



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

Citation: 2010 TMOB 48
Date of Decision: 2010-04-08

**IN THE MATTER OF AN OPPOSITION
by Industries Lassonde Inc. and A.
Lassonde Inc. to application No. 1,026,857
for the trade-mark OASIS in the name of
Philip Morris Products S.A.**

[1] On August 25, 1999, Fabrique de Tabac Reunies S.A. filed an application to register the trade-mark OASIS (the Mark), based upon proposed use of the Mark in Canada. During the prosecution of the application the applicant's name was changed to Philip Morris Products S.A. (the Applicant). The statement of wares currently reads: "tobacco; cigarette smoking system consisting of cigarettes, electronic cigarette lighter, recharging and cleaning unit for electronic lighter," (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 1, 2005. On August 1, 2005 Industries Lassonde Inc. (Industries) and A. Lassonde Inc. (Lassonde) (together "the Opponent"), filed a statement of opposition. The Opponent pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

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

[4] The Opponent filed the affidavits of Martine Girard, Benoit Boucher, and Lise Paquette as well as certified copies of trade-mark registrations relied on in the statement of opposition.

[5] The Applicant filed the affidavit of Lisa Saltzman in support of its application.

[6] Both parties filed written arguments and were represented at an oral hearing.

Grounds of Opposition

[7] The grounds of opposition as are as follows:

1. The Application does not conform to the requirements of s. 30(e) because the Applicant did not intend to use the Mark at the date of filing the application, namely August 25, 1999 and does not have the intention of using the said Mark, either by itself or through a licensee;
2. The Application is not registrable in view of s. 12(1)(d) since the Mark is confusing with the trade-mark registrations of Industries Lassonde Inc. (Industries), namely the following:
 - a. OASIS registration No. TMA139,031 in association with:
Jus et breuvages de fruits; (2) Eau de sources; (3) Jus de légumes. Services :
Operation d'un etablissement de restaurations; Opération d'un débit de
boissons;
 - b. OASIS SÉLECTION registration No. TMA504,018 in association with: Jus
de fruits et boissons aux fruits non-alcoolisées;
 - c. OASIS CLASSIQUE registration No. TMA511,799 in association with: Jus
de fruits et boissons aux fruits non-alcoolisées;
 - d. OASIS FLORIDA PREMIUM registration No. TMA513,293 in association
with: Jus de fruits de la Floride et boissons aux fruits de la Floride non-
alcoolisées;
 - e. FLORIDA'S BEST OASIS registration No. TMA514,720 in association with:
Jus de fruits de la Floride et boissons aux fruits de la Floride non-alcoolisées;
 - f. OASIS registration No. TMA530, 717 in association with: Jus et breuvages de
fruits
 - g. OASIS FLORIDA'S PREMIUM registration No. TMA533,622 in association
with: Jus de fruits de la Floride et boissons aux fruits de la Floride non-
alcoolisées;

- h. OASIS SORBET PREMIUM registration No. TMA591,789 in association with: Jus de fruits, boisson aux fruits non alcoolisées et desserts glacés nommément sorbets, crème glacée, friandises glacées sur bâtons;
- i. OASIS PLUS & DESSIN registration No. TMA593,656 in association with: Jus de fruits et boissons aux fruits non-alcoolisées;
- j. TROPICAL OASIS registration No. TMA599,333 in association with: Bases and concentrates used in making frozen drinks, both alcoholic and non-alcoholic; bases and concentrates for making smoothies;
- k. OASIS registration No. TMA363,415 in association with: pressure regulators for scuba equipment;
- l. OASIS registration No. TMA 388,255 in association with: Valve pour l'opération et l'ajustement de système d'irrigation souterraine;
- m. OASIS PREMIUM registration No. TMA644,247 in association with: Jus de fruits et boissons aux fruits non alcoolisées;
- n. OASIS PREMIUM DESSIN registration No. TMA644,605 in association with: Jus de fruits et boissons aux fruits non-alcoolisées;
- o. OASIS registration No. TMA 660,667 in association with: sorbets;
- p. OASIS 100%Fruit 100% PUR registration No. TMA654,184 in association with: Jus de fruits et boissons aux fruits non-alcoolisées.

