

**IN THE MATTER OF AN OPPOSITION
by The Procter & Gamble Company to
application No. 1,065,175 for the trade-
mark BLANCHISSANT MULTI-ACTION
filed by SmithKline Beecham Inc.**

On June 28, 2000, the applicant, SmithKline Beecham Inc., filed an application to register the trade-mark BLANCHISSANT MULTI-ACTION. The application is currently based upon proposed use of the trade-mark in Canada in association with dentifrices, mouth washes and breath fresheners. The applicant has disclaimed the right to the exclusive use of the word BLANCHISSANT in respect of the wares apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of May 15, 2002. On July 10, 2002, the opponent, The Procter & Gamble Company, filed a statement of opposition against the application.

The applicant filed and served a counter statement.

The opponent filed the affidavit of a law clerk, Lindsey Van Poorten, in support of its opposition while the applicant filed the affidavit of a trade-mark searcher, Karen E. Thompson, in support of its application. Neither affiant was cross-examined.

Each party filed a written argument and was represented at an oral hearing.

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”), there is an initial 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*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Discussion of Grounds of Opposition

Grounds of opposition have been pleaded under s. 38(2)(b) and (d) of the Act. I will begin by addressing the latter.

Section 38(2)(d) - Distinctiveness

This ground of opposition has been pleaded as follows:

The Trade-mark is not distinctive within the meaning of Section 2 of the *Act*, in that it is not either adapted to distinguish nor capable of distinguishing the wares in association with which it is alleged it will be used by the Applicant from the wares provided by the Opponent and/or its predecessors-in-title, and other marketers, traders and manufacturers of the same products. The Applicant's Trade-mark is not, and cannot become, distinctive of the Applicant.

Given that third parties would naturally use the term BLANCHISSANT MULTI-ACTION to describe the same products that perform the same function, such a term would not distinguish the wares of one manufacturer of such products from another manufacturer of such products. Any product that functions as a multiple action whitener should be able to be described as such by any manufacturer.

The material date with respect to distinctiveness is the date of filing the opposition. [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 (F.C.A.) at 424]

Mr. Justice Denault stated in *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3d) 418 (F.C.T.D.) at 428:

While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark within the meaning of s. 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others.

Furthermore, in *Canadian Council of Professional Engineers v. APA - The Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 at 253, Mr. Justice O'Keefe said:

While it is true that a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive, it is not correct to hold that merely because a mark is adjudged *not* to be either purely descriptive or deceptively misdescriptive, it is therefore distinctive.

The opponent has introduced the following dictionary definitions:

multi- *a combining form meaning:* 1. having many 2. more than two 3. many times more than

action 1. the doing of something 2. a thing done, 3. [*pl.*] behavior 4. an effect, as of a drug 5. the way of working, as of a machine...

blanchir 1. to whiten, lighten...

In addition, I have checked another French-English dictionary (*Cassell's*) and confirmed that the exact word "blanchissant" is listed therein, with the following translation: *a.* That whitens or grows white; foaming.

Based simply on the foregoing, I conclude that the applicant's mark, being the combination of descriptive words, is not inherently adapted to distinguish the wares of the applicant from similar wares of others. I note that this is not a case where the mark incorporates any distinctive feature, such as a design element, or adopts an usual linguistic construction. This is not a case like *Pizza Pizza Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 202 (F.C.T.D.) where Rouleau J. stated at page 204:

They have in fact "coined" a phrase. The court is satisfied that the proposed trade mark, having no specific descriptive connotation, is capable of distinguishing the wares of the respondent from the wares of others. The words "pizza pizza" together do not go together in a natural way and the court is satisfied that they do not have a descriptive meaning. The words are capable of acquiring the specified meaning as a trade mark.

Instead, I find this case to be more analogous to *Molson Companies Ltd. v. John Labatt Ltd. et al.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.). In that case, the Court addressed the issue of whether a trade-mark that consists of a surname and a descriptive term is not distinctive because such a mark, as a whole, is not adapted to distinguish the services of the applicant from the like services

of others bearing the same surname. At page 164 of that decision, Mr. Justice Cattanach stated:

The trade mark LABATT EXTRA serves to distinguish the beverages of "Labatt" from the beverages of other brewers of a different surname. It is not inherently adapted to distinguish the beverages of the applicant from the wares of other brewers of like quality, in their subjective views, who also bear the surname "Labatt".

In the present case, while BLANCHISSANT MULTI-ACTION might serve to distinguish the applicant's dentifrices, mouth washes and breath fresheners from those of others that do not whiten, or only whiten by a single method, I do not see how the trade-mark would serve to distinguish the applicant's oral care products from the oral care products of others that also produce whitening results by multiple means.

