



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

**Citation: 2015 TMOB 69**  
**Date of Decision: 2015-04-09**

**IN THE MATTER OF AN OPPOSITION  
by The Proctor & Gamble Company to  
application No. 1,519,201 for the trade-  
mark SOOTHING CUCUMBER in the  
name of Reckitt Benckiser (Canada) Inc.**

[1] On March 15, 2011, Reckitt Benckiser (Canada) Inc. (the Applicant) filed application No. 1,519,201 to register the trade-mark SOOTHING CUCUMBER (the Mark). The application for the Mark is based upon proposed use in Canada and it covers goods which are described as:

Antibacterial soaps; soaps for personal use; hand cleaning preparations; non-medicated handwashes; liquid soaps for hands, face and body; non-medicated skin care preparations namely, barrier creams, lotions and gels; hand sanitizing preparations; antibacterial skin cleansers; antibacterial handwash; antibacterial hand lotions, creams and gels; antibacterial skin protection lotions, creams and gels.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* dated October 19, 2011 and on December 19, 2011, The Proctor & Gamble Company (the Opponent) filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). On March 12, 2012, the Applicant requested an interlocutory ruling regarding certain alleged deficiencies in the pleadings. Further to the Applicant's request, an amended statement of opposition was filed on April 23, 2012. On May 15, 2012, the Registrar granted leave to file the amended statement of opposition and ruled that the pleadings were sufficient.

[3] The grounds of opposition are based upon sections 30(b), 12(1)(b) and 2 (distinctiveness) of the Act.

[4] A counter statement denying each of the grounds of opposition was filed by the Applicant on June 6, 2012.

[5] As evidence in support of its opposition, the Opponent filed the affidavit of James Meadway, sworn October 5, 2102 (the Meadway affidavit) and the affidavit of Daniel Hynes, sworn October 9, 2012 (the Hynes affidavit). Neither of the affiants was cross-examined.

[6] In support of its application, the Applicant filed the affidavit of Gay Owens, sworn February 4, 2013 (the Owens affidavit). Ms. Owens was cross-examined and the transcript of her cross-examination has been made of record.

[7] Both of the parties filed written arguments.

[8] A hearing was held on January 29, 2015 and attended by both parties.

#### Onus

[9] 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 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) at 298].

#### Preliminary Matter

[10] At the hearing, the Opponent withdrew the section 30(b) ground of opposition. I will therefore not be addressing this ground in my decision.

## Analysis of Remaining Grounds of Opposition

### *Section 12(1)(b)*

[11] The Opponent has pleaded that the Mark is not registrable under section 12(1)(b) of the Act in that it is clearly descriptive of the character or quality of the goods in association with which it is proposed to be used.

[12] The material date for considering the registrability of the trade-mark under section 12(1)(b) of the Act is the filing date of the application, namely March 15, 2011 [*Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[13] The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized by the Federal Court of Appeal in *Ontario Teachers' Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[14] The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product or service and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[15] The Opponent alleges that the Mark clearly describes that the Applicant’s products are made out of cucumber and that they have a soothing character or quality. By contrast, the Applicant submits that the combination of the words “soothing” and “cucumber” creates a unique phrase that is not commonly used in the English language and which would mystify consumers as to its meaning.

[16] As stated by Justice Martineau in *Neptune SA v Canada (Attorney General)* (2003), 29 CPR (4th) 497 (FCTD) at paragraph 11:

To determine whether a trade-mark falls under [the section 12(1)(b)] exclusion, the Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts...

[See also *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 301 (FC) at para 48; *aff'd* (2012), 99 CPR (4th) 213 (FCA).]

[17] In addition to applying common sense, I also note that I may exercise my discretion to take into account dictionary definitions for the words which make up the Mark [*Envirodrive Inc v 836442 Alberta Ltd*, 2005 ABQB 446 (ABQB); *Yahoo! Inc v audible.ca inc* (2009), 76 CPR (4th); *Lakeside Produce Inc v Imagine IP, LLC* 2011 TMOB 17 (CanLII)].

[18] In its written argument, the Applicant pointed out that in the *Canadian Oxford Dictionary* (2d) “soothing” is defined as: 1) to bring about or restore to a peaceful or tranquil state; 2) to reduce the intensity of; and 3) to soften, allay or relieve pain or emotion.

