good faith, that it was entitled to register the Mark in Canada in association with the Wares.

[20] Normally, this ground of opposition will succeed if exceptional circumstances had been proven, such as evidence of the Applicant's bad faith [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no evidence on file of that nature. Consequently, the second ground of opposition is also dismissed.

[21] In order to meet its initial burden with respect to the fifth ground of opposition the Opponent must show that it had previously filed an application and that it was still pending at the advertisement date of the present application (September 29, 2004) [see s.16(4) of the Act]. Application 701,873 was filed on March 30, 1992 and registered on May 5, 1995 under registration number TMA442,464. Therefore it was no longer pending at the advertisement date of the present application. [see *Hudson's Bay Co. v. Kmart Canada Ltd./Kmart Canada Limitee* (1997), 76 C.P.R. (3d) 526].

[22] I also noted that, in her affidavit, Ms. Lebel did attach a copy of application 1,239,972, filed on December 8, 2004. Such application was not mentioned in the statement of opposition and in any event was filed subsequent to the filing of the Applicant's application. Therefore I shall not take into consideration this application.

[23] For all these reasons the fifth ground of opposition is also dismissed.

#### Registrability of the Mark under s. 12(1)(d)

[24] The Opponent has met its initial burden by filing, through the affidavit of Ms. Lebel, a photocopy of an extract of CIPO Canadian Trade-marks database for registration TMA442,464 for the trade-mark MESMERIZE and registration TMA635,139 for the trade-mark MESMERIZE FOR MEN. I used my discretion and checked the register. I can confirm that these registrations are still in good standing.

[25] Registration TMA442,464 for the trade-mark MESMERIZE covers woman's fragrance, namely, roll-on, talc, perfumed cream, lotion, body spray, bath and shower gel while registration TMA635,139 for the trade-mark MESMERIZE FOR MEN covers soap

on a rope, cologne, hair and body wash, talc, personal deodorant/antiperspirant, after shave conditioner and lotion.

[26] I must determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the Opponent's registered trade-marks MESMERIZE and MESMERIZE FOR MEN. I believe that the Opponent's strongest case is with registration TMA442,464 in view of the trade-mark and the wares covered by such registration.

[27] The test to decide if there is a likelihood of confusion between the parties' trade-marks is set out in s. 6(2) of the Act wherein 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 wares associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 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 wares; 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. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[28] The Opponent's trade-mark MESMERIZE is a common word in the English language. Mr. Ryan was an articling student at the time he executed his affidavit. He filed extracts of various English dictionaries for the definition of the word "mesmerize". I will simply refer to the Canadian Oxford Dictionary wherein "mesmerize" is defined in the following terms: "1. Fascinate, hold, spellbound. 2. *Psych.* Hypnotize".

[29] During her cross-examination Ms. Leithman admitted that the use of the trade-mark MESMERIZE in association with the wares covered by its registration is intended to connote to the Opponent's customers that the use of the fragrance products may hypnotise others.



[30] As for the Mark, it is a coined word, despite a phonetic similarity to the word “mesmerize”. It is written also with a capital E, therefore putting some emphasis on the word “eyes”. The Mark is therefore more inherently distinctive than the Opponent’s trade-mark MESMERIZE.

[31] The distinctiveness of a trade-mark may be enhanced through use or extensive promotion in Canada. I shall now summarize the evidence filed by both parties on the use of their respective trade-marks.

[32] Ms. Lebel, was employed by Avon Canada Inc. at the time she signed her affidavit. She explains that Avon Canada Inc. is the Opponent’s subsidiary and licensee in Canada. She provides general information on the Opponent which has been operating and selling products in Canada since 1924. The advertising of the Opponent’s products is mainly achieved through the distribution of catalogues by over 60,000 Avon’s Sales representatives and also through Avon Canada Inc.’s website. She does provide the cost of advertising and promoting the products featured in Avon’s catalogues on a yearly basis since 1997 but there is no breakdown per trade-mark. There is also a breakdown on a yearly basis of the number of Avon’s catalogue distributed in Canada since 1997 which exceeds 32 millions on a yearly basis between 1997 and 2004.

