



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

**Citation: 2012 TMOB 9**  
**Date of Decision: 2012-01-24**

**IN THE MATTER OF AN OPPOSITION  
by Industries Lassonde Inc. and A.  
Lassonde Inc. to application No. 1,299,845  
for the trade-mark OASIS in the name of  
OCHC LLC**

Introduction

[1] On May 1, 2006 GlaxoSmithKline Consumer Healthcare Inc. (Glaxo) filed application No. 1,299,845 to register the trade-mark OASIS (the Mark) based on proposed use in Canada. It covers the following wares:

Non-medicated mouth and breath fresheners; non-medicated preparations and substances to freshen the mouth and breath, namely mouthwashes, mouth sprays, non-medicated lozenges, chewing gum; non-medicated preparations and substances to moisturize the mouth, namely mouthwashes, mouth sprays, non-medicated lozenges, chewing gum; non-medicated moisturizers for the mouth, namely mouthwashes, mouth sprays, non-medicated lozenges, chewing gum; dentifrices, dental gels, bleaching preparations for the teeth, tooth polishing preparations, tooth whitening preparations and accelerators, cosmetic stain removal preparations for the teeth; chewing gum and lozenges for dental hygiene; medicated preparations and substances for the relief of dry mouth and for the relief of symptoms and conditions associated with xerostomia; medicated preparations and substances according to a special formula for use by people requiring simulation of the salivary glands to bring about the relief from dry mouth symptoms associated with temporary or permanent salivary gland dysfunction, medicated lozenges; medicated tooth polishing preparations, medicated tooth whitening preparations, medicated mouthwashes, medicated bleaching preparations for the teeth; flexible and disposable dental trays;

toothbrushes, toothpicks, dental floss, brushes and sponges, holders and applicators thereof. (the Wares).

[2] The application was advertised on March 28, 2007 in the *Trade-marks Journal* for opposition purposes. Industries Lassonde Inc. (Industries) and A. Lassonde Inc. (Lassonde) (Industries and Lassonde collectively referred to as the Opponent) filed a statement of opposition on May 18, 2007 which was forwarded by the Registrar to the Applicant on June 28, 2007.

[3] The applicant filed a counter statement on July 17, 2008 denying the grounds of opposition pleaded by the Opponent.

[4] The Opponent filed as its evidence the affidavit of Pierre Turner and Nathalie Nasserri as well as certificates of authenticity for some of the OASIS Registered trademarks (as defined hereinafter) and certified copies of file wrapper for applications 1299845, 1256423 and 1262449 while the applicant filed the affidavit of Mark Geiger. The Opponent filed the affidavit of Léna Chabot as its reply evidence.

[5] Both parties filed written arguments and were represented at the hearing.

[6] There were successive assignments of this application during the course of this opposition. Glaxo assigned the application to Stafford-Miller (Ireland) Limited (Stafford). The latter then transferred the application to Gebauer Oral Care LLC (Gebauer Oral) which in turn assigned it to OCHC LLC (OCHC). I shall refer to Glaxo, Stafford, Gebauer Oral and OCHC indistinctively as the Applicant.

### The Grounds of Opposition

[7] The grounds of opposition raised by the Opponent can be summarized as follow:

1. The application does not satisfy the requirements of s. 30 of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the Act) in that:
  - a) Contrary to s. 30(a) of the Act the application does not contain a description in ordinary commercial terms of the following wares: tooth whitening preparations and accelerators; medicated preparations and substances for the relief of dry mouth and for the relief of symptoms and

conditions associated with xerostomia; medicated preparations and substances according to a special formula for use by people requiring simulation of the salivary glands to bring about the relief from dry mouth symptoms associated with temporary or permanent salivary gland dysfunction, medicated lozenges; medicated tooth polishing preparations, medicated tooth whitening preparations, medicated mouthwashes, medicated bleaching preparations for the teeth; flexible and disposable dental trays; toothbrushes, toothpicks, dental floss, brushes and sponges, holders and applicators thereof;

