



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

**Citation: 2011 TMOB 138**  
**Date of Decision: 2011-08-01**

**IN THE MATTER OF AN OPPOSITION by  
Helen of Troy Limited to application  
No. 1,336,973 for the trade-mark BIOXO  
MOUSSE OXO-DEGRADABLE FOAM &  
Design in the name of Cascades Canada Inc.**

[1] On February 26, 2007, Cascades Canada Inc. (the Applicant) filed an application to register the trade-mark BIOXO MOUSSE OXO-DEGRADABLE FOAM & Design (shown below) (the Mark) based upon proposed use of the Mark in Canada in association with the following wares: “food container” (the Wares):



[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 26, 2007.

[3] On February 21, 2008, Helen of Troy Limited (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(a) and (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person

entitled to registration of the Mark pursuant to s. 38(2)(c) of the Act in view of the fact that the Mark is confusing with the Opponent's family of OXO trade-marks (hereinafter referred to collectively as the Opponent's family of OXO Marks), which have been previously used and made known in Canada by the Opponent. A table outlining the particulars of the trade-mark registrations and applications covered by the Opponent's family of OXO Marks, as listed by the Opponent in its statement of opposition, is attached to my decision as Schedule A. The statement of opposition further claims that the Mark is not registrable pursuant to s. 12(1)(b), (c) and (e) of the Act in view of the fact that the Mark clearly describes that the Wares biodegrade when exposed to oxygen.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavits of Lynda Palmer, an independent trade-mark searcher, sworn July 30, 2008; Adam Marcus Tracey, a barrister and solicitor with the law firm representing the Opponent in the present opposition proceeding, sworn July 29, 2008; and William Ferguson, the President of Danesco Inc. (Danesco), which is the distributor of the Opponent's products in Canada, sworn August 29, 2008. In support of its application, the Applicant filed the affidavit of Michel Iliesco on January 9, 2009. However, that affidavit was struck from the record and returned to the Applicant pursuant to r. 44(5) of the *Trade-marks Regulations*, SOR/96-195, by way of Office letter dated August 6, 2009. Accordingly, there is no evidence on record from the Applicant.

[6] Only the Opponent filed a written argument and was represented at an oral hearing.

#### Onus and relevant dates

[7] 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 evidentiary 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 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v.*

*Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] The relevant dates for considering the circumstances in regard to each of the grounds of opposition in the present proceeding are the following:

- Grounds based on s. 30(a) and (i) of the Act: the date of filing of the application [see, respectively, *Delectable Publications Ltd. v. Famous Events Ltd.* (1989), 24 C.P.R. (3d) 274 (T.M.O.B.); and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428];
- Ground based on s. 12(1)(b) of the Act: the date of filing of the application [see *Fiesta Barbecues Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.); and *Havana Club Holding S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.)];
- Grounds based on s. 12(1)(c) and (e) of the Act: the date of my decision [see *Anheuser-Busch Inc. v. John Labatt Ltd./John Labatt Ltée* (2001), 14 C.P.R. (4th) 548 (T.M.O.B.); and *Insurance Co. of Prince Edward Island v. Prince Edward Island Mutual Insurance Co.* (1999), 2 C.P.R. (4th) 103 (T.M.O.B.)];
- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on non-entitlement pursuant to s. 38(2)(c) and s. 16(3)(a) and (b) of the Act: the date of filing of the application; and
- Ground based on non-distinctiveness of the Mark: the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); and *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.)].

#### Analysis of the grounds of opposition

[9] I will now assess each of the grounds of opposition without necessarily respecting the order in which they were raised in the statement of opposition.

### Section 12(1)(b) ground of opposition

[10] The Opponent has pleaded that the Mark is contrary to s. 12(1)(b) of the Act in that it “is clearly descriptive or deceptively misdescriptive of the character of the [Wares]. More particularly, the [Mark] clearly describes that the [W]ares biodegrade when exposed to oxygen”.

