



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 271

Date of Decision: 2021-12-01

IN THE MATTER OF AN OPPOSITION

**Make Up United International
Limited**

Opponent

and

Noxell Corporation

Applicant

1,783,159 for TOTAL TEASE

Application

INTRODUCTION

[1] Make Up United International Limited (the Opponent) opposes registration of the trademark TOTAL TEASE (the Mark), which is the subject of application No. 1,783,159 (the Application) by Noxell Corporation (the Applicant).

[2] The Application is based on proposed use in association with cosmetics.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's registration for the trademark TEEEZ in association with goods including "soaps, namely bath soaps, body soaps, hand soaps; perfumery, essential oils for aromatherapy, essential oils for personal use, essential oils for the manufacture of perfumes, cosmetics, hair lotions"

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] The Application was filed on May 19, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of February 8, 2017.

[6] On April 6, 2017, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on registrability under section 12(1)(d), entitlement under sections 16(2)(a) and 16(3)(a), and distinctiveness under section 2 of the Act, all of which turn on the issue of a likelihood of confusion between the applied for Mark and the Opponent's trademark. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act, which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[7] The Applicant filed and served a counter statement denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Michel Johannes Franciscus Vermonden (sworn May 28, 2018). In view of Mr. Vermonden's failure to attend cross-examination, his affidavit was struck from the record pursuant to section 56(4) of the *Trademarks Regulations*, SOR/2018-227. The Opponent subsequently sought and was granted leave to file, as additional evidence, a certified copy of registration No. TMA842,500 for the Opponent's trademark TEEEZ.

[9] In support of the Application, the Applicant filed the affidavit of Biserka Horvat (sworn November 25, 2019) and a certified copy of the file history for the subject Application.

[10] Neither party filed written representations, and only the Applicant was represented at a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, the Opponent must first

adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition

[12] The section 12(1)(d) ground of opposition turns on whether there is a likelihood of confusion between the Mark and the Opponent's registered trademark TEEEZ (TMA842,500). In particular, the Opponent has pleaded that the Mark is confusing with the registered trademark TEEEZ, which is owned and used by the Opponent in association with at least "soaps, namely bath soaps, hand soaps; perfumery, essential oils for aromatherapy, essential oils for personal use, essential oils for the manufacture of perfumes, cosmetics, hair lotions". A full list of the goods associated with this registration is provided at Schedule A of this decision.

[13] I have exercised my discretion to check the register and confirm that registration No. TMA842,500 for the trademark TEEEZ is extant as of the date of this decision. However, the registration is the subject of a proceeding under section 45 of the Act. In the section 45 proceeding, by decision of the Registrar dated November 23, 2021, the Registrar concluded that the registration should be amended to include only the goods "cosmetics" [*Fasken Martineau Dumoulin LLP v Make Up United International Limited*, 2021 TMOB 252].

[14] The period to appeal the November 23, 2021 decision of the Registrar has not passed; therefore, the decision has not taken effect. Consequently, for the purpose of this opposition proceeding, I consider the Opponent's registration No. TMA842,500 as it currently stands in association with the full complement of goods, rather than the amended version set out in the Registrar's November 23, 2021 decision.

Test for confusion

[15] The test for confusion is one of first impression and imperfect recollection. In determining whether two trademarks are confusing, all the surrounding circumstances should be

considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks 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 trademarks in appearance, or sound or in the ideas suggested by them. 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 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 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 of the trademarks and the extent to which they have become known

[16] The Applicant's Mark consists of a combination of the words TOTAL TEASE, whereas the Opponent's trademark TEEEZ could, in my view, be perceived as an intentional misspelling of the word "tease".

[17] I find the parties' marks to have a similar degree of inherent distinctiveness as neither trademark is descriptive of its associated goods. However, the unconventional spelling of the Opponent's trademark also contributes to the inherent distinctiveness of the trademark and renders it slightly more inherently distinctive than the Mark.

[18] The distinctiveness of a trademark may be further increased through promotion or use. However, in this case, there is no evidence in this regard. Accordingly, I find that this factor, which is a combination of the inherent distinctiveness of the parties' trademarks and the extent to which they have become known, favours the Opponent, albeit only slightly.

Length of time in use

[19] The Application for the Mark is based on proposed use, and the Applicant has not adduced any evidence that use of the Mark has commenced since the date of filing of the Application.

[20] With respect to the Opponent's trademark, the registration shows that a declaration of use was filed on January 7, 2013. Absent any other evidence, I can only infer *de minimis* use of the

Opponent's trademark from the certificate of registration adduced [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37; *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. However, such an inference does not support the finding that the Opponent's trademark was known to any significant extent or that it has been continuously used since the date declared [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

[21] Accordingly, this factor favours neither party.

