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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 055

Date of decision: 2022-03-24

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF OPPOSITIONS

**Make Up United International
Limited**

Opponent

and

L'OREAL, Société Anonyme

Applicant

1,805,644 for NYX

Applications

PROFESSIONAL MAKEUP SLIP

TEASE & Design

1,821,584 for NYX



PROFESSIONAL MAKEUP PIN-UP

TEASE & Design

INTRODUCTION

[1] Make Up United International Limited (the Opponent) opposes registration of the trademarks NYX PROFESSIONAL MAKEUP SLIP TEASE & Design and NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design (reproduced below) subject of

Application Nos. 1,805,644 and 1,821,584, respectively, on behalf of L'OREAL, Société Anonyme (the Applicant).

Application No. 1,805,644	Application No. 1,821,584
 <p>The logo for Application No. 1,805,644 features the word "NYX" in a bold, black, sans-serif font. Below it is a small black triangle pointing downwards, followed by the words "PROFESSIONAL MAKEUP" in a smaller, black, sans-serif font. At the bottom, the words "SLIP TEASE" are written in a bold, black, sans-serif font.</p>	 <p>The logo for Application No. 1,821,584 features the word "NYX" in a bold, black, sans-serif font. Below it is a small black triangle pointing downwards, followed by the words "PROFESSIONAL MAKEUP" in a smaller, black, sans-serif font. At the bottom, the words "pin-up tease" are written in a black, cursive script font.</p>

[2] Application No. 1,805,644 is based on the proposed use of the mark in connection with [TRANSLATION] “make-up”.

[3] Application No. 1,821,584 is based on the proposed use of the mark in connection with [TRANSLATION] “mascaras”.

[4] In general, each of the oppositions is based on allegations of confusion between the Applicant’s trademark and the Opponent’s trademark TEEEZ in relation to various products, including cosmetics.

[5] For the following reasons, I consider that each of the oppositions should be rejected.

THE FILES

[6] Application No. 1,805,644 for the mark NYX PROFESSIONAL MAKEUP SLIP TEASE & Design was filed on October 20, 2016. This application was advertised in the *Trademarks Journal* on July 12, 2017.

[7] Application No. 1,821,584 for the mark NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design was filed on February 6, 2017. This application was advertised in the *Trademarks Journal* on July 5, 2017.

[8] Unless otherwise indicated, any subsequent use of “the Mark” in my decision is a reference to both the NYX PROFESSIONAL MAKEUP SLIP TEASE & Design and NYX PROFESSIONAL MAKEUP PIN UP TEASE & Design trademarks.

[9] It should be noted that the *Trademarks Act*, RCS 1985, c T-13 (the Act) was amended on June 17, 2019. Therefore, all references in this decision are made to the Act as amended, except for references to the grounds of opposition that pertain to the Act before it was amended. [See section 70 of the Act, which provides that section 38(2) of the Act as it read before June 17, 2019, applies to applications advertised before that date.]

[10] Each of the statements of opposition, filed on August 24, 2017, raises grounds of opposition alleging that the Mark is not registrable (s. 12(1)(d) of the Act); that the Applicant is not the person entitled to the registration of the Mark (s. 16(2)(a) and 16(3)(a) of the Act); and that the Mark is not distinctive (s. 2 of the Act). In support of its grounds of opposition, the Opponent alleges the likelihood of confusion with its registered trademark TEEEZ (No. TMA842,500) previously used and made known in Canada, at least in association with the following goods: “*soaps, bath soaps, body soaps, hand soaps; perfumery, essential oils for aromatherapy, essential oils for personal use, essential oils for the manufacture of perfume, cosmetics, hair lotions.*”

[11] In each file, the Applicant filed and served a counter statement denying all the allegations pleaded in the statement of opposition.

[12] Both parties submitted evidence in each file.

[13] Only the Applicant filed written representations in each file and was represented at the hearing held for both files.

THE PARTIES’ RESPECTIVE BURDEN OR ONUS

[14] It is initially up to the Opponent to establish the merits of each of its oppositions. The Opponent must ensure that each of its grounds of opposition is properly pleaded and that it meets the initial evidentiary burden by establishing the facts relied upon in support of each ground. Once this initial evidentiary burden has been met, the Applicant bears the legal onus of

establishing, on a balance of probabilities, that no grounds of opposition prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

THE PARTIES' EVIDENCE

[15] I provide below an overview of the evidence filed by the parties in each case.

Opponent's evidence

[16] In each case, the Opponent filed an affidavit by Michel Johannes Franciscus Vermonden dated May 28, 2018, which are attached as Exhibits A to H. Since the affidavits of Mr. Vermonden are essentially identical, I will use the singular in reviewing them. I would add that I will ignore some of the statements made by Mr. Vermonden that amount to issues of fact and law that the Registrar must determine.