All of which are owned by Opponent Industries Lassonde Inc.

- 3. Contrary to s. 16(3)(a), the Applicant is not the person entitled to the registration since at the date of filing, the Mark was confusing with the trade marks used in Canada by the Opponent Industries Lassonde Inc:
 - a. OASIS DEL SOL application No. 1,246,389 used since May 1, 1990
 - b. OASIS PAUSE SANTÉ application No. 1,246,391 used since December 1, 1995
 - c. OASIS HEALTH BREAK application No. 1,246,393 used since December 1, 1995
- 4. The Mark is not distinctive within the meaning of s. 2 and is not capable of distinguishing the wares of the applicant from those of others, and in particular those of Industries Lassonde Inc.

5. The Applicant could not have been satisfied that it was entitled to use the trade-mark in Canada in association with the wares claimed pursuant to s. 30(i).

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[8] 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 evidential 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[9] I will discuss below what I consider to be the most relevant portions of the Opponent's evidence.

[10] The affidavit of Martine Girard, the Vice-President of Quality Assurance of Industries since 1988, sets out the license arrangements between her company and its subsidiaries. Ms Girard states that Industries directly controls the quality and the character of the wares sold in association with the OASIS marks (set out above) under license by Lassonde. Ms. Girard visits the Lassonde premises regularly to confirm that products are being manufactured in accordance with Industries' requirements. Copies of the license agreement and the Graphic Standards Manual to be followed by Lassonde in using the OASIS trade-marks are attached as Exhibits MG-1 and 2.

[11] The affidavit of Benoit Boucher relates to marketing and sales of the Opponent's wares. Mr. Boucher provides that Lassonde is a food products company, and in particular sells juice and fruit drinks under a number of trade-marks including marks that include OASIS. He further states that OASIS products can be found in a majority of Quebec supermarkets, convenience stores, pharmacies, and discount stores, as well as in some supermarkets elsewhere in Canada. OASIS juice, refrigerated and in powder form had 30% of the market in 2005; Exhibits BB-2 comprises photographs of packaging of the wares in use since 1999 and displays various juice products bearing OASIS marks.

[12] The Boucher affidavit sets out that the Opponent and its predecessors have used the mark OASIS and its different versions continuously in Canada:

1. Since at least as early as 1965 in association with “juice and fruit drinks”;
2. Since at least as early as 1981 in association with vegetable juice;
3. Since at least as early as February 2000 in association with spring water;
4. Since at least as early as July 2002 in association with sorbets;
5. Since at least as early as November 2003 in association with “frozen mixes for alcoholic and non-alcoholic drinks”.

[13] Mr. Boucher provides representative invoices of sales by Lassonde for wares sold under OASIS marks from the period 1967 to 2006 (Exhibit BB-3). These invoices relate to juices and fruit drinks only, with a few instances of sales of frozen juice concentrates.

[14] As Exhibit BB-4 of his affidavit, Mr. Boucher provides samples of different flyers and coupons that display the OASIS marks. These flyers and coupons are from 2003-2006, were distributed in stores and door-to-door, and are representative of flyers and coupons of this period and the period prior to 2003. I note that these flyers and coupons relate to advertisements mostly for juices bearing the OASIS marks. However, subsequent to 2003 there are a few instances of OASIS sorbet advertisements and coupons, as well as a coupon for OASIS nutritional supplements.

[15] I note that in general, it appears from the evidence filed that at the time of the filing of the instant application, the Opponent’s OASIS trade-marks had only been used in association with juice and fruit drinks.

[16] Mr. Boucher attaches evidence relating to television and radio promotion of OASIS products, related invoices from broadcasters, and print ads. Advertising appears to have been primarily in Quebec; there is some evidence of television advertising across Canada in the French language.

