IN THE MATTER OF AN OPPOSITION
by Clinique Laboratories Inc. to application no. 758,251 for the trade-mark PERSONAL CHEMISTRY filed by Arax Mansourian
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On June 28, 1994, the applicant, Arax Mansourian, filed an application to register the trade-mark PERSONAL CHEMISTRY based on proposed use in Canada in association with the wares "personal care products such as cosmetics, perfume, facial care products, hair treatment and shampoo." In order to overcome an objection at the examination stage, the wares were subsequently amended to

> personal care products and cosmetics, namely foundation, blush, eyeliner, eye shadow, lipstick, lip gloss, perfume, cologne, eau de toilette, after-shave lotion, shaving gel, shaving cream, hair shampoo, deodorant soap, skin soap, toilet soap, personal deodorants, body lotions, bath oils, skin creams and skin lotions; and facial care products, namely facial creams and facial lotions.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 12, 1995 and was opposed by Clinique Laboratories Inc. on January 12, 1996. A copy of the statement of opposition was forwarded to the applicant on January 31, 1996. The applicant responded by filing and serving a counter statement. The grounds of opposition are reproduced in full below:

The opponent's design mark (hereinafter "CHEMISTRY CLINIQUE") referred to in paragraphs (a) and (b) above is illustrated below:

regn. no. 448, 056

The opponent's evidence consists of the affidavits of Eunice Valdivia, Executive Vice-President, Marketing and Finance of the opponent company; Robert W. White, Senior Vice President, Canada of the Audit Bureau of Circulations ; and Jehangir Choksi, student at law. The applicant's evidence consists of the affidavits of Arax Mansourian, the applicant herein, and Linda Victoria Thibeault, trade-mark searcher. The opponent's evidence in reply consists of the affidavit of Kendrick Lo, student. There was no cross-examination of any of the affiants. Only the opponent filed a written argument, however, both parties attended at an oral hearing.

Ms. Valdivia's evidence may be summarized as follows. The opponent Clinique is a manufacturer, distributor and seller of personal care products including fragrance and cosmetic products, and skin care and body care products for both men and women. The opponent has used its house mark CLINIQUE (regn. nos. 395,800 and 401,415) in Canada in association with the aforementioned wares and related services since about 1970, and has used its mark CHEMISTRY CLINIQUE in Canada in association with men's cologne and aftershave since 1995. Sales of cologne under the mark CHEMISTRY CLINIQUE since August 1995 have been about $300,000 and sales of aftershave since November 1995 have been about$50,000. Such sales together represent about 8,700 bottles of product sold. The mark CHEMISTRY CLINIQUE has been promoted by means of posters, blotter cards, and dyptychs at point of sale advertising, in magazines including a fashion supplement to the *Globe and Mail* and in promotional material distributed by retailers such as The Bay. Cologne and aftershave sold under the mark CHEMISTRY CLINIQUE are available at Eaton's, Sears, Holt Renfrew and in various specialty stores across Canada. The introduction of CHEMISTRY CLINIQUE products was reported in newspapers and magazines including the *London Free Press* (July 25, 1995) and *Flare* magazine

(October 1995).

Mr. Choksi's affidavit serves to introduce into evidence extracts from the magazines *Soap/Cosmetics/Chemical Specialties* (November 1995), *Chatelaine* (October 1995) and the newspaper *The Times* wherein the opponent's new product CHEMISTRY CLINIQUE was either discussed at length or mentioned briefly. Mr. White evidenced circulation figures as follows. The total average paid circulation for the six month period ending December 31, 1995 was about 182,000 for the magazine *Flare* and about 809,000 for the magazine *Chatelaine*.

Ms. Mansourian's evidence may be summarized as follows. She is fully familiar with Canadian retailing of cosmetics and colognes and the like, and familiar with the opponent's operations. According to Ms. Mansourian, the opponent's wares, including CHEMISTRY CLINIQUE products, are sold at counters which include only the opponent's products, as explained at paragraph 4 of her affidavit:

Ms. Thibeault's affidavit serves to introduce into evidence a state of the trade-marks register search for marks "indexed under the work 'CHEMISTRY' in connection with cosmetics and toiletries." However, her search reveals too few relevant third party marks to assist the applicant.

Mr. Lo's affidavit, filed as evidence in reply, contradicts the evidence of Ms. Mansourian in respect of how CHEMISTRY CLINIQUE products may be purchased. Mr. Lo attended at two

stores located in Toronto namely, Holt Renfrew and Luwinna. At both stores the opponent's wares including CHEMISTRY CLINIQUE products were not sold at stand-alone counters but at open shelves adjacent to shelves offering for sale similar wares of other manufacturers.

Each of the grounds of opposition turn on the issue of confusion between the applied for mark PERSONAL CHEMISTRY and the opponent's mark CHEMISTRY CLINIQUE. The material dates to consider the issue of confusion are the date of my decision with respect to the first ground of opposition alleging non-registrability; the date of filing the application (June 28, 1994) with respect to the second ground of opposition alleging non-entitlement and with respect to the fourth ground alleging non-compliance with Section 30(i); and the date of opposition (January 12, 1996) with respect to the third ground alleging non-distinctiveness of the applied for mark PERSONAL CHEMISTRY. However, nothing turns on whether the issue of confusion is assessed at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark PERSONAL CHEMISTRY and the opponent's mark CHEMISTRY CLINIQUE. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive. All relevant factors are to be considered although all factors do not necessarily have equal weight. The weight to be given to

each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark CHEMISTRY CLINIQUE possesses a fair degree of inherent distinctiveness since the phrase as a whole has no obvious connection to cologne or aftershave, other than to suggest that the product or some components may have been manufactured in a "clinic" by chemical means. The opponent's mark would have acquired some reputation in Canada after the fall of 1995 as a result of sales and advertising under its mark, discussed earlier. The applied for mark PERSONAL CHEMISTRY also possesses a fair degree of inherent distinctiveness because the term as a whole suggests a physical attraction between two persons. The subject application for the mark PERSONAL CHEMISTRY is based on proposed use in Canada and there is no evidence to indicate that the mark acquired any reputation at any material date. The length of time that the marks in issue have been is use favours the opponent as it has been using its mark since fall 1995. The nature of the parties' wares sold under the marks in issue are the same or similar, and there is potential for the parties' channels of trade to overlap given Mr. Lo's evidence that not all sales of CHEMISTRY CLINIQUE products are through stand-alone counters. The marks in issue resemble each other to a fair degree visually and aurally owing to component CHEMISTRY common to both marks. However, as alluded to earlier, the marks in issue resemble each other to a lesser degree in the ideas they suggest. Further, the applicant has been unable to show that the word CHEMISTRY is a common component of marks used in association with personal care products or the like.

In view of the above, I find that, at each relevant date, I am in a state of doubt whether the applied for mark PERSONAL CHEMISTRY is confusing with the opponent's mark

CHEMISTRY CLINIQUE. As such doubt must be resolved against the applicant, the subject application is refused.

DATED AT HULL, QUEBEC, THIS 19th DAY OF MAY, 1999.

Myer Herzig,
Member,
Trade-marks Opposition Board