

IN THE MATTER OF AN OPPOSITION
by Smithkline Beecham Inc. to application
No. 816,114 for the trade-mark AH!
filed by Colgate-Palmolive Canada Inc.

On June 24, 1996, the applicant, Colgate-Palmolive Canada Inc., filed an application to register the trade-mark AH! for “toothpaste and mouthwash” based on proposed use in Canada. The application was advertised for opposition purposes on October 25, 1996.

The opponent, Smithkline Beecham Inc., filed a statement of opposition on September 23, 1997, a copy of which was forwarded to the applicant on October 7, 1997. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereinafter “the *Act*”) because it clearly describes or deceptively misdescribes a character or quality of the applied for wares. The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the *Act* because the word “AH!” has by *bona fide* commercial usage become recognized in Canada as designating the quality of toothpaste and mouthwash. The third ground is that the applied for trade-mark is not distinctive of the applicant.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Mary Jane Lemenchick, Carl Gauthier, and Suzy Torres. As the affiants Gauthier and Torres were not made available for cross-examination, their affidavits no longer form part of the record of this opposition (see Office letter dated June 2, 1999). As its evidence, the applicant submitted an affidavit of Denise Lacombe. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the opponent’s first ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the *Act* is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). Furthermore, the issue is to be determined from the point of view of an everyday user of the wares. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984),

Ms. Lemenchick identifies herself as a trade-mark agent employed with the agents for the opponent. Her affidavit introduces into evidence the following definition for the word “AH” obtained from Webster’s II New College Dictionary: “Used to express various emotions, as surprise, pain, or satisfaction.”

The applicant’s evidence consists of the affidavit of Ms. Lacombe who identifies herself as a law student employed with the agents for the applicant. Her affidavit introduces into evidence a number of excerpts from several dictionaries which she searched on-line which include the following definitions for the word “AH”:

Merriam-Webster Dictionary- used to express delight, relief, regret or contempt

Webster’s Revised Unabridged Dictionary - an exclamation, expressive of surprise, pity, complaint, entreaty, contempt, threatening, delight, triumph etc. according to the manner of utterance.

Easton’s 1897 Bible Dictionary - an exclamation of sorrow or regret

The Newbury House Online Dictionary - expression of surprise, disgust, pain, understanding, pleasure, etc.

Wordsmyth English Dictionary-Thesaurus - used to express surprise, joy, pain, agreement, dislike and other emotions or reactions according to the context.

At the oral hearing, the opponent relied on a number of cases to support her argument that the word “AH!” is clearly descriptive or deceptively misdescriptive of the applied for wares. For example, the opponent referred to the decision in Imperial Tobacco Limited v. Benson & Hedges (Canada) Inc. (1983), 75 C.P.R. (2d) 115 (F.C.T.D.) (hereinafter “Imperial Tobacco”), where although the word “RIGHT” was found to have a plethora of dictionary meanings, when used in association with wares, the common theme of the definitions was “suitable, proper, desirable and satisfactory”. The court found that throughout the definitions there was “the thread of meeting some standard”. As a result, the word RIGHT was found to have “the laudatory connotation that wares modified thereby meet a specified standard and are desirable and satisfactory.”

The opponent submitted that in the present case, although there were several different

dictionary definitions for the word AH, the common theme throughout the definitions is that the word is used to express a variety of emotions. When used in association with mouthwash and toothpaste, the opponent argues that the mark AH! can only have one meaning, that of a pleasure or satisfaction that is derived from use of the applicant's products. It is therefore the opponent's submission that the word AH, just as the word RIGHT in the Imperial Tobacco case, supra, has the laudatory connotation that the wares modified thereby meet a specified standard or quality and are desirable and satisfactory. In other words, since the mark AH! describes the expression of pleasure or satisfaction, the first impression of the everyday user of the wares would be that the wares must be of a high quality. The opponent further asserts that, as in Melitta-Werke Bentz & Sohn v. VKI Technologies Inc. (1992), 44 C.P.R. (3d) 256 (T.M.O.B.), the use of the exclamation point in the present case emphasizes the laudatory nature of the word AH.

In my view, the present case can be distinguished from the Imperial Tobacco decision. In Imperial Tobacco, the word RIGHT was considered as an adjective that modified the wares whereas the word AH in the present case functions as an interjection. Further, the definition for the word RIGHT in that case was "suitable, proper, desirable or satisfactory" whereas in the present case, the word AH is defined as *the expression or exclamation of* an emotion such as pleasure or satisfaction. As such, the word AH!, with or without an exclamation mark, does not in my view laud the merits or superiority of mouthwash or toothpaste.

In my view, the present case can be compared to the decision Morris et al. Trading as Happy Cooker Catering v. Lisko (1982), 70 C.P.R. (2d) 254 (TMOB) (hereinafter "Happy Cooker"). In that case, Chairman Partington made the following comments at p.255:

"As a matter of immediate impression and from the point of view of the average user of the applicant's services or the average consumer of the applicant's publications or kitchen wares, I do not consider that such a person would consider the trade-mark THE HAPPY COOKER to be clearly descriptive of either the character or quality of the applicant's wares or services. Rather, the trade-mark THE HAPPY COOKER as applied to the applicant's wares or services *would be suggestive to the average consumer or user of the applicant's wares or services of the pleasure which one might derive from using the wares or utilizing the services of the applicant*" (emphasis added).

In the present case, I do not consider that the average consumer of the applicant's toothpaste or mouthwash, as a matter of immediate impression, would consider the trade-mark AH! to be clearly descriptive of either the character or quality of the applicant's wares. Rather, as in the Happy Cooker case, supra, the trade-mark AH! as applied to the applicant's wares would be suggestive to the

average consumer or user of the applicant's wares of the pleasure which one might derive from using the wares of the applicant. I have therefore concluded that the s.12(1)(b) ground of opposition is not successful.

As for the second ground of opposition, the opponent asserts that the applied for trade-mark is not registrable pursuant to Section 12(1)(e) because it contravenes Section 10 of the *Act*. As the opponent has not filed any evidence in support of this ground, this ground of opposition is also unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (*i.e.* - September 23, 1997): 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.).

The opponent submits that as the applicant's mark is based on proposed use, and as the applicant has not filed any use of its trade-mark in Canada, the applicant's mark cannot be said to have acquired any distinctiveness. Further, the opponent submits that the mark cannot be adapted to distinguish the applicant's wares from those of others because it is laudatory and clearly descriptive of the character or quality of the applicant's wares.

My findings respecting the first ground of opposition also apply to this ground. As the opponent has provided no other evidence to support its ground of non-distinctiveness, this ground of opposition is unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the *Act*, I reject the opposition pursuant to s.38(8) of the *Act*.

DATED AT HULL, QUEBEC, THIS 23rd DAY OF April, 2001.

C.R. Folz,
Member,
Trade Marks Opposition Board.