



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

Citation: 2011 TMOB 83
Date of Decision: 2011-05-31

**IN THE MATTER OF AN
OPPOSITION by Canada Safeway
Limited to application No. 1,360,632
for the trade-mark OM ORGANICS
& Design in the name of Meadowfresh
Dairy Corporation**

[1] On August 22, 2007, Meadowfresh Dairy Corporation (the Applicant) filed an application to register the trade-mark OM ORGANICS & Design (the Mark) based on proposed use in Canada. The Mark, shown below, has been applied for in association with the following wares (the Wares):

- (1) Dairy products.
- (2) Non-alcoholic beverages, namely, yogurt-based drinks, soy-based drinks, dairy-based drinks, fruit-based drinks, vegetable-based drinks, energy drinks, tea-based drinks, coffee-based drinks, chocolate-based drinks, cocoa-based drinks, fruit juices, vegetable juices, teas, coffees, and drinking water.
- (3) Fresh and frozen prepared foods and meals, namely fresh and frozen fruits, fresh and frozen vegetables, fresh and frozen cheeses, fresh and frozen dairy products, fresh and frozen cooked and uncooked meats, namely, chicken, turkey, pork, beef, and lamb, fresh and frozen cooked and uncooked seafood, fresh and frozen stews and casseroles, fresh and frozen prepared meals, fresh and frozen soups, and fresh and frozen salads.
- (4) Dry pre-packaged foods namely, mixes for brownies, cakes, cookies, scones, puddings, pancakes, waffles and soups; noodles; pasta; and rice.
- (5) Desserts, namely, cakes, pies, pastries, cookies, brownies and puddings; confections, namely almond, chocolate, frozen, gum, peanut, and sugar confections; and snack foods, namely, cereal-based, corn-based, fruit-based, granola-based, rice-based, and wheat-based snacks.



[2] The subject Application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 1, 2008 and was opposed by Canada Safeway Limited on December 9, 2008. The Registrar forwarded a copy of the statement of opposition to the Applicant on January 20, 2009, as required by s. 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[3] The grounds of opposition can be summarized as follows:

- Pursuant to s. 38(2)(a) of the Act, the application does not conform to the requirements of s. 30(b), 30(e) and 30(i) of the Act, in that the Applicant did not indicate a date of first use if the Mark has been used in association with each of the Wares (s. 30(b)), did not intend to use the Mark in association with each of the Wares (s.30(e)), and could not have been satisfied that it was entitled to use the Mark in view of the Applicant's knowledge of the Opponent's prior use and prior rights in respect of the Opponent's confusingly similar trade-marks (s.30(i));
- Pursuant to s. 38(2)(b) of the Act, the Mark is not registrable pursuant to s. 12(1)(d) of the Act since it is confusingly similar with the Opponent's trade-mark registration TMA 674,881 for O ORGANICS & Design;
- Pursuant to s. 38(2)(c) of the Act, the Applicant is not the person entitled to registration in view of s. 16(3)(a) of the Act, since at the relevant date, the Mark was confusing with the Opponent's trade-marks O ORGANICS & Design and O ORGANICS, which had previously been used in Canada; in view of s. 16(3)(b) of the Act, at the relevant date, the Mark was confusing with trade-mark applications O ORGANICS and O ORGANICS & Design covered by application No. 1,352,600

and No. 1,355,683 respectively, having been previously filed in Canada and pending as of the date of the instant application; and

- Pursuant to s. 38(2)(d) of the Act, the Mark is not distinctive within the meaning of s. 2 of the Act, more specifically the Mark is confusing with the Opponent's trade-marks as previously identified.

[4] The Applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[5] The Opponent filed the affidavit of Ted Middleton, sworn May 29, 2009, and the affidavit of Susan Burkhardt, sworn June 2, 2009. The Applicant filed the affidavit of Rahim Z. Talib, sworn September 30, 2009.

[6] Only the Opponent filed a written argument. An oral hearing was not requested in this matter.

Onus and Material Dates

[7] 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 evidentiary 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].

[8] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3) - the filing date of the application, namely August 22, 2007;

- s. 38(2)(d)/s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Opponent's Evidence

Affidavit of Susan Burkhardt

[9] Ms. Susan Burkhardt is a law clerk at the Opponent's law firm; she provides details of her access to the electronic database of the Canadian Intellectual Property Office (CIPO) and attaches copies of particulars with respect to the registrations and applications set out below for which the Opponent is the owner/applicant.

