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## **OWNER OF L'OREAL PARIS TRADE-MARK SUCCEEDS IN OPPOSING ATTEMPT TO REGISTER L'OREAL PARIS FOR VITAMIN SUPPLEMENTS BY QUESTIONING APPLICANT'S GOOD FAITH**

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LAWYERS, PATENT & TRADEMARK AGENTS

In a recent case that examined the serial filing by an applicant of others' well-known trade-marks, L'Oréal, the renowned cosmetics company, succeeded in opposing an attempt by an individual to register the trade-mark L'OREAL PARIS in association with vitamin, mineral and herbal supplements and combinations thereof along with aloe vera drinks (*L'Oréal v. Marcon*, 2010 TMOB 66, D.H. Carreau, Chairperson, May 17, 2010; issued June 7, 2010).

On December 11, 2003, Robert V. Marcon (hereafter: "Marcon" or the "Applicant") filed an application to register the trade-mark L'OREAL PARIS (hereafter: the "Trade-mark") on the basis of proposed use of such Trade-mark in Canada in association with the above-mentioned products. This application was advertised for opposition purposes on January 3, 2007 and on May 31, 2007, L'Oréal (hereafter: "L'Oréal" or the "Opponent") opposed the L'OREAL PARIS mark filed by Marcon.

In its statement of opposition, L'Oréal alleged that Marcon's application did not conform to the requirements of section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter: the "Act") on the basis that the Applicant could not have been satisfied that he was entitled to use the mark L'OREAL PARIS in Canada because the Applicant had adopted a "*modus operandi*" of filing applications for well-known trade-marks in identical or related fields in Canada.

Additionally, the statement of opposition alleged that the Trade-mark L'OREAL PARIS filed by Marcon was not registrable because of confusion with a number of the Opponent's registered trade-marks contrary to section 12(1)(d) of the Act, including most notably, the trade-mark L'OREAL PARIS registered under registration number TMA 655,217 and the trade-mark L'OREAL registered under registration number TMDA29020.

In her reasons, Chairperson Carreau dealt first with the issue of confusion raised by the Opponent's statement of opposition. On this topic, Marcon argued that the

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Opponent's trade-mark L'OREAL PARIS was a weak mark. Chairperson Carreau disagreed noting that the strength of the Opponent's L'OREAL PARIS trade-mark had increased through significant use in Canada over the years. The evidence revealed that the net sales of products in Canada in association with the Opponent's L'OREAL PARIS trade-mark from 1997 to 2007 were quite important. In view of the Opponent's evidence, Chairperson Carreau was satisfied that the Opponent's L'OREAL PARIS trade-mark had become very well-known in Canada.

As for the parties' respective fields of trade, Chairperson Carreau noted that the Opponent's perfumery products, cosmetics, make-up, skin and body care products, beauty products as well as hair care, coloration and hair products differed from the Applicant's wares mentioned in his application.

While this was true, the Opponent argued that the evidence pointed to a connection between the parties' respective wares. Indeed, as its evidence demonstrated, the Opponent had more than a hundred cosmetic related patents in Canada, including those in the field of nutricosmetics, described as an alternative type of cosmetics which activate the biological resources of the skin from within. Additionally, the Opponent also furnished evidence demonstrating that aloe vera was a common component in skin care, beauty and hair care products.

On the issue of the wares of the parties, Chairperson Carreau agreed with the Opponent's submission that it was not necessary for the parties to operate in the same general field or industry for there to be likelihood of confusion (since the wares or the services need not be of the same general class for the use of a trade-mark to cause confusion with another).

Chairperson Carreau noted the extensive reputation and use of the Opponent's registered trade-mark L'OREAL PARIS in Canada, the overlap between the channels of trade and the fact that the marks were identical and concluded that Marcon had not discharged his burden of showing, on a balance of probabilities, that there was not a reasonable likelihood of confusion between his Trade-mark, L'OREAL PARIS, and the Opponent's registered trade-mark, L'OREAL PARIS. The ground of opposition based on confusion was therefore successful.

Chairperson Carreau thereafter turned to the ground of opposition based on Section 30(i) of the Act that requires that an applicant include in his application for registration of a trade-mark a statement that he is satisfied that he is entitled to use the trade-mark in Canada in association with the listed wares or services described in the application.

Chairperson Carreau reminded the parties that the presence of such statement in an application is more than a formal requirement, it is confirmation of the applicant's good faith in submitting its application for registration of the trade-mark in Canada. Accordingly, when an applicant has provided the statement required by section 30(i) of the Act, this ground of opposition will only succeed in exceptional cases, such as

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the ones where there is bad faith on the part of the applicant. What was the evidence submitted by the Opponent in the present case?

Here, the Opponent furnished evidence demonstrating that in 2003, when the L'OREAL PARIS application was filed, the Applicant also filed in his name several other applications to register the following trade-marks in Canada: BAYER; BEEFEATER; BUDWEISER, COORS; CORONA; DOM PERIGNON; EVIAN; FINLANDIA; HEINEKEN; JACK DANIEL'S; NESCAFÉ; NESTLÉ; SENSODYNE; TIM HORTONS; ABSOLUT; CANADIAN CLUB; SOUTHERN COMFORT and CHANEL.

The Opponent also filed certified copies of several Canadian trade-mark registrations, evidencing that the trade-marks filed by Marcon in 2003 had already been registered in Canada, some several decades earlier, in the name of third parties. Thus, it was established that the trade-mark BAYER stands registered in the name of Bayer Aktiengesellschaft, BEEFEATER in the name of Allied Domecq Spirits & Wine Limited, CHANEL in the name of Chanel S. de R.L., COORS in the name of Coors Global Properties, Inc., CORONA in the name of Cervceria Modelo, S.A. de C.V., DOM PERIGNON in the name of Champagne Moët & Chandon, FINLANDIA & DESIGN in the name of Finlandia Vodka Worldwide Ltd., HEINEKEN in the name of Heineken Brouwerijen B.V., L'OREAL PARIS in the name of L'Oréal, NESTLE in the name of Société des Produits Nestlé S.A., SENSODYNE in the name of GlaxoSmithKline Consumer Healthcare Inc., TIM HORTONS & DESIGN in the name of The TDL Marks Corporation and EVIAN in the name of Société anonyme des eaux minérales d'Evian.

The Opponent also established that the above parties also owned many related or associated trade-marks in Canada.

For its part, the Applicant did not file any evidence with respect to his compliance with section 30(i) of the Act. This ground of opposition was also allowed for the following reasons:

[32] The evidence demonstrates that the particular facts of this case are exceptional. Specifically, in view of the evidence filed by the Opponent and in the absence of any evidence filed by the Applicant, I am not satisfied that the Applicant's statement required by s. 30(i) of the Act was made in good faith. I also reach this conclusion on the basis of having already found that there is a likelihood of confusion between the Applicant's Mark and the Opponent's registered trade-mark L'OREAL PARIS. Accordingly, the s. 30(i) ground of opposition also succeeds.

This decision is worth noting since section 30(i) of the Act is rarely a successful ground of opposition. The circumstances of these proceedings seem to have provided the "perfect storm" of events in order to enable the Registrar to conclude that good faith appeared not to be present in this case. However, this conclusion would not have been reached without the evidence of third party registrations filed by

the Opponent; this decision highlights the importance of carefully considering the content of an opponent's evidence in support of a section 30(i) ground of opposition.

*L'Oréal was represented by ROBIC, LLP in this case.*



