



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

**Citation: 2016 TMOB 142
Date of Decision: 2016-08-17**

**Mecca Cosmetica Pty Ltd and Kit
Cosmetics Pty Ltd** **Opponent**

and

Rexall Brands Corp. **Applicant**

1,608,879 for KIT & Design **Application**

[1] On January 7, 2013, Rexall Brands Corp. (the Applicant) filed an application to register the trade-mark KIT & Design set out below (the Mark).



[2] The application is based on the Applicant's proposed use of the Mark in Canada in association with goods (1) and on the Applicant's use of the Mark in Canada in association with goods (2) and goods (3).

Goods:

(1) Nail care preparations and nail cosmetics; nail care implements, namely nail brushes, nail buffers, nail buffing blocks, nail smoothing blocks, emery boards, nail clippers, nail files, nail and cuticle scissors, nail and cuticle nippers, cuticle removers and pushers; manicure sets and manicure sets with pouches; callus remover, callus and corn shaver; pumice stones and sponges; foot file paddles and foot smoothing paddles; bath sponges; bath and shower gloves; shower caps; spa moisturizing booties and gloves; bath towels; spa eye masks, sleep masks; cosmetic brushes, sponges, cases, towelettes, wipes; tweezers; eyelash curlers, eyebrow shapers; magnifying mirrors; hosiery; watches; cosmetic and nail brush cleansers; skin care preparations; hair accessories; hair dryers, hair diffusers, hair curlers, hair crimping irons, curling irons, hair cutting scissors; personal care scissors; mustache scissors with comb; cosmetic cotton balls and pads, cotton swabs; cosmetics.

(2) Nail polish.

(3) Jewelry.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 19, 2014.

[4] Mecca Cosmetics Pty Ltd and Kit Cosmetics Pty Ltd (collectively referred to as the Opponent) filed a statement of opposition on September 19, 2014. The Opponent has pleaded grounds of opposition pursuant to sections 30, 16, and 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Applicant filed and served a counter statement. Neither party filed evidence. Only the Applicant filed a written argument; no hearing was held.

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[5] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Analysis of the Grounds of Opposition

Section 30(b) Ground of Opposition

[6] The Opponent alleges in its statement of opposition that the Applicant has not used the Mark in Canada in association with nail polish or jewelry as of the dates of first use alleged in the application. There is no evidence to support such an allegation. As such, this ground of opposition is rejected.

Section 30(e) Ground of Opposition

[7] The Opponent alleges in its statement of opposition that the Applicant does not intend to use the Mark in association with Goods (1). As there is no evidence to support such an allegation, this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[8] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada given the prior making known of the trade-marks KIT and kit design by Kit Cosmetics Pty Ltd. Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence of bad faith or exceptional circumstances. This ground of opposition is therefore rejected.

Section 16(1)(a) and 16(3)(a) Grounds of Opposition

[9] The Opponent alleges in its statement of opposition that the Applicant is not the person entitled to register the trade-mark in view of Kit Cosmetics Pty Ltd's making known of the trade-marks KIT and kit design in Canada. In order to meet its initial burden in support of the non-

entitlement grounds of opposition based upon sections 16(1)(a) and 16(3)(a) of the Act, the Opponent was required to show that its trade-marks KIT and kit Design had been made known in Canada prior to the dates of first use in the application for nail polish and jewelry and the filing date of the application for Goods (1). It has not done so. This ground of opposition is therefore rejected.

Section 2 Ground of Opposition

[10] The Opponent alleges in its statement of opposition that the Mark is not distinctive in view of Kit Cosmetics Pty Ltd's making known of the trade-marks KIT and kit design in Canada. In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of the date of filing its statement of opposition, September 19, 2014, that one or both of its trade-marks KIT and kit Design, were known to some extent at least and the reputation of one or both of these marks in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. It has not done so. This ground of opposition is therefore rejected.

Disposition

[11] Having regard to the foregoing, 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.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

LOW MURCHISON RADNOFF LLP

FOR THE OPPONENT

BERESKIN & PARR LLP/S.E.N.C.R.L.,
S.R.L.

FOR THE APPLICANT