



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

Citation: 2010 TMOB 107
Date of Decision: 2010-07-26

**IN THE MATTER OF AN OPPOSITION
by Industries Lassonde Inc. and A.
Lassonde Inc. to application No. 1,266,852
for the trade-mark OLIVIA'S OASIS &
Design in the name of Olivia's Oasis Inc.**

[1] On August 2, 2005 Olivia's Oasis Inc. (the Applicant), filed an application to register the trade-mark OLIVIA'S OASIS & Design (the Mark) based upon proposed use of the Mark in Canada in association with wares (1) and use since November 2004 in association with wares (2). The Mark is shown below:



[2] The statement of wares reads:

(1) "Body/bath/shower washes and gels, exfoliants, massage bars, massage oil, bath oil, bubble bath, foot and body scrubs, hand lotion, body lotion, face lotion, foot cream, face cream and body cream, glycerin bars, bath salts, lip balm and face masks.

(2) Skin care products, namely liquid hand wash and bar soap.” (the Wares)

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 1, 2006.

[4] On July 4, 2006 Industries Lassonde Inc. (Industries) and A. Lassonde Inc. (Lassonde) (together “the Opponent”), filed a statement of opposition in which 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). Leave was granted to amend the statement of opposition on August 18, 2008; the grounds of opposition can be summarized as follows:

- Non-compliance with s. 30(a) in that the wares “body/bath/shower washes and gels, exfoliants, massage bars, glycerin bars” are not defined in ordinary commercial terms.
- Non-compliance with s. 30(b) in that the Applicant did not use the Mark in Canada since November 2004 in association with wares (2).
- Non-compliance with s. 30(e) in that the Applicant did not intend to use the Mark in Canada by itself and or through a licensee in association with the wares marked (1); at the filing date of the application, the Applicant was using the Mark in association with the wares marked (1).
- Non-compliance with s. 30(i) since the Applicant could not be satisfied that it was entitled to use the Mark in Canada.
- Non-entitlement pursuant to s.16(1)(a) and s.16(3)(a), as the Mark was confusing with the Opponent’s registered trade-marks, as well as non-entitlement pursuant to s.16(1)(b) and s.16(3)(b) as the Mark was confusing with three trade-mark applications previously filed by the Opponent. The Opponent’s registrations and applications were previously used and made known in Canada at the relevant dates and not abandoned at the advertisement date.

- The Mark is not registrable pursuant to s. 12(1)(d) as it is confusing with the Opponent's OASIS trade-mark registrations as well as its trade-mark registration for OLINDA.
- The Mark is not distinctive.

The Opponent relies on its registered trade-marks (the OASIS Marks), namely, the following:

- OASIS registration No. TMA139,031 in association with: (1) Jus et breuvages de fruits; (2) Eau de source; (3) Jus de légumes. Services: Opération d'un établissement de restauration; Operation d'un débit de boissons.
- OASIS SÉLECTION registration No. TMA504,018 in association with: Jus de fruits et boissons aux fruits non-alcoolisées.
- OASIS CLASSIQUE registration No. TMA511,799 in association with: Jus de fruits, de légumes et boissons aux fruits non-alcoolisées.
- 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.
- FLORIDA'S BEST OASIS registration No. TMA514,720 in association with: Jus de fruits et boissons aux fruits non alcoolisés.
- OASIS registration No. TMA530,717 in association with: (1) Machine elements and equipments, namely: vending machines, (excluding water coolers, bottled water coolers, water dispensers, drinking fountains, water vending machines, water filtration goods and dehumidifiers); (2) Coin or counter-freed apparatus, (excluding water coolers, bottled water coolers, water dispensers, drinking fountains, water vending machines, water filtration goods and dehumidifiers); (3) Juices.
- OASIS FLORIDA'S PREMIUM registration No. TMA533,622 in association with: Jus de fruits et boissons aux fruits non-alcoolisées.
- OASIS SORBET PREMIUM registration No. TMA591,789 in association with: Jus de fruits, boissons aux fruits non alcoolisées et desserts glacés nommément sorbets, crème glacée, friandises glacées sur bâtons.
- OASIS PLUS & DESSIN registration No. TMA593,656 in association with: Jus de fruits non alcoolisés et boissons aux fruits non alcoolisées [sic].
- TROPICAL OASIS registration No. TMA599,333 in association with: Bases and concentrates used in making frozen drinks, both alcoholic and non alcoholic [sic]; bases and concentrates for making smoothies.

