

IN THE MATTER OF AN OPPOSITION by Procter & Gamble Inc. to application No. 763,285 for the trade-mark GOLD COAST & Design filed by Hunter Packaging Ltd.

On September 2, 1994, the applicant, Hunter Packaging Ltd., filed an application to register the trade-mark GOLD COAST & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada by the applicant itself and through a licensee in association with:

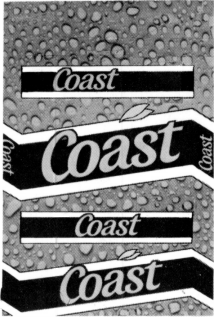

“Single use amenities, namely, shampoo, body lotion, conditioner, bath gel, liquid shower soap, mouthwash, cologne, lip balm, laundry detergent, hand soap, bath soap, glycerine soap, dish soap, shower caps, sewing kits, shoe mitts, shoe sponge, shoe horns, corkscrews, buffet clips, namely plastic holders for wine glasses, ice buckets, waste baskets, acrylic display trays for holding single use amenities, toothbrushes, lint brushes, lint mitts, pens, bath grains, eye gel, body and face cleansers, massage oils and amenity kits containing one or more of the foregoing items.”



The opponent, Procter & Gamble Inc., filed a statement of opposition on August 13, 1996, a copy of which was forwarded to the applicant on August 28, 1996. The applicant served and filed a counter statement on September 10, 1996. The opponent submitted as its evidence the affidavit of C.H. Pearce while the applicant filed as its evidence the affidavits of Lorne Memory, Linda J. Elford, Andrea C. Johnson, Susan Martinez Francouer, Maral Hassessian and Annie Bellerive. Both parties submitted written arguments and neither party requested an oral hearing. During the opposition proceeding, the applicant changed its name to Hunter Amenities International Ltd./ Les Articles D'accueil Hunter Internationale Ltée. Further, during the opposition, the applicant amended its application by deleting “corkscrews, buffet clips, namely plastic holders for wine glasses, ice buckets” from its statement of wares.

The opponent has alleged the following as its grounds of opposition:

a) The applicant's trade-mark GOLD COAST & Design is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant's mark is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
COAST	117,943	Sudsing cleaner, cleanser and detergent
COAST	206,746	Toilet soap
COAST	248,959	Toilet soap
	248,960	Toilet soap
	257,014	Toilet soap

b) The applicant is not the person entitled to registration of the trade-mark GOLD COAST & Design, in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-marks COAST and COAST & Design which had been previously used in Canada in association with the wares covered in the registrations noted above;

c) The applicant is not the person entitled to registration of the trade-mark GOLD COAST & Design, in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-marks COAST and COAST & Design, applications for which had been previously filed in Canada by the opponent;

d) The applicant's trade-mark GOLD COAST & Design is incapable of distinguishing the wares covered in the present application from the wares in the opponent's COAST and COAST & Design registrations identified above.

I would note initially that the opponent has not identified any trade-mark applications which were pending as of the date of advertisement of the present application. As a result, the opponent has failed to meet the burden upon it under Subsection 16(4) of the *Trade-marks Act* in relation to the third ground of opposition. I have therefore dismissed this ground of opposition.

The opponent's first ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark is confusing with its registered trade-marks identified above. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date. With respect to the ground of opposition based on Paragraph 12(1)(d) of the *Trade-marks Act*, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. Further, the material dates with respect to the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's filing date [September 2, 1994] and the date of opposition [August 13, 1996].

With respect to the Paragraph 16(3)(a) ground of opposition, there is an initial burden on the opponent in view of the provisions of Subsections 16(5) and 17(1) of the *Trade-marks Act* to establish its prior use and prior making known of the trade-marks COAST and COAST & Design in Canada in association with toilet soap, sudsing cleaner, cleanser and detergent, the wares covered in the opponent's registrations, as well as show that it had not abandoned its trade-marks in this country as of the date of advertisement of the present application in the *Trade-marks Journal* [March 13, 1996]. The Pearce affidavit meets the initial burden on the opponent insofar as establishing the opponent's prior use and non-abandonment of the trade-marks COAST and COAST & Design [registration No. 257,014] in Canada at least in association with toilet soap. Thus, this ground also turns on the issue of the likelihood of confusion between the applicant's mark and the opponent's trade-marks COAST and COAST & Design as applied to toilet soap.

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], the registered trade-marks COAST and COAST & Design are inherently distinctive as applied to the wares covered in the opponent's registrations as is the applicant's trade-mark GOLD COAST & Design as applied to the wares covered in the present application. The Memory affidavit shows that

the applicant commenced use of its proposed use trade-mark GOLD COAST & Design in association with single use amenities in Canada on July 4, 1995 and that sales of its products from 1995 to 1997 inclusive have exceeded \$28,000. On the other hand, the Pearce affidavit establishes that the opponent's trade-marks COAST and COAST & Design have become known in this country in association with toilet soap with sales exceeding \$22,000,000 from 1990 to 1996 inclusive and advertising expenditures during this time exceeding \$3,700,000. Thus, the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] clearly favours the opponent. Likewise, the length of time the trade-marks have been in use [Para. 6(5)(b)] is a further surrounding circumstance which weighs in the opponent's favour, the opponent having used its trade-marks COAST and COAST & Design in Canada in association with toilet soap since 1978 whereas the applicant commenced use of its trade-mark in July of 1995.

