

IN THE MATTER OF AN OPPOSITION
by Diamondice Ltd. to application
No. 658,312 for the trade-mark
BLUE DIAMOND SPRINGS filed by
Blue Diamond Spring Water Limited

On May 23, 1990, the applicant, Blue Diamond Spring Water Limited, filed an application to register the trade-mark BLUE DIAMOND SPRINGS based on proposed use in Canada with the following wares:

drinking water, bottles for drinking water,
water coolers, dispensers and cups

and with the following services:

service of providing bottled water delivery
to user premises.

The application was amended to include a disclaimer to the word SPRINGS and was subsequently advertised for opposition purposes on May 15, 1991.

The opponent, Diamondice Ltd., filed a statement of opposition on June 3, 1991, a copy of which was forwarded to the applicant on June 26, 1991. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark DIAMONDICE registered under No. 351,631 for "bottled water namely spring water."

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Anne L. Wasson, Jude Batty and Virginia Cowan. The applicant did not file evidence. Both parties filed a written argument but no oral hearing was conducted.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's proposed mark BLUE DIAMOND SPRINGS would be perceived as the name of the source of the applicant's wares and possibly its services. Thus, the applicant's mark is not inherently strong. There is no evidence from the applicant and I must therefore conclude that its mark has not become known at all in Canada.

The opponent's registered mark DIAMONDICE is slightly suggestive of the opponent's wares since it suggests that the opponent's bottled water comes from ice of superior quality. Thus, although the applicant's mark is a coined word, it is not inherently strong. The opponent's evidence establishes that its mark has been used in Alberta but it does not establish the extent of that use. Thus, I must conclude that the opponent's mark has not become known to any measurable extent.

The length of time the marks have been in use favors the opponent. The applicant's wares and services are either the same as or closely related to the opponent's registered wares. Furthermore, the Wasson affidavit establishes that the opponent uses its registered mark in association with the delivery of bottled water to its clients. Thus, the trades of the parties would be the same.

As for Section 6(5)(e) of the Act, the marks of the parties bear a fair degree of resemblance in all respects. The most distinctive component of the applicant's mark (i.e. - the word DIAMOND) is identical to the first and more dominant component of the opponent's mark.

The Wasson affidavit establishes that the manner of actual use of the opponent's trade-mark enhances the likelihood for confusion. The opponent's mark DIAMONDICE is consistently used above the words SPRING WATER on labels and crests which prominently feature the color blue. The use of the words DIAMONDICE SPRING WATER on a partially blue label increases the likelihood that consumers would assume that product emanated from the same source as the applicant's BLUE DIAMOND SPRINGS product.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the wares, services, trades and marks of the parties and the manner in which the opponent has actually used its mark to date, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark is not confusing with the opponent's registered mark. The ground of opposition based on Section 12(1)(d) of the Act is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1993.

David J. Martin,
Member,
Trade Marks Opposition Board.