- OASIS registration No. TMA363,415 in association with: pressure regulators for scuba equipment.
- OASIS registration No. TMA 388,255 in association with: Valve pour l'opération et l'ajustement de système d'irrigation souterraine.
- OASIS PREMIUM registration No. TMA644,247 in association with: Jus de fruits et boissons aux fruits non alcoolisés.
- OASIS PREMIUM Dessin registration No. TMA644,605 in association with: Jus de fruits et boissons aux fruits non alcoolisés.
- OASIS registration No. TMA 660,667 in association with: (1) sorbets; (2) Smoothies.
- OASIS 100% Fruit 100% PUR registration No. TMA654,184 in association with: Jus de fruits et boissons aux fruits non alcoolisées [sic].
- OASIS PAUSE SANTÉ registration No. TMA 659,418 in association with: Jus de fruits et boissons de fruits non alcoolisés.
- OASIS HEALTH BREAK registration No. TMA 659,675 in association with: Jus de fruits et boissons de fruits non alcoolisés.
- OASIS DEL SOL registration No. TMA 659,597 in association with: Jus de fruits et boissons aux fruits non alcoolisés.

[5] The Opponent also relied on its registration for OLINDA No. TMA 663,379 in association with: huile, nommément, huile d'olive.

[6] The Opponent relied on its applications OASIS HEALTH PRO 1,263, 627 (filed July 5, 2005), OASIS PRO SANTÉ 1,263,626 (filed July 5, 2005) and OASIS 100% pur 100% FRUITS 1,214, 572 (filed April 26, 2004).

[7] The Applicant filed and served a counter statement on September 12, 2003 in which it denied the Opponent's allegations.

[8] The Opponent filed certified copies of 12 of the registrations relied on in the statement of opposition, as well as the Affidavits of Martine Girard and Benoit Boucher. The Applicant filed the affidavit of Deborah Kudzman in support of its application.

[9] The Opponent filed a written argument; both parties were represented at an oral hearing.

Opponent's Evidence

[10] Certified copies were provided for some of the registrations; however, I note that the Registrar has the discretion to verify the particulars of all pertinent registrations and/or applications. I confirm that as of today's date all the registrations relied on by the Opponent are in good standing, for the wares as set out above. With respect to the applications cited by the Opponent (as set out above), these were abandoned in 2007 subsequent to the date of advertisement of the subject application.

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

[12] The affidavit of Martine Girard, 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 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 Marks are attached as Exhibits MG-1 and 2.

[13] The affidavit of Benoit Boucher relates to marketing and sales of the Opponent's wares. Mr. Boucher has been Vice-president of Marketing since December 2004. He states that Lassonde is a food products company that in particular sells juice and fruit drinks under a number of trade-marks including the OASIS Marks. Lassonde is a wholly owned subsidiary of Industries and uses the OASIS Marks under license from Industries, and has done so since July 19, 2000.

[14] Mr. Boucher 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 the OASIS Marks.

[15] The Boucher affidavit sets out that the Opponent and its predecessors have used the OASIS Marks 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; and
5. Since at least as early as November 2003 in association with frozen mixes for alcoholic and non-alcoholic drinks.

[16] Mr. Boucher provides representative invoices of sales by Lassonde for wares sold under the OASIS Marks from the period 1967 to 2006 (Exhibit BB-3). These invoices appear to relate to sales of juices and fruit drinks only, with a few instances of sales of frozen juice concentrates. In most cases the invoices refer to the OASIS (one word) Mark, in some cases other OASIS Marks (word OASIS in combination with other word(s)) appear in the invoices.

