IN THE MATTER OF AN OPPOSITION by Canadelle Inc., now Canadelle Limited Partnership, to application No. 713,335 for the trade-mark ELITA C'EST NATUREL filed by Sterling Trading Inc.

On September 22, 1992, the applicant, Sterling Trading Inc., filed an application to register the trade-mark ELITA C'EST NATUREL based upon proposed use of the trade-mark in Canada in association with:

> "Pantyhose, stockings, socks, sleepwear, dressing gowns, lingerie, headbands and slippers."

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of October 20, 1993 and the opponent, Canadelle Inc., filed a statement of opposition on January 20, 1995, a copy of which was forwarded to the applicant on March 16, 1995. The opponent filed as its evidence the affidavit of Richard C. Price while the applicant submitted as its evidence the affidavit of Elliot M. Berzan. Further, both parties filed written arguments and both were represented at an oral hearing. On February 26, 1998, the opponent advised the Opposition Board that, as a result of a corporate reorganization, Canadelle Inc. is now called Canadelle Limited Partnership.

As its first ground, the opponent alleged that the present application does not comply with Section 30 of the ***Trade-marks Act*** in that the applicant could not properly state in its application that it was satisfied that it was entitled to use the trade-mark ELITA C'EST NATUREL in Canada in that, as of its filing date, the applicant knew or should have known that the opponent owned, had used in Canada and was continuing to use in Canada the following trade-marks in association with the wares covered by each registration:

Trade-mark	***Registration No.***	***Wares***
AU NATUREL	377,272	bras, panties and girdles
NATURELLE	415,797	foundation garments, namely brassieres, girdles and bandeaus
NATURALLY YOURS	371,599	bras, panties and girdles

While the legal burden is upon the applicant to show that its application complies with Section 30

of the ***Trade-marks Act***, there is an initial evidentiary burden on the opponent in respect of its Subsection 30(i) ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. However, no evidence has been furnished by the opponent to show that the applicant could not properly have been satisfied that it was entitled to use its trade-mark ELITA C'EST NATUREL in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p. 195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition which are based on allegations of confusion between the applicant's trade-mark ELITA C'EST NATUREL and the opponent's trade-marks.

The second ground of opposition is based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the opponent alleging that the applicant's trade-mark ELITA C'EST NATUREL is not registrable in that it is confusing with the registered trade-marks AU NATUREL and NATURALLY YOURS, registration Nos. 377,272 and 371,599, covering "bras, panties and girdles". In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark ELITA C'EST NATUREL and the registered trade-marks AU NATUREL and NATURALLY YOURS, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically set forth in Subsection 6(5) of the ***Trade-marks Act***. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date in respect of the Paragraph 12(1)(d) ground of opposition [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the applicant's trade-mark ELITA C'EST NATUREL as applied to pantyhose, stockings, socks, sleepwear, dressing gowns, lingerie, headbands and slippers is inherently distinctive when considered in its entirety even though the word NATUREL may suggest to some consumers that the applicant's wares are made from natural fibres or fabrics. The opponent's trade-mark AU

NATUREL possesses some measure of inherent distinctiveness even though it may suggest to some consumers that the bras, panties and girdles associated with the trade-mark are made from natural fibres or fabrics. Further, the opponent's mark NATURALLY YOURS is inherently distinctive when applied to bras, panties and girdles.

While no evidence relating to sales of wares associated with the trade-mark ELITA C'EST NATUREL have been adduced by the applicant, the Berzan affidavit establishes that the applicant's mark has become known to a minor extent in Canada through its promotional activities relating to the ELITA C'EST NATUREL mark. For its part, the opponent adduced the affidavit of its Vice-President, Finance and Administration, Richard C. Price. No specimens showing the manner of use of either of the trade-marks NATURALLY YOURS and AU NATUREL have been annexed as evidence by the opponent and paragraph 14 of the Price affidavit is ambiguous in failing to identify the "wares" associated with the sales figures provided by him. However, Exhibits D and E and paragraphs 9 to 13 of the Price affidavit do relate the opponent's trade-marks NATURALLY YOURS and AU NATUREL to its bras, panties and girdles. Moreover, the applicant has not challenged Mr. Price's evidence by way of cross-examination. I have concluded, therefore, that the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] weighs in the opponent's favour.

The length of time the trade-marks have been in use [Para. 6(5)(b)] is also a surrounding circumstance which favours the opponent. In this regard, the Price affidavit attests to use by the opponent of its trade-marks NATURALLY YOURS and AU NATUREL since 1990 whereas no evidence has been furnished by the applicant that it has yet commenced use of its trade-mark ELITA C'EST NATUREL in Canada as contemplated by Subsection 4(1) of the ***Trade-marks Act***.

Paragraphs 6(5)(c) and 6(5)(d) of the ***Act*** require the Registrar to have regard to the nature of the wares (or services) associated with the trade-marks at issue and the respective channels of trade of the parties. In this regard, the applicant's bras, panties and girdles covered in registration Nos. 377,272 and 371,599 overlap the applicant's lingerie and are closely related to the applicant's pantyhose, stockings and sleepwear in that these wares all fall within the category of ladies' intimate

wearing apparel. On the other hand, the applicant's dressing gowns, socks, headbands and slippers differ specifically from the opponent's wares although they fall within the general category of wearing apparel, as do the opponent's wares. To the extent that the wares of the parties either overlap or are related, I would expect that the channels of trade of the parties could or would overlap. Further, the applicant's dressing gowns, socks, headbands and slippers could also be sold through the same channels of trade as the opponent's wares although not necessarily in close proximity to each other.

