

**IN THE MATTER OF AN OPPOSITION by
SmithKline Beecham Inc. sometimes trading as SmithKline
Beecham Consumer Healthcare to application
No. 845,785 for the trade-mark GREEN AND LIGHT GREEN
TOOTHPASTE Design filed by Procter & Gamble Inc.**

On May 22, 1997, the applicant, Procter & Gamble Inc., filed an application to register the trade-mark GREEN AND LIGHT GREEN TOOTHPASTE Design based upon proposed use of the trade-mark in Canada in association with toothpaste. Colour is claimed as a feature of the mark. The mark and colour claim are reproduced below:

The trade-mark is lined for the colour green. Starting with the top stripe, the first and third stripes are green and the second and fourth stripes are light green.

The application was advertised for opposition purposes in the *Trade-marks Journal* of December 24, 1997. The opponent, SmithKline Beecham Inc. sometimes trading as SmithKline Beecham Consumer Healthcare, filed a statement of opposition on August 24, 1998. The applicant filed and served a counter statement.

The opponent did not file any rule 41 evidence. The applicant's rule 42 evidence consisted of the affidavit of Darren Mahaffy. As rule 43 evidence, the opponent filed the affidavit of

Wendy D. Riel. Both parties filed a written argument and both were represented at an oral hearing.

A number of grounds of opposition were pleaded but at the oral hearing the opponent's agent confirmed that only three grounds were being pursued. One of these is a descriptiveness ground of opposition, the opponent pleading that the applicant's mark is not registrable pursuant to paragraph 12(1)(b) of the *Trade-marks Act* in that it is clearly descriptive or deceptively misdescriptive of a character or quality of the wares in association with which it is intended to be used. There is nothing in the statement of opposition that explains what character or quality the mark allegedly describes or misdescribes. The way in which the mark might be considered to be descriptive is not self-evident. This ground of opposition therefore does not constitute a proper ground as it is not in compliance with paragraph 38(3)(a) as a result of the pleadings not including any allegations of fact to support the assertions. I note that there is also no evidence from the opponent that would clarify the manner in which the mark is allegedly descriptive or misdescriptive. Although there is a legal burden upon the applicant to show that its mark is registrable, the opponent must first adduce sufficient evidence to support its claim that the mark is clearly descriptive or misdescriptive. For these reasons, the paragraph 12(1)(b) ground of opposition is unsuccessful.

I would point out that the opponent's position, according to its written argument, is that the mark clearly indicates that the wares comprise toothpaste that functions to both clean teeth and freshen breath [page 6, opponent's written argument]. Even if I had accepted

that the paragraph 12(1)(b) ground had been sufficiently pleaded, I would not have found that the mark clearly describes the wares as "toothpaste that functions to both clean teeth and freshen breath". I base this conclusion on the fact that there is no evidence that this would be the immediate impression of the typical consumer. 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; "clearly" means "easy to understand, self-evident or plain [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at p. 34]. Frankly, I do not see how the mark can be clearly descriptive given that I was unable to discern the basis on which it was allegedly descriptive prior to reading the opponent's written argument.

A further ground of opposition is that the applicant's trade-mark is not distinctive in that it does not distinguish the wares in association with which it is intended to be used from the wares of others. Again, we have been provided with no further particulars in support of this pleading. If we look elsewhere in the statement of opposition, there is an allegation under another ground that the applicant knew that toothpaste incorporating stripes has been sold in the normal course of trade in Canada by others since 1984. Although I have my doubts that the distinctiveness ground of opposition complies with paragraph 38(3)(a), I will, for completeness sake, give it further consideration.

The legal onus is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from the wares of others throughout Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (TMOB)].

However, there is an initial burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness. The material date with respect to this ground is the date of filing of the opposition, namely August 24, 1998 [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

Darren Mahaffy, the Brand Manager - Oral Care of the applicant, attests that the applied-for mark has been used by the applicant in Canada since September 1997 in association with its CREST toothpaste and that the trade-mark appears on the toothpaste packaging. He further attests that to his knowledge his company's CREST toothpaste is the only toothpaste that uses two shades of the same colour in a toothpaste design featured on toothpaste packaging.

Wendy Riel, a registered trade-mark agent with the opponent's agents, provides a toothpaste product that she purchased on November 14, 2000. As that evidence postdates the material date, it is of no consequence with respect to the distinctiveness ground of opposition.

I conclude that the opponent has not met its initial evidential burden with respect to its distinctiveness ground of opposition as there is no evidence that others used a mark similar to that of the applicant as of August 24, 1998. If the distinctiveness ground were considered to be based on the allegation that the applied-for mark is clearly descriptive of the wares, it would also fail, for the same reasons that the descriptiveness ground of opposition failed.

In its written argument, the opponent also argues that the applicant's mark is not distinctive because it is not associated with a single source; it argues that, instead of identifying a source, it identifies a flavour or function. I will not discuss this point further as it was not raised in the opponent's pleadings; nor was it raised by the opponent's evidence.

The outstanding ground of opposition pleads that the trade-mark is not registrable in that it is not a trade-mark within the meaning of section 2 of the *Act*. This ground of opposition has not been properly pleaded as section 12, which deals with registrability, does not encompass a pleading that a mark is not a trade-mark. An opposition based on the allegation that a mark is not a trade-mark is properly pleaded under section 30 of the *Act*. Moreover, even if the opponent had referred to section 30, it would not have raised a ground of opposition because there are no reasons set out in the pleadings as to why the applied-for mark is not a trade-mark. It is only in the opponent's argument that functionality is raised. For these reasons, I conclude that this ground of opposition fails because of non-compliance with paragraph 38(3)(a) of the *Act*. In addition, it is noted that there is no evidence in support of the opponent's position that the applicant's mark was functional as of the date material with respect to a Section 30 ground of opposition, namely the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469, at p. 475].

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 16TH DAY OF DECEMBER, 2002.

**Jill W. Bradbury
Hearing Officer**