[17] As Exhibit BB-4 of his affidavit, Mr. Boucher provides samples of 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. Subsequent to 2003 there are a few instances of OASIS sorbet advertisements and coupons.

[18] Mr. Boucher attaches evidence (Exhibit BB-6) 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.

[19] According to the Annual Reports attached as Exhibit BB-7, 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. I note that Mr. Boucher does not provide a breakdown of sales for each of the OASIS Marks.

[20] The evidence indicates that since 2004, Lassonde has invested one million dollars annually for promotions of OASIS goods. Again, I note that Mr. Boucher does not provide a breakdown of sales for each of the OASIS Marks.

[21] The Boucher affidavit indicates that the OASIS products have won numerous awards as evidenced in copies of news articles attached as Exhibit BB-9 and BB-10.

[22] Mr. Boucher alleges that some of the products sold in association with the OASIS Marks contain flax oil, and attaches extracts from the Lassonde website that support this as Exhibit BB-11. Mr. Boucher also provides that the Opponent has been selling products containing olive oil. More particularly, Lassonde has used the mark OLINDA under license in association with olive oil. Mr. Boucher attaches sample publicity for OLINDA products, including an extract from the website and media articles (Exhibits BB-13, BB-14). Exhibit BB-16 is a photograph of sample packaging of the OLINDA products. I note that no evidence of sales of olive oil in association with the OLINDA trade-mark has been provided.

Applicant's evidence

[23] I now turn to the relevant portions of the Applicant's evidence.

[24] In her affidavit Deborah Kudzman states that she is the President of the Applicant, which carries on the business of importation, sale and distribution of skin care and body care products manufactured exclusively in Turkey for the Applicant. The affiant states that the wares are targeted to women between the ages of 25 and 40 having a middle or higher than average level of income.

[25] Ms. Kudzman indicates that sales of liquid hand wash and bar soap commenced in November 2004, and that there were sales of the products to Jean Coutu Pharmacies in Quebec from November 2004 to May 2005. Exhibit 1 comprises copies of invoices dated December 2004 for sales and deliveries of liquid hand wash and bar soap in November 2004.

[26] Also attached as Exhibit 2 is a promotional leaflet used from November 2004 to May 2005, in connection with liquid hand wash and bar soap. The leaflet appears to be targeted to informing potential customers that the Applicant's products are exceptional skin care products from Turkey, where olive oil based soaps have been made since the 6th century. The information further provides that the bar soap is a traditional hand crafted bar, free from harsh chemicals and ideal for those with sensitive skin or allergic reactions to mass-produced soaps. The focus of the product information appears to be on the qualities of purity, and the benefits of traditional natural skin care and olive oil for the skin.

[27] Subsequently, on May 17, 2005 a Distribution Agreement was signed with Nergy Sante Inc. A list of 10 pharmacies is provided where the Applicant's products were sold during the period May 2005 to October 2007.

[28] As a means of introducing the Applicant's line of skin care and body care products, sales representatives of Nergy Sante Inc., made promotional leaflets available to potential customers. Exhibit 3 comprises copies of such leaflet used by the sales representatives from September 2005 to May 2007. I note that this leaflet was made available after the filing date of the subject application, and that it refers to the Applicant's "liquid hand wash", "bar soap" as well as "body wash".

[29] With respect to point of sale advertising, the affiant also attaches 18 photographs of display stands located in pharmacies, a header card, product information booklet, shelf talkers, and packaging for a promotional bar soap. I note that the photographs indicate three products on display, although the text on the labels is not clearly discernable, the shape and look of the respective containers corresponds to the images of the products as displayed in the promotional leaflets, and thus would appear to comprise, "liquid hand wash", "bar soap" and "body wash".

[30] Similarly, Exhibit 9 is described as circulars distributed by retailers in May 2005, and I note that in addition to descriptions of OLIVIA'S OASIS bar soap and liquid hand wash, it includes reference to "body wash"; also indicated in the circular under the heading "coming soon" is a "massage bar". I would observe that this circular appears to have been distributed prior to the filing date; however, no evidence of actual sales of products other than "bar soap" and "liquid hand wash" has been provided.