Considering next the degree of resemblance between the trade-marks at issue [Para. 6(5)(a)], I find there to be little resemblance in appearance, sounding or in the ideas suggested by the applicant's trade-mark ELITA C'EST NATUREL and the opponent's trade-mark NATURALLY YOURS. However, I consider there to be at least some similarity in appearance between the opponent's trade-mark AU NATUREL and the applicant's mark and both marks may suggest to some consumers the idea of natural fibres or fabrics.

As a further surrounding circumstance in assessing the issue of confusion, the applicant has relied upon state of the register evidence comprising four registered trade-marks identified in paragraph 11 of the Berzan affidavit. Two of the registrations for the trade-marks COTON GINNY NATURELLEMENT & Design and COTON GINNY NATURELLEMENT cover *inter alia* underwear while the registrations for the trade-marks LES NATURELS DE MARC-DANIEL and NATURELLES DE GÉRARD PASQUIER & Design cover clothing but not ladies' intimate wearing apparel. Given that only four registrations have been identified by the applicant and no evidence of use of any of these marks has been adduced by the applicant, and bearing in mind that only two of the marks arguably cover ladies' intimate wearing apparel, little if any weight can be accorded this evidence.

Having regard to the above, I find that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion between its trade-mark ELITA C'EST NATUREL as applied to the applicant's "Pantyhose, stockings, sleepwear, lingerie" and the opponent's registered trade-mark AU NATUREL in that these marks bear some similarity in appearance and ideas suggested and

are applied to related or overlapping wares which could travel through the same channels of trade. On the other hand, I do not consider that there would be a reasonable likelihood of confusion between the applicant's trade-mark as applied to "socks, dressing gowns, headbands and slippers" and either of the opponent's registered trade-marks. I have therefore rejected the Paragraph 12(1)(d) ground as it relates to these wares.

The third ground is based on Paragraph 16(3)(a) of the ***Trade-marks Act***, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark ELITA C'EST NATUREL in that, as of the applicant's filing date, the applicant's trade-mark was confusing with its trade-marks AU NATUREL, NATURELLE and NATURALLY YOURS which had been previously used in Canada in association with the wares covered in the respective registrations identified above. However, the issue of confusion between the applicant's trade-mark ELITA C'EST NATUREL and the trade-marks AU NATUREL and NATURALLY YOURS has been considered in relation to the Paragraph 12(1)(d) ground. While the material date for considered the issue of confusion is relation to the Subsection 16(1) ground is the applicant's filing date and not the date of decision, I do not consider the difference in the material dates to materially alter the conclusions reached in assessing the surrounding circumstances in respect of the second ground. As a result, it is only necessary to consider the issue of confusion between the applicant's trade-mark ELITA C'EST NATUREL and the opponent's mark NATURELLE under this ground of opposition.

Having regard to Subsections 16(5) and 17(1) of the Act, the opponent must establish its prior use of its trade-mark NATURELLE in association with foundation garments, namely brassieres, girdles and bandeaus prior to the filing date of the present application [September 22, 1992], as well as to show that it had not abandoned its trade-mark as of the date of advertisement of the present application [October 20, 1993]. While the Price affidavit establishes that the opponent may have sold panties in association with its trade-mark NATURELLE prior to the applicant's filing date, it does not show that the opponent has used its trade-mark NATURELLE in association with any of the wares covered in registration No. 415,797. In this regard, I do not agree with the opponent's submission that the "lightweight control" panties sold by the opponent in association with its trade-mark qualify as girdles. Thus, the opponent has failed to meet its initial burden in

respect of this ground in relation to the trade-mark NATURELLE and I have therefore rejected this ground of opposition.

The fourth ground is based on Paragraph 16(3)(b) of the ***Trade-marks Act***, the opponent alleging that the applicant is not the person entitled to registration in view of its previously filed applications for registration of the trade-marks AU NATUREL, NATURELLE and NATURALLY YOURS. However, the opponent's three trade-mark applications matured to registration prior to the date of advertisement of the present application [October 20, 1993]. As a result, the opponent has not met the initial burden on it under Subsection 16(4) of the ***Trade-marks Act*** of showing that any of its previously-filed applications were still pending as of the date of advertisement of the present application. I have therefore dismissed this ground.

The final ground relates to the alleged non-distinctiveness of the applicant's trade-mark in view of the allegations of confusion between the applicant's mark ELITA C'EST NATUREL and the opponent's trade-marks AU NATUREL, NATURELLE and NATURALLY YOURS as applied to the wares covered in its registrations. While the material date for considering this ground is the date of opposition, the earlier material date does not materially alter the conclusions reached in assessing the surrounding circumstances in respect of the Paragraph 12(1)(d) ground. It is therefore only necessary to consider the opponent's mark NATURELLE in relation to this ground of opposition. However, the only evidence of use of the trade-mark NATURELLE is relation to panties, there being no evidence of use of the trade-mark NATURELLE in association with any of the wares covered in registration No. 415,797. As a result, the opponent has failed to meet the evidentiary burden upon it in respect of this ground as it relates to its trade-mark NATURELLE. I have therefore rejected this ground of opposition.

In view of the above, I refuse the present application as applied to "Pantyhose, stockings, sleepwear, lingerie" and otherwise reject the opponent's opposition to registration of the trade-mark ELITA C'EST NATUREL as applied to "socks, dressing gowns, headbands and slippers". In this regard, I would note the decision of the Federal Court, Trial Division in ***Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH***, 10 C.P.R. (3d) 492 in respect of there being

authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC THIS 18th DAY OF MARCH, 1998.

G.W.Partington,
Chairperson,
Trade Marks Opposition Board.