- b) Contrary to s. 30(e) of the Act the Applicant did not have the intention to use the Mark in Canada as a trade-mark at the filing date of the application by itself or through licensees or itself and through licensees in association with all of the Wares;
  - c) Contrary to s. 30(b) and (e) of the Act the Applicant was using the Mark in Canada at the filing date of the application;
  - d) Contrary to s. 30(i) Applicant could not have declared itself satisfied that it is entitled to use the Mark in Canada in association with the Wares in view of the fact that the Applicant could not have been unaware at the filing date of the application, of the use by the Opponent of its trade-marks OASIS registered and in the process of being registered in Canada as described hereinafter;
2. The application is not registrable in view of s. 12(1)(d) since the Mark is confusing with the trade-mark registrations of Industries, namely the following (hereinafter referred to as the OASIS Registered trade-marks):
- a. OASIS registration No. TMA139,031 in association with: juices and fruit drinks; spring water and vegetable juice. Services : restaurant and operation of a drinking establishment;
  - b. OASIS SÉLECTION registration No. TMA504,018 in association with: fruit juices and non-alcoholic fruit drinks;
  - c. OASIS CLASSIQUE registration No. TMA511,799 in association with: fruit juices and non-alcoholic fruit drinks;
  - d. OASIS FLORIDA PREMIUM registration No. TMA513,293 in association with : Florida fruit juices and non-alcoholic Florida fruit drinks;
  - e. OASIS registration No. TMA530, 717 in association with: fruit juices and drinks;
  - f. OASIS SORBET PREMIUM registration No. TMA591,789 in association with: fruit juice, non-alcoholic fruit drinks and frozen dessert products namely sherbet, ice cream, frozen treats on sticks;
  - g. TROPICAL OASIS registration No. TMA599,333 in association with: bases and concentrates used in making frozen drinks, both alcoholic and non-alcoholic; bases and concentrates for making smoothies;
  - h. OASIS PREMIUM registration No. TMA644,247 in association with: fruit juices and non-alcoholic fruit drinks;

- i. OASIS PREMIUM DESSIN registration No. TMA644,605 in association with: fruit juices and non-alcoholic fruit drinks;
  - j. OASIS registration No. TMA 660,667 in association with: sorbets;
  - k. OASIS DEL SOL registration No. TMA659,597 in association with: fruit juices and non-alcoholic fruit drinks;
  - l. OASIS PAUSE SANTÉ, registration TMA659,418 in association with: non-alcoholic fruit juices and beverages;
  - m. OASIS HEALTH BREAK, registration TMA659,675 in association with: non-alcoholic fruit juices and beverages.
3. The Applicant is not entitled to the registration of the Mark pursuant to s. 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the OASIS Registered trade-marks which have been previously used or made known in Canada as well as the trade-marks hereinafter described:
- a) OASIS PLUS, application 1,307,246, used since October 31, 2006;
  - b) OASIS COLLECTION PREMIUM, application 1,307,247, used since June 20, 1996;
  - c) OASIS COLLECTION PREMIUM, application 1,307,251, used since June 20, 1996.
4. The Applicant is not entitled to the registration of the Mark pursuant to s. 16(3)(b) of the Act in that at the filing date of the application the Mark was confusing with the Opponent's applicable OASIS Registered trade-marks as well as the previously filed applications listed hereinafter:
- a) OASIS 100%Fruit 100% PUR, application 1,214,572 filed on July 26, 2004;
  - b) OASIS HEALTH PRO application No. 1,263,627 filed on July 5, 2005;
  - c) OASIS PRO SANTÉ application No. 1,263,626 filed on July 5, 2005.
5. Pursuant to s. 38(2)(d), the Applicant's Mark is not distinctive of the applicant's Wares as it does not distinguish nor is it adapted to distinguish the Wares from the wares and services of others, in particular, those of the Opponent, its predecessors in title and licensees in association with the OASIS Registered trade-marks or in the course of being registered in Canada.

[8] By interlocutory ruling dated June 18, 2008 the Registrar struck ground of opposition 1(c) from the record. In its written argument the Opponent desisted from the fourth ground of opposition (entitlement based on s. 16(3)(b) of the Act).

#### Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[9] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

#### Relevant dates

[10] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: the filing date of the application (May 1, 2006);
- Registrability of the Mark under s. 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)]
- Entitlement to the registration of the Mark, where the application is based on proposed use: the filing date of the application (May 1, 2006) [see s. 16(3) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (May 18, 2007) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

#### Grounds of Opposition Summarily Dismissed

[11] In its written argument the Opponent admits that there is no evidence in the record to support the third ground of opposition. Therefore this ground of opposition is dismissed as the Opponent failed to meet its evidential burden.

[12] The Opponent argues that the following wares are not described in ordinary commercial terms:

tooth whitening preparations and accelerators; medicated preparations and substances for the relief of dry mouth and for the relief of symptoms and conditions associated with xerostomia; medicated preparations and substances according to a special formula for use by people requiring stimulation of the salivary glands to bring about the relief from dry mouth symptoms associated with temporary or permanent salivary gland dysfunction, medicated lozenges; medicated tooth polishing preparations, medicated tooth whitening preparations, medicated mouthwashes, medicated bleaching preparations for the teeth; flexible and disposable dental trays; toothbrushes, toothpicks, dental floss, brushes and sponges, holders and applicators thereof.

[13] It alleges in its written argument that those terms are incomprehensible for the ordinary consumer. It further argues that those terms are not found in Mr. Geiger's affidavit, the Vice President Sales & Marketing of Gebauer Company. As such the Opponent asserts that it has met its initial evidential burden. I beg to differ. No evidence has been filed by the Opponent to support such ground of opposition. The only technical term is "xerostomia" but that does not mean that "medicated preparations and substances for the relief of dry mouth and for the relief of symptoms and conditions associated with xerostomia" is not written in ordinary commercial terms. It covers medicated preparations to be taken by those who are suffering from xerostomia. The other wares are written in plain English terms. Consequently the ground of opposition 1a) is also dismissed for failure by the Opponent to meet its evidential burden.

[14] Concerning the ground of opposition based on s. 30(e) of the Act, the Opponent submits that Mr. Geiger, in his affidavit, only refers to oral demulcent and a moisturizing mouthwash. He describes how these products are sold in the United States in association with the Mark and he alleges that they will be sold in Canada in the same manner. No reference is made by Mr. Geiger to the other products. Moreover the Opponent argues that less than two years after filing the application Glaxo transferred the Mark. Therefore how could it have the intention to use the Mark at the filing date of the application?

[15] The fact that Mr. Geiger limited his comments on the packaging, distribution and channels of trade to only oral demulcent and a moisturizing mouthwash does not mean that Glaxo did not have the intention to use the Mark at the filing date of the application. In fact Mr. Geiger's affidavit is dated October 2, 2009, which is after the relevant date. In the absence of any other relevant facts I do not see how the assignment of the application

by Glaxo would prove that it did not have the intention to use the Mark in Canada at the filing date of the application.

[16] For all these reasons I also dismiss ground of opposition 1b).

Registrability of the Mark under s. 12(1)(d) of the Act

[17] The test to determine if there is a likelihood of confusion is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria. Moreover in its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 S.C.C. 27 the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under s. 6(5) of the Act is often the degree of resemblance between the marks.

*the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known*

[18] At the hearing the Opponent argued that it cannot have cited against it time after time a decision that issued almost 25 years ago. It refers to the judgment rendered by the Federal Court in *A. Lassonde & Fils Inc. v. Imperial Tobacco Ltd.* (1987), 17 C.P.R. (3d) 8 (FCTD) which has been cited in two recent Registrar's decisions in *Industries Lassonde Inc. v. Olivia's Oasis Inc.* [2010], TMOB 107 (CanLII) and *Industries Lassonde Inc. v. Philip Morris Products S.A.* [2010], TMOB 48 (CanLII). In the latter two decisions the Registrar is referring to the Federal Court judgment in *Imperial Tobacco Ltd.* to support his finding that the Opponent's trade-mark OASIS is not an inherently strong mark. It appears from a reading of the *Imperial Tobacco Ltd.* case that, even though the Court did not state explicitly that the trade-mark OASIS was a weak trade-mark, the reference to

the Supreme Court judgment in *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101 certainly supports such interpretation.