Furthermore, the present applicant has not introduced any evidence of its mark being used or promoted. There is therefore no basis on which to conclude that the proposed-use mark at issue has acquired distinctiveness in Canada.

Accordingly, this ground of opposition succeeds.

Section 38(2)(b) - Registrability

Having already rejected the application on one ground, I need not address this ground of opposition but I will do so briefly.

The opponent pleads that BLANCHISSANT MULTI-ACTION is not registrable pursuant to s. 12(1)(b) because it clearly describes a character and quality of the wares, namely "dentifrices, mouth washes and breath fresheners" with "multi-action whitening", or the trade-mark is deceptively misdescriptive. The opponent alleges that BLANCHISSANT MULTI-ACTION clearly means that the dentifrices, mouth washes and breath fresheners whiten by many processes. In support, the opponent relies on ordinary dictionary definitions of the words BLANCHISSANT, MULTI- and ACTION and states that the term "multi-action" is used to describe various products, including other toothpaste products, that provide benefits via multiple avenues.

The underlying section of the Act reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin

The Opposition Board considers the material date with respect to s. 12(1)(b) to be the date of filing of the application. [see *Havana Club Holdings S. A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)] I acknowledge that at the time that the opponent filed its evidence, the accepted material date with respect to s. 12(1)(b) was the date of decision. Moreover, the opponent has argued that the date of decision should still be considered to be the material date based on its submission that, contrary to what was said in *Fiesta Barbeques, supra*, the statements in *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 (F.C.A.) concerning the material date were not *in obiter*. A similar argument was made in *Canadian Council of Professional Engineers v. Management Engineers GmbH* (2004), 37 C.P.R. (4th) 277 (T.M.O.B.). In that case, Board Member Herzig was sympathetic to the opponent's argument but ultimately chose to follow the principle of comity of decision making and adopted the date of filing of the application as the material date. For similar reasons, I am treating the filing date as the material date.

The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the average purchaser of those wares. 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. [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186] Character means a feature, trait or characteristic of the wares and "clearly" means "easy to understand, self-evident or plain". [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34] The fact that a particular

combination of words does not appear in any dictionary does not prevent a trade-mark from being found to be clearly descriptive or deceptively misdescriptive. If each portion of a mark has a well-known meaning in English or French, it may be that the resultant combination would be contrary to s. 12(1)(b) of the Act.

The opponent's affiant, Ms. Van Poorten, has provided various examples of products that display one or more of the words BLANCHISSANT, MULTI-ACTION, DUAL ACTION, MULTI-ACTIVE, *etc.* but all of these products were purchased in 2003, *i.e.* well after the material date.

I find that BLANCHISSANT MULTI-ACTION is highly suggestive, even descriptive, but it is not clearly descriptive of a character of the wares. I reach this conclusion because the word "multi-action" is somewhat vague and further information is required in order to understand the various ways employed by the wares to achieve whitening.

I therefore conclude that BLANCHISSANT MULTI-ACTION is not contrary to s. 12(1)(b) of the Act and accordingly the registrability ground of opposition fails.

Before closing, I will mention that I did not find the applicant's evidence to assist its case with respect to this ground. Its evidence consisted of a search of the Canadian Trade-marks Register directed to marks that include the words MULTI and/or MULTIPLE combined with the words ACTIVE and/or ACTION, in any class. Five such applications/registrations were located. The case law makes it clear that state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace. Moreover, inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. Five applications/registrations are insufficient for me to draw any meaningful inferences. [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *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.)]

In its written argument, the applicant submitted that the applications/registrations submitted in its evidence show “that the Trade-marks Office has clearly taken the position that the term MULTI-ACTION and MULTI-ACTIVE are not clearly descriptive or deceptively misdescriptive.” However, the opponent has successfully countered this argument by pointing to the decision in *Neptune S. A. v. Attorney General of Canada* (2003), 29 C.P.R. (4th) 497 (F.C.T.D.). As summarized by the opponent, “in that case, the applicant had pointed to entries already on the register but these were considered by the Registrar and rejected and the Federal Court, on appeal, held that the Registrar could reasonably rely on the fact that if there had been errors in the past, there was no reason to perpetuate such errors.” [see also *Aetna Life Insurance Co. of Canada et al. v. S. N. J. Associates, Inc.* (2001), 13 C.P.R. (4th) 539 (T.M.O.B.) at 550]

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 27TH DAY OF MARCH 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board