
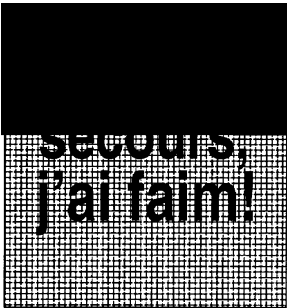

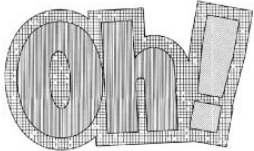


**IN THE MATTER OF AN OPPOSITION
by Hershey Canada Inc. to application No.
858,184 for the trade-mark OH CANADA
filed by Michael Barnett**

On October 8, 1997, the applicant, Michael Barnett, filed an application to register the trade-mark OH CANADA for “chocolate bars and candy” based on proposed use in Canada. The application was amended to include a disclaimer to the word CANADA and was subsequently advertised for opposition purposes on September 23, 1998.

The opponent, Hershey Canada Inc., filed a statement of opposition on February 22, 1999, a copy of which was forwarded to the applicant on March 24, 1999. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks owned by the opponent:

<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Wares/Services</u>
	466,130	Advertising services in conjunction with the sale of candy.
OH HUNGRY? OH	483,528	Candy.

HENRY!		
	440,152	Advertising services in conjunction with the sale of candy.
OH! J'AI FAIM.	447,453	Advertising services in conjunction with the sale of candy.
	447,827	Advertising services in conjunction with the sale of candy.
OH SECOURS, J'AI FAIM!	439,924	Advertising services in conjunction with the sale of candy.
OH! J'AI FAIM.	483,664	Candy.
	479,699	Marketing, promotion and advertising services in conjunction with the sale of candy.
OH HUNGRY?	501,487	Candy. Marketing, promotion and advertising services in conjunction with the sale of candy.
OH HENRY!	TMDA038673	Confectionery. Ice cream products, namely ice cream bars and bulk ice cream. Milk shakes.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date,

the applied for trade-mark was confusing with the registered trade-marks listed above previously used in Canada by the opponent. The third ground is that the applied for trade-mark is not distinctive because it is confusing with the trade-marks listed above used by the opponent in Canada.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its Brands Manager of Marketing, Brenda Yatabe. Ms. Yatabe was cross-examined on her affidavit and the transcript of that cross-examination forms part of the record of this proceeding. The opponent was subsequently granted leave to submit an affidavit of Ruth Palazzolo which serves simply to provide a certified copy of the opponent's registration No. TMDA038673 for the trade-mark OH HENRY! The applicant chose not to submit evidence. Only the opponent filed a written argument and an oral hearing was conducted at which both parties were represented.

At the oral hearing, the opponent's agent submitted the replies to undertakings given during the Yatabe cross-examination. Those replies had not been previously submitted by the applicant. However, since the applicant did not object, I admitted those replies as part of the evidence of record in this case.

The Evidence

The Yatabe affidavit details an extensive advertising and promotional campaign conducted by the opponent in relation to its candy bar product sold under the trade-mark

OH HENRY! Ms. Yatabe provides numerous examples of advertising materials used from 1994 on which include the trade-mark **OH HENRY!** and a number of variations employing the component **OH** such as **OH HUNGRY?**, **OH SECOURS**, **J'AI FAIM!** and **OH! J'AI FAIM**. As revealed during the cross-examination of Ms. Yatabe on her affidavit, a number of these variations were used simply in the advertising of the opponent's **OH HENRY!** product. The evidence therefore does not support the use of these variations as trade-marks in association with advertising services performed for others.

Ms. Yatabe states that, since January 17, 1994, her company spent in excess of \$8 million in its so-called **OH** advertising campaign. On cross-examination, she was asked to provide an annual breakdown of those expenditures for the period 1994 to 1999 which revealed that the total expenses were actually in excess of \$12 million (see Ms. Yatabe's reply to the undertaking given in respect of question 300). Although Ms. Yatabe did not provide Canadian sales figures for the actual **OH HENRY!** candy bar, in the absence of cross-examination specifically on point, I am prepared to assume that such sales have been significant since 1994 given the extensive advertising expenditures.

The advertising activities evidenced by Ms. Yatabe are extensive and broad ranging. The opponent has engaged in television advertising, outdoor advertising, bus shelter advertising, exterior bus advertising and on-campus advertising at Canadian universities. As part of its **OH** advertising campaign, the opponent also advertised in conjunction with Toronto Maple Leafs hockey games during the period 1995 to 1998. Billboards and posters bore the trade-mark **OH HENRY!** in association with various **OH**-based hockey-related

phrases such as G'Oh Leafs G'Oh!, Oh'pen Net!, P'Ohke Check and Oh Canada.