[17] The Applicant conducted a written cross-examination of Mr. Vermonden. He answered the questions through an affidavit dated May 29, 2019, which are attached as Exhibits A to E. The written questions and reply affidavit were filed in each file.

[18] Mr. Vermonden states that he is the president of Distribrands International Corporation B.V., which also does business under the name Teaz Cosmetics International. In addition, Mr. Vermonden states that he is the president of the Opponent, a Hong Kong entity, which is part of a group of companies that he identifies as the "Teaz Group" and subsequently designates in his affidavit using the clipped form "Teaz" [para 1]. Thus, my use of the term "Teaz" in the review of the evidence reflects Mr. Vermonden's use of that term in his affidavit.

[19] Mr. Vermonden states that Teaz is a high-end, fashion-focused international cosmetics company, positioned in the high-end of the beauty industry. Teaz manufactures and markets a variety of cosmetics, which generally fall into four categories: Lip products, eye products, face products, and nail products [para 3].

[20] Paragraphs 4 to 9 of Mr. Vermonden's affidavit are presented as relevant to the international market, while paragraphs 10 to 21 are presented as relevant to the Canadian market.

I believe that the most relevant evidence for the purpose of providing an overview of it is presented in paragraphs 10 to 15 of Mr. Vermonden's affidavit. Moreover, his written cross-examination dealt with this evidence.

[21] The following is therefore a relatively exhaustive summary of the assertions contained in paragraphs 10 to 15 of Mr. Vermonden's affidavit, documentary evidence submitted in support of them, and statements contained in the reply affidavit to the cross-examination.

- In Canada, Teaz has an exclusive partnership with Hudson's Bay (The Bay) stores [para 10 of the affidavit]. This partnership began on July 17, 2015, and the first shipment of products arrived in Canada on or about April 12, 2016 [para 3 of the reply affidavit]. A copy of the bill of lading for this first delivery is submitted under Exhibit B of the reply affidavit.
- Teaz's products are sold in TEEEZ shops located inside Bay stores [para 11 of the affidavit]. Photos of TEEEZ shops in various Bay stores are submitted under Exhibit E of the affidavit. The first sale of TEEEZ products in stores dates back to April 15, 2016 [para 6 of the reply affidavit].
- TEEEZ products are also sold through *www.thebay.com* since April 18, 2016 [para 13 of the affidavit; para 8 of the reply affidavit]. Printouts of this website are filed under Exhibit F of the affidavit.
- The amounts invested for the promotion and advertising of TEEEZ products in Canada were CA\$655,995 in 2016 and CA\$245,776 in 2017 [para 14 of the affidavit]. Examples of promotions and advertising are filed under Exhibit G of the affidavit.
- Exhibit H of the affidavit consists of a sampling of sales invoices for TEEEZ products, with some information blacked out for confidentiality reasons. The companies Teaz Company B.V. and Teaz Company USA LLC issuing certain invoices are companies related to Teaz [para 15 of the affidavit]. Mr. Vermonden refused to file invoices without blacked-out prices on the ground that this information is not relevant and that the quantities of products sold are identified on the invoices [para 9 of the reply affidavit].

[22] I reproduced below the first part of paragraph 10.2 of the reply affidavit relating to questions about Dupuis Magna Cosmetics, to which are addressed some of the invoices attached under Exhibit H of the affidavit:

Dupuis Magna Cosmetiques was a licensed distributor of TEEZ branded products in Canada from in or around July 2011 to in and around July 2015. At all material times, and to the extent necessary, Make Up United International Limited (a part of the Teaz Group of companies) has had direct or indirect control over the character and quality of all products manufactured and sold, and any related sales, advertising and promotional activities, in association with its TEEEZ formative trade-mark in Canada.

[23] I conclude my review of the Opponent's evidence by noting that a significant number of questions from the written cross-examination relate to designations and references to items identified on invoices filed under Exhibit H of the affidavit [paras 14–24 of the reply affidavit].

Applicant's evidence

[24] In each case, the Applicant filed an affidavit by Brian Slatford, dated October 25, 2019, attached as Exhibits BSL-1 to BSL-3. Mr. Slatford, a trademark agent in training working for the Applicant's trademark agents, was not cross-examined.

[25] In each case, Mr. Slatford submits the following evidence:

- the results of a search identifying all trademarks including the “NYX” component held by the Applicant in Canada [para 3; Exhibit BSL-1];
- the results of a search for trademarks including the word “tease” registered in Canada in Class 3 [paras 4–5; Exhibit BSL-2]; and
- copies of decisions rejecting the Opponent's oppositions to registration applications filed by the Applicant in jurisdictions other than Canada, namely an application for the mark NYX PROFESSIONAL MAKEUP SLIP TEASE & Design in Turkey and applications for the mark NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design for the European Union and in France [para 6; Exhibit BSL-3].