[19] In view of the various meanings which may be attributed to “soothing cucumber”, I do not find the Mark as a whole to be self-evident or plain in meaning in the context of the Applicant’s goods, particularly as a matter of first impression. In my view, it is unclear whether “soothing” is intended to convey that the Applicant’s goods are “soothing” in a physical sense and are meant, for example, to soften, allay or relieve some sort of physical pain or discomfort or that they are “soothing” in a relaxing or emotional sense, perhaps in an aromatherapy kind of way. Consumers of the Applicant’s goods may also wonder whether they are made of cucumber or whether they simply have cucumber like properties or a cucumber fragrance. Thus, while “soothing” and “cucumber” and even “soothing cucumber” may well be descriptive of some aspect(s) of the Applicant’s goods, I do not consider the Mark to be *clearly* descriptive within the meaning of section 12(1)(b) of the Act.

[20] I note that by way of the Owens affidavit, the Applicant also filed evidence to show that a number of other trade-marks having a similar format to the Mark have been allowed or registered in the past. However, I do not consider this evidence to be relevant, as none of the marks which

were located by Ms. Owens contain the word “soothing”, only one contains the word “cucumber” and each case must be decided on its own merit.

[21] In view of the foregoing, this ground of opposition is unsuccessful.

### *Section 2 - Distinctiveness*

[22] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act in that it is neither adapted to distinguish nor capable of distinguishing the goods in association with which it is proposed to be used from those of a number of third parties which also use the term “soothing cucumber”. Appendix “A” to the amended statement of opposition provides examples of some of these third parties and Appendix “B” consists of print-outs from websites which the Opponent states correspond to the third parties set out in Appendix “A”.

[23] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

[24] There is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once that burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[25] In support of this ground of opposition, the Opponent relies upon the Meadway and Hynes affidavits. I will provide a brief overview of each of these affidavits below.

### *Hynes Affidavit*

[26] Mr. Hynes is a student with the agent for the Opponent. On October 9, 2012, Mr. Hynes conducted internet searches to locate some of the products which were identified in the amended Statement of Opposition. Exhibit “A” consists of a print-out from a website showing a product which is described as Soothing Cucumber Organic Facial Gel. The product appears to be

available for purchase on-line and the company selling the product is identified as being a Canadian company. Exhibit “J” consists of a print-out from a website showing a shaving cream product which is described as a cream that provides a smooth shave while “protecting the skin with soothing cucumber...”. The website and the manufacturer are identified as being Canadian.

[27] Exhibit “B” consists of a print-out from a website showing a product which is described as being a balancing complexion mist with “soothing cucumber” and chamomile extracts. Exhibit “C” consists of a print-out from a website showing a product which is described as a soothing eye makeup remover having a “soothing cucumber-infused formula”. Exhibit “D” consists of a print-out from a website showing a product which is described as a masque having a “soothing cucumber – honeysuckle fragrance”. Exhibit “G” consists of a website printout showing a product which is described as a lotion having a “soothing cucumber” juice. Exhibit “H” consists of a print-out from a website showing a product which is described as cleanser having “soothing cucumber” extract. Exhibit “I” consists of a print-out from a website showing a product which is described as an eye gel having “soothing cucumber”. Exhibit “K” consists of a print-out from a website showing a product which is described as fragrance having a “soothing cucumber scent”. Exhibit “L” consists of a print-out from a website showing a lotion that is “soothing cucumber” based. Exhibit “M” consists of a print-out from a website showing a product which is described as a face refresher in which “soothing cucumber” provides a nourishing, calming effect. It is not clear whether the products which are identified in Exhibits “B”-“I” and “K”-“M” are available for sale in Canada.

#### *Meadway Affidavit*

[28] Mr. Meadway is an investigator who purports to have conducted an investigation of products available in Canada and the United States that have the words “soothing” and “cucumber” included as part of the product name or description and which relate to soaps and skin care preparations [Meadway affidavit, para 1].

