IN THE MATTER OF AN OPPOSITION by Kraft General Foods Canada Inc. (now Kraft Canada Inc.) to application No. 684,130 for the trade-mark MAGIC WHIP filed by Tritap Food Broker, a Division of 676166 Ontario Limited

On June 17, 1991, Tritap Food Broker, a Division of 676166 Ontario Limited, filed an application to register the trade-mark MAGIC WHIP, together with an application for registration of a person as a registered user of the trade-mark in respect of "dessert topping". The applicant amended its application prior to advertisement to disclaim the right to the exclusive use of the word WHIP apart from its trade-mark.

The application was advertised for opposition purposes in the ***Trade-marks Journal*** of August 26, 1992 and the opponent, Kraft General Foods Canada Inc., filed a statement of opposition on October 15, 1992. As its evidence, the opponent filed the affidavits of Marian E. MacDonald, Peter Bruce Hunter and Robert Eugene Weagle, together with certified copies of the registrations identified in the statement of opposition. The applicant submitted as its evidence the affidavits of Karen Messer, Linda Elford, L. Jane Sargeant and Joel Usher. Both parties filed a written argument and both were represented at an oral hearing.

As its first ground of opposition, the opponent alleged that the applicant's application does not comply with Section 30(g) of the ***Trade-marks Act*** in that the applicant's post office box number does not qualify as a principal office or place of business and that this deficiency is not overcome by the provision of the name and address of the applicant's representative for service. The opponent also alleged that, as of its filing date, the applicant did not intend to use the trade-mark MAGIC WHIP in the form set forth in the application and consequently the present application is contrary to Section 30(h) of the ***Trade-marks Act***. As well, the opponent alleged that the present application does not comply with Section 30(i) of the ***Trade-marks Act*** in that, at all material times, the applicant was aware of the opponent's prior adoption, use and registration of and reputation in the confusingly similar trade-marks identified below, such that the applicant could not properly have made the statement that it was satisfied that it was entitled to use its trade-mark MAGIC WHIP in Canada.

At the oral hearing, the opponent withdrew its allegations that the present application does not comply with Sections 30(g) and 30 (h) of the ***Trade-marks Act***. As a result, the only remaining issue in respect of the Section 30 ground is that the present application is contrary to Section 30(i) of the ***Trade-marks Act***. While the legal burden is upon the applicant to show that its application complies with Section 30(i) of the Act, there is an initial evidentiary 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]. Assuming that the applicant had been aware of the opponent's 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 MAGIC WHIP in Canada on the basis *inter alia* that its mark is not confusing with the opponent's trade-marks relied upon in its statement of opposition. 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].

The second ground of opposition is that the trade-mark MAGIC WHIP is not registrable in view of the provisions of Section 12(1)(d) of the ***Trade-marks Act*** because it is confusing with the following registered trade-marks of the opponent:

Trade-mark	**Registration No.**	**Wares**
COOL WHIP	151,731	Dessert toppings
DREAM WHIP	113,623	Powdered preparations for making dessert toppings, puddings, pie fillings. Dessert toppings.
MIRACLE WHIP	UCA03315	Salad dressings
WHIPPED & Design	192,284	Cream cheese. Margarine
WHIP 'N CHILL	201,987	Dessert mix
WHIP	264,536	