[11] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares or services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression. I wish to reproduce on this point the following statements from the Federal Court:

To be objectionable as descriptive under s. 12(1)(b) the word must be clearly descriptive and not merely suggestive and, for a word to be clearly descriptive, it must be material to the composition of the goods or product: refer to Fox, *Canadian Law of Trade Marks and Unfair Competition*, 3rd. ed. (1972), at p. 102; *Thermogene Co. Ltd. v. La Compagnie Chimique de Produits de France Ltée*, [1926] Ex. C.R. 114 at p. 118; *Deputy Attorney-General of Canada v. Jantzen of Canada Ltd.* (1964), 46 C.P.R. 66 , [1965] 1 Ex. C.R. 227, 30 Fox Pat. C. 112. Similarly, to be "misdescriptive" the word must somehow relate to the composition of the goods and falsely or erroneously describe something which is material or purport to qualify something as material to the composition of the goods when in fact it is not.

- *Provenzano v. Registrar of Trade Marks* (1977), 37 C.P.R. (2d) 189 (Addy, J.), at 189-190; *affmd.* (1978), 40 C.P.R. (2d) 288

If part of a proposed trade-mark is objectionable, the question arises whether the whole can still be registered. [...] The answer depends on whether the objectionable part of the proposed trade-mark forms a significant part of the whole and, therefore, causes it to remain deceptively misdescriptive. The parties differed on the question whether the offensive part of the trade-mark must be the dominant element of it or merely a dominant feature. As I read the case law, the proper test is whether the deceptively misdescriptive words "so dominate the applied for trade mark as a whole such that . . . the trade mark would thereby be precluded from registration" [p. 255]: *Chocosuisse Union des Fabricants Suisses de Chocolate v. Hiram Walker & Sons Ltd.* (1983), 77 C.P.R. (2d) 246 (T.M.O.B.), citing *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 (F.C.T.D.).

- *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507, at 514 (O'Reilly J.)

[12] The Opponent, relying on Exhibits 10 to 12 attached to the Palmer affidavit, submits that the words MOUSSE OXO-DEGRADABLE FOAM are generic and indicate that the Wares biodegrade when exposed to oxygen.

[13] However, the Applicant does not seek to register the descriptive words MOUSSE OXO-DEGRADABLE FOAM *per se* but rather the Mark BIOXO MOUSSE OXO-DEGRADABLE FOAM & Design as a whole. As acknowledged by the Opponent in its written argument and at the oral hearing, the Mark is dominated by the word BIOXO, which appears in much larger and bolder print than the words MOUSSE OXO-DEGRADABLE FOAM. There is no allegation by the Opponent that the coined word BIOXO either clearly describes or falsely describes something which is material or purports to qualify something as material to the composition of the Wares, as required by Mr. Justice Addy in *Provenzano*. Accordingly, the Mark as a whole cannot be clearly descriptive or deceptively misdescriptive of the character or quality of the Wares.

[14] Therefore, the s. 12(1)(b) ground of opposition is dismissed.

#### Section 12(1)(c) and (e) grounds of opposition

[15] The Opponent has pleaded that the Mark is contrary to s. 12(1)(c) of the Act in that it “is the name of the wares in connection with which the [Mark] is proposed to be used. More particularly, the [W]ares are containers which biodegrade when exposed to oxygen. In the alternative, the Opponent states that the Applicant is prohibited under s. 12(1)(e) from adopting the words BIOXO MOUSSE OXO-DEGRADABLE FOAM as a trade-mark in association with containers which biodegrade when exposed to oxygen in view of s. 10 [of the Act]”.

[16] The Opponent did not make any submissions with respect to these two grounds of opposition in its written argument or at the oral hearing. In view of my findings above under the s. 12(1)(b) ground of opposition, it is not necessary to proceed with a detailed analysis of the s. 12(1)(c) and (e) grounds of opposition. Suffice it to say that the Opponent has failed to satisfy

its initial evidentiary burden to establish that the Mark as a whole is the name of the Wares or that it has become recognized in Canada as designating the kind or quality of any such wares.

[17] Therefore, the s. 12(1)(c) and (e) grounds of opposition are dismissed.