[10] The O ORGANICS & Design trade-mark No.TMA674,881, shown below, was registered on October 13, 2006 for the wares:

Organic foods and beverages, namely, bread, frozen fruits, frozen vegetables, macaroni and cheese, maple syrup, peanut butter, salad dressing, juice, canned beans, eggs, pasta sauce, frozen entrees, frozen chicken.



[11] The same trade-mark was filed on July 16, 2007 under application No. 1,355,683, for the following wares:

(1) Organic foods and beverages, namely, jams, marmalade, ketchup, mustard, olive oil, vinegar, tea, broth, pasta, soy milk, dairy products, spices, fresh vegetables, apple sauce.

(2) Organic foods and beverages, namely, flour, sugar, edible nuts, salsa, baby formulas, baby food, baby cereal, cookies, breakfast cereal.

[12] The affiant provided details of the Opponent's application No. 1,352,600, for O ORGANICS filed on June 21, 2007 for the following wares:

(1) Organic foods and beverages, namely, bread, frozen fruits, frozen vegetables, macaroni and cheese, maple syrup, peanut butter, salad dressing, juice, canned beans, eggs, pasta sauce, frozen entrees, frozen chicken.

(2) Organic foods and beverages, namely, jams, marmalade, ketchup, mustard, olive oil, vinegar, tea, broth, pasta, soy milk, dairy products, spices, fresh vegetables, apple sauce.

(3) Organic foods and beverages, namely, flour, sugar, edible nuts, salsa, baby formulas, baby food, baby cereal, cookies, breakfast cereal.

[13] Ms. Burkhardt also attaches details of application Nos. 1,391,797 and 1,391,920 for the trade-marks O ORGANICS FOR BABY & Design and O ORGANICS FOR TODDLER & Design which were filed by the Opponent on April 17 and 18, 2008 respectively. The respective statements of wares are reproduced below:

(Application No. 1,391,797) Snack food, namely, crackers, cereal-based bars, fruit-based bars, fruit based snacks; apple sauce; cookies; baby food; baby formula; rice cereal; fruit juices and drinks..

(Application No. 1,391,920) Snack food, namely, crackers, fruit-based bars, fruit based snacks; cookies.

[14] I note that although Ms. Burkhardt provided these particulars, none of the grounds of opposition specifically refer to these two applications, which were filed subsequent to the subject Application.

Affidavit of Ted Middleton

[15] Mr. Middleton is the Director of Consumer Brands of Canada Safeway Limited - the Opponent. He provides that the Opponent operates 215 supermarket retail locations in the provinces of Alberta, British Columbia, Manitoba, Ontario and Saskatchewan; the location and address of each store is provided. He further provides that the Opponent also operates several manufacturing and food processing facilities in Western Canada and that the Opponent has been in continuous operation since 1929.

[16] The affiant states that in the normal course of trade, products bearing the Opponent's trade-marks (that I shall refer to herein as the O ORGANICS trade-mark) are manufactured and packaged by Lucerne Foods. Lucerne Foods was formerly a separate entity but is currently an operating unit within the Opponent; Mr. Middleton states that "at all times

Canada Safeway has had direct or indirect control over the character and quality of the O ORGANICS Branded Products.”

[17] It appears that the O ORGANICS trade-mark is presently in use on a wide variety of products. The affiant lists more than 160 products and the dates of commencement of use range from February 2006 to April 27, 2009. Also provided is the statement that “[a]ll of these products have been sold and most are currently available in all of Canada Safeway’s supermarkets, and all feature the O ORGANICS Trade-marks.” I note that the various product lines tend to correspond with the statement of wares for the Opponent’s trade-marks; representative labels for most product lines are also attached, all of which feature the design trade-mark as depicted in TMA674,881; some of the labels also include product descriptions which commence with the trade-mark “O Organics” (stylized “O” and “Organics”- capitalized but followed by lower case letters) without any design features.

[18] Sales of O ORGANICS products in Canada totaled 15M in 2006, 39M in 2007, 49M in 2008 and 16M for the relevant part of 2009 (January to May). Mr. Middleton also provides a partial breakdown of the figures for 2008: beverages account for over 2M, fresh and frozen prepared foods account for over 28M, pre-packaged foods and pasta account for over 2.7M, desserts and snack foods account for over 800K and dairy products (including yogurt and cheese) account for over 1.5M.