[31] Also attached are articles in magazines and newspapers distributed in the province of Quebec featuring Applicant's products, namely, advertisements in *Échos Vedettes*, extracts from Applicant's website, copies of poster and floor displays at The National Women's Show held in Montreal in April 2006, and a copy of the flyer distributed at The National Women's Show. Ms. Kudzman provides that the products were also displayed at The National Women's Show and distributed as samples in Montreal in April 2007. Ms. Kudzman states that the Applicant spent \$100,000 for packaging and promotion of its products between November 2004 and September 2007.

[32] It appears, from a review of the affidavit as a whole, that liquid hand wash and all natural bar soap bearing the Mark were sold prior to the filing date. While there is evidence of advertising of "body wash" prior to the filing date, there is no evidence of actual sales pursuant to s. 4(1) of the Act. The promotional literature provided by Ms. Kudzman relating to other wares in the OLIVIA'S OASIS product line, and the photographs of point of sale product displays including "body wash" all occurred subsequent to the filing date.

[33] Ms. Kudzman provides information regarding the retail outlets selling the Applicant's wares, stating that they are all pharmacies that sell natural products. Ms. Kudzman alleges that Applicant's products are found in completely different locations or sections from where food, confectionaries, beverages and drinks are sold. She also provides that Applicant's products have never been sold to supermarkets, *depanneurs* and wholesale food distributors. The affiant also indicates that no instances of confusion between OLIVIA'S OASIS and the OASIS Marks or OLINDA have been brought to her attention.

[34] In this regard I note that the Opponent argued that the photographs provided of the Applicant's products on display indicate that further down the aisle from the Applicant's

products there appear to be cartons of juice on display. I am not in agreement with this submission. A review of the 18 photographs provided indicates that all of the Applicant's product displays are in the personal care/cosmetics section of the pharmacy. In one of the photographs, its possible that there is a stand-up cooler containing beverages in the distance against a back wall; however, I note that it is so far away that one cannot be certain that it is a cooler and what it contains. In any event, I would observe that it is not part of the aisle in question, rather part of the aisle that runs along the back of the store, perpendicular to the aisle in question.

Grounds of Opposition under s. 30

[35] 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].

[36] The material date that applies to grounds of opposition under s. 30 is the filing date of the application, namely August 2, 2005 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)].

[37] With respect to the ground of opposition based on s. 30(a), the Opponent argues that "body/bath/shower washes and gels, exfoliants, massage bars, glycerin bars" are not defined in ordinary commercial terms. More particularly the Opponent objected to the use of the oblique in the statement of wares. In this regard, I am of the view that a reasonable understanding of the use of the oblique in this case is that it removes the need for repetition. For example, it obviates the need to state: "body washes and gels", "bath washes and gels", as well as "shower washes and gels". I find this reasonably self evident and therefore sufficiently specific; as a result I am satisfied that these wares are in ordinary commercial terms.

[38] Additionally, the Opponent objected to the use of "exfoliants", since it is unclear what form the exfoliant took. In this regard I would observe that the *Canadian Intellectual Property*

Trade-marks Office Wares and Service Manual, expresses the general principle that the context may serve to specify an otherwise unacceptable identification of wares. I am guided by this reasonable approach and also by the fact that the *Merriam-Webster's Medical Dictionary* © 2007, defines “exfoliant” as: “a mechanical or chemical agent (as an abrasive skin wash or salicylic acid) that is applied to the skin to remove dead cells from the surface, also called exfoliator”. Having regard to the foregoing, I am of the view that in the context of wares that can all be described as skin and body care products, an “exfoliant” is readily understandable as a skin care product for use in removing dead cells from the surface of the skin, for “exfoliating” the skin. As a result, I find the Opponent’s argument in this regard unfounded. The ground of opposition based on s. 30(a) of the Act is dismissed.