Section 30(i) ground of opposition

[18] The Opponent has pleaded that the application does not comply with the requirements of s. 30(i) of the Act in that “the [A]pplicant could not have been satisfied that it was entitled to use or register [the Mark] in view of the fact that the [W]ares were not specifically described in ordinary commercial terms and in view of the fact that the [Mark] is confusing with the Opponent’s family of [OXO Marks]”.

[19] This ground, as pleaded, does not raise a proper ground of opposition. The pleading concerning the improper statement of the Wares is more appropriately raised under s. 30(a) of the Act (discussed below). Furthermore, the mere fact that the Applicant may have been aware of the existence of the Opponent’s family of OXO Marks does not preclude it from making the statement in its application required by s. 30(i) of the Act.

[20] Even if the ground had been properly pleaded, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances 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 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the present case.

[21] Therefore, the s. 30(i) ground of opposition is dismissed.

Section 30(a) ground of opposition

[22] The Opponent has pleaded that the application does not conform to the requirements of s. 30(a) of the Act in that “the application does not state the specific [W]ares in ordinary

commercial terms with which the [Mark] is intended to be used”.

[23] In its written argument and at the oral hearing, the Opponent has detailed further its pleading. More particularly, the Opponent, relying on the following exhibits attached to the Palmer affidavit, submits that the Applicant’s own materials identify the products covered under the Mark as packaging rather than containers:

- Exhibit 10 that consists of pages downloaded from the website *www.cnw.ca*, which contains what seems to be a press release from the Applicant entitled “A Worldwide First – Cascades Launches Bioxo™ Oxo-Degradable Polystyrene Foam Containers”, which describes the Applicant’s products as follows:

[...] Cascades today [March 15, 2007] officially launches Bioxo™, the first product line of containers made from totally oxo-degradable polystyrene foam. Manufactured by Cascades, Bioxo™ containers are specifically designed to degrade within three years, unlike traditional polystyrene foam containers [...].

How Does Bioxo™ Work?

Bioxo™ is the result of the addition of TDPA (Totally Degradable Plastic Additives), developed by the Canadian firm EPI of Vancouver. Mixed with the base resin, the TDPA additive gives the polystyrene foam special degradation properties without compromising the performance of the packaging products. After use, when the product is discarded in a landfill site, it begins to undergo oxidative degradation much faster than traditional plastic products. Oxygen, together with the heat, UV radiation or mechanical stress transforms the polystyrene foam with its TDPA additive into a fine powder, which bacteria and other micro-organisms can digest.

The line of Bioxo™ products poses no hazard for human health or the environment. [...] A distinctive label appears on all Bioxo™ products to inform consumers that they are using a container that contributes to environmental protection. [...] [Underlining is mine]

- Exhibit 11 that consists of pages downloaded from the website *www.norampac.com*, which contains the afore-mentioned press release from the Applicant and two flyers of the Applicant displaying the Mark. More particularly, one of the flyers describes the Applicant’s products as follows:

Economical, practical and now oxo-degradable, the Gusto/BIOXO™ line of plates and bowls will satisfy all your needs with 3 plate styles and 2 bowl sizes. Gusto/BIOXO™ is unique because of its rounded-square design, its rigidity and its strong resistance. These plates and bowls are ideal for all institutional applications as well as food presentation at picnics, buffets and celebrations. [Underlining is mine]

Whereas the other flyer describes the Applicant's products as follows:

The polystyrene foam of the future!

Unlike traditional polystyrene foam trays which require several hundred years to degrade, BIOXO™ containers are specifically designed to degrade into a fine powder within three years. BIOXO™ foam trays will take up considerably less space in landfill sites.

BIOXO™ environmental and economical packaging alternative. [Underlining is mine]

- Exhibit 12 that consists of a copy of a paper dated February 25, 2006 by Roger Angold who is identified as the principal scientist with Pyxis CSB Ltd. The paper considers the balance of benefit and disadvantage of the use of oxodegradable plastics.

[24] I disagree with the Opponent. As emphasised in the quotations reproduced above, the Applicant's products are described as a line of containers made from totally oxo-degradable polystyrene foam. The containers can take the form of plates, bowls and trays of different sizes, and are suitable for institutional applications as well as food presentation at picnics, buffets and celebrations. As such, they fall under the category of Wares described as "food container" in the Applicant's application.

