

**IN THE MATTER OF AN OPPOSITION
by Ocean Fisheries Limited
to application no. 828,505
for the trade-mark OCEAN CHOICE
filed by 602390 Ontario Limited**

On November 8, 1996, the applicant, 602390 Ontario Limited, filed an application to register the trade-mark OCEAN CHOICE, based on proposed use in Canada, in association with the following wares

fresh, frozen and processed fish and seafood, namely, clams, shrimp, mussels, scallops, lobsters, squid, cuttle fish, crab, oysters, salmon, fish and fillets.

The applicant subsequently amended its application to disclaim the right to the exclusive use of the word CHOICE apart from the mark as a whole in order to comply with an objection to the mark raised by the Examination Section of the Trade-marks Office. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 25, 1997 and was opposed by Ocean Fisheries Limited on March 17, 1998. A copy of the statement of opposition was forwarded to the applicant on April 15, 1998. The applicant responded by filing and serving a counter statement generally denying the grounds of opposition and noting a technical error in the opponent's pleadings.

The first ground of opposition alleges that the applied for mark OCEAN CHOICE is not registrable, pursuant to Section 12(1)(d) of the *Trade-marks Act*, because it is confusing with the opponent's registered marks namely, (i) OCEAN BRAND, regn. no. 285,905 covering a variety of salmon products, (ii) OCEAN'S DESIGN, regn. no. 289,015, covering canned salmon, (iii) OCEAN'S DESIGN, regn. no. 309,431, covering a variety of fish products, (iv) OCEAN'S DESIGN, regn. no. 331,646, covering hats, T-shirts, socks, other like items, pens and umbrellas, (v) OCEAN'S ROYALE, regn. no. 341,551, covering a variety of fish products. The opponent's three above-mentioned OCEAN'S DESIGN marks are the same, as illustrated below:



The second ground of

opposition alleges that the applicant

is not entitled to register the mark OCEAN CHOICE, pursuant to Section 16(3) of the *Act*, because at the date of filing of the application for OCEAN CHOICE, it was confusing with (i) the opponent's above-mentioned marks previously used and made known in Canada, (ii) the opponent's mark THE NATURAL CHOICE "previously used and made known in Canada by the opponent and for which an application for registration has been filed."

The third ground of opposition alleges that the applied for mark is not distinctive or adapted to distinguish the applicant's wares from the opponent's wares. The fourth and final ground of opposition alleges that the subject trade-mark application does not comply with Section 30(1)[sic] of the *Act* because the applicant was aware of the opponent's above-mentioned marks. The opponent further pleads as follows:

The opponent's evidence consists of the affidavits of Christine Dafoe, Sales and Marketing Co-ordinator of the opponent company, and Margaret McKay, student at law. Ms. McKay's affidavit serves to introduce into evidence (i) extracts from various dictionaries, and a thesaurus, explaining the meaning of the word "choice," (ii) the results of a trade-marks register search for marks comprised of the word "choice" used in association with food or beverage products. The applicant's evidence consists of the affidavit of Kendra Preston-Brooks, a trade-mark searcher, and certified copies of three cases decided by this Board. Ms. Brooks' affidavit serves to introduce into evidence the results of a trade-marks register search for marks comprised of the word "ocean" used in association with fish, seafood and related food products. Both parties submitted written arguments, however, only the opponent was represented at an oral hearing.

Ms. Dafoe's affidavit does not break down the opponent's sales of fish products under its

marks OCEAN BRAND, OCEAN'S DESIGN, and OCEAN ROYALE. However, the exhibit material attached to Ms. Dafoe's affidavit is comprised mostly of examples of use of the mark OCEAN'S DESIGN and omits any examples of use of the marks OCEAN BRAND or OCEAN ROYALE. Further, it would appear from Exhibit A that the opponent's considerable sales of its fish products have been made under the mark OCEAN'S DESIGN. Accordingly, the determinative issue in this proceeding, based on the opponent's pleadings in the statement of opposition, is whether the applied for mark OCEAN CHOICE is confusing with the opponent's mark OCEAN'S DESIGN.

The material dates to assess the issue of confusion are (i) the date of my decision, with respect to the first ground of opposition alleging that the mark OCEAN CHOICE is not registrable; the date of filing the subject application (that is, November 8, 1996), in respect of the second ground of opposition alleging non-entitlement and in respect of the last ground of opposition alleging non-compliance with Section 30(i) of the *Act*; and the date of opposition (that is, May 17, 1998), in respect of the third ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In the circumstances of the instant case, nothing turns on whether the issue of confusion is determined at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark OCEAN CHOICE and the opponent's mark OCEAN'S DESIGN. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. That is, in assessing whether two marks are confusing, I must consider whether, as a matter of first impression on the mind of an ordinary person having a vague recollection of the mark, the use of both marks in the same area is likely to lead to the inference that the wares associated with those marks are produced by, or emanate from, the same person:

see *Miss Universe v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.). The use of a mark would cause confusion with the use of another mark if the use of both marks in the same area would be likely to lead to the inference that the wares associated with those marks are manufactured or sold by the same person, whether or not the wares are of the same general class. The test is a theoretical test in the sense that it is not dependant on there being evidence of actual use of the marks at issue in the same area: see s. 6(2) of the *Act*; *Oshawa Holdings Ltd v. Fjord Pacific Marine Industries Ltd.* (1981), 55 C.P.R. (2d) 39 (F.C.A.); *Canadian Tire Corp. v. Cooper Tire & Rubber* (1994), 59 C.P.R. (3d) 402 (TMOB).

Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D).