[19] One must distinguish between the inherent distinctiveness of a trade-mark and its acquired distinctiveness through use. The conclusion on the latter will depend on the evidence filed in the record. Thus a finding on such issue may vary from file to file even though the same trade-mark is at issue. However a finding by a court of law on the inherent distinctiveness of a trade-mark shall be binding when assessing such factor in another file involving the same trade-mark unless a clear error in law was committed in reaching such finding.

[20] The Opponent's trade-mark OASIS is not an inherently strong mark. It is not a coined word. On this point I may add that the word OASIS, both in English and French, when used in association with juices, suggests something refreshing. As for the Applicant's Mark it is also not an inherently strong mark.

[21] The Mark has not acquired any distinctiveness as there is no evidence of its use in Canada. Mr. Geiger's affidavit only relates to the use of the Mark in the United States in association with some of the Wares. This evidence is not relevant to determine the extent of the acquired distinctiveness of the Mark in Canada. There is no evidence in Mr. Geiger's affidavit of any spill-over advertising that may lead to a conclusion that the Mark was known in Canada.

[22] Mr. Turner has been, since March 2008, Industries' vice-president, quality assurance. He was between August 2005 and March 2008 director, project development, for Industries. He states that Lassonde is a subsidiary of Industries. Lassonde manufactures juices and fruit drinks under various trade-marks including the trade-mark OASIS. Industries is a public company and owns shares of two subsidiaries including Lassonde and does manage and control its subsidiaries' activities.

[23] Industries has been the owner of the trade-mark OASIS since July 19, 2000 and its various versions (identified in his affidavit as the OASIS trade-marks). He does refer to OASIS, OASIS CLASSIQUE, OASIS SORBET PREMIUM, TROPICAL OASIS,



OASIS PREMIUM, OASIS PAUSE SANTÉ and OASIS HEALTH BREAK. He alleges that since 2000 Industries makes use of the OASIS trade-marks through its licensee Lassonde. In fact a license was granted by Industries to Lassonde on December 24, 1999 which came into force on July 19, 2000. It was subsequently amended on March 6, 2006. He filed a copy of those contracts. Industries controls directly the characteristics and quality of the wares bearing any of the OASIS trade-marks. He does explain how Industries exercises control over the use of these trade-marks. There is no doubt that any use of the trade-mark OASIS or any other registered trade-marks having as a component OASIS by Lassonde is deemed use of those trade-marks by Industries [see s. 50 of the Act]. In fact the Applicant has not challenged the use of Industries' OASIS trade-marks by Lassonde.

[24] Ms. Nasserri has been the Marketing Director of Lassonde since November 2005. She repeats essentially the same allegations contained in Mr. Turner's affidavit as to the relationship between Industries and Lassonde. She adds that before May 1<sup>st</sup>, 1992 Lassonde was known under the trade-name A. Lassonde & Fils Inc. During the 1960's A. Lassonde & Fils Inc. was also carrying on business under the trade-name Les Produits Oasis (Foods) Enrg.

[25] She states that Lassonde and its predecessors in title have used the trade-mark OASIS and its various versions in Canada:

- since 1965 in association with fruit juices and fruit drinks;
- since 1981 in association with vegetable juices;
- since February 2000 in association with spring water;
- since July 2002 in association with sorbets;
- since November 2003 in association with frozen mixes for alcoholic and non-alcoholic beverages.

[26] Ms. Nasserri affirms that the trade-mark OASIS and its various versions are affixed on the packaging of the products manufactured, on containers, plastic bottles or on cans. Exhibit NN-1 is a list of products presently manufactured and sold in Canada in association with one of the OASIS trade-marks. Such list makes reference to the various OASIS trade-marks used in association with juices, sorbets and natural spring water.

[27] She filed as exhibit NN-2 pictures of various packaging on which appears one of the OASIS trade-marks (OASIS, OASIS CLASSIC, OASIS CLASSIQUE, OASIS NATURE'S COLLECTION (not mentioned as part of the OASIS trade-marks), OASIS PREMIUM and TROPICAL OASIS), all in association with the various products enumerated above.

