

IN THE MATTER OF AN OPPOSITION by A. Lassonde & Fils Inc.  
to application No. 689,200 for the trade-mark NORTHERN OASIS  
filed by Withey's Water Softening & Purification Ltd.

On September 10, 1991, Withey's Water Softening & Purification Ltd. filed an application to register the trade-mark NORTHERN OASIS based on use of the trade-mark in Canada since August, 1989 in association with '*Soft drinks namely; bottled water*' and in association with services identified as the '*operation of a business dealing in bottling of water for others*'.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of July 29, 1992 and the opponent, A. Lassonde & Fils Inc., filed a statement of opposition on August 12, 1992. During the opposition, the opponent was granted leave pursuant to Rule 42 [now Rule 40] of the *Trade-marks Regulations* to amend its statement of opposition. The opponent filed as its evidence the affidavits of Jean Gattuso and Jocelyne Lamontagne while the applicant submitted as its Rule 42(1) evidence the affidavit of Fred Withey. Further, the applicant was granted leave to file as further evidence the affidavits of Stephen Sharp and Don Gowan.

The first ground of opposition set forth in the amended statement of opposition is based on Section 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not be satisfied that it was entitled to use the trade-mark NORTHERN OASIS in Canada in association with the wares and services covered in the present application in that, as of the filing date of the present application, the applicant was aware of the use by the opponent of its OASIS trade-marks in Canada. While the legal burden is upon the applicant to show that its application complies with Section 30(i) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. As no evidence has been filed by the opponent in support of its allegations that the applicant could not have been satisfied that it was entitled to use the trade-mark NORTHERN OASIS in Canada, it has failed to meet the evidential burden upon it in respect of this ground. In any event, and even had the applicant been aware of the opponent's OASIS trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark NORTHERN OASIS in Canada

on the basis *inter alia* that its mark is not confusing with the opponent's OASIS trade-marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at pg. 155].

As its second ground, the opponent alleged that the applicant has not used its trade-mark NORTHERN OASIS in Canada in association with the wares and services covered in the present application. As in the case of the first ground of opposition, there is an initial evidential burden on the opponent in respect of the Section 30(b) ground even though the legal burden is upon the applicant to establish that its application complies with the provisions of Section 30(b) of the *Trade-marks Act*. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Furthermore, the evidential burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act [see *Tune Masters v. Mr. P's Mastertune*, 10 C.P.R.(3d) 84, at p. 89].

No evidence has been furnished by the opponent in support of its allegation that the applicant has not used its trade-mark NORTHERN OASIS in association with the wares and services covered in the present application. Accordingly, the opponent has not met the initial burden upon it in respect of this ground. Moreover, the evidence furnished by way of the Sharp and Gowan affidavits arguably points to use of the trade-mark NORTHERN OASIS in association with bottled water, within the scope of Section 4(1) of the *Trade-marks Act*. As a result, I have dismissed the second ground of opposition.

The third ground is based on Section 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark is not registrable in that the trade-mark NORTHERN OASIS is confusing with the opponent's registered trade-mark OASIS, registration No.139,031, covering '*jus et breuvages de fruits*' and services identified as '*opération d'un établissement de restauration; opération d'un débit de boissons*'. As its fourth ground, the opponent has alleged that the applicant

is not the person entitled to registration of the trade-mark NORTHERN OASIS in that, as of the applicant's claimed date of first use, the applicant's trade-mark was confusing with the opponent's applications for registration of the trade-mark OASIS, serial Nos. 476,028, 511,133 and 279,889. Photocopies of the opponent's registration and pending applications are annexed as exhibits to the Lamontagne affidavit.

The most relevant of these grounds is the Section 16(1)(b) ground which is based on the opponent's pending application for registration of the trade-mark OASIS, application No. 511,133, covering *inter alia* mineral and aerated waters. As Exhibit JL-2 to the Lamontagne affidavit establishes that application No. 511,133 was still pending as of the date of advertisement of the present application, the opponent has met the requirements of Section 16(4) of the *Trade-marks Act* in respect of Section 16(1)(b) ground. Accordingly, the legal burden is upon the applicant to demonstrate that there would be no reasonable likelihood of confusion between its trade-mark NORTHERN OASIS as applied to the wares and services covered in the present application and the opponent's trade-mark OASIS as applied to mineral and aerated waters as of August 31, 1989, the material date for assessing the non-entitlement ground. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the *Trade-marks Act*. Furthermore, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the applicant's claimed date of first use.