[29] In paragraphs 2-4 of his affidavit, Mr. Meadway states that he conducted internet searches using various search engines using the terms “soothing” and “soothing cucumber”. His searches were conducted in September and October of 2012. Attached as Exhibits “1”-“3” are print-outs of the first page or first few pages of the search results which were obtained for these

searches. Mr. Meadway's search for "soothing cucumber" using the Google search engine resulted in 1,740,000 "hits". According to Mr. Meadway, these results often referred to products associated with soaps and skin care preparations [Meadway affidavit, par 3, Exhibit "2"]. The first page of this search which is attached as Exhibit "2" does show a number of references to "soothing cucumber" in the context of skin care products. Notably, the very first reference is to a .ca website and relates to a "soothing cucumber cleansing body wash".

[30] In paragraphs 5 to 16 of his affidavit, Mr. Meadway provides details pertaining to products which are available for sale on-line and which are shipped and sold to Canadians from either Canada or the United States. Mr. Meadway located the websites for many of these products by repeating or referring to the searches using the term "soothing cucumber" which he mentioned in paragraphs 2 and 4 of his affidavit. Mr. Meadway purchased a number of products from these websites.

[31] Attached as Exhibits "4" to "30" are print-outs from the websites showing the product information and copies of the shipping orders for the items which Mr. Meadway purchased. Some of these include: a product described as Soothing Cucumber Organic Facial Gel (Exhibits "8" and "9"), which was shipped from Canada; a product identified as Soothing Cucumber Mask (Exhibits "12" and "13"), which was shipped from the United States; a product identified as Gel Eye Coolers Soothing Cucumber Scent (Exhibits "19" and "20"), which was shipped from the United States; a product identified as Soothing Cucumber Mask (Exhibits "23" and "24"), which was purchased on a Canadian website and which was shipped from Canada; and a product identified as After Sun Mask Soothing Coconut & Cucumber (Exhibits "25" and "26") which was shipped from Canada.

[32] In paragraphs 17 to 23 of his affidavit, Mr. Meadway identifies a number of retail establishments which he visited in Canada, in which he observed various products having the words "soothing" and "cucumber" included as part of the product name or description. Mr. Meadway purchased a number of such products. Attached as Exhibits "31" to "49" are photographs of the products which he purchased and copies of the receipts for those purchases. Some of the products which were purchased by Mr. Meadway include: shampoo and conditioner which are described as having a "soothing scent of cucumber" (Exhibits "35"- "37"); facial

towelettes, creams, moisturizers and cleansers which are described as “Yes to Cucumbers Soothing” (Exhibits “38”-“42”); and body wash which is described as having the “soothing scent of cucumber” (Exhibit “44”).

[33] The Applicant has raised a couple of objections to the Opponent’s evidence. First, the Applicant notes that searches and investigations which were conducted by Mr. Hynes and Mr. Meadway were carried out after the December 19, 2011 material date and that their affidavits were also sworn after this date. In view of this, the Applicant takes the position that I cannot consider this evidence. Second, the Applicant asserts that the internet portion of the Opponent’s evidence constitutes inadmissible hearsay.

[34] With respect to the material date issue, I note that approximately 9 months had passed between the filing of the statement of opposition (December 19, 2011) and the dates on which Mr. Hynes and Mr. Meadway conducted their searches and investigations and swore their affidavits. In view of the relatively short amount of time between these dates, the Opponent submits that it is reasonable for me to infer that the state of the internet/ marketplace would have been similar at the material date to what it was at the time that Mr. Hynes and Mr. Meadway conducted their searches and investigations and swore their affidavits. The Applicant, of course, disagrees. Both parties relied on case law to support their respective positions.

[35] The Opponent directed my attention to two cases in which evidence post-dating a material date was considered [see *Speedo Knitting Mills Pty Ltd v Beaver Knitwear (1975) Ltd* (1985), 4 CPR (3d) 176 (TMOB) and *Credit Union Central of Canada v Bank of Montreal* (2001), 12 CPR (4<sup>th</sup>) 275 (TMOB)]. I note that each of those cases involved grounds of opposition relating to confusion and the nature of the evidence differed somewhat from that which has been put forward in the present case. The Applicant directed my attention to two cases involving descriptiveness and distinctiveness issues, in which such evidence was not considered [see *Lakeside Produce Inc v Imagine IP, LLC* (2011), 90 CPR (4th) 296 (TMOB) and *Kellogg Canada Inc v Nature’s Path Foods Inc* (2007), 61 CPR (4th) 460 (TMOB)]. However, in those cases, the evidence post-dated the material date by a more significant amount of time than it does in the present case.