[19] Mr. Middleton states that the Opponent actively promotes and advertises the products in association with its O ORGANICS trade-mark through in-store, print and online advertising. In-store advertising has taken place by way of feature signs, shelf-talkers and till signs that bore the Opponents trade-mark(s) in prominence. A variety of representative signs are provided as exhibits. Coupons are frequently distributed, samples of coupons bearing the Opponent’s trade-mark are also provided. Print advertising takes place by way of weekly flyers featuring a variety of products including products bearing the Opponent’s trade-mark; sample flyers are attached dated May 2006, March 2007, September 2008, January, February, March and April 2009, each of which appears to include at least one such product. Mr. Middleton provides that the Opponent’s flyers contain the same content across all of

Canada; between 3.3M and 3.5M advertising flyers are distributed weekly either in the supermarkets or by delivery to consumers' homes.

[20] In addition, the Opponent's website, *www.safeway.ca*, features a number of pages devoted to O ORGANICS products, including a product list.

[21] Mr. Middleton states that a newsletter named "Shelf Talk" produced by Safeway's Consumer Brands Department is distributed to over 30,000 employees providing information regarding the Opponent's brands. These products have been featured in various issues of the newsletter; an example is provided of the newsletter that coincided with the launch of the O ORGANICS products in March 2006. The affiant also attaches an illustration of a shopping tote bag bearing the O ORGANICS trade-mark; sales for the tote bags have amounted to over 900K since 2007.

[22] Since at least as early as December 2006, Canada Safeway has sold dairy products (yogurt and cheese) in Canada in association with the O ORGANICS trade-mark. Attached as Exhibit E is a copy of the packaging of yogurt which is stated to be representative of how the Opponent's trade-mark appears in association with yogurt and cheese. I note that the packaging shows the design trade-mark (TMA674,881) but in colour. The large O is on a background band of bright green and orange that encircles the yogurt container; below is the word ORGANICS in white print on a thin small black band that encircles the container. This is another example where there is a paragraph of product information on the side of the container, which is entitled "Organic from the Source" and which begins with "O Organics yogourt is made in..." .

[23] The other sample labels, referred to above in paragraph [17] show use of the Opponent's trade-mark in a similar manner, a large O on a green and orange background band of colour of varying lengths depending on the type of packaging, with the word "ORGANICS" appearing under it. I note that there is a TM symbol beside the large O. When the word form of the trade-mark is used in descriptive material, as in the example set out above, the O is in italics and bold font, and Organics is in the same font and size as the rest of the paragraph.

Applicant's Evidence

Affidavit of Rahim Z. Talib

[24] Rahim Z. Talib identifies himself as the President and Chief Executive Officer for the Applicant. The Applicant is a full service dairy that processes, packages and distributes a range of dairy products, including milk, cream, whipping cream, butter, sour cream, cream cheese, cottage cheese and yogurt in Canada; it has been in operation for over 15 years.

[25] The Applicant is the owner of the registered trade-mark OM NATURAL & Design (TMA734,957) reproduced below, which was registered on February 23, 2009 with respect to wares identical to those listed above. The affiant provides sample labels, product invoices, and pages from the website, *www.omnaturalproducts.com*, that relate to yogurt-based drinks that have been sold in Canada since September 2007.



[26] Mr. Talib provides annual Canadian sales data for 2007 to 2009 that total \$12,298 for 2007, \$28,160 for 2008 and \$3,035 for 2009 (to September 30). The Applicant spent approximately \$131,476 in 2007 and approximately \$33,043 in 2008 in marketing goods bearing the OM NATURAL & Design trade-mark. The affiant states that the Applicant has devoted extensive resources and time to conduct market research and promotional activities for the goods bearing the OM NATURAL & Design trade-mark; focus groups, product sampling and demonstration programs in grocery stores in Canada have been conducted since September 2007. Promotional T-shirts bearing the OM NATURAL & Design were distributed at the product samplings, and a photograph of such a T-shirt is attached as Exhibit D. OM NATURAL & Design products are promoted online at the

www.omnaturalproducts.com website; this website is accessible in Canada and has been in operation since July 2007. Use of this website has been continuous and continues to date.

[27] The Applicant has also promoted its goods bearing the OM NATURAL & Design trade-mark at Western Canada's largest hospitality trade-show for three consecutive years beginning in 2007.

[28] Mr. Talib's affidavit states that the line of products that would bear the Mark would be a natural extension of the "OM brand", stating that the Mark has not yet been used in Canada with respect to the Wares. The Applicant had not (at that time) obtained an allotment of organic milk from the British Columbia Marketing Board, which according to Mr. Talib was the key to the launching of the new trade-mark.

[29] Mr. Talib states that he is not aware of any instances where the applicant has been approached by a consumer who has confused the Applicant's products bearing the mark OM NATURAL & Design with the Opponent's trade-mark.