[39] Regarding the ground of opposition based on s. 30(b), I am satisfied that the Applicant had been using the Mark on wares (2) since November 2004, based on the invoices provided that show sales of liquid hand wash and soap bars. This is supported by the affiant’s statements and the circulars and flyers that provide evidence of how the wares were marked at the time of sale.

[40] The Opponent argues that the trade-mark as it was used and as it appears in the early circulars and flyers is not the Mark as applied for. I note however, that the Mark as used prior to the application date differs only slightly from the Mark as applied for, in that the leaf design is more stylized and placed differently so that it is attached to the letter S. In this case the question to be asked is whether the mark was used in such a way that it did not lose its identity and remained recognizable as the mark applied for in spite of the differences between them. Having regard to the very minor, “petty” differences between the Mark as used before the filing date and as applied for, I have no trouble concluding that the dominant features remain identical and that the Mark remains clearly recognizable. Thus I find this argument *de minimis* and without merit [see *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.); *Registrar of Trade Marks v. Compagnie Internationale pour l’informatique CII Honeywell Bull, Societe Anonyme* (1985), 4 C.P.R. (3d) 523 (F.C.A.); *Honey Dew Ltd. v. Rudd* (1928), [1928] Ex. C.R. 83 (Can. Ex. Ct.)]. Accordingly, the s. 30(b) ground of opposition is dismissed.

[41] With respect to the ground of opposition based on s. 30(e) of the Act, the Opponent may rely on the Applicant’s evidence to meet its initial burden in relation to this ground but the

Opponent must show that the evidence is clearly inconsistent with the Applicant's claim [see *Molson Canada v. Anheuser-Busch Inc.*, 2003, 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[42] In the present case, there is nothing in the Applicant's evidence which is clearly inconsistent with the claim that it intended to use the Mark in association with wares (1). Furthermore, as discussed with respect to the s. 30(b) ground pertaining to use of the Mark on wares (2) and its "petty" differences from the Mark as applied for, there is no basis for finding that the Applicant had no intention of using the Mark as applied for. Accordingly, the s. 30(e) ground is dismissed.

[43] With respect to the ground of opposition based on s. 30(i) of the Act, no evidence was filed demonstrating that the Applicant was aware of any prior rights of the Opponent when it filed its application. Even if the Applicant was aware of the Opponent's use in Canada of the Opponent's Trade-marks, that alone would not prevent the Applicant from making in good faith the statement required. 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.

Section 12(1)(d) and OASIS Registrations

[44] The Opponent has met its initial burden as it pleaded that the Mark is not registrable because it is confusing with its trade-mark registrations (the OASIS Marks) as listed above.

[45] 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.)].

[46] 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).

[47] 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 Cattanach, 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 that juices and skin care products 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.

[48] In view of the foregoing, the main focus of my comments with respect to confusion will be on the registrations for the one word OASIS Marks registered in association with beverages, namely registration Nos. TMA139,031, TMA530,717 and TMA660,667; these registrations will be referred to together as the "OASIS only Mark". I will briefly discuss the Opponent's OLINDA Mark and two of the OASIS Marks where, like the subject Mark, OASIS is not the first portion of the Mark (FLORIDA'S BEST OASIS TMA514,720 and TROPICAL OASIS TMA599,333).

[49] If a likelihood of confusion is found between the OASIS only Mark and the subject Mark, this will be determinative. By the same token, if there is no finding of likelihood of confusion in the aforesaid circumstances, then there will be no need to assess confusion in depth

with any of the Opponent's other registrations that include more than the word OASIS, (or OASIS TMA363,415 and TMA 388,255 registered for pressure regulators for scuba diving, and underground irrigation systems respectively). This is so, since logically, confusion based on the word OASIS alone in association with retail wares such as beverages is the Opponent's strongest argument.

[50] 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, there is no likelihood of confusion between the Opponent's OASIS only Mark and the subject Mark OLIVIA'S OASIS.

[51] 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.