[28] She states that through the years Lassonde has made changes to the various versions of the OASIS trade-marks such that some are abandoned while others are added. She cites as examples the abandonment of OASIS DEL SOL, OASIS PLUS, OASIS SÉLECTION, OASIS COLLECTION PREMIUM and OASIS PREMIUM COLLECTION while since 2007 Lassonde has introduced OASIS FRUITZOO fruit juices and since 2008 OASIS COLLECTION NATURE/ OASIS NATURE'S COLLECTION fruit juices. As of the date of execution of her affidavit (February 26, 2009) the list of trade-marks used are:

OASIS CLASSIQUE/OASIS CLASSIC for fruit and vegetable juices;  
OASIS FRUITZOO for fruit juices with added minerals;  
OASIS for fruit juices;  
OASIS COLLECTION NATURE/ OASIS NATURE'S COLLECTION for refrigerated mixed fruit juices;  
OASIS PAUSE SANTÉ/ OASIS HEALTH BREAK for refrigerated fruit juices;  
OASIS PREMIUM for orange and apple refrigerated juices;  
OASIS SORBET PREMIUM for fruit sorbets;  
OASIS for spring water;  
TROPICAL OASIS offered only for food services such as hotels, restaurants and institutions which include frozen mixes for alcoholic and non-alcoholic beverages.

[29] The wares bearing one of the OASIS trade-marks are sold to Canadian consumers in supermarkets, convenience stores, drug stores, discount stores, warehouse type stores and home delivery, through food services such as in schools, airline companies, hotels, hospitals and restaurants. Lassonde also sells those products to distributors in Canada that resell them to retail stores of the various types mentioned above. To evidence the sale of products manufactured and sold in association with the OASIS trade-marks Ms. Nasseri filed invoices from 1967 to 2008 as exhibit NN-3 to her affidavit. She filed as exhibit

NN-8 Industries' annual reports from 1998 to 2005 inclusive. She states that the annual sales in Canada of products bearing the OASIS trade-marks have been in excess of:

120 million in 2005;  
170 million in 2007; and  
210 million in 2008.

She provides the Opponent's market share for juices in the Province of Quebec and in Canada for the years 2007 (39.8% in Quebec) and 2008 (46.3% in Quebec).

[30] Ms. Nasseri states that the OASIS trade-marks have been advertised for many years on radio, television, in newspapers and magazines, on Internet, during special events and by way of sponsorships and contests across Canada. Lassonde has spent over \$1.4 million in 2006, more than \$200,000 in 2007 and over \$1.3 million in 2008 to promote the OASIS trade-marks. She filed as exhibit NN-4 examples of promotional material such as: flyers and discount coupons distributed between 2003 and 2008. Samples of advertisements published in 2008 to promote the OASIS trade-marks in Canadian magazines such as *Chatelaine*, *Style Art Home*, *Canadian Living*, *Canadian House & Home*, *Today's Parent* were filed as exhibit NN-5. More than 9 million rebate coupons were distributed.

[31] There were advertising campaigns on various English specialized channels such as Bravo, Food Channel, Showcase and on conventional networks such as CBC, Global and CTV. Ms. Nessari filed a CDROM containing samples of those TV commercials. During the summer of 2008 there was a publicity campaign in Western Canada on billboards in Calgary, Edmonton and Vancouver.

[32] As examples of sponsorship activities, Ms. Nasseri cites the Vancouver Sun Run during which in April 2008 more than 52,000 samples of OASIS juice and more than 10,000 discount coupons were distributed. Similar activities were held during the Montreal OASIS Marathon in September 2008, Sporting Life TORONTO in May 2008, Scotia Bank Waterfront Run Toronto in September 2008 and ZOORun Toronto in October 2008. There is also the sponsorship of 4 tradeshow such as Toronto Metro Home Show in January 2008, Vancouver Wellness Show in February 2008, Toronto Life

Fest in April 2008 and the Calgary Women's Show in February 2008. It also sponsored Fêtes de la Nouvelle-France in Quebec City in August 2008.

[33] Ms. Nasserri lists the prizes won by the various products bearing one of the OASIS trade-marks since 1996. She filed extracts of articles published in newspapers and magazines referring to the prizes awarded to products bearing those trade-marks. She filed copies of articles published since March 1979 in newspapers and magazines about the various products bearing one of the OASIS trade-marks.