ANALYSIS OF THE GROUNDS OF OPPOSITION

[26] The grounds for opposition, the parties' evidence, and the applicant's written and oral representations are identical in both cases. In addition, the differences between the mark NYX PROFESSIONAL MAKEUP SLIP TEASE & Design and the mark NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design have no bearing on my analysis of the grounds of opposition. Therefore, unless otherwise indicated, any finding in respect of a ground of opposition applies to both Applications No. 1,805,644 and No. 1,821,584.

Preliminary remarks

[27] The Applicant filed several written representations in support of its position that none of the evidence provided by Mr. Vermonden's affidavit dated May 28, 2018, supports the conclusion that the trademark TEEEZ has been used in Canada at any time. With respect to the replay affidavit dated May 29, 2019, the Applicant essentially submits that it confirms the weakness of the Opponent's evidence.

[28] According to the Applicant's written representations, even in the event of a finding that the evidence demonstrates the use of the TEEEZ mark in Canada, it would be necessary to find that the evidence does not demonstrate the use of the mark by the Opponent itself, nor demonstrate a use that benefits the Opponent because of the lack of evidence establishing that the Opponent controls, directly or indirectly, the characteristics or quality of the products associated with its mark used by other companies in the Teaz Group, as required by section 50(1) of the Act.

[29] At the hearing, I sought comments from the Applicant as to whether Mr. Vermonden's assertions in paragraph 10.2 of the reply affidavit, which are reproduced in paragraph 22 of my decision, are sufficient to establish the Opponent's control of the character or quality of the goods associated with its mark. The Applicant essentially argued that even if the issue of the use of the mark TEEEZ was decided in favour of the Opponent, this would be of no consequence in assessing the likelihood of confusion given the degree of resemblance, or rather the absence of resemblance, between the parties' marks.

[30] In general, I find that the Applicant's position regarding the shortcomings of the Opponent's evidence is not without merit. In any event, I do not see the need to further discuss the evidence submitted by the Opponent, nor to decide on the use of its mark. As will be apparent from my analysis below, the outcome of each opposition does not revolve around whether the evidence demonstrates the use of the mark TEEZ in Canada by the Opponent or a use deemed to be that of the Opponent under section 50(1) of the Act.

Non-Registrability of the Mark – Section 12(1)(d) of the Act

[31] The material date for deciding on the ground of opposition alleging that the Mark is non-registrable because of the confusion regarding association with the registered trademark TEEZ (No. TMA842,500) of the Opponent is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[32] Having exercised the Registrar's discretion and checked the Register of Trademarks, I confirm that registration No. TMA842,500 is in effect. I note that the statement of goods of the registration was amended on February 27, 2022, to read "*cosmetics*". This amendment is the result of a proceeding under section 45 of the Act [see *Fasken Martineau Dumoulin LLP v Make Up United International Limited*, 2021 TMOB 252].

[33] Since the Opponent has met its initial evidentiary burden, the Applicant must therefore demonstrate, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's TEEZ mark registered in relation to cosmetics.

The test for confusion

[34] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the conclusion that the goods associated with those trademarks are manufactured, sold, leased, hired or that the services associated with these trademarks are hired or performed by the same person, regardless of whether these services are in the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not deal with confusion between

trademarks themselves, but rather with the likelihood that goods or services from one source will be perceived as being from another source.

[35] In determining whether trademarks cause confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and each of these factors can be assigned a different weight depending on the context [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 for further discussion of the general principles that govern the test for confusion].

[36] In *Masterpiece*, above, the Supreme Court of Canada reiterated that the degree of resemblance between trademarks in appearance or sound, or in the ideas they suggest, is often the factor that may be most important in the confusion analysis. In its discussion of the importance of this factor, the Supreme Court wrote the following at paragraph 49 of *Masterpiece*:

... As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532). As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (*ibid.*).

[37] In the circumstances of this case, I believe that the confusion analysis should begin by examining the degree of resemblance between the trademarks.

[38] It is well established in case law that in assessing confusion, trademarks should not be dissected into their constituent parts. Trademarks should instead be examined as a whole. I note that in *Masterpiece*, the Supreme Court observed that it is preferable, when comparing trademarks, to first consider whether the marks have a particularly striking or unique appearance [see *Masterpiece*, above, para 64].

[39] In this case, the Opponent's mark TEEEZ consists of one element.