[52] 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) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[53] 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 a dictionary word suggestive of something thirst quenching (as an oasis in a desert). I find OLIVIA'S OASIS to possess slightly more inherent distinctiveness since although composed of a name and a dictionary word, together the words form a more unique or distinctive combination.

[54] With respect to the extent that the marks have become known, there is ample evidence that the Opponent's OASIS only Mark has become known through use and promotion. Sales invoices have been provided commencing in 1967; in 2005 annual sales of Opponent's juices in Canada reached \$120 million. Mr. Boucher provides that in the year prior to the date of the affidavit (August 22, 2006) juices sold under the group of OASIS 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 OASIS only Mark, and how much is related to any of the other OASIS Marks; no itemized sales figures are provided. Based on the significant evidence of sales however, I am nonetheless able to conclude that the Opponent's OASIS Marks, which include the OASIS only Mark, have become known to some extent in Canada in association with juice.

[55] The Applicant's Mark has become known to a lesser extent in association with wares (2) "bar soap" and "liquid hand wash"; although no direct evidence of sales have been provided of the wares (1), it appears that some use has commenced since the filing date. While there are magazine articles discussing the product in general and its benefits, it is not apparent from the evidence that the Applicant's Mark has acquired the same level of distinctiveness as that of the Opponent.

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

[56] The subject application is based both on use since November 2004 for wares (2) and on proposed use for wares (1). There is evidence that use has commenced on wares (1) since the filing date. The Opponent has provided invoice evidence that its OASIS only Mark has been

used in association with juice and fruit drinks since at least as early as 1967. Clearly, the Opponent's OASIS only Mark has been in use longer than the Applicant's Mark.

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

[57] 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 natural skin and body care products, targeted to women, in pharmacies.

[58] 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 and argued that there is an overlap between the nature of the business and the wares, since both would be sold in the same stores. Further the Opponent argued that its registration for OLINDA in association with olive oil indicated that the nature of its business was broader than the sale of juices and fruit drinks.

[59] The Applicant argues that the products and the trade are entirely different, and I agree. The nature of the wares is different; juices and drinks are food consumption products, skin and body care products are not. I accept the proposition that the wares might be sold in the same outlets, such as pharmacies, however, given the wide variety of products sold in a pharmacy I do not find that this fact necessarily favours the Opponent. On balance, since the Opponent's wares are food related and for consumption, and the Applicant's wares are for topical application, I find the differences in the nature of the wares and the trade favours the Applicant.

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

[60] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. While the marks at issue must be assessed in their

entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it. In this regard it is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188].

[61] In the present case, the first portion of the marks at issue is completely different. The Opponent has only one portion - OASIS, whereas the first portion of the subject Mark is OLIVIA'S. As a result, I am of the view that when taken in their entirety, the similarity of the common element OASIS is reduced, since, in the Applicant's Mark it does not have a determinative influence on the public perception of the Mark. This is so, since the ideas suggested by the Marks as a whole are different. The Applicant's Mark suggests first and foremost that it emanates from someone named Olivia, while the Opponent's word mark simply suggests an oasis.

Section 12(1)(d) and OLINDA Registration No. TMA663,379

[62] The analysis of confusion with the Opponent's Mark OLINDA for use with olive oil can be briefly summarized. No information has been provided regarding the length of time OLINDA has been in use, although I note that the registration indicates that a declaration of use was filed on February 13, 2006. The most that I may infer is that there has been some minimal use of the Mark; however, in any event, I find that this factor favours the Applicant since its use began in November 2004.

[63] I find OLINDA to be a coined word and therefore more inherently distinctive than the Applicant's Mark; however, although both wares contain olive oil, one is for food consumption and the other for skin and body care products. These wares would not be sold in close proximity to each other; furthermore, it is not apparent to me that OLINDA olive oil would even be sold in a pharmacy.

[64] With respect to the similarity between the Marks in ideas, appearance and sound, other than the fact that both start with OL, I find the Marks to be different in sound and appearance, and completely different in ideas suggested.

Section 12(1)(d) and FLORIDA'S BEST OASIS Registration No: TMA514,720 and TROPICAL OASIS Registration No: TMA599,333.