[34] From this evidence I have no difficulty in concluding that the Opponent's OASIS trade-mark is well-known in the Province of Quebec and is known to some extent in the rest of Canada. However such acquired distinctiveness is limited to fruit juices. It is known to a lesser extent when used in association with sorbets and spring water. Overall this factor clearly favors the Opponent.

*The length of time the trade-marks have been in use*

[35] From the evidence detailed above, this factor also clearly favors the Opponent.

*The nature of the wares and their channels of trade*

[36] It is not surprising that this factor has been the focus of attention of both parties in view of the fact that the trade-marks in issue are identical. The Applicant's Wares can be described in general terms as hygienic mouth and dental care products. Therefore the Applicant argues that there is no connection between the Wares and the Opponent's products, namely fruit juices, sorbets and spring water, which would fall in the general category of food and beverage products.

[37] The Opponent asserts that the evidence shows, through the affidavit of Ms. Chabot, an articling student with the Opponent's agent firm at the time of execution of her affidavit, that mouthwash and fruit juices are sold in supermarkets and pharmacies and sometimes in close proximity to one another. In fact Ms. Chabot states that on October 26, 2009 she visited a METRO supermarket in Town of Mount Royal, Quebec in order to locate mouthwash and food products. She took pictures of various aisles. She

also visited a UNIPRIX pharmacy in Montreal in order to locate mouthwash and food products. She also took pictures of various aisles. One of the pictures shows that the mouth wash sold under the trade-mark LISTERINE is displayed in close proximity to juices being offered for sale. She also visited a PROVIGO supermarket in Montreal, Quebec in order to locate mouthwash and food products. She took pictures of various aisles.

[38] It would appear from this evidence that pharmacies and supermarkets, at least in the Province of Quebec, do offer for sale to their customers fruit juices and mouthwash.

[39] Comparing the nature of the parties' wares, they are different. The Opponent sells juices and the application covers hygienic mouth and dental care products. This factor favours the Applicant.

[40] As for the channels of trade I have before me evidence that mouthwash is offered for sale in supermarkets while juices are sold as well in pharmacies. There would appear to be some overlap in the parties' respective channels of trade.

*Degree of resemblance*

[41] The marks are identical.

*Additional surrounding circumstances*

[42] The Opponent argues that its trade-mark OASIS should benefit from a wider ambit of protection as it is a well known trade-mark. As stated above I consider the trade-mark OASIS to be well known in the province of Quebec as it holds 46.3% of the market share of juices. Section 6(2) of the Act makes reference to the use of a trade-mark "in the same area". Thus if the use of the Mark is likely to cause confusion in the province of Quebec it would be sufficient to refuse the application for the registration of the Mark. On the territorial issue, I refer to *Masterpiece, supra*. The Supreme Court clearly stated "that the test for confusion is based upon the hypothetical assumption that both trade names and trade-marks are used "in the same area", irrespective of whether this is the case" (at par. 30).

[43] Another important factor to take into consideration when determining if a well known trade-mark should be entitled to wider scope of protection is if the Opponent's trade-mark is clearly product specific or if it has been used in connection with a diversity of wares and services [see *Mattel, Inc., supra*]. The comments made by the Supreme Court in *Mattel* were in the context of famous trade-marks (BARBIE, VIRGIN, APPLE). Certainly the trade-mark OASIS, even in the province of Quebec has not reached that status. However these remarks can serve as a guideline when assessing the scope of protection which could be given to a well known trade-mark.

[44] The evidence shows that there is on the market citrus flavour mouthwash. The Opponent argues that therefore the gap between its juices and mouthwash is reduced. Consequently, a consumer familiar with the Opponent's fruit juices sold in association with the trade-mark OASIS, who sees mouthwash being offered for sale in association with the Mark, is likely to assume that such product originates from the Opponent. The latter contends that the fact that both types of products are offered for sale in the province of Quebec in pharmacies and supermarkets reinforced such conclusion.