[40] As for the Mark, it consists of several elements. I believe that NYX is the striking element of the Mark. In other words, the word TEASE, although phonetically similar to TEEEZ, is not a striking element of the Mark. Moreover, the phonetic similarity between TEASE and TEEEZ is mitigated by the positioning of TEASE in the Mark.

[41] In this respect, in the mark NYX PROFESSIONAL MAKEUP SLIP TEASE & Design, the word "tease" is preceded by the word "slip." In the mark NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design, the word "tease" is preceded by the word "pin-up." In each of the marks, the two words are presented in a single graphic form. I find that the word "tease" in each mark is linked to the word that precedes it; the word "tease" would therefore be seen and spoken in combination with the word that precedes it. In other words, the word "tease" would not be seen or spoken in isolation.

[42] In addition to the phonetic and visual differences between the marks, I believe that there is no resemblance in terms of the ideas they suggest.

[43] I agree with the Applicant's oral representations that the consumer may not associate the mark TEEEZ with the dictionary word "tease" as this word has no meaning or connotation in the context of cosmetics. Therefore, it can be said that the idea suggested by the Opponent's mark TEEEZ is not obvious in this case.

[44] I also agree with the Applicant's oral representations that its mark NYX PROFESSIONAL MAKEUP PIN-UP TEASE & Design suggests the idea of a beautiful, attractive girl. In this regard, having exercised the discretion of the Registrar, I refer to the following definition of the word "pin-up" in the *Larousse* dictionary: [TRANSLATION] "A good-looking young woman with sex appeal."

[45] Finally, in my opinion, it is likely that "slip tease" in the mark NYX PROFESSIONAL MAKEUP SLIP TEASE & Design is understood as a play on words inspired by the word "strip-tease."

[46] In the end, considering the trademarks as a whole, I conclude that they do not resemble each other. Therefore, and in accordance with the rationale of the Supreme Court of Canada in *Masterpiece*, I find that the remaining factors become irrelevant and do not need to be considered.

Conclusion – Likelihood of confusion

[47] In view of the foregoing, and in particular the lack of resemblance between the marks at issue, I find that the Applicant has met its legal onus of establishing, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trademark TEEEZ.

[48] Therefore, I reject the ground of objection based on section 12(1)(d) of the Act in each file.

Non-entitlement to register the Mark – Sections 16(2)(a) and 16(3)(a) of the Act

Section 16(2)(a) of the Act

[49] The ground of opposition raised under section 16(2)(a) of the Act is invalid in this case as the application for registration is based on proposed use. Therefore, I reject the ground of opposition in each file.

Section 16(3)(a) of the Act

[50] The ground of opposition raised under section 16(3)(a) of the Act alleges that the Applicant is not the person entitled to the registration of the Mark because of the confusion with the mark TEEEZ that the Opponent alleges it had previously used and made known in Canada in connection with the goods identified in the statement of opposition.

[51] The material date for assessing this ground of objection is the filing date of the application for registration, which is in this case October 20, 2016 (Application No. 1,805,644) and February 6, 2017 (No. 1,821,584).

[52] In addition to having to establish the use or making known of its TEEEZ mark in Canada on the material date, the Opponent must establish that its mark had not been abandoned at the date of advertisement of the application for registration; in this case on July 12, 2017 (Application No. 1,805,644) and July 5, 2017 (Application No. 1,821,584).

[53] The difference between the material dates has no bearing in this case, so my finding on the ground of objection based on section 12(1)(d) of the Act also applies to this ground of opposition. Therefore, even if it were found that the Opponent had met its evidentiary burden, I would find that the Applicant met its legal onus of proving, on a balance of probabilities, that the Mark did not cause confusion with the mark TEEEZ on the material date.

[54] Therefore, I reject the ground of opposition based on section 16(3)(a) of the Act in each file.

Non-distinctiveness of the Mark – Section 2 of the Act

[55] The material date for the assessment of the ground of opposition alleging that the Mark is not distinctive under section 2 of the Act is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[56] The Opponent has the initial burden of establishing that its trademark TEEEZ was sufficiently known in Canada as of August 24, 2017, to negate the distinctiveness of the Mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657].

[57] Again, the difference between the material dates has no bearing on this case, so my finding on the ground of opposition based on section 12(1)(d) of the Act also applies to this ground of opposition. Therefore, even if it were found that the Opponent had met its evidentiary burden, I would find that the Applicant met its legal onus of proving, on a balance of probabilities, that the Mark was distinctive on the material date.

[58] Therefore, I reject the ground of opposition based on section 2 of the Act in each file.

DECISION

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

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Daniel Lepine

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

HEARING DATE February 16, 2022

APPEARANCES

No one appearing	For the Opponent
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