[17] According to the Annual Report attached as Exhibit BB-6, Lassonde and its related companies have consolidated annual sales in excess of \$145 million each year from 1998 onwards. Sales in association with the OASIS marks with juice and fruit drinks have undergone considerable growth over the past 35 years, with sales in Canada exceeding \$120 million per year in 2005.

[18] The affidavit of Lise Paquette attaches pages from the website of the Altria Group the parent company of Kraft Foods, Philip Morris International, Philip Morris U.S.A., and Philip Morris Capital Corporation. The information is regarding the corporate structure of Altria; I note that these companies are described in the attached web pages as “Food and Beverage”, “International Tobacco”, “Domestic Tobacco” and “Financial Services” respectively. Also included in the extract of web pages is detailed information about each of those companies.

[19] I find it reasonable to accept that the website of a large multinational corporation would be reliable, although I note that Ms. Paquette provides no indication of how these materials were accumulated and if she herself accessed the Internet and downloaded the pages; neither is the necessity of filing the evidence in this manner apparent. However, since the Applicant did not object to the admissibility of this evidence, and did have the opportunity to file evidence to respond to it [see *Canadian Council for Professional Engineers v. Alberta Institute of Power Engineers* (2008), 71 C.P.R. (4th) 37, at paragraph 35], I am willing to accord this affidavit some weight in these proceedings. In any event, as will become clear below, the evidence in this affidavit is not determinative in these proceedings.

[20] Also in evidence are certified copies of the registrations relied on by the Opponent, as set out above. I note that of these, the following were filed and registered subsequent to the filing of the Applicant’s application (August 25, 1999):

- OASIS SORBET PREMIUM TMA No. 591,780 filed - February 14, 2002;
- OASIS PLUS & Design TMA NO. 593,656 filed - January 22, 2003;
- TROPICAL OASIS TMA NO. 599,333 filed - January 22, 2003.

[21] I will now discuss the relevant portions of the Applicant’s evidence.

[22] In her affidavit Lisa Saltzman states that she is the Director of the trade-mark searching department with Onscope a division of Marque d’or Inc. Part of her employment responsibilities is to review and search the files and records of the Canadian Intellectual Property Office (CIPO) on the ONSCOPE/Marque d’Or Inc. database created under annual license from CIPO.

[23] At the request of the Applicant, a search of the Canadian trade-mark register was conducted by Ms. Saltzman on March 16, 2007. Ms. Saltzman describes that she conducted the search by entering the term “*OASIS*”; the purpose of the asterisks was to broaden the search to include marks that contain the word OASIS as a prefix or suffix or infix. Ms. Saltzman’s report sets out the parameters of the search and the relevant dates on which certain fields in CIPO database have been updated.

[24] The state of the register search reveals that in addition to the Opponent’s registrations, there are 24 approved for registration or registered trade-marks consisting of the word OASIS only, with either no design features or minimal design features for wares and/or services. Of these, 2 had been expunged or abandoned at the time of the oral hearing. I have exercised my discretion and confirmed that there are still 24 trade-marks, either approved for registration (but opposed)(4) or registered for wares (15) and services (5). In addition there are 3 phonetic equivalents (i.e. OASYS/OASES), and 31 other trade-marks, either registered (24), or approved for registration (7), in which OASIS forms a part. In note that the registrations for wares (15) are in the names of different owners for a wide variety of wares, including: watering apparatus for animals; computer software; medical devices; industrial garments; polymers; laminated insulating film; electronic devices for telecommunications; barbeque grills; foam, pins and growing media for plant propagation.