[25] In this regard, I disagree with the Opponent's submission made at the oral hearing that because the Applicant's line of containers do not appear to be intended for the storage of food for long periods of time, they cannot be qualified as "food containers". I further note that an analogy can be made between the wares "food container" described in the Applicant's application and "beverage containers" that are listed as acceptable as such in the Canadian Intellectual Property Office (CIPO)'s *Trade-marks Wares and Services Manual*.

[26] Therefore, the s. 30(a) ground of opposition is dismissed.



### Section 12(1)(d) ground of opposition

[27] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's family of OXO Marks. As listed in Schedule A, the registrations covered by such family of marks are the following: TMA445,556, TMA596,249 and TMA654,787. The application Nos. 1,242,644, 1,323,596, 1,354,543 and 1,380,637 as pleaded by the Opponent cannot form the basis of the s. 12(1)(d) ground of opposition as the Opponent has not pleaded that such applications have matured to registration. As I consider the Opponent's registration Nos. TMA445,556 and TMA596,249 both for the OXO word mark to be the most pertinent, I will focus my analysis on these two registrations of the Opponent, unless indicated otherwise.

[28] The Opponent has provided through the Palmer affidavit, particulars of the Opponent's registration Nos. TMA445,556 and TMA596,249 obtained from CIPO trade-mark database. I have exercised the Registrar's discretion to confirm that they are in good standing as of today's date.

[29] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's OXO word mark.

[30] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[31] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the

trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[32] The Opponent's OXO word mark is inherently distinctive, not describing any particular feature of the Opponent's wares associated therewith. As per my findings made above under the s. 12(1)(b) ground of opposition, the Applicant's Mark as a whole is also inherently distinctive.

[33] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, there is no evidence that the Applicant's proposed use Mark has been used in Canada pursuant to s. 4 of the Act or that it has become known to any extent whatsoever in Canada.

[34] Indeed, the only evidence of record pertaining to the Mark is found in the Opponent's evidence and consists of Exhibits 10 and 11 to the Palmer affidavit discussed above. While such exhibits are to the effect that the Applicant has commenced use of the Mark in Canada as of March 15, 2007, they do not show how the Mark is affixed on the Wares themselves or on their packaging or is in any other manner so associated with the Wares. The extent of the Applicant's possible sales is not provided.

[35] Turning to the Opponent's OXO word mark, the Opponent's registration Nos. TMA445,556 and TMA596,249 respectively issued on July 28, 1995 and December 3, 2003 on the basis of use of the mark since January 1991 on wares (1), declarations of use of the mark filed on June 2, 1995 and October 30, 2003 on wares (2), and use and registration of the mark on wares (3), (4), (5), and (6). Such registrations in themselves can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use of the OXO word mark in Canada [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. That said, I am satisfied from my review of the Ferguson and

Palmer affidavits, that the Opponent's OXO word mark has, indeed, been used extensively since at least 1996 in association with most, if not all, of the vast array of household items and kitchen utensils and gadgets listed in the Opponent's aforementioned registrations, as well as with, since at least 2007, a range of food containers.

[36] As put forward by the Opponent, the Ferguson affidavit establishes that in 1996, when Mr. Ferguson's family purchased Danesco, OXO products were already a major line in the Canadian marketplace. The OXO line of products is one of the major lines that is distributed by Danesco and has been a steady and successful line of products in Canada for many years [paragraphs 2, 3 and 24 of his affidavit].

[37] Mr. Ferguson provides as Exhibit A the pages from the Danesco catalogue which outline the range of products that are currently available for sale in Canada under the OXO line. Danesco's website *www.danescoinc.com* also provides a list of the OXO products that are distributed throughout Canada. Exhibit A shows the wide range of household items and kitchen utensils and gadgets, which are sold in Canada under the OXO trade-mark. In particular, there is a full range of food containers in multiple sizes going from a 0.3 L small, square container to a large container which can contain up to 5.2L. Mr. Ferguson states that the word OXO appears not only on the packaging for the products, but is also engraved or marked on each and every product [paragraphs 4 and 25 of his affidavit, Exhibit A].