Analysis of Grounds of Opposition

Section 38(2)(a)

[30] As set out above, the Opponent alleged that the application does not conform to the requirements of s. 30(b), 30(e) and 30(i) of the Act; however, no facts were advanced in support of any these grounds.

[31] The Opponent has not met its burden under s. 30(b) since the Application is based on proposed use; this ground is therefore dismissed.

[32] 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.)].

[33] In the present case, there is nothing in the Applicant's evidence which is clearly inconsistent with the claim that it intends to use the Mark in association with the applied for wares. Although the affiant explains that it is waiting for an allotment of organic milk prior to launching its products in association with the Mark, Mr. Talib makes no statements to indicate that the Applicant plans to use the Mark only on milk, or dairy products. The Applicant is clearly a commercially viable business whose activities might well entail expansion of its product lines. I therefore find that the evidence, on its face, is not inconsistent with the Applicant's claim that it intends to use the Mark in Canada in association with the applied for wares. Accordingly, the s. 30(e) ground is dismissed.

[34] 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 38(2)(b)/ Section 12(1)(d)

[35] The remaining grounds of opposition, namely, s. 12(1)(d), s.16(3) non-entitlement and s.2 non-distinctiveness, all revolve around the issue of the likelihood of confusion pursuant to s.6(5). I will deal with this issue as it applies to s. 12(1)(d), since this is the Opponent's strongest case given the later material date (the date of this decision).

[36] The Opponent alleges that the Mark is confusing with trade-mark registration No. TMA674,881 for O ORGANICS & Design as shown above. The Opponent has satisfied its initial burden under this ground as its registration is in good standing. The burden of proof therefore now lies with the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's trade-mark.

[37] 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.

[38] The weighing of the factors will vary depending on the unique facts of each case; these enumerated factors need not be attributed equal weight; the list of factors set out is not exhaustive of matters that could be considered. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) [*Mattel*]; *United Artists Corp. v. Pink Panther Beauty Corp.* (1988), 80 C.P.R. (3d) 247 (Fed. C.A.) at 263-264; *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée.* (2006), 49 C.P.R. (4th) 401 (S.C.C.)]

[39] The test for confusion is one of first impression and imperfect recollection. 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. The purchaser in mind is described as the casual consumer somewhat in a hurry (*Mattel* at para. 58). The question is whether this mythical consumer with a vague recollection of the first mark will, on seeing the second comer's mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares bearing the first mark (*United States Polo Assn. v. Polo Ralph Lauren Corp.*, [2000] 9. C.P.R. (4th) 51 (F.C.A.) at 58).

[40] 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, (F.C.T.D.), aff'd (1982), 60 C.P.R. (2d) 70 (F.C.A.)]. I will therefore commence with the consideration of this factor, as this will influence the need for analysis under the other factors.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[41] 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 trade-mark that may have a determinative influence on the public’s perception of it [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. In approaching the analysis of the resemblance of the trade-marks at issue, it is therefore important to consider whether there is an aspect of the trade-mark that is particularly unique.

[42] In the present case, the trade-marks at issue are clearly not visually identical; and the Mark does contain certain unique elements. It consists of a uniquely shaped design with a solid background, and below the word ORGANICS and the stylized word “Om” are distinctive design elements that appear to be characters in an Indic script. In contrast, the Opponent’s trade-mark as depicted in the registration consists of a stylized upper case “O”, a descriptive word, background shading and a line design. In other words, I do not find, overall, that the Opponent’s trade-mark has any of the Mark’s particularly striking or unique elements.

[43] When sounded, the trade-marks are similar, since the common element is the word “organics” preceded by either an “O” or “Om”. However, I do not consider that this similarity would have a determinative influence on the public perception of the trade-marks. Firstly, I find it self-evident that ORGANICS is descriptive in relation to food products, and thus the word portions are weak. Secondly, the ideas suggested by the word portions as a whole are different in that the inclusion of “Om” in the Mark suggests a meditative, religious context. In this regard I observe that dictionary definitions of “Om” indicate that it is a mantra associated with Buddhism and Hinduism; *Om*” is defined in various dictionaries as follows:

- *Miriam-Webster Dictionary Online* - “a mantra consisting of the sound ōm and used in contemplation of ultimate reality”; Origin - *Sanskrit First Known Use: 1788*.
- *Canadian Oxford Dictionary* - “a mystic syllable used as a mantra and at the beginning and end of prayers etc.”
- *Concise Oxford Dictionary* - “in Hinduism & Tibetan Buddhism a mystic syllable, considered the most sacred mantra.”