Grounds of Opposition under s. 30(e) and s. 30(i)

[25] The material date that applies to grounds of opposition under s. 30 is the filing date of the application, namely August 25, 1999 in this case. [see *Delectable Publications Ltd. v. Famous Events Ltd.* (1989), 24 C.P.R. (3d) 274 (T.M.O.B.); *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B)]

[26] The initial evidential burden under s. 30 is on the Opponent. The Opponent has “the burden of adducing sufficient evidence to persuade the trier of fact that the alleged facts are true” (*John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 at 298). This burden is less onerous where the application is based on proposed use, rather than prior use of a Mark in Canada (*McDonald's Corporation and McDonald's Restaurants of Canada Ltd. v. M.A.*

Comacho-Saldana International Trading Ltd. carrying on business as Macs International (1984), 1 C.P.R. (3d) 101 at 104.

[27] With respect to the ground of opposition based on s. 30(e), no evidence was filed demonstrating that the Applicant had no intent of using the applied for trade-mark as of the date of filing of the application. Accordingly this ground is dismissed.

[28] Regarding the ground of opposition based on s. 30(i), no evidence was filed demonstrating that the Applicant was aware of any prior rights of the Opponent when it filed its application. Where an applicant has provided the statement required by s. 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the Opponent has not evidenced any bad faith on behalf of the Applicant, this ground is dismissed.

Ground of opposition under s. 12(1)(d)

[29] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[30] The Opponent has met its initial burden as it pleaded that the Mark is not registrable because it is confusing with its trade-marks as listed above.

[31] In addition, the Opponent alleged a family of marks and argued that where there is a family of marks there is greater likelihood that the public would consider a similar mark as indicating another product manufactured by the same person who produced the wares in association with the family of marks (*Everex Systems, Inc. v. Everdata Computer Inc.* (1992), 44 C.P.R. (3d) 175 (F.C.T.D.), and *Edwin Co. Ltd c. S.D.B. Design Group Inc.* (1986), 9 C.P.R. (3d) 465 (F.C.T.D.)). However, as set out in *Manufacturiers de Bas de Nylon Doris Ltee v Warnaco Inc.* (2004), 38 C.P.R. (4th) 519 (F.C.T.D.), [*Manufacturiers de Bas de Nylon Doris*], where evidence establishes a family of trade-marks, the consumer would probably believe that *closely*

related products (i.e. hosiery and undergarments) used with a similar mark would derive from the same source (emphasis added).

[32] Although there is considerable evidence of sales and advertising, I am not satisfied that the Opponent has established a family of marks. As pointed out by Cattnach, J. in *McDonald's Corporation et al v. Yogi Yogurt Ltd. et al.*, 66 C.P.R. (2d) 101 at p.114, [*Macdonalds*], there can be no presumption of the existence of a family or series of trade-marks in opposition proceedings; the party seeking to establish a family of marks must show that it has used the trade-marks comprising the series to a sufficient extent as to constitute a family of marks. In this case McDonalds Corporation provided evidence of sales of each ware in the family; in the present proceeding, the Opponent has not broken down its sales and advertising figures by trade-mark and thus it is difficult to assess the extent to which a "family" of marks would be recognized by the consumer. Furthermore, I am not convinced (as will become apparent below), that juices and tobacco are "so closely related" (see *Manufacturiers de Bas de Nylon Doris, supra*), such that the existence of a family of marks is a relevant consideration in this case.

[33] In view of the foregoing, I will focus my comments on the Opponent's registrations for the word OASIS only (namely registration Nos. TMA139,031; TMA363,415 ; TMA388,255; TMA530,717; and TMA660,667), since logically, if confusion is found between those OASIS marks and the subject application, that will be determinative in this proceeding. By the same token, if no confusion between those trade-marks and the subject application is found, then clearly no confusion will be found between any of the Opponent's other registrations that include more than the word OASIS since there would be a lower likelihood of confusion with such trade-marks. I will therefore now assess the evidence with a view to determining if the Applicant has met the legal burden on it to demonstrate that, based on a balance of probabilities, confusion between the Opponent's OASIS trade-marks and the Applicant's OASIS trade-mark is not likely.

[34] The test for confusion is one of first impression and imperfect recollection on the part of a hurried consumer. 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.