[33] Samples of catalogues distributed during each year between 1997 and 2005 (exhibits D to L inclusive) have been filed. The following items were advertised in association with the trade-mark MESMERIZE:

Exhibit D (1997): Cologne spray, body lotion, bath and shower gel, perfumed oil, deodorant, perfumed talc, body cream, perfumed skin softener, fragrance balm, oil body spray;

Exhibit E (1998): Perfumed oil body spray, body lotion, cologne spray, deodorant, bath and shower gel, perfumed talc, body cream;

Exhibit F (1999): bath and shower gel, body cream, deodorant, body lotion, oil body spray, perfumed talc, cologne spray, fragrance balm, bath crystal scent, fragranced candle, bath and shower gel;

Exhibit G (2000): cologne spray, deodorant, perfumed talc, bath and shower gel, body cream, perfumed skin softener, cooling spray, bath crystal scent, body lotion, fragranced candle;

Exhibit H (2001): bath and shower gel, body lotion, deodorant, cologne spray, perfumed talc, perfumed skin softener, cooling spray, perfumed talc, roll-a-scent, body cream;

Exhibit I (2002): perfumed skin softener, cologne spray, body lotion, roll-a-scent, deodorant, body cream, perfumed talc, cooling spray, bath and shower gel;

Exhibit J (2003): cologne spray, deodorant, bath and shower gel, perfumed talc, perfumed skin softener and body powder.

[34] As for the catalogues for the years 2004 and 2005 (Exhibits K and L) there are no products being offered for sale in association with the trade-mark MESMERIZE. However, there are products being offered for sale in association with the trade-mark MESMERIZE FOR MEN such as cologne spray, after shave lotion and soap on a rope.

[35] During her cross-examination, Ms. Leithman admitted that since 2004 there have been no products bearing the trade-mark MESMERIZE directed to women that have been advertised in the catalogues or on the Opponent's website. However, she stated that products bearing the trade-mark MESMERIZE are still on the order forms used by Avon's sales representatives. There have been sales in 2004 and 2005 of those products as evidenced by the invoices dated March 10, 2004 (skin softener), July 26, 2004 (cologne spray) and September 21, 2005 (body spray) part of Exhibit N to Ms. Lebel's affidavit.

[36] Ms. Farley-Pope has been the Applicant's President since May 1989. She provides details of her working background that shows that she has been involved in the cosmetics and health care products industry since 1974. She explains that the Applicant is a Canadian distributor and sales agency for cosmetics and healthcare products since 1989. It sells products under its own brand names, including the Mark.

[37] The Applicant started selling products in association with the Mark in December 2003. The products currently sold under the Mark include: strip eyelashes, individual

eyelashes, eyelash curlers, eyelash adhesives, eyelash adhesive remover, eyelash and glue kits and Halloween eyelashes (hereinafter referred to as the Products to distinguish them from the Wares). The Mark is printed on the packaging of these products as appears from pictures of some of the Products and their packaging filed by Ms. Farley-Pope.

[38] The Products bearing the Mark are advertised to retailers and consumers online on the Applicant's website. She filed a copy of a webpage of the Applicant's website on which those products are advertised. The Products are also advertised regularly on in-store display stands and boards. She filed pictures of those stands and boards on which appears the Mark. Finally, the Products are also advertised to consumers in flyers that are generated and distributed for retailers that sell them. She filed samples of those flyers on which the Mark appears in association with some of the Products.

[39] She could not provide sales figures of the Products bearing the Mark for the years 2003 and 2004 as they were in archives when she executed her affidavit. However she disclosed them for the years 2005 to 2007 inclusive which exceeded on an annual basis \$180,000. She stated during her cross-examination that the sales of the Products bearing the Mark in Canada during 2004 would have been in the range of \$250,000. She filed sample invoices (the oldest one going back to December 2006) showing the sale of the Products in Canada in association with the Mark.

[40] We have a situation where the evidence in the record establishes extensive use of the Opponent's trade-mark MESMERIZE from 1997 to 2003 inclusive in association with various women's fragrance and toiletries and some token use of that trade-mark in association with those products in Canada since 2004. On the other hand the Mark has been in use in Canada in association with some of the Wares since 2004.

[41] I conclude from this evidence that the first factor described in s. 6(5) of the Act does slightly favour the Applicant. The Mark is more inherently distinctive than the Opponent's trade-mark MESMERIZE. Moreover the Applicant's Mark has become known to some extent because of its use since 2004. In so far as the use of the Opponent's trade-mark MESMERIZE, any reputation acquired between 1997 and 2003 through such use in association with women's fragrance and toiletries, has diminished

ever since that time because of its token use and lack of promotion since 2004 in association with those wares.

[42] The Opponent has used the trade-mark MESMERIZE since at least 1997. The Applicant has been using the Mark since December 2003. This factor favours the Opponent.

[43] The third factor to be considered is the nature of the wares associated with the parties' respective trade-marks. The Opponent's trade-mark MESMERIZE is registered in association with woman's fragrance while the Wares covered by the present application are eye beauty products. They are both aimed at women. I note that in its written argument the Applicant is arguing that the Opponent's current wares associated with the trade-mark MESMERIZE FOR MEN are aimed at men. However in the context of a ground of opposition under s. 12(1)(d) I must compare the Wares to the wares covered by certificate of registration TMA442,464. I consider that the parties' wares fall into the category of women beauty products. This factor favours the Opponent.