[44] In view of the foregoing, I have determined that while the trade-marks at issue certainly have some similarities in sound, on balance, this factor favours the Applicant as the differences in appearance and in ideas suggested would have a determinative influence on the public's perception of the trade-marks.

[45] Having made this determination, I turn briefly to the remaining factors, which I would observe at the outset, do not, in the circumstances of this case, outweigh the differences between the two trade-marks in appearance and idea suggested.

6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[46] As noted above, the Mark includes unique design elements and the word “om”; as a result, I find it to have a significant degree of inherent distinctiveness. In contrast, the Opponent's trade-mark has little inherent distinctiveness as the word portions are descriptive, (O is the first letter of the word “Organic” and as such a suggestive reference to the wares being organic); I find the background line and shading to be of less visual interest. Overall, in considering each trade-mark as whole, I find that the Mark has more inherent distinctiveness than the Opponent's trade-mark.

[47] As the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I will now turn to the extent to which the trade-marks have become known in Canada.

[48] With respect to the distinctiveness acquired through use of the marks at issue, it is clear that the Opponent has used its trade-mark in Canada to a much greater extent than has the Applicant. On balance, taking into consideration that the Mark is significantly more inherently distinctive, but that the Opponent's trade-mark has acquired distinctiveness through use, I do not find that the analysis under this factor significantly favours one party over another; neither do I find that it outweighs the determination made under s. (6)(5)(e).

6(5)(b) – the length of time each trade-mark has been in use

[49] The Opponent's trade-mark has been in use since February 2006; the Applicant has not commenced use of its Mark, As a result, I find that this factor favours the Opponent; however, given the differences between the trade-marks I do not find that it outweighs the determination under s. (6)(5)(e).

6(5)(c) and (d) – the nature of the wares and trade

[50] With respect to the nature of the wares, I note that the Opponent's trade-mark registration is in association with a variety of food products, as is the subject application. Some of the products are clearly overlapping in nature. Further, both parties are in the business of selling foods through retail grocery store outlets, and I find it reasonable to assume that the Applicant would continue to do so with its sales under this Mark. However, the Opponent has stated that it sells exclusively through its own retail stores. Nonetheless, there is still some degree of overlap in the wares and in the trade, although I do not find that it outweighs the determination made under s. 6(5)(e).

Additional Surrounding Circumstances

[51] As an additional surrounding circumstance, I have given regard to the existence and use of the Applicant's trade-mark OM NATURAL & Design, since it incorporates what I find to be the unique, or striking, distinctive elements of the applied for Mark. As noted above, the design elements and the word OM are inherently distinctive, and since they have been in use since September 2007, I find it reasonable to infer that the overall look and design of the Mark would have acquired some degree of additional distinctiveness as a result.

[52] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' wares.

Section 38(2)(c) Non-entitlement

[53] 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 trade-marks O ORGANICS and O ORGANICS & Design previously used in Canada, as well

as with its trade-mark application Nos. 1,352,600 (O ORGANICS) and 1,355,683 (O ORGANICS & Design) both of which were previously filed in Canada and pending at the date of advertisement of the Mark. Any other trade-mark applications referred to in the Opponent's pleadings and evidence are not under consideration as they were filed after the filing date of the subject Application.

[54] The Opponent has met its burden under s. 16(3)(a), as it has established use of both trade-marks as at the filing date of the Application; its burden under s. 16(3)(b) has also been met, as these applications were filed prior to the Application, and were still pending as at the date of advertisement of the Mark. 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 either of the Opponent's O ORGANICS trade-marks (i.e. with or without the design). As a result, the grounds of opposition pleaded under s. 16(3)(a) and s. 16(3)(b) are dismissed.

Section 38(2)(d) Non-distinctiveness

[55] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. As outlined above, the Opponent has established use of the O ORGANICS trade-marks from which it can be inferred that some distinctiveness has been acquired; however, in view of the determination of lack of confusion (the difference in material date having no effect on this finding), I find that as of the material date the Opponent's use did not negate the inherent distinctiveness of the applied for Mark.

[56] This finding also applies to those applications that post-date the Applicant's filing date (O ORGANICS FOR BABY & Design and O ORGANICS FOR TODDLER & Design) for which some minimal use has been shown, since clearly there is less likelihood of confusion with those trade-marks due to the additional material therein.

[57] This ground is therefore also dismissed.

[58] In view of all of the foregoing, and 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