The opponent's mark OCEAN'S DESIGN possesses little inherent distinctiveness in that it is suggestive of the source of the fish products sold under the opponent's mark. The design features of the mark contribute little to the inherent distinctiveness of the mark. Similarly, the applied for mark OCEAN CHOICE possesses little inherent distinctiveness because the term "ocean" is suggestive of the source of the fish products intended to be sold under the mark, and because the term "choice" has a laudatory connotation. Ms. Dafoe's evidence is to the effect that the opponent has been using its mark OCEAN'S DESIGN since at least 1983 and that sales under the opponent's marks averaged about \$21 million annually for the period 1987 - 1994 inclusive, and about \$31 million annually for the period 1995 - 1998 inclusive. Advertising and promotion costs totaled to about \$1.2 million for the period 1989 - 1998 inclusive. As mentioned earlier, the evidence is consistent with the majority of sales and advertising being under the mark OCEAN'S DESIGN. I therefore infer that the opponent's mark OCEAN'S DESIGN had

acquired some reputation as of the earliest material date and acquired a significant reputation as of the later material dates. There is no evidence showing that the applied for mark OCEAN CHOICE acquired any reputation at any material date. The length of time that the marks have been in use favours the opponent as there is no evidence that the applied for mark, which is based on proposed use in Canada, has ever had marketplace exposure. The parties' wares are the same or closely related and, in the absence of evidence to the contrary, I assume that the parties would market their wares through the same channels of trade. The marks in issue bear a high degree of resemblance aurally and in ideas suggested as the first component of the applied for mark is almost the same as the opponent's mark. However, the marks in issue are distinct visually owing largely to the design features comprising the opponent's mark.

As a surrounding circumstance, the applicant has submitted that the significance of any resemblance between the marks in issue is mitigated by the state of the register evidence introduced by means of the Preston-Brooks affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R.(3d) 432 (TMOB) and *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). See also *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. In the instant case, leaving aside for the moment hearsay issues raised by the opponent, the applicant's evidence demonstrates that at all relevant times numerous trade-marks including the term OCEAN were registered for a variety of fish products. I can therefore conclude (again, leaving aside hearsay issues) that at least some of those marks are in use and that consumers are accustomed to distinguishing among such marks by relying on their other components.

The opponent, for its part, points to another surrounding circumstance pleaded in the statement of opposition, namely, that it has used the mark THE NATURAL CHOICE in conjunction with its mark OCEAN'S DESIGN. The opponent's position is summarized at paragraph 46 of its written argument, reproduced below:

I am not certain that I would agree with the opponent that the phrase THE NATURAL CHOICE or the combined phrase OCEAN'S. THE NATURAL CHOICE have been used as trade-marks in association with wares within the ambit of Section 4(1) of the *Trade-marks Act*. In my view the more defensible position is that the term THE NATURAL CHOICE, as shown in the exhibit material attached to Ms. Dafoe's affidavit, is possibly used as a trade-mark, within the ambit of Section 4(2) of the *Act*, for the service of providing recipes. However, in my view nothing turns on whether the opponent is able to conclusively establish whether the term THE NATURAL CHOICE has been used a trade-mark for wares or for services. At the very least the opponent has certainly employed the term THE NATURAL CHOICE as an advertising slogan by itself and in conjunction with the mark OCEAN'S DESIGN. In my view, the evidence supports the opponent's submissions that the public has to a certain extent become accustomed to identifying the terms THE NATURAL CHOICE and OCEAN'S. THE NATURAL CHOICE with the opponent.

Considering the above, and taking into account the inherent weakness of the word OCEAN as an element of a trade-mark applied to seafood products, and even if I were to accept the applicant's state of the register evidence at full value, I find that I am in a state of doubt whether the public, already familiar with the opponent's mark OCEAN'S DESIGN and its use in conjunction with the advertising slogan THE NATURAL CHOICE, would believe that fish products sold under the mark OCEAN CHOICE originate with the opponent. As such doubt must be resolved against the applicant, I must find that the applicant has not met the legal onus on it to

show that the marks in issue are not confusing.

The applicant in its written argument has relied on a trilogy of Board cases wherein the present opponent Ocean Fisheries Limited was unsuccessful in opposing the applied for marks OCEAN PEARL, OCEAN FRESH, and OCEAN CLUB for use in association with fish products: see *Ocean Fisheries Ltd. v. A. Raptis & Sons* (1991), 35 C.P.R. (3d) 473; *Ocean Fisheries Ltd. v. J.S. McMillan Fisheries Ltd.* (1991), 40 C.P.R. (3d) 444; *Ocean Fisheries Ltd. v. Eurotrade Import-Export Inc.* (1992), 42 C.P.R. (3d) 554. In each of the above-mentioned cases the low inherent distinctiveness of the opponent's mark OCEAN'S DESIGN and the state of the register evidence showing common adoption of the word OCEAN as a component of trade-marks for fish products were key factors in the Board rejecting the opponent's opposition. The instant case is distinguishable from the above trilogy of cases in that the opponent has demonstrated use of the advertising slogan THE NATURAL CHOICE (and possibly its use as a service mark) in conjunction with its mark OCEAN'S DESIGN. That circumstance supports the opponent's position that the use of the two marks OCEAN'S DESIGN and OCEAN CHOICE would likely lead to the inference that the wares sold under the two marks are processed and sold by the same person. I would also mention that because Kendra Preston-Brooks has not adequately explained in her affidavit why the source of her information is reliable, I must rule that the applicant's state of the register search is inadmissible hearsay and cannot, in law, be accorded any probative value: see *Sta-Rite Industries Inc. v. GSW Inc.* (1999), 87 C.P.R.(3d) 300

at 305, paragraphs 18,19, 20 (F.C.T.D.).

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 18th DAY OF June , 2001.

Myer Herzig,
Member,
Trade-marks Opposition Board