The Grounds of Opposition

As for the first ground of opposition, I will first consider the issue of confusion with the opponent's registration No. TMDA038673 for the trade-mark OH HENRY! for 'inter alia' "confectionery." The material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's trade-mark OH CANADA is inherently distinctive in relation to "chocolate bars and candy." However, the component CANADA is inherently weak when used with any product in Canada, that fact having effectively been recognized by the applicant by including a disclaimer to that word in his application. Thus, the applicant's mark is not inherently strong. There being no evidence from the applicant, I must conclude that his mark has not become known at all in Canada.

The opponent's registered mark OH HENRY! is inherently distinctive since it has no

suggestive connotations when used in association with confectionery or candy bars. As noted, the opponent did not provide sales figures for its OH HENRY! product. However, given the extensive expenditures made on the opponent's OH advertising campaign, I am prepared to conclude that there have been very extensive sales of its OH HENRY! product in Canada since 1994. On that basis, I am able to conclude that the opponent's mark has become very well known in this country.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of the parties are the same and presumably their trades would also be the same.

As for Section 6(5)(e) of the Act, there is some visual and phonetic resemblance between the marks at issue since they both commence with the word OH. The ideas suggested by the marks, however, do differ since the opponent's mark is an exclamation of surprise uttered to someone named Henry whereas the applicant's mark is the phonetic equivalent of our country's national anthem "O Canada."

As an additional surrounding circumstance in this case, I have considered the extensive advertising campaign conducted by the opponent since 1994 centered around the OH component of its trade-mark OH HENRY! Given the numbers involved, most Canadians have likely been exposed to the opponent's campaign and its emphasis on the component OH used in a number of variations and forms. This, in my view, increases the likelihood that consumers seeing another candy bar product with a name beginning with the

word OH would assume some connection with the opponent. The fact that there is no evidence of any other OH-prefixed trade-marks for food products in Canada underscores this conclusion (see also page 58 of the Yatabe transcript).

At the oral hearing, the applicant's agent sought to rely on two official marks apparently referred to during the initial prosecution of the present application. Although the Opposition Board has the discretion to check the records of the Trade-marks Office, that discretion is generally only exercised in the case of a registration or pending application which forms the basis of a ground of opposition: see Royal Appliance Mfg. Co. v. Iona Appliances Inc. (1990), 32 C.P.R.(3d) 525 at 529 (T.M.O.B.). Exercising that discretion in the present case is unjustified and would be prejudicial to the opponent. If the applicant wished to rely on the two official marks, he should have evidenced those marks in the usual manner.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the identity between the wares and trades of the parties, the reputation associated with the opponent's trade-mark, the extensive OH-based advertising campaign and the presence of at least some resemblance between the marks, I find that, on a balance of probabilities, the applicant has not discharged the burden on him to show that the marks at issue are not confusing. In other words, I find that I am left in a state of doubt respecting the issue (i.e. - the probabilities one way or the other are equal) and I must therefore resolve that doubt against the applicant. Insofar as it is based on the opponent's registration No.

TMDA038673, the first ground of opposition is therefore successful and it is unnecessary to consider the other aspects of that ground.

As for the second ground of opposition based on Section 16(3)(a) of the Act, the opponent has shown use of its trade-mark OH HENRY! prior to the applicant's filing date and non-abandonment of that mark as of the applicant's advertisement date. The second ground therefore remains to be decided on the issue of confusion as between the two marks as of the applicant's filing date. Again, the onus is on the applicant to show no reasonable likelihood of confusion.

For the most part, my conclusions respecting the first ground of opposition are applicable to the second ground as well. Thus, I find that, on a balance of probabilities, the applicant has failed to discharge the burden on him to show that the marks are not confusing. Insofar as the second ground of opposition is based on prior use of the trade-mark OH HENRY!, it is therefore successful and it is unnecessary to consider the remaining aspects of that ground.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that his mark is adapted to distinguish or actually distinguishes his 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. - February 22, 1999): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Insofar as the third ground is based on the opponent's trade-mark **OH HENRY!**, it essentially turns on the issue of confusion between that mark and the applicant's mark. Given my conclusions above respecting the first and second grounds, it also follows that, on a balance of probabilities, the applicant has failed to satisfy the onus on him to show that his mark is not confusing with the opponent's trade-mark **OH HENRY!**. Thus, the third ground is also successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 27th DAY OF JANUARY, 2004.

David J. Martin,
Member,
Trade Marks Opposition Board.