



## MADRID PROTOCOL

Total Provisional Refusal of Protection

(Rule 17(1) of the Regulations under the Protocol)

**I. Name of the Office:**

Canadian Intellectual Property Office

**II. International registration number:**

1594188

**III. Name of the holder:**

Thrive Causemetics, Inc.

**IV. Information concerning the type of provisional refusal:**

Total provisional refusal based on an opposition.

(i) Name of the opponent:

Avon NA IP LLC

(ii) Address of the opponent:

One Avon Place  
Suffern, NY 10901  
UNITED STATES OF AMERICA

**V. Information concerning the scope of the provisional refusal:**

The provisional refusal affects all the goods and services.

**VI. Grounds for refusal (where applicable, see item VII):**

38(2)(b): The trademark is not registrable Section 12(1)(d): The trademark is not registrable because it is confusing with a registered trademark. The trademark is confusing with the following registered trademark(s): TMA980994 Additional information: Under section 38(2)(b) of the Act, the TIMELESS AMBITION mark is not registrable because, contrary to section 12(1)(d) of the Act, the Opposed Mark is confusing with the Opponent's registered trademark no. TMA980994 for TIMELESS. 38(2)(c): The applicant is not the person entitled to registration of the trademark Section 16(1)(a): The applicant is not the person entitled to registration because the trademark applied for was confusing with a trademark previously used or made known in Canada by any other person. List of trademark(s) relied upon, including Trademarks that are not the subject of an application or registration, and the associated goods or services: Under section 38(2)(c) of the Act, the Applicant is not the person entitled to register the TIMELESS AMBITION mark under section 16 of the Act because, as of the Application filing date, namely April 8, 2021, contrary to section 16(1)(a) of the Act, the Opposed Mark was confusing with the Opponent's TIMELESS trademark, which has and had been extensively used and made known in Canada for more than 40 years in association with fragrances, cosmetics and toiletries, and which was not abandoned as of the date the Application was advertised (i.e., October 26, 2022). 38(2)(d): The

trademark is not distinctive Section 38(2)(d): The trademark is not distinctive The trademark is not distinctive within the meaning of section 2 of the Trademarks Act for the following reasons: Under section 38(2)(d) of the Act, the Opposed Mark is not distinctive of the Applicant, within the meaning of "distinctive" as set out in section 2 of the Act, because the Opposed Mark does not actually distinguish, nor is it adapted to distinguish, the goods of the Applicant identified in the Application from the goods of other traders, namely the goods of the Opponent, namely fragrances, cosmetics, and toiletries, sold and provided continuously and extensively in association with its TIMELESS trademark. 38(2)(f): At the filing date of the application in Canada, determined without taking into account section 34(1), the applicant was not entitled to use the trademark in Canada in association with the goods and services Section 38(2)(f): At the filing date of the application in Canada, determined without taking into account section 34(1), the applicant was not entitled to use the trademark in Canada in association with the goods and services The applicant is not entitled to use the trademark in Canada for the following reasons: d. Under section 38(2)(f) of the Act, at the filing date of the TIMELESS AMBITION application, namely April 8, 2021, the Applicant was not entitled to use the trademark in Canada in association with the goods in the Application for the following reasons: i. Use of the Opposed Mark would violate the Applicant's exclusive rights in its registered TIMELESS trademark under section 19 of the Act. ii. Use of the Opposed Mark in Canada with the goods covered by the Application is likely to cause confusion with the Opponent's TIMELESS trademark, contrary to section 20 of the Act. iii. Use of the Opposed Mark would depreciate the goodwill associated with the Opponent's registered TIMELESS trademark, contrary to section 22 of the Act.

## VII. Information relating to an earlier mark:

1780159 TMA980,994

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- (i) Filing date and number, and, if any, priority date:  
2016-04-29, **1780159**
- (ii) Registration date and number (if available):  
2017-09-20, TMA980,994
- (iii) Name and address of the owner:  
Avon NA IP LLC  
One Avon Place  
Suffern, New York 10901  
UNITED STATES OF AMERICA
- (iv) Reproduction of the mark:  
TIMELESS
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):  
Cosmetics and toilet preparations, namely, skin lotions and creams, perfumes, cologne, talc, soaps for personal use and bath oil

## **VIII. Provisions of the applicable law:**

38(2)(b): The trademark is not registrable

Section 12(1)(d): The trademark is not registrable because it is confusing with a registered trademark.

38(2)(c): The applicant is not the person entitled to registration of the trademark

Section 16(1)(a): The applicant is not the person entitled to registration because the trademark applied for was confusing with a trademark previously used or made known in Canada by any other person.