Nature of the goods, services or business; and the nature of the trade

[22] It is the Applicant's statement of goods as defined in the Application versus the Opponent's registered goods that govern my determination of this factor.

[23] Insofar as the trademarks at issue both cover "cosmetics", there is direct overlap between the parties' goods. I also find there to be some overlap or at least a connection between the Applicant's Goods and the following goods of the Opponent, namely "soaps, namely bath soaps, body soaps, hand soaps; perfumery, essential oils for aromatherapy, essential oils for personal use, essential oils for the manufacture of perfumes, lotions" insofar as they are all personal care products or related thereto.

[24] There is no evidence of actual trades that could assist me in determining the probable type of business or trade intended by the parties. However, given that the parties' overlapping goods fall under the same general category, for the purposes of assessing confusion, and in the absence of evidence to the contrary, I find that there is potential for overlap between the parties' channels of trade.

[25] Accordingly, these factors favour the Opponent.

Degree of resemblance

[26] As noted above, in most instances, the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [*Beverly Bedding & Upholstery Co v*

Regal Bedding & Upholstery Ltd (1980), 47 CPR (2d) 145 (FCTD), conf. 60 CPR (2d) 70 (FCA)].

[27] When considering the degree of resemblance, the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[28] In *Masterpiece*, *supra*, the Court observed that while the first word (or syllable) of a trademark may, for purposes of distinctiveness, be the most important in some cases [*Conde Nast Publications Inc v Union des editions modernes* (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trademark that is particularly striking or unique.

[29] In the present case, the Opponent's trademark TEEEZ is comprised of a single, striking element. The applied-for trademark TOTAL TEASE is comprised of two dictionary words; I do not consider one word to be more striking than the other. Rather, it is the combination of the words that is the striking element of the Mark. With respect to the appearance of the trademarks, I find that when considered in their entirety, the marks are very different. The Opponent's trademark features an unconventional spelling of the word "tease" which includes a string of repeated letters followed by the letter "z" ("TEEEZ") which makes a strong visual impact, whereas the Mark does not. Also, the Mark consists of two words which further contributes to the difference in appearance. When sounded, the marks share some similarity as they both include the phonetic equivalent of the word "tease". However, the combination of this word with the prefix "total" in the Applicant's Mark distinguishes it to some extent.

[30] With respect to the ideas suggested, the parties' marks are similar in that they share the word "tease" and thus presumably the ideas suggested by this word. However, as noted by counsel for the Applicant, it is arguable that the ideas suggested by the Opponent's trademark TEEEZ would not be immediate or obvious given that the average consumer might not instantly make the association between the Opponent's mark and the dictionary word "tease".

[31] On balance, I find that the differences between the trademarks, particularly in appearance, significantly outweigh the similarities of the parties' marks in sound and ideas suggested. Accordingly, this factor favours the Applicant.

Surrounding circumstance – state of the register and marketplace evidence

[32] State of the register and marketplace evidence favours an applicant when the presence of a common element in trademarks causes purchasers to pay more attention to the other features of the trademarks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42].

[33] For example, in *Kellogg Salada Canada Inc v Maximum Nutrition Ltd*, [1992] 3 FC 442, 43 CPR (3d) 349 (FCA), where the issue was whether confusion existed between the trademark NUTRI-VITE and the trademarks NUTRI-MAX and NUTRI-FIBRE, the court found that consumers were accustomed to making fine distinctions between various NUTRI trademarks based on small differences in their suffixes. In *Kellogg*, there were at least 47 trademark registrations and 43 trade names, plus a further 18 trademark registrations after the filing date that contained the word “Nutri” as part of the mark.

[34] In *McDowell*, Justice MacTavish explains that evidence of third party trademark registrations with a common element is only significant where the registered marks are commonly used in the market in question: *Cie Gervais Danone v Astro Dairy Products Ltd*, 1999 CanLII 7656 (FC), 160 FTR 27 at para 17, [1999] FCJ No 408 (FCTD). For an inference to be drawn that a word or element is common to the trade, there must be evidence of common use in the marketplace by third parties (*Cie Gervais* at paras 17-18; *Kellogg* at para 14).