[36] In view of the relatively short nine month (approximately) period of time which we are dealing with in the present case and in view of the nature of the search results, I find it reasonable to infer that the state of the internet/ marketplace would have been similar at the material date to what it was at the time that Mr. Hynes and Mr. Meadway conducted their searches and investigations and swore their affidavits. I am therefore prepared to give this evidence some weight.

[37] With respect to the hearsay issue, I agree that some aspects of the internet portion of the Opponent's evidence do constitute hearsay. For example, in the website printouts which are attached as exhibits to the Hynes affidavit and to the Meadway affidavit, various statements are made about the products which are being described or identified. I am not prepared to accept these website printouts as truth of the contents therein. However, I do find it appropriate to consider these website printouts as evidence of the existence of instances of use of the terms "soothing", "cucumber" or "soothing cucumber" by other traders on the internet to identify or describe products which are similar to those which are associated with the Mark [*Candrug Health Solutions Inc v Thorkelson* (2007), 2007 FC 411 (CanLII), 60 CPR (4th) 35 (FC), reversed (2008), 2008 FCA 100 (CanLII), 64 CPR (4th) 431 (FCA)].

[38] Overall, I find the Opponent's evidence sufficient to establish that at least some other traders have used "soothing cucumber" or various other combinations of "soothing" and "cucumber" to identify or describe products which are similar to those of the Applicant and which are advertised or available for sale to Canadians.

[39] I therefore find that it can reasonably be concluded that facts alleged to support the Opponent's non-distinctiveness ground of opposition exist. Accordingly, I find that the Opponent has met its initial evidential burden in respect of this ground of opposition. In view of this finding, the legal onus is on the Applicant to establish, on a balance of probabilities, that the Mark was distinctive as of the material date.

[40] As its evidence, the Applicant has filed the Owens affidavit. Ms. Owens is employed with the agent for the Applicant as a trade-mark searcher [Owens affidavit, para 1]. Ms. Owens obtained print-outs of the particulars for a number of trade-mark registrations and allowed applications. Attached as Exhibit "A" to her affidavit are copies of the print-outs. There are over

40 trade-marks included in Schedule “A”. Some examples include: ALOE CARE; BODY BUTTER; ALLURING AVOCADO; MILK GLOW; MINT CLEAN; ENERGIZING MANDARIN; and STRAWBERRY SPLASH. Notably, none of the trade-marks contain the word “soothing” and only one contains the word “cucumber”.

[41] The Applicant appears to have put these trade-marks into evidence as examples of marks which may be said to be descriptive in nature and which have been allowed or registered in the past. I do not find that Ms. Owens’ search results are able to assist me in drawing any meaningful conclusions regarding the distinctiveness of the Mark. As mentioned previously, the trade-marks which Ms. Owens located do not bear much similarity to the Mark and each case must be decided on its own merit. Furthermore, distinctiveness is not currently assessed during examination and there is no evidence before me that any of these marks successfully overcame a distinctiveness challenge during opposition.

### *Conclusion*

[42] The application for the Mark is based upon proposed use and there is no evidence that the Mark had acquired any distinctiveness through use as of the material date. Although I did not find the Mark to be *clearly* descriptive due to the fact that it may be said to have more than one meaning within the context of the Applicant’s goods, the fact remains that “soothing”, “cucumber” and “soothing cucumber” are descriptive words by their very nature and as a result of their associated meanings, they may aptly be used to describe certain aspects of the types of goods which are associated with the Mark. In fact, the Opponent has filed some evidence to establish that third parties have used the words “soothing” and “cucumber” in various manners or “soothing cucumber” in order to identify or describe products which are similar to those of the Applicant and which are advertised or available for sale to Canadians.

[43] The Applicant has not filed any evidence which I consider to be helpful in supporting its contention that the Mark is distinctive. In the best case scenario for the Applicant, I find that the probabilities are evenly balanced between a finding that the Mark was distinctive and a finding that it was not distinctive as of the material date. Consequently, I find that the Applicant has failed to satisfy, on a balance of probabilities, the legal onus on it to show that the Mark is distinctive within the meaning of section 2 of the Act.

[44] Accordingly, this ground of opposition is successful.

*Disposition*

[45] In view of 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.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office