[38] Mr. Ferguson further states that OXO branded kitchen utensils, containers and gadgets are distributed in every province of Canada through a wide range of retail outlets including major department stores such as *The Bay*, *Zellers*, *Home Outfitters*, and in hardware and home care stores such as *Home Hardware* and *Canadian Tire*, as well as specialty kitchenware stores such as *Ma Cuisine*, *The Linen Chest*, and *Linens N Things* [paragraph 5 of his affidavit].

[39] Since 1996, sales of OXO branded kitchen wares in Canada have never been less than \$2 million per annum. Mr. Ferguson states that in the last fiscal year (that is 2007), Danesco had sales in excess of \$7 million in OXO branded merchandise. As stressed by Mr. Ferguson, these

sales figures are wholesale figures and not retail prices, which would be higher [paragraph 6 of his affidavit].

[40] In order to illustrate the scope of these sales over the years, Mr. Ferguson provides as Exhibit B a random sampling of invoices showing the sales of a myriad of OXO products from 1998 to 2008 [paragraph 7 of his affidavit, Exhibit B]. Included in this sampling is an invoice dated January 9, 2008, showing the sale, *inter alia*, of the OXO range of containers shown in Exhibit A.

[41] Mr. Ferguson further provides as Exhibits C1 to C11 examples of pages from Danesco's catalogues from 2001 to 2008, which show some of the OXO branded products available in Canada. Danesco's catalogues are distributed to retailers across Canada [paragraphs 8 to 19 of his affidavit, Exhibits C1 to C12].

[42] Mr. Ferguson further states that the OXO line of products are also advertised in Canadian house ware and home decorating magazines. They have also been the subject of editorial commentary in food magazines [paragraphs 20 to 22 of his affidavit, Exhibits D, E and F].

[43] Mr. Ferguson's evidence of use of the OXO word mark is further corroborated by Ms. Palmer. Ms. Palmer visited various websites, including Danesco's website mentioned above, and she attaches as Exhibits 4 to 9 to her affidavit copies of the pages that she downloaded from such websites featuring some of the Opponent's OXO line of products. She also states that she attended at three different retail outlets in Ottawa, Ontario to locate and purchase a small random sampling of the products bearing the Opponent's OXO word mark and she attaches as Exhibits 14 to 20 to her affidavit copies of the photographs of some of the wares which she personally took at the *Sears*, *The Bay* and *Domus* locations and copies of the sales slips pertaining to her purchases.

[44] To sum up, the sales figures provided for the years 1996 to 2007, together with the advertising and widespread distribution of the Opponent's OXO household items and kitchen utensils and gadgets in Canada in the same years, lead me to conclude that the OXO trade-mark

has deeper roots and has become known significantly in Canada in association with a wide range of household and kitchen wares.

[45] In view of the foregoing, the overall consideration of the inherent distinctiveness of the parties' marks and the extent to which they have become known, as well as of the length of time the trade-marks have been in use, favours the Opponent.

[46] Turning to the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the Opponent's registrations [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[47] The Opponent's registration No. TMA569,249 covers, *inter alia*, "thermal insulated containers for food" whereas the Applicant's application covers "food container". The Ferguson and Palmer affidavits further evidence longstanding use of the Opponent's OXO trade-mark with a vast array of household items and kitchen utensils and gadgets (including, since at least 2007, a range of food containers) [see with respect to food containers Exhibit 5 to the Palmer affidavit, and Exhibits B, C5, C12 and D to the Ferguson affidavit].

[48] While the Opponent's food containers appear to differ in their exact nature from those of the Applicant described in Exhibits 10 and 11 to the Palmer affidavit in that the Opponent's containers are made of plastic or metal and are meant for the storage of food whereas the Applicant's containers are made of oxo-degradable foam and appear to be meant for use as disposable containers to serve and pack food, I agree with the Opponent that the Applicant's wares could be perceived as a natural extension of the Opponent's vast array of kitchen utensils,

gadgets and containers.