[35] Ms. Horvat's affidavit includes the results of a search of the Canadian Trademarks Register for active trademarks containing the word “tease” which are of record in association with goods classified in Class 3 of the Nice Classification system. This search yielded 28 trademarks, the particulars of which are included at Exhibit 3 to her affidavit. In reviewing the search results, I note the following which diminishes the number of applicable results:

- The search includes two applications which are formalized. In the absence of evidence of use, these applications do not result in the inference that the marks are in use in Canada: MAC NATURAL TEASE (1,981,297) and PRETTY IN PINK TEASE (1,960,438).
- The subject Application of the Applicant is among the results listed.
- Two of the trademarks identified in the search do not appear to include the word “tease” but instead consist of design marks including Chinese characters that translate to “at ease” which is clearly different from the word “tease”: CHANDO & 3 Chinese characters design (1,022,742); CHCEDO & 3 Chinese characters design (TMA823,808).
- The trademark “AT-EASE” (TMA216,646) was included in the results; however, these words are clearly different from the word “tease”.
- In three of the trademarks, the word “tease” is either very difficult to see or not visible within the designs of these marks: LA SENZA BODY KISS Label (TMA840,036); LA SENZA BODY KISS Berry Lovely Label (TMA840,035); HUDON LE SOIXANTE-DIX-HUIT et la tête de cheval (TMA926,742).

[36] In addition to the state of the register search, Ms. Horvat includes printouts from Canadian websites including: the Victoria’s Secret’s website showing TEASE REBEL, VICTORIA’S SECRET TEASE, and TEASE GLAM fragrance; NYX Cosmetics’ website showing various SLIP TEASE lip cosmetic products; Redken’s website showing QUICK TEASE hair spray; Sephora’s website showing the “Texas Tease Teasing Brush” styling hairbrush, and Shopper’s Drug Mart’s website showing Buxom’s “Big Tease™ Plumping Mascara”. These websites appear to correspond to a number of trademarks identified in the state of the register search.

[37] I am prepared to accord limited significance to Ms. Horvat’s marketplace evidence as it appears that some third parties have been active under trademarks incorporating the word “tease” in association with cosmetics and personal care products generally (though the Texas Tease Teasing Brush is slightly more removed as it is a hairbrush). Accordingly, this factor favours the Applicant to a limited extent with the following caveats. First, it is not certain that a sufficient number of registrations and examples of use in the fields of the parties has been provided for this

factor to significantly favour the Applicant. Second, there is very limited evidence that any of these third party trademarks has acquired any reputation in the marketplace.

Conclusion

[38] The question posed by section 6(2) of the Act is whether customers of the Goods provided with the Mark would believe that these goods are provided, authorized, or licensed by the Opponent owing to its trademark TEEEZ. I have assessed this as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark, at a time when they have no more than an imperfect recollection of the Opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[39] Having regard to section 6(5), I find that the Applicant has met the legal onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark TEEEZ. I reach this conclusion as I find the differences existing between the trademarks outweigh the overlap in the goods of the parties and the potential for overlap in their trades. Accordingly, this ground of opposition is rejected.

Sections 16(2)(a) and 16(3)(a) grounds of opposition

[40] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of section 16(3)(a) of the Act because, at the date of filing of the Application, the Mark was confusing with the Opponent's trademark TEEEZ, which was previously used and made known by the Opponent in Canada in association with a variety of products and at least the goods identified above at paragraph 3 of this decision.

[41] The Opponent has provided no evidence of the use or making known of its trademark in Canada. Therefore, it has not met its initial evidential burden and this ground of opposition is rejected.

[42] With respect to the ground of opposition pleaded under section 16(2)(a) of the Act, as the Application does not include a claim of foreign use and registration, this ground is improperly pleaded and is therefore rejected.

Section 2 ground of opposition

[43] The Opponent has pleaded that the Mark is not distinctive because it is not capable of distinguishing the Applicant's goods from those of others, particularly the goods sold by the Opponent under the trademark TEEEZ, nor is it adapted to so distinguish them.

[44] To meet its initial evidential burden under this ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with the relevant goods and/or services so as to negate the distinctiveness of the applied for trademark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FCTD)].

[45] In this case, the Opponent has provided no evidence of the use of its trademark in Canada. Therefore, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

DISPOSITION

[46] In view of all the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2021-11-03

APPEARANCES

No one appearing

FOR THE OPPONENT

Jonathan Burkinshaw

FOR THE APPLICANT

AGENT(S) OF RECORD

Osler, Hoskin & Harcourt LLP

FOR THE OPPONENT

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FOR THE APPLICANT

SCHEDULE A

The full statement of goods in the Opponent's registration No. TMA842,500 is set out below:

(1) Bleaching preparations and detergents for laundry use; all purpose cleaning preparations, all purpose scouring liquids, all purpose scouring powders, and general use abrasives; soaps, namely bath soaps, body soaps, hand soaps; perfumery, essential oils for aromatherapy, essential oils for personal use, essential oils for the manufacture of perfumes, cosmetics, hair lotions; dentifrices; precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments, namely clocks, wristwatches; clothing, namely lingerie, underwear, scarfs; footwear, namely shoes, boots, sandals, beach footwear, casual footwear, evening footwear, sports footwear; headgear, namely hats.