[44] With respect to the channels of trade, some of the Wares presently on the market are sold through chain drug stores such as London Drugs, Shoppers Drug Mart, Value Drug Mart, Pharmasave, Jean Coutu, Uniprix, Familiprix and chain retail stores such as Wal-Mart, Loblaws, and Zellers.

[45] The Opponent's wares are mainly offered for sale and sold through orders placed from its catalogues to its sales representatives, and those provided online.

[46] In her affidavit Ms. Farley-Pope does state that in drug retail outlets, fragrances are displayed together, and often locked in showcases, due to their higher costs while eyelashes and the related adhesives are self-serve products, meaning that consumers can touch and examine the package without assistance. They are usually displayed next to the facial cosmetics and nail care products. She did file pictures taken at two drug stores to support such allegation. During her cross-examination she mentioned that display stands for false eyelashes could be located in close proximity to skincare products. However she stated that such a situation would occur only because those display panels would be

placed at the end or beginning of an aisle, for no specific reason, wherein skincare products are located. Normally the skincare products are placed in one aisle while cosmetics are located in a different aisle.

[47] As pointed out by the Opponent, in one of the advertisements filed by the Applicant, Exhibit E to Ms. Farley-Pope, a flyer of Pharmasave drug store, fragrance and the Applicant's false eyelashes are advertised on the same page.

[48] Both parties argued, from this factual situation, that the results of the analysis of that criterion should favour their position. One must remember that what needs to be compared is the normal channels of trade that would be used by the Applicant for the Wares with those that would be used by the Opponent for the wares listed in its registration.

[49] In *Culinar Inc. v. Mountain Chocolates Ltd.* (1998), 86 C.P.R. (3d) 251 the Registrar stated:

In assessing the likelihood of confusion between trade-marks in respect of a Paragraph 12(1)(d) ground of opposition, the Registrar must have regard to the channels of trade which would normally be associated with the wares set forth in the applicant's application and the opponent's registration since it is the statement of wares covered in the respective application and registration which determine the scope of the monopoly being claimed by the parties in relation to their marks [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (Fed. C.A.), at pp. 10-12]. Thus, absent a restriction in the statement of wares set forth in the present trade-mark application as to the channels of trade associated with the applicant's wares, the Registrar cannot, when considering the issue of confusion, take into consideration the fact that the applicant may only be selling its wares through a particular channel of trade such as its own retail stores [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1984), 2 C.P.R. (3d) 361 (Fed. T.D.), at pg. 372 (1986), 12 C.P.R. (3d) 110 (Fed. C.A.), at pg. 112]. Thus, in the present opposition, neither the applicant's application nor the opponent's registration limit the channels of trade associated with their respective wares. However, the respective statements of wares 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. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (Fed. C.A.), at p. 169].

[50] Applying these principles to the present case, I conclude that there is some overlap in the channels of trade. There is no restriction in the Opponent's registration that would limit the sale of its wares through its own agents, catalogues and its website. I note that there is evidence of a potential overlap in the channels of trade as appears from a Pharmasave flyer and in so far as sales through the Internet are concerned. This factor does favour the Opponent.

[51] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. One must look at the marks in their totalities and should not dissect each one of them into their components. Also it must be remembered that the applicable test is the imperfect recollection that would have an average consumer of the Opponent's trade-mark when facing the Wares bearing the Mark. Would that person's first impression be that the Wares originate from the Opponent?

[52] There is definitively a similarity in the pronunciation of the marks in issue. Ms. Farley-Pope, during her cross-examination mentioned that the Applicant created the Mark wherein the pun of the word was that it wanted the consumers to feel good about themselves, enthralling. Therefore there is also a similarity in the ideas suggested by the marks of the parties. Finally the first portion of the marks is identical.

[53] As an additional surrounding circumstance the Applicant argues that the get-up or the way the Wares are packaged and, as a consequence the way the Mark is presented to the public, is an important consideration in determining the likelihood of confusion. The Applicant relies on the appearance of its packaging on which the Mark appears in a cursive angled font, typically accompanied by a large picture of a woman's eyes or face. The Applicant stresses the fact that the Mark comprises the upper case "E" thus making prominent the word "Eyes".