[49] Exhibit 11 to the Palmer affidavit indicates that the Applicant's Wares are directed to both the agri-food business and to consumers. In the absence of evidence to the contrary, there is no reason to conclude that the parties' wares could not travel through the same channels of trade (like for instance *Zellers* and *Canadian Tire* retail stores) and be directed to the same consumers.

[50] This brings me to address the degree of resemblance between the parties' trade-marks. There is a relatively fair degree of resemblance between the marks OXO and BIOXO MOUSSE OXO-DEGRADABLE FOAM & Design owing to the fact that the Mark is dominated by the word BIOXO. While the Mark may evoke something that is environmentally friendly, the word BIOXO may be perceived as a truncation of the words BIO and OXO. It may also arguably be perceived as a combination of the prefix "BI" for "having two" and the word OXO.

[51] The Opponent puts forward that the degree of resemblance between the parties' marks has been noted at the examination stage in a pending trade-mark application file as evidenced by way of the Tracey affidavit. The Tracey affidavit evidences that the Applicant's Mark being the subject of the present opposition proceeding has been cited against application No. 1,354,543, which is an application filed by the Opponent herein for the trade-mark OXO, which refers to, *inter alia*, food storage containers. However, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage. Accordingly, little weight, if any, can be accorded to this particular surrounding circumstance.

[52] As a further surrounding circumstance, the Opponent puts forward that the Palmer affidavit indicates that there are only two other trade-marks which include the element OXO standing on the register of trade-marks, namely the OXO trade-mark being the subject of a series of trade-mark registrations owned by Brooke Bond Group Limited in association with meat extract in cube or liquid form and the trade-mark BBSP & LOGO being the subject of a

registration in association with various financial services. While I agree with the Opponent that the state of the register evidence introduced by way of the Palmer affidavit supports to some extent the finding made above as to the inherent distinctiveness of the Opponent's OXO trade-mark, I find such surrounding circumstance not determinative in the present case.

[53] As a further surrounding circumstance, the Opponent puts forward that it owns a family of OXO Marks. The Applicant submits that where a family of trade-marks exists, there is an even greater likelihood than would otherwise be the case that the public will consider another mark having the common characteristic of the family as a trade-mark used in association with wares produced or approved by the owner of the family of trade-marks.

[54] A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family (a registration or application does not establish use) [*Techniquip Ltd. v. Canadian Olympic Assn* (1998), 80 C.P.R. (3d) 225 (F.C.T.D.), aff'd (1998) 3 C.P.R. (4th) 298 (F.C.A.); *Now Communications Inc. v. CHUM Ltd* (2003), 32 C.P.R. (4th) 168 (T.M.O.B.)]. In the present case, the Opponent has evidenced use of the OXO word mark and design mark. However, such design mark has not been alleged by the Opponent in its statement of opposition. Furthermore, the Opponent has not evidenced use of the OXO STEEL trade-mark identified in Schedule A. While the catalogue attached as Exhibit A to the Ferguson affidavit displays a line of OXO kitchen utensils under the mark "Steel™", such mark differs from "OXO STEEL". Accordingly, I am not prepared to accord weight to this surrounding circumstance.

#### Conclusion regarding the likelihood of confusion

[55] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[56] I am of the view that the Opponent's evidence raises sufficient doubts as to the likelihood

of confusion considering the fact that there is a relatively fair degree of resemblance between the parties' marks, that the Opponent's OXO trade-mark has achieved a significant reputation in Canada, and that the Wares covered by the Applicant's application overlap with those of the Opponent or could be considered a natural extension of the Opponent's various kitchen wares that are offered for sale in Canada. As such, I find that the Applicant has not met its legal onus to show that it is not reasonably likely that an individual who has an imperfect recollection of the Opponent's OXO word mark as applied to the various kitchen wares of the Opponent, would not, as a matter of first impression and imperfect recollection conclude that the Applicant's Wares share a common source.

[57] Accordingly, the s. 12(1)(d) ground of opposition succeeds.