[35] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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 given equal weight. The weight to be given to each depends on the circumstances (see in general *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349).

(a) inherent distinctiveness of the trade-marks and the extent to which they have become known

[36] I agree with the previous judicial determination that OASIS is not an inherently strong mark (see *A. Lassonde & Fils Inc. v. Imperial Tobacco Ltd et al.* (1987), 17 C.P.R. (3d) 8 (F.C.T.D.)). In relation to juices, OASIS is suggestive of something thirst quenching (as an oasis in a desert); in contrast OASIS has more inherent distinctiveness with respect to Applicant's products, since the suggestion of an "oasis" in relation to tobacco and related products is more obscure.

[37] With respect to the extent that the marks have become known, there is evidence that the Opponents OASIS marks have become known through use or promotion. For example the Boucher affidavit provides that in the year prior to date of the affidavit (August 22, 2006) juices sold under the OASIS trade-marks occupied 30% of the market, and in Quebec 58% of the market. The Opponent's juices can be found in a majority of retailers of Quebec including supermarkets, convenience stores, pharmacies, and discount stores. I note that the affidavit does not specify how much of this market share is related to the one word OASIS trade-marks, and how much is related to any of the other trade-marks; no itemized sales figures are provided. Nonetheless I am able to conclude that the Opponent's OASIS trade-marks (including OASIS

alone), have become known at least to some extent in Canada in association with juice. There is no evidence that the Applicant's mark has become known at all.

(b) the length of time each has been in use

[38] The subject application is based on proposed use, and there is no evidence that such use has commenced. In contrast, the Opponent has provided evidence that its OASIS marks have been used in association with juice and fruit drinks since at least as early as 1967. Although the Boucher affidavit also states that the OASIS trade-marks have been in use with vegetable juice since at least as early as 1981, with spring water since at least as early as February 2000, and with frozen drink mixes, alcoholic and non-alcoholic, since at least as early as November 2003; no satisfactory evidence of sales or advertising in connection with these wares has been provided.

(c) the nature of the wares, services or business, and (d) the nature of the trade

[39] With respect to the nature of the wares and business, the Opponent's evidence establishes that it is in the business of selling fruit juices and fruit drinks (and allegedly currently also selling related products such as vegetable juices, sorbet, and water) to retail outlets such as pharmacies, supermarkets, etc. The Applicant sells tobacco and tobacco products, and proposes to use the subject trade-mark OASIS in association with "tobacco; cigarette smoking system consisting of cigarettes, electronic cigarette lighter, recharging and cleaning unit for electronic lighter."

[40] The Opponent advanced several cases in support of its contention that the differences between the wares should not be a determining factor in the assessment of confusion. The Opponent submitted that in fact, the differences in the wares at issue (fruit juices and tobacco products) were smaller than in the decisions of *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltee*, [2006] 1 S.C.R. 824, and *Mattel Inc., v. 3894207 Canada Inc.*, 2006 S.C.C 22 [*Mattel*].

[41] The Opponent also argued that in any event, that there is overlap between the nature of the business and the wares, since both would be sold in the same stores. In support, the Opponent relied on the concept of a "nexus" between the wares as discussed in *S & S Productions Inc. v. Messier* (2006), 57 C.P.R. (4th) 132. In this case it was established that POSSUM LODGES for

the sale and rental of recreational lodging and related services was confusing with POSSUM LODGE for production and distribution of television programs, because there was a “nexus” between the two, in that POSSUM LODGE was the name of the lodge in a television series (The Red Green Show). The Opponent also relied on the decision in *Advance Magazine Publishers Inc. v. Masco Building Products Corp.* (1999), 86 C.P.R. (3d) 207, where it was found that there was a reasonable likelihood of confusion between VOGUE for door locks and hardware and VOGUE and VOGUE DECORATION for magazines and magazines relating to interior design. In this case a “nexus” was found between the door locks and the features, articles and advertisements found in the VOGUE and VOGUE DECORATION magazines concerning interior decoration. In so finding, the court also observed that the applicant had not limited its use of the mark to products which would be *foreign to the ambit of protection* that the VOGUE mark now has (emphasis added).