38(2)(d): The trademark is not distinctive

Section 38(2)(d): The trademark is not distinctive

38(2)(f): At the filing date of the application in Canada, determined without taking into account section 34(1), the applicant was not entitled to use the trademark in Canada in association with the goods and services

Section 38(2)(f): At the filing date of the application in Canada, determined without taking into account section 34(1), the applicant was not entitled to use the trademark in Canada in association with the goods and services

## **IX. Information relating to the possibility to request a review or file an appeal or otherwise respond to the opposition:**

(i) Time limit to request a review or file an appeal or otherwise respond to the opposition:

2023-06-28

(ii) Calculation of time limit (the time limit runs from):

2023-06-28

(iii) Authority to which such request for review, appeal or response should be made:

Registrar of Trademarks

(iv) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:

Correspondence must be in French or English

(v) Other requirements, if any:

Not applicable

## **X. Date and signature of the Office:**

Registrar of Trademarks

2023-04-28

## STATEMENT OF OPPOSITION

Processed: April 27, 2023 11:43:11

Transmission identification: Kellykv620230426120246000\_SO\_ES15480051

Electronic application timestamp: April 26, 2023 12:02:46

### Canadian Intellectual Property Office

Place du Portage 1  
50 Victoria Street  
Gatineau, QC K1A 0C9  
Canada

### Trademark details

**Trademark:** TIMELESS AMBITION

**Application number:** 2111595

**International registration no.:** 1594188

**Case number:** 1

**Status:** Proposed Opposition

**Advertised date:** 2022-10-26

**Current deadline:** 2023-04-26

### Applicant

**Applicant name:** Thrive Causemetics, Inc.

**Address of the applicant:** 10900 NE 4th Street, Suite 2300 Bellevue WA 98004, UNITED STATES OF AMERICA

**Name of the appointed trademark agent OR name of the firm at which all trademark agents are appointed:** SMART & BIGGAR LP

**Address of the agent:** 1100-150 York street TORONTO, ON M5H3S5 CANADA

**Phone number of the agent:** 416-593-5514

### Opponent

**Opponent name:** Avon NA IP LLC

**Type:** Organization

**Address:** One Avon Place, Suffern, NY 10901 UNITED STATES OF AMERICA

**Address for service in Canada:** Scotia Plaza, 40 King Street West, 40th Floor, Toronto, ON M5H3Y2 CANADA

**Preferred method of correspondence:** Paper

**Language of correspondence:** English

**Name of the appointed trademark agent OR name of the firm at which all trademark agents are appointed:**

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

**Address of the agent:** SCOTIA PLAZA 40 KING STREET WEST 40th FLOOR , TORONTO, ON M5H3Y2 CANADA

**Phone number of the agent:** 416-364-7311

**Agent's reference number:** 4137.OT11317CA00

**Attention to:** Meghan Dillon

### Request submitted by

**Name of the appointed trademark agent OR name of the firm at which all trademark agents are appointed:**

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

**Address of the agent:** SCOTIA PLAZA 40 KING STREET WEST 40th FLOOR , TORONTO, ON M5H3Y2 CANADA

**Phone number of the agent:** 416-364-7311

**Agent's reference number:** 4137.OT11317CA00

**Attention to:** Meghan Dillon

**Name of the individual trademark agent (not firm) submitting this correspondence:** Meghan Dillon

**Request details**

The grounds of opposition are as follows:

**38(2)(b): The trademark is not registrable**

**Section 12(1)(d): The trademark is not registrable because it is confusing with a registered trademark.**

The trademark is confusing with the following registered trademark(s):  
TMA980994

Additional information:

Under section 38(2)(b) of the Act, the TIMELESS AMBITION mark is not registrable because, contrary to section 12(1)(d) of the Act, the Opposed Mark is confusing with the Opponent's registered trademark no. TMA980994 for TIMELESS.

**38(2)(c): The applicant is not the person entitled to registration of the trademark**

**Section 16(1)(a): The applicant is not the person entitled to registration because the trademark applied for was confusing with a trademark previously used or made known in Canada by any other person.**

List of trademark(s) relied upon, including Trademarks that are not the subject of an application or registration, and the associated goods or services:

Under section 38(2)(c) of the Act, the Applicant is not the person entitled to register the TIMELESS AMBITION mark under section 16 of the Act because, as of the Application filing date, namely April 8, 2021, contrary to section 16(1)(a) of the Act, the Opposed Mark was confusing with the Opponent's TIMELESS trademark, which has and had been extensively used and made known in Canada for more than 40 years in association with fragrances, cosmetics and toiletries, and which was not abandoned as of the date the Application was advertised (i.e., October 26, 2022).

**38(2)(d): The trademark is not distinctive**

The trademark is not distinctive within the meaning of section 2 of the Trademarks Act for the following reasons:

Under section 38(2)(d) of the Act, the Opposed Mark is not distinctive of the Applicant, within the meaning of "distinctive" as set out in section 2 of the Act, because the Opposed Mark does not actually distinguish, nor is it adapted to distinguish, the goods of the Applicant identified in the Application from the goods of other traders, namely the goods of the Opponent, namely fragrances, cosmetics, and toiletries, sold and provided continuously and extensively in association with its TIMELESS trademark.

**38(2)(f): At the filing date of the application in Canada, determined without taking into account section 34(1), the applicant was not entitled to use the trademark in Canada in association with the goods and services**

The applicant is not entitled to use the trademark in Canada for the following reasons:

d. Under section 38(2)(f) of the Act, at the filing date of the TIMELESS AMBITION application, namely April 8, 2021, the Applicant was not entitled to use the trademark in Canada in association with the goods in the Application for the following reasons:

- i. Use of the Opposed Mark would violate the Applicant's exclusive rights in its registered TIMELESS trademark under section 19 of the Act.
- ii. Use of the Opposed Mark in Canada with the goods covered by the Application is likely to cause confusion with the Opponent's TIMELESS trademark, contrary to section 20 of the Act.
- iii. Use of the Opposed Mark would depreciate the goodwill associated with the Opponent's registered TIMELESS trademark, contrary to section 22 of the Act.

**Submission date:** 2023-04-26  
**Submission time:** 12:02:46 EDT