[45] I have taken into consideration the case law cited by the parties. The determination of these cases is facts driven. In some instances cited by the Applicant the main factor was the lack of resemblance between the marks in issue.

[46] The Opponent is also arguing that it owns a family of OASIS trade-marks and as such the trade-mark OASIS should benefit from a wider ambit of protection. At the outset I mentioned to the parties that it appeared to me that the evidence filed established a family of OASIS trade-marks. At the hearing it was pointed out to me that my colleague P. Heidi Sprung in *Industries Lassonde Inc. v. Philip Morris Products S.A.* [2010] TMOB 48 (CanLII) was not convinced that the Opponent had established a family of OASIS marks. Obviously such conclusion is linked to the evidence filed. Therefore it is difficult to import from that decision a conclusion based on the evidence in that file. In any event without making a definite conclusion that the Opponent has proven the existence of a family of OASIS trade-marks I refer to the comments made by my colleague P. Heidi Sprung in *Industries Lassonde Inc., supra* where she stated that it

would appear that the concept of family of trade-marks applies when the wares of the applicant are closely related products [see *Manufacturiers de Bas de Nylon Doris Ltee v. Warnaco Inc.* (2004), 38 C.P.R. (4<sup>th</sup>) 519 (F.C.T.D.)]. In our situation we do not have this close relationship between the Wares and fruit juices.

[47] There is no evidence that the Opponent has expanded the use of its registered trade-marks to other products, except for sorbet and spring water.

[48] I disagree with the Opponent that there exists, on a balance of probabilities, a likelihood that a consumer, familiar with the Opponent's fruit juices sold in association with the trade-mark OASIS, will think that any of the Wares and especially mouthwash sold in association with the Mark originates from the Opponent. I reach this conclusion on the basis of the following facts: the parties' wares are unrelated. We have juice and hygienic mouth and dental care products. The fact that juices and mouthwashes, for example as it is the best case scenario for the Opponent, could be found in grocery stores and pharmacies in Quebec is not sufficient to outweigh the distinction in the nature of the wares. I note that in cases such as *Edelweiss Food Products Inc. v. World's Finest Chocolate Canada Ltd.* (2000), 5 C.P.R. (4<sup>th</sup>) 256 where the products in issue were meat and chocolate, two food products sold in supermarkets, the Registrar concluded that they were intrinsically different. A similar conclusion was reached in *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3<sup>d</sup>) 483 (fruit cake and barbecue sauce).

[49] I am not prepared to make the leap proposed by the Opponent namely that, because of the fame of its trade-mark OASIS, the Registrar should refuse the registration of the Mark in association with the Wares.

[50] I conclude that the Applicant has discharged its onus to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark OASIS. Consequently the second ground of opposition is also dismissed.

### Entitlement and distinctiveness grounds of opposition

[51] Under the ground of opposition of entitlement the Opponent has the initial burden to prove that it had used its trade-mark OASIS prior to the filing date of the application and that it had not abandoned such use at the advertisement date [see s. 16(3) and (5) of the Act]. In so far as the lack of distinctiveness of the Mark is concerned, the Opponent has the initial evidential burden to prove that its trade-mark OASIS had become sufficiently known at the filing date of the statement of opposition, to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted at the relevant date to distinguish or actually distinguished throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[52] The Opponent's evidence of use of the trade-mark OASIS described under the previous ground of opposition is sufficient to conclude that the Opponent has met its initial burden of proof with respect to these two additional grounds of opposition. Consequently the burden shifts on the Applicant that has to prove, on a balance of probabilities, that the Mark was not confusing with the Opponent's trade-mark OASIS and was apt to distinguish the Wares from the Opponent's wares at the relevant dates.

[53] The only difference between the registrability ground of opposition based on s. 12(1)(d) on one hand and entitlement based on s. 16(3)(a) of the Act and distinctiveness of the Mark based on s. 2 of the Act on the other hand, is that the analysis of the surrounding circumstances listed under s. 6(5) of the Act would be done at earlier relevant dates identified above. Those earlier dates would not have an impact on my analysis of the relevant surrounding circumstances done under the registrability ground of opposition.

[54] Consequently those grounds of opposition are dismissed.



Disposition

[55] 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.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office