Non-distinctiveness ground of opposition

[58] The Opponent has pleaded that the Mark is not distinctive of the Applicant nor does it actually distinguish the Wares of the Applicant from the wares of others, including the Opponent, nor is it adapted to distinguish them. "More particularly in view of the fact that the [Mark] is confusing with the Opponent's family of [OXO Marks] it cannot actually distinguish, nor is it adapted so as to distinguish the [Wares] from those of the Opponent".

[59] An opponent meets its initial onus with respect to a non-distinctiveness ground if it shows that as of the filing date of the statement of opposition its trade-mark had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the applied-for mark [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. As per my review of the Ferguson and Palmer affidavits above, the Opponent has met this burden with respect to the word mark OXO.

[60] The ground therefore remains to be decided on the issue of confusion between the marks as of the filing date of the statement of opposition. As I came to the conclusion that, based on the evidence filed in the record, the Mark is confusing with the Opponent's OXO trade-mark under s. 12(1)(d) and because the difference in relevant dates does not affect my analysis, the non-



distinctiveness ground of opposition therefore succeeds.

Remaining grounds of opposition

[61] As I have already refused the application under two grounds, and keeping in mind that the Applicant's participation in this proceeding has been minimal, I will not address the remaining grounds of opposition.

Disposition

[62] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

SCHEDULE A

Trade-mark	Regn./Appln. No. & Dates	Wares
OXO	TMA445,556 1995-07-28	<p>(1) Kitchen utensils, namely, peelers, graters, corers, zesters, pizza wheels, cheese planes, grapefruit trimmers, pie servers, jar openers, ice cream scoops, kitchen knives, bottle openers, can openers, scissors, garlic presses, turners, spatulas, cooking spoons, cooking forks, ladles, skimmers, strainers, corkscrews, spaghetti servers, potato mashers, whisks, measuring cups and measuring spoons.</p> <p>(2) Cake servers, tongs, rolling mincers and food slicers; barbecue tools, namely, turners, forks, tongs and brushes; garden tools, namely, trowels, cultivators, scratchers, forks, transplanting trowels, weeders, garden scissors; kitchen items, namely, mixing bowls and bag holders.</p>
OXO	TMA596,249 2003-12-02	<p>(1) Garden tools, namely, cultivators and forks; files and chisels; knives; kitchen utensils, namely meat tenderizers, nut crackers; scissors and utility knives; household cleaning products, namely, brooms, mops, feather dusters, squeegees, furniture dusters, toilet brushes; kitchen utensils, namely, kitchen scrubbing brushes, scrubbing brushes, dustpans and dusting brushes, crumb brushes, sweeper brushes, brushes for basting meat, brushes for basting vegetables, bagel holders, non-electric citrus juicers, corkscrews, corn cob holders, thermal insulated containers for food, wire mesh frying screens to prevent splatter, melon ballers, mugs, pepper mills, potato ricers, salt shakers, shrimp cleaners; strainers, tea kettles, vacuum sealing wine preservers; baking utensils, namely, rolling pins, pastry brushes and flour sifters; barbecue utensils, namely, forks, tongs and spatulas for use in grilling on a barbecue, barbecue sets comprised of forks, spatulas and tongs; pet grooming implements, namely, brushes, combs, slicker brushes and pet hair rakes.</p> <p>(2) Hand tools, namely, pliers, hammers, screwdrivers, cutters, saws, paint scrapers, wrenches; chisels; kitchen utensils, namely, salad tongs and ice scrapers; colanders for household use; plungers for clearing blocked drains; automobile accessories, namely, hand-held car wash brushes for domestic use, wheel cleaning brushes, mugs for use while travelling, brushes with ice scraper attachment; wheel dressing applicators, namely, wax applicators, buckets for use while washing automobiles and brooms for cleaning the interior of automobiles.</p> <p>(3) Flatware, namely, knives, forks and spoons, peelers and poultry shears.</p> <p>(4) Kitchen utensils; namely, rolling mincers; barbecue tools; namely, forks; garden tools; namely, transplanting trowels, weeders and garden scissors; kitchen items; namely, mixing bowls, turners, and brushes.</p> <p>(5) Kitchen utensils; namely, non-electric peelers, graters, corers, pizza wheels, cheese planes, grapefruit trimmers, non-electric kitchen</p>