[54] There is no guarantee that such form of packaging will always be used in association with the Wares. As for the use of the upper case "E", even though the word "Eyes" is part of the Mark, it is still the overall impression of the Mark that is important

in the mind of a consumer having a vague recollection of the Opponent's trade-mark MESMERIZE. One should note that such trade-mark also comprises the letter "e" in the middle of the trade-mark.

[55] The Applicant argues that the Mark has co-existed with the Opponent's trade-mark MESMERIZE for over 6 years without any instances of confusion. Such absence of confusion could be explained by the fact that there has been little co-existence of the marks since the introduction of the Mark in late 2003. However there has been use of the trade-mark MESMERIZE FOR MEN since that year but in association with men's fragrance, after shave lotion and soap on a rope.

[56] From this analysis I reach the conclusion that the Applicant has not met 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 MESMERIZE. My conclusion is based on the fact that the marks in issue do resemble one another phonetically, visually and in the ideas suggested by them. The wares of the respective parties fall in the same category: beauty products and there is an overlap in their channels of trade as appears from the Applicant's own evidence. I refer to the flyer part of Exhibit E to Ms. Farley-Pope's affidavit illustrating on the same page some of the Wares together with fragrance.

[57] Consequently I maintain the third ground of opposition.

[58] I wish to add that if I were to make a similar detailed analysis of the various factors listed under s. 6(5) of the Act to assess the likelihood of confusion between the Mark and the Opponent's registered trade-mark MESMERIZE FOR MEN I would arrive at a different conclusion. In fact the addition of the words "FOR MEN" would serve to distinguish the marks. It does suggest that the wares sold in association with such trade-mark (cologne spray, after shave lotion, soap on a rope) are intended for men while the evidence filed showed that the Wares are mainly intended for women. So not only the wares of the parties are different but an additional argument exists in favour of the Applicant with respect to their channels of trade. Finally the degree of resemblance is less because of the addition of the words "FOR MEN" to "MESMERIZE".

Ground of opposition based on s. 16(3)(a) of the Act

[59] In order to meet its initial onus under this ground of opposition, the Opponent had to show that it previously used the trade-mark MESMERIZE and that it had not abandoned such use at the date of advertisement of the present application [see s. 16(5) of the Act]. From the evidence described under the ground of opposition of registrability of the Mark, I conclude that the Opponent has met its initial onus in so far as MESMERIZE and MESMERIZE FOR MEN are concerned. There is no evidence of use of the trade-mark MESMERIZE FOR HER.

[60] The issue remains the determination of a likelihood of confusion between the Mark and the Opponent's trade-marks MESMERIZE and MESMERIZE FOR MEN. My analysis of the various relevant factors under the previous ground of opposition would generate the same conclusion as the difference in the relevant dates does not alter the outcome of the analysis done. I may add that at the earlier relevant date, the Applicant had not used the Mark in Canada in association with any of the Wares. Therefore there could not have been any instances of confusion as there was no co-existence of the parties' marks at that time.

[61] Consequently, I maintain the fourth ground of opposition.

Distinctiveness

[62] To meet its initial onus the Opponent had to prove that its trade-marks MESMERIZE and MESMERIZE FOR MEN had become sufficiently known on February 28, 2005, the filing date of the statement of opposition to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. I voluntarily omitted the trade-mark MESMERIZE FOR HER as there is no evidence of its use. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's aforesaid trade-marks such that it was adapted to distinguish or actually distinguished throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].



[63] In its written argument the Opponent argued that the relevant date in this instance would be the filing date of the amended statement of opposition. No jurisprudence has been provided to substantiate such position. The difference in the dates between the filing date of the original statement of opposition and the filing date of the amended statement of opposition would not be a determining factor in this case. In any event, I note that in the amended statement of opposition there were no amendments to the ground of opposition of distinctiveness. Therefore I fail to see why the filing date of the latter would be the relevant date.

[64] From the evidence described under the ground of opposition of registrability of the Mark, I conclude that the Opponent has met its initial onus to show that its trade-mark MESMERIZE was sufficiently known in Canada in association with fragrance and toiletries as of the relevant date. The evidence filed by Ms. Lebel also shows that the trade-mark MESMERIZE FOR MEN was known to some extent in Canada at the relevant date in association with cologne spray, after shave lotion and soap on a rope. I note that all these products are advertised for men.

[65] The issue to be decided remains the likelihood of confusion between the Mark and the Opponent's aforesaid trade-marks. The difference in the relevant dates between this ground of opposition and registrability would not influence my analysis of the various relevant factors considered. My conclusion is that the Mark was not distinctive and was not apt to distinguish, at the relevant date, the Applicant's Wares from the Opponent's products bearing the trade-mark MESMERIZE. Consequently this ground of opposition is also maintained.

Disposition

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

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office