[42] Even if I were to give consideration to the aforementioned affidavit of Lise Paquette and the fact that a tobacco company and major food company may be owned by the same multinational parent company, in my view this does not alter the fact that these products are completely different and are in fact manufactured by different types of companies. In my view, the existence of a global corporate structure is too remote from the consumer retail experience to create a “nexus” between these two wares at the level of consumer perception. In the instant case the nexus is not proximate to the consumer experience in the same way the connection between a fictional place in a TV series and an actual place, or the connection between stylish decorative products likely to be featured in VOGUE magazines, would be.

[43] The Applicant argues that the products and the trade are entirely different. Sales of tobacco products are highly regulated in all provinces and territories; tobacco products are sold behind the counter in a manner such that they are not visible on the shelves and the consumer must ask for them by name. In support of the fact that tobacco sales are highly regulated and as such would never appear in close proximity to the Opponent’s products, the Applicant provided a copy of the tobacco laws and regulations for each province and territory across Canada.

[44] It is not necessary to review the provincial tobacco laws and regulations in detail. It is quite apparent that such sales are regulated in each province and territory in a similar manner,

namely that tobacco products are to be sold behind the counter with restrictions on visibility of packaging and on advertising.

[45] In any event, the existence of the tobacco legislation merely serves to demonstrate and underline the fact that these two types of wares are marketed, promoted and sold differently. Clearly the purpose of the tobacco regulation is for public protection as the consumption of tobacco is considered a health risk. This is in direct contrast to juices which are considered to have health benefits. See for example, Exhibit BB-4a to the Boucher affidavit relating to sponsorship of marathons by OASIS, which includes the description “pure fruit juice goodness”. Consequently I am of the view that these wares are in two very different categories, and that there is no overlap in trade beyond appearing in the same general type of retail outlets in the same way as, for example, windshield washer fluid and potato chips might be sold in those retail outlets. Further, I cannot accept that there is a “nexus” between the respective wares that would generate a likelihood of confusion despite the differences in the wares and the trade.

[46] In fact, in a similar case, involving the same types of wares, *A. Lassonde & Fils Inc. v. Imperial Tobacco Ltd et al.* (1987), 17 C.P.R. (3d) 8, (F.C. T.D.), Rouleau J, found as follows (p.16):

I do not think that the respondent’s manufactured tobacco products and the appellant’s fruit juices and beverages or even possibly preserves, desserts, soft drinks and candy can be confused solely because the wares all bear the trade-mark OASIS. Tobacco and refreshments are very different types of wares; I concede that they are both consumer goods which may be found in the same commercial establishment, but their inherent characteristics, such as their containers, their components, form, taste, nutritional aspects and effects or even the way in which they are consumed, surely cannot be associated. The type of product to be marked under the mark OASIS is so different in the case at bar that it constitutes a significant distinction.

In my opinion there is an even greater difference in the nature of the trade in each product. The tactics and methods used by the manufactured tobacco industry to sell its products are very different from those of the food industry. Further, there is no resemblance between the appearance and the location of the products in a store; tobacco products are generally grouped behind a counter while goods such as fruit juice or beverages are on display stands accessible to everyone. However, this is just an example which serves to show one of the reasons why I do not think that a reasonable person would confuse the origin of the products associated with the appellant’s and the respondent’s trade-marks.

[47] In view of the foregoing, I find these factors overwhelmingly in favour of the Applicant.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[48] Overall, I find that while the applicant's trade-mark is identical in appearance and sound to the Opponent's OASIS trade-marks, as previously noted, the ideas suggested in association with juices and beverages in general is quite explicit i.e. a thirst quenching juice (as an oasis in a desert). I do not find that the same idea is generated by OASIS in association with tobacco or related products.