		knives, scissors and zesters; measuring cups and measuring spoons; kitchen utensils; namely, pie servers, jar openers, ice cream scoops, bottle openers, non-electric can openers, garlic presses, turners, spatulas, cooking spoons, cooking forks, potato mashers, and whisks. (6) Kitchen pots and pans.
OXO STEEL	TMA654,787 2005-12-09	(1) Kitchen utensils namely, non-electric fruit and vegetable peelers, pizza cutters, cheese slicers, planes, zesters and peelers, non-electric can openers and cooking forks, kitchen utensils, namely pie servers, ice cream scoops and spades, bottle openers, turners, spatulas, cooking spoons, potato mashers, meat tenderizers, strainers, kitchen ladles, spaghetti servers, skimmers for removing solids floating on a liquid, serving spatulas, serving spoons, serving ladles, silicone spatulas, silicone spoon spatulas, and graters; cutting boards, cocktail shakers, garlic presses, serving tongs, ice buckets, whisks, graters for household purposes, jar openers, household utensil, namely tuners, corn cob holders.
OXO	1,242,644 2005-01-05 (ALLOWED)	Mixers (handheld and tabletop); electric food blenders for domestic use (handheld and tabletop); electric can openers; electric food processors; electric food mixers; electric citrus juicers; electric juice extractors; electric knives; electric knife sharpeners; electric garment steam pressing machines; electric hair clippers; electric ice crushers; electric space heaters; waffle irons; household irons; toasters; hot plates; broilers; electric bells; vacuum cleaners; table and floor lamps; coffee grinders and mills; digital scales; mechanical scales; electronic scales; electric irons; digital thermometers; hanging scales; electric air cleaners for domestic use; clothing steamers; electric hair styling irons; ice cream and yogurt makers; electric hair dryers; humidifiers; electric vaporizers; indoor barbecue grills; electric barbecue grills; charcoal barbecue grills; electric waffle makers; electric toasters and toaster ovens; electric rice cookers; electric bread makers; electric sandwich grills; electrically heated beverage makers and dispensers for domestic use; electric frying pans; electric steamers; cookers; fondue pots; electric skillets and griddles; coffee makers; flashlights.
OXO	1,323,596 2006-11-09 (ALLOWED)	Rechargeable electric lights, namely rechargeable tabletop lights, rechargeable emergency lights, outdoor rechargeable lights, rechargeable travel lights, rechargeable catering lights, rechargeable restaurant lights, rechargeable desk lights; light shades and decorative covers for rechargeable lights; and rechargeable light mounting accessories of metal and plastic, namely, stands for rechargeable lights, wall mounting brackets for rechargeable lights, floats for rechargeable lights, and lanyards for rechargeable lights.
OXO	1,354,543 2007-07-04	(1) Salad spinners, food storage containers, non-food storage containers, aprons, oven mitts, pot holders, measuring cups, trash cans, coffee presses, step ladders, trivets, clips, tacks, 'lazy susan' turntables, laundry organizers, closet organizers, bag handles, thermal containers, dish racks, drawer organizers, paper towel holders, sink

		mats and strainers, bath and shower organizers, bar serving items, timers.
OXO	1,380,637 2008-01-24	(1) Cutting boards; soap dishes; soap dispensers; thermal beverage containers; ice, water and household buckets; fly swatters. (2) Watering cans, napkin holders, planters for flowers and plants, serving trays, cooking and household thermometers, tape measures, food scales, carpenter levels, decorative magnets, hand-held mandoline slicers, fruit pitters, rakes, utensil holders, tool caddies, non-metal tool boxes, general purpose non-metal clips for household use, plastic clips for sealing bags, plastic utility hooks. (3) plastic water bottles, carafes, pitchers, drink coasters, spice racks, dinner plates, food and soup bowls, training cups for babies and children, suction devices namely shower caddies, corner baskets, storage baskets, divided baskets, soap dishes, sponge and cloth holders, hooks and clips, wine racks, high chairs, booster seats, diaper changing stations, wall-mounted tool racks, display racks, cloth bibs, plastic baby bibs, clothing namely shirts, caps and jackets.