



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

Citation: 2019 TMOB 50
Date of Decision: 2019-05-31

IN THE MATTER OF AN OPPOSITION

Unilever Canada Inc.	Opponent
and	
Coty Germany GmbH	Applicant
1,710,649 for EXTRA FRESH	Application

[1] Unilever Canada Inc. (the Opponent) opposes registration of the trade-mark EXTRA FRESH (the Mark), that is the subject of application No. 1,710,649 by Coty Germany GmbH (the Applicant). Filed on January 13, 2015, the application is based on use of the Mark in Canada since at least as early as November 2012 with shower gels, fragrances and perfumery, deodorants for personal use, after shave, hair care preparations (Goods).

[2] The Opponent alleges in its statement of opposition that: (i) the application does not conform to the requirements of sections 30(b) and 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable pursuant to section 12(1)(b) of the Act; and (iii) the Mark is not distinctive under section 2 of the Act.

[3] For the reasons that follow, I refuse the application on the basis that the Applicant has not met its legal onus of proving that the Mark is registrable pursuant to section 12(1)(b) of the Act, specifically that the Mark is not clearly descriptive of a character of the Goods.

The Record

[4] The Opponent filed a statement of opposition on June 14, 2016. The Applicant filed and served its counter statement. Neither party filed evidence or a written argument, nor requested a hearing.

Evidential Burden and Legal Onus

[5] The Applicant bears the legal onus of establishing that, on a balance of probabilities, its application complies with the requirements of the Act. 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)].

Grounds of Opposition

Section 12(1)(b) Ground of Opposition

[6] I will first consider the ground of opposition based on section 12(1)(b) of the Act. The material date for this ground of opposition is the date of filing the application [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021].

[7] The Opponent pleads that the Mark is not registrable under section 12(1)(b) of the Act in that it is clearly descriptive or deceptively misdescriptive of the character or quality of the Goods. Specifically, the Opponent pleads that the Mark clearly describes “that the goods result in the consumer feeling extra fresh after using the products”.

[8] In deciding whether the Mark is clearly descriptive, the Mark must be considered as a matter of first impression within the context of the Goods [*John Labatt Ltd v Carling Breweries Ltd* (1974), 18 CPR (2d) 15 at 19 (FCTD)]. “Character” means a feature, trait or characteristic of the goods and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34 (Ex Ct)]. Further, the character or quality of a good includes its effect or function [*Sharp Kabushiki v Dahlberg Electronics, Inc* (1983), 80 CPR (2d) 47 (TMOB) at 55].

[9] Finally, in determining whether a trade-mark is registrable under section 12(1)(b) of the Act, the Registrar must not only consider the evidence but also apply common sense [*Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD)]. Finally, the purpose of the prohibition in section 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD at para 15)].

The Opponent Meets Its Evidential Burden

[10] An opponent's initial evidential burden with respect to a section 12(1)(b) ground of opposition may be met simply by reference to the ordinary meaning of the words in an applicant's mark [see, for example, *Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)]. An opponent may not need to adduce evidence where its ground of opposition may be based entirely on the ordinary meaning of words [*McIntosh v La-Co Industries Inc*, 1998 CanLII 18596 (TMOB)]. In considering whether the Opponent has met its initial evidential burden in this case, I have taken judicial notice of the following definitions for EXTRA and FRESH in the Canadian Oxford Dictionary (2nd ed) [see *Molson Breweries, A Partnership v Saigon International Enterprise Inc*, 2002 CanLII 61422 (TMOB) with respect to the Registrar having regard to dictionary definitions to assist in the determination of a section 12(1)(b) ground]:

EXTRA

adjective additional; more than is usual or necessary or expected.

adverb

1. more than the usual, specified, or expected amount.

2. additionally: *was charged extra*.

noun

1. an extra or additional thing.

2. a thing for which an extra charge is made.

3. a person engaged temporarily to fill out a scene in a film or play, esp. as one of a crowd.