[65] The analysis of confusion with the Opponent's Marks - FLORIDA'S BEST OASIS and TROPICAL OASIS for use with wares (that I have) categorized respectively as juices and fruit drinks, and drink concentrates, can be summarized very briefly. The comments above with respect to s. 12(1)(d) and the OASIS only Mark apply, save for the fact that the evidence suggests that these Marks have not been in use as long as the Opponent's OASIS only Mark. The fact that OASIS is not the first element in these two Marks does not significantly alter the analysis with respect to the degree of resemblance with the subject Mark. This is so since neither FLORIDA'S BEST nor TROPICAL bear any resemblance to the word - OLIVIA'S, and further, in my view the positioning of those words (in front) diminishes the determinative influence OASIS might have on the perception of the Opponent's Marks.

Conclusion with respect to s. 12(1)(d)

[66] The Applicant points out that the Opponent has not filed any evidence of instances of actual confusion between the parties' Marks. It is true that an adverse inference may be drawn concerning the likelihood of confusion when concurrent use on the evidence is extensive and no evidence of confusion has been given by an opponent [see *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. However, it is unnecessary to consider this point, as I am satisfied, having considered all of the factors, that the Applicant has discharged its burden to prove, on a balance of probabilities that the Mark is not likely to cause confusion with any of the Opponent's Marks. It is trite law that the enumerated factors in s. 6(5) need not be attributed equal weight; the fact that the OASIS Marks contain an identical portion is insufficient to make confusion likely in view of the overall differences in the Marks and the nature of the wares and trade. I have no trouble finding that the Applicant has discharged its burden with respect to OLINDA given the differences between the Marks in appearance, sound and ideas suggested.

Grounds of Opposition under s. 16(3)(a) and s. 16(3)(b)

[67] The Opponent alleges that the Applicant is not the person entitled to registration of the Mark under s.16(3)(a) and s.16(3)(b) as the Mark was confusing with the Opponent's

registrations (the OASIS Marks), previously used in Canada, as well as the trade-mark applications OASIS HEALTH PRO 1,263, 627 (filed July 5, 2005), OASIS PRO SANTÉ 1,263,626 (filed July 5, 2005) and OASIS 100% pur 100% FRUITS 1,214, 572 (filed April 26, 2004).

[68] With respect to s.16 (3)(a), as set out above, the Boucher affidavit provides evidence through invoices, annual sales figures and photos of product packaging, that the Opponent's registrations (at least the OASIS only Mark) were in use prior to the Applicant's filing date of August 2, 2005 and that, in accordance with s.16(5), they were not abandoned as of the advertisement of the subject Mark (March 1, 2006).

[69] With respect to s. 16(3)(b) the Opponent has established that its applications had been filed prior to August 2, 2005, and in accordance with s.16(4) that they were pending at the date of the advertisement of the subject Mark (March 1, 2006). As noted previously, the applications were not abandoned until 2007.

[70] However, as s.16 grounds of entitlement are based on confusion as assessed under s. 6(5) of the Act, the difference in material dates having no effect on the determination of confusion in this case, for the reasons set out above with respect to s. 12(1)(d), I find no likelihood of confusion with the Opponent's relevant registrations and applications. As a result the s.16 (3)(a) and s.16(3)(b) grounds of opposition fail.

Ground of Opposition under s. 2

[71] 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]. It is not necessary for the Opponent to show that its mark had become well known, it is sufficient to establish that its mark had become known sufficiently to negate the distinctiveness of the Applicant's mark.

[72] In the present proceedings, although the Opponent's evidence of use of its OASIS Marks may satisfy its initial burden, I do not find the evidence to be sufficient to negate the distinctiveness of the Applicant's Mark given the differences between the Marks and their associated wares. In view of my findings with respect to the issue of confusion under s. 6(5) of the Act, the Opponent has not produced evidence sufficient for me to find that the Applicant's Mark cannot be distinctive in association with skin care and body care products.

Disposition

[73] 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