As for the nature of the wares [Para.6(5)(c)] and the nature of the trades [Para.6(5)(d)] of the parties, it is the applicant's statements of wares and the wares covered in the opponent's registrations which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 381, at pp. 390-392 (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. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corporation v. Coffee Hut Stores Ltd.*, 68 C.P.R.(3d) 168, at p. 169 (F.C.A.)].

The opponent's registrations cover toilet soap, sudsing cleaner, cleanser and detergent and these wares appear to overlap or to be closely related to the applicant's "Single use amenities, namely, shampoo, body lotion, conditioner, bath gel, liquid shower soap, laundry detergent, hand soap, bath soap, glycerine soap, dish soap, bath grains, body and face cleansers", bearing in mind that the opponent's statement of wares encompasses within its scope single use amenity toilet soap, cleaner, cleanser and detergent. However, I would note that the Pearce affidavit shows that the opponent has only sold toilet soap in association with its COAST trade-marks and that the

opponent's toilet soap is sold to supermarkets, grocery stores, mass merchandisers, club stores and drug stores, the Pearce affidavit being silent as to the opponent having sold its COAST toilet soap as single use amenities. On the other hand, Mr. Memory states that the applicant's single use amenities are not sold at the retail level, but rather are sold only in the hospitality sector and primarily to hotels for distribution without charge to their clients. As a result, I have concluded that there would be no overlap in the channels of trade of the parties.

Apart from the above, I find that the remaining wares covered in the present application, that is, "Single use amenities, namely, mouthwash, cologne, lip balm, shower caps, sewing kits, shoe mitts, shoe sponge, shoe horns, acrylic display trays for holding single use amenities, toothbrushes, lint brushes, lint mitts, pens, massage oils, eye gel and amenity kits containing one or more of the foregoing items" differ from the wares covered in the opponent's registrations and, having regard to the foregoing, that there would be no overlap in the channels of trade associated with these wares and the opponent's wares.

With respect to the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the applicant's trade-mark GOLD COAST & Design bears a minor degree of similarity in appearance to the trade-marks COAST and COAST & Design when the trade marks are considered in their entireties as a matter of immediate impression. However, there is a fair degree of similarity in sounding between the trade-marks at issue. Further, the trade-mark GOLD COAST & Design suggests the idea of relaxing at a beach whereas the opponent's COAST and COAST & Design trade-marks do not convey such an idea.

As a further surrounding circumstance with respect to the issue of confusion, the applicant submitted evidence of the state of the register by way of the Elford affidavit, as well as the results of the computerized trade-mark search conducted by Ms. Martinez Francouer. While the search results revealed the existence of a number of registrations including the word COAST, only two of the registrations disclosed by these searches covered wares which are related to those of the parties. However, this evidence does point to there having been relatively frequent adoption of the word COAST as an element of a trade-mark. The Martinez Francouer affidavit also introduces into

evidence the results of an Internet domain name search. However, the vast majority of the domain names which appear to be of any relevance are associated with web sites situated outside of Canada. As a result, and absent evidence that Canadians have accessed these web sites, I am not prepared to accord any weight to their existence.

Ms. Hassessian has annexed to her affidavit the results of corporate name and business name searches conducted by the affiant which included the word COAST in the name. Further, Andrea C. Johnson states in her affidavit that she telephoned twenty-three of the businesses identified in the search results annexed to the Hassessian affidavit and made note of the telephone salutation, the product line or channel of trade of each business, as well as the address and telephone number of the business. While most of the businesses identified by Ms. Johnson were involved in products or trade channels completely unrelated to the wares and trade of the parties, five of the businesses were involved in retail hair and beauty products and include COAST as part of their business name. Finally, the Bellerive affidavit introduces into evidence the results of computerized searches which she conducted. However, the results of the NUANS computerized search of registered business names only disclosed two entries which, from their names, appear to be at least somewhat related to the wares of the parties while the on-line search of the CIDREQ database maintained by the government of Quebec failed to disclose any entries which I considered to be relevant. Nevertheless, the results of these searches show that COAST has been adopted as an element of a number of corporate and business names in Canada.

Having regard to the above and, in particular, to the different channels of trade associated with the wares of the parties and the fact that there is little similarity between the trade-marks at issue either in appearance or in the ideas suggested although there is a fair degree of similarity in their sounding, and bearing in mind that the word COAST has been adopted as an element of a number of trade-marks, corporate names and business names in Canada, including evidence of the use of such business names in the area of retail hair and beauty products, I find that the applicant has met the legal burden upon it of showing that there would be no reasonable likelihood of confusion between its trade-mark GOLD COAST & Design and the opponent's trade-marks. I have therefore dismissed the Paragraph 12(1)(d) ground of opposition. Likewise, I am of the view that there would

be no reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's filing date or the date of opposition, the materials dates for considering the non-entitlement and non-distinctiveness grounds. I have therefore also rejected the second and fourth grounds of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 18TH DAY OF DECEMBER, 1995.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.