Both the applicant's trade-mark NORTHERN OASIS as applied to the wares and services covered in the present application and the opponent's trade-mark OASIS as applied to mineral and aerated waters are inherently distinctive.

The Gattuso affidavit indicates that the affiant is the Executive Vice-President, Assistant Director General of A. Lassonde Inc., previously A. Lassonde & Fils Inc. However, no documentation relating to a change in name or identity of the opponent was furnished by the opponent during the course of the opposition. As a result, this opposition continues to identify A.

Lassonde & Fils Inc. as opponent. While Mr. Gattuso provides evidence relating to the reputation of the opponent's trade-mark OASIS as applied to fruit juices, no evidence has been furnished by the opponent relating to its use of the trade-mark OASIS in association with either mineral or aerated waters. Likewise, as of August 31, 1989, the applicant's trade-mark NORTHERN OASIS had not become known to any extent in Canada. Moreover, the length of use of the trade-marks at issue as of the applicant's claimed date of first use is not a relevant surrounding circumstance in assessing the likelihood of confusion between the applicant's trade-mark as applied to bottled water and the opponent's trade-mark OASIS as applied to mineral and aerated waters.

The trade-marks OASIS and NORTHERN OASIS are similar in appearance, sounding and in the ideas suggested by them, the applicant's trade-mark incorporating the entirety of the opponent's mark OASIS. Thus, the only remaining criteria which must be considered under Section 6(5) of the Act are the nature of the wares and services of the parties and their respective channels of trade.

In assessing the likelihood of confusion between trade-marks in respect of a Section 16(1)(b) ground of opposition, the Registrar must have regard to the channels of trade which would normally be associated with the wares and services set forth in the applicant's application and the opponent's application since it is the statement of wares and services covered in the respective applications of the parties rather than their actual trade to date which determine the scope of the monopoly to be accorded to the applicant and the opponent should their respective trade-marks proceed to registration [*see Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R. (3d) 3, at pp. 10-12 (FCA)]. Thus, absent a restriction in the statement of wares or services set forth in the present trade-mark application as to the channels of trade associated with the applicant's wares or services, the Registrar cannot, when considering the issue of confusion, take into consideration the fact that the applicant may only be selling its wares or offering its services in a particular geographic area in Canada or that such wares or services were only available through a particular type of retail outlet or through a particular channel of trade [*see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc.*, 2 C.P.R. (3d) 361, at pg. 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at pg. 112 (FCA)]. As neither the applicant's application nor the opponent's pending application limit the

channels of trade associated with the wares and services of the parties, I must assume that the channels of trade associated with the applicant's bottled water and the opponent's aerated and mineral waters would or could overlap. As well, the wares themselves appear to be quite similar in that the opponent's wares could be sold as bottled mineral or bottled aerated water.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. As a result, and considering that there is a high degree of resemblance between the trade-marks at issue, the applicant's mark including the entirety of the opponent's trade-mark, and that the applicant's bottled water and the opponent's mineral and aerated waters are overlapping and could travel through the same channels of trade, I find that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion.

As for the applicant's services, these are defined in the present application as the '*operation of a business dealing in bottling of water for others*'. In my view, the average user of such services would expect the person operating a water bottling business to sell bottled water and deliver it to their premises and to pick up empty water containers, as well as to sell or rent water coolers. The average user of such services might also expect the person operating a water bottling business to provide a self-service facility whereby customers can attend the applicant's premises to refill their own containers with bottled water. These basically are the services which Mr. Withey has described in his affidavit as being the services provided by the applicant to its customers in association with its trade-mark NORTHERN OASIS. I believe that the average consumer having an imperfect recollection of the opponent's trade-mark OASIS as applied to mineral or aerated waters might well be confused if he or she were to encounter the applicant's NORTHERN OASIS water bottling services or advertising or promotional materials relating to such services. Consequently, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion in these proceedings as it related to the services covered in the present application.

In view of the above, the applicant is not the person entitled to registration of the trade-mark NORTHERN OASIS as applied to the wares and services covered in this application.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 4<sup>th</sup> DAY OF SEPTEMBER, 1996.

G.W. Partington,  
Chairman,  
Trade-marks Opposition Board.