4. a special issue of a newspaper etc

FRESH

adjective

1. newly made or obtained: *fresh sandwiches*.
(of snow) newly fallen.
2. other, different; not previously known or used: *start a fresh page* / / *we need fresh ideas* / / *make a fresh start*.
additional: *fresh supplies*.
3. [foll. by *from*] lately arrived from (a specified place or situation).
4. not stale or musty or faded: *fresh flowers* / / *fresh eggs* / / *fresh memories*.
5. (of food) not preserved by drying, salting, canning, freezing, etc.
(of fruit) not cooked.
6. not salty: *fresh water*.
7. pure, untainted, refreshing, invigorating: *fresh air*.
bright and pure in colour: *a fresh complexion*.
8. (of the wind) brisk; of fair strength.
9. alert, vigorous, fit: *never felt fresher*.
10. *informal* impudent or presumptuous, esp. in a sexual way.
11. young and inexperienced.
12. *N Amer.* (esp. of a cow) having just given birth and giving a renewed supply of milk.

[11] Considering the Mark as a matter of first impression within the context of the Goods, I find that the first impression created by EXTRA FRESH is that it describes the effect of the Opponent's products, either the intended feeling of a consumer after using the Goods (of being newly cleaned beyond the usual degree) or how a consumer will be perceived by others. Accordingly, I find that the Opponent has met its evidential burden. I find this case similar to *Thomson Research Associates Ltd v Registrar of Trade Marks* (1982), 67 CPR (2d) 205 (FCTD), where Mahoney J. considered an appeal of the Registrar's decision refusing an application for the trade mark ULTRA FRESH for bacteriostats and fungistats. At page 208 of the decision, the trial judge made the following comments:

I agree with the respondent that "ultra fresh" is clearly descriptive. It is not descriptive of the bacteriostats and fungistats themselves but it does clearly describe, or deceptively misdescribe, the condition of the product, *e.g.*, the underwear, after treatment with those bacteriostats and fungistats.

I do not think that the various authorities, of which *GWG Ltd., supra*, is an example, dealing with the distinction between trade marks merely suggestive of a characteristic of the wares and those clearly descriptive of them are pertinent. "Ultra clean" does not merely suggest a characteristic of the bacteriostats and fungistats at all; it clearly suggests

the principal, if not only, effect of their application to other wares, in other words, their function.

This was affirmed in *Thomson Research Associates Ltd v Canada (Registrar of Trade Marks)* (1983), 71 CPR (2d) 287 (FCA):

In our view, ULTRA FRESH is clearly descriptive of the function, the purpose and the effect when used as intended, of the bacteriostats and fungistats in association with which it is used as a trade mark. It follows that its registration was properly refused as being contrary to para. 12(1)(b) of the Trade Marks Act, R.S.C. 1970, c. T-10.

The Applicant Fails to Meet Its Legal Onus

[12] Since the Applicant has advanced no evidence or arguments in support of its pleading that the Mark is registrable pursuant to section 12(1)(b) of the Act, I find that the Applicant has not met the legal onus upon it. Accordingly, this ground of opposition is successful.

Section 2 Ground of Opposition

[13] The Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act, since it does not distinguish nor is capable of distinguishing the Goods of the Applicant from the goods of a number of third parties who use the term “extra fresh”. As the Opponent has failed to provide any evidence of use of or reputation in Canada for EXTRA FRESH by the third parties listed in the statement of opposition, it has failed to meet its evidential burden. Accordingly, this ground of opposition is rejected.

Sections 30(b) and 30(e) Ground of Opposition

[14] The Opponent pleads that the application does not conform to the requirements of section 30(b) and section 30(e) of the Act as the Applicant has incorrectly stated the basis for the application, which should have been proposed use, and/or has incorrectly stated the date of first use. The Opponent has not provided any evidence in support of its allegations. As such, the Opponent has failed to meet its evidential burden. Accordingly, this ground of opposition is rejected.

Disposition

[15] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

Agents of Record

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For the Opponent

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For the Applicant