

IN THE MATTER OF AN OPPOSITION
by Ocean Fisheries Limited to
application No. 539,302 for the
trade-mark OCEAN PEARL filed
by A. Raptis & Sons

On March 29, 1985, the applicant, A. Raptis & Sons, filed an application to register the trade-mark OCEAN PEARL for "fish and fish products including crustaceans" based on use in Canada since April 26, 1974. The application was amended to include a disclaimer to the word PEARL and was subsequently advertised for opposition purposes on January 20, 1988.

The opponent, Ocean Fisheries Limited, filed a statement of opposition on April 29, 1988, a copy of which was forwarded to the applicant on May 16, 1988. The first ground of opposition is that the application does not comply with the provisions of Section 30(a) of the Trade-marks Act because the statement of wares is not in ordinary commercial terms. The second ground is that the application does not comply with the provisions of Section 30(b) of the Act because the applicant did not use the applied for trade-mark in Canada since the date claimed.

The third 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 opponent's trade-mark OCEAN'S & Design (illustrated below) registered under No. 298,015 for "canned salmon" and under No. 309,431 for "canned tuna and canned salmon" and with the opponent's trade-mark OCEAN BRAND registered under No. 285,905 for a long list of salmon products. The fourth ground is that the applicant's trade-mark is not distinctive in view of the opponent's use of its registered trade-marks.

The applicant filed and served a counterstatement. As its evidence, the opponent filed the affidavit of Edward Anthony Safarik. The applicant filed the affidavits of Harrison Pierce, John Graham, John Opolko and Lynda Doxsee and two statutory declarations of Constantinos Raptis. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

As for the opponent's first two grounds of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30 of the Act. There is, however, an evidential burden on the opponent to support the allegations of fact underlying those two grounds. Since the opponent has failed to file any evidence directed to those allegations of fact, the first two grounds are unsuccessful. I also note that the applicant's own evidence points to its compliance with the provisions of Section 30.

As for the opponent's third ground of opposition, the material time for considering the issue of confusion with a registered trade-mark is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. 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.

The opponent's mark OCEAN'S & Design is inherently weak since it is suggestive of the source of origin of the registered wares. However, the Safarik affidavit evidences extensive sales by the opponent in Canada of salmon and tuna products in association with the registered mark. Safarik also provides evidence of advertising activities and expenses in relation to that mark. Thus, I am able to conclude that the opponent's mark had become known in Canada as of the material time.

The opponent's mark OCEAN BRAND is also inherently weak since the word BRAND is a non-distinctive term. Since there is no clear evidence of use of that mark, I must conclude that it had not become known at all in Canada as of the filing of the opposition.

The applicant's mark is not inherently strong, the words OCEAN PEARL having a somewhat suggestive and laudatory connotation in association with the applied for wares. The disclaimer of the word PEARL underscores this conclusion. There is, however, evidence of continuous sales of the applicant's OCEAN PEARL product from 1971 on although the extent of those sales is not clear. Thus, I am only able to ascribe a limited reputation for the applicant's trade-mark in Canada as of the material time.

The length of time the marks have been in use favors the applicant. The wares of the parties are similar and presumably the trades would overlap. The marks themselves bear a fairly high degree of resemblance in all respects since the first component of the applicant's mark is identical to the first component of the registered mark OCEAN BRAND and is similar to the opponent's design mark.

As an additional surrounding circumstance, I have considered the state of the register evidence introduced by means of the Doxsee affidavit. My review of the results of Ms. Doxsee's search reveals 23 registrations owned by 16 different owners for trade-marks including the word OCEAN registered for fish products as of the material time. All but a few of those marks commence with the word OCEAN. Given those numbers, I am able to conclude that at least some of the registered marks are in use. I can therefore also conclude that consumers would be accustomed to some extent to seeing OCEAN-prefixed marks in the marketplace for fish products. Consequently, those consumers would be somewhat more likely to distinguish such marks by centering on their other components. There is also some evidence of third party use of OCEAN-prefixed trade-names which strengthens that conclusion to a minor degree.

As a further surrounding circumstance, I have also considered that there has apparently been a lengthy period of contemporaneous use of the applicant's mark and the opponent's design mark and there is no evidence of any incidents of actual confusion having arisen between the marks. Given the absence of information as to the geographical extent of the applicant's use and given the relatively low sales of the applicant's product in Canada, I can only give minor consideration to this circumstance.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also considered my previous unreported decision in Ocean Fisheries Limited v. Collage Communicators Limited (S.N. 612,710; October 31, 1990) in which I refused a similar application for the trade-mark OCEAN TREASURE based on the same registrations under consideration in the present case. In that previous decision, I indicated that if the applicant's state of the register evidence had been more reliable, the result might well have been different.

In the present case, the wares, trades and marks of the parties are similar. However, the word OCEAN is inherently weak when used for fish products and the applicant's evidence has shown, to some extent, that that word is a common component of third party marks in the trade. The evidence also suggests, at least to a minor extent, that there has been longstanding, contemporaneous use of the marks without confusion. Thus, I find

that the applicant has satisfied the onus on it to show that the marks at issue are not confusing and the third ground is therefore also unsuccessful. Since the fourth ground essentially turns on that same issue, it, too, is unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 28th DAY OF FEBRUARY 1991.

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