[49] It is trite law that the enumerated factors in s. 6(5) need not be attributed equal weight (see in general *Mattel, supra*). Accordingly, the fact that the marks are identical in appearance and sound is not necessarily determinative, having regard to the other factors.

other surrounding circumstances

[50] As summarized previously, the Applicant by way of the affidavit of Lisa Saltzman has provided evidence of the state of the register. The Saltzman affidavit evidences 5 existing registrations in the name of different owners for the word OASIS alone (or with minimal design elements) for services, and 15 such registrations for wares. However, I note that none of the registrations are for wares that would commonly be sold in grocery stores, pharmacies or convenience stores where one might find both juices and tobacco products. Since state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)], I am unable to make inferences about the marketplace that support the Applicant in this case.

[51] This issue is not determinative however, as I am satisfied, having considered all of the other factors, that confusion between the marks is not likely and I dismiss the s. 12(1)(d) ground

of opposition. The fact that the trade-marks are identical is insufficient to make confusion likely in view of the differences in the nature of the wares and the trade; this is so notwithstanding that OASIS does not appear to be a common trade-mark for goods sold in grocery stores, pharmacies or convenience stores. Overall, based on the evidence at hand, I am not convinced that the circumstances have changed since the earlier decision in *A. Lassonde & Fils Inc. v. Imperial Tobacco Ltd et al.*, *supra*.

Ground of Opposition under s.38(2)(c) and s. 16(3)(a)

[52] The Opponent alleges that pursuant to s. 38(2)(c) of the Act the Applicant is not the person entitled to registration of the Mark under s. 16(3)(a) since, as of the date the Applicant filed its application (August 25, 1999), the trade-mark was confusing with trade-marks used in Canada by the Opponent, namely OASIS DEL SOL (since May 1, 1990), OASIS PAUSE SANTE (since December 1, 1995) and OASIS HEALTH BREAK (used since December 1, 1995) in association with fruit juices. In order for this ground of opposition to be considered at all, the Opponent must meet an initial evidentiary burden establishing that the relied on marks were used prior to the filing date of the subject application. As noted previously, Opponent's evidence of use is not broken down by trade-mark, and thus I am unable to determine to what, if any, extent these trade-marks had been used prior to the filing date of the subject application.

[53] In any event, as this ground of entitlement is based on confusion as assessed under s. 6(5) of the Act, for the reasons set out above with respect to s. 12(1)(d), I find no confusion with the Opponent's applications set out above, and accordingly this ground fails.

Ground of Opposition under s. 38(2)(d) and s. 2

[54] Regarding the ground of opposition based on lack of distinctiveness pursuant to s. 2 of the Act, the Opponent needs to have shown that as of the filing of the opposition, OASIS had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4th) 427), [*Bojangles*]. It is not necessary for the Opponent to show that its mark had become well known, it is sufficient to establish that its mark

has become known sufficiently to negate the distinctiveness of the applicant's mark. As stated by Noel J in the *Bojangles* case at p. 444: "A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient."

[55] The Opponent relied on *AST Data Ltd v. AST Research* (1991) 37 C.P.R. (3d) 555 [AST], to support its position that it had established that its marks were sufficiently well known to negate the distinctiveness of the Applicant's mark. However, I note that in the AST case both the trade-marks and the nature of the trade of the Opponent and the Applicant were virtually identical – computer hardware and software versus computer related products and services. Furthermore, the evidence revealed instances of actual confusion.

[56] In the present proceedings, although the Opponent's evidence of use of its marks may arguably satisfy its initial burden, I do not find the evidence to be sufficient to negate the distinctiveness of the Applicant's mark for use on tobacco and related products. The Opponent has not produced evidence sufficient for me to find that the Applicant's Mark cannot be distinctive in association with wares completely unrelated to juices such as tobacco and tobacco related products.

Disposition

[57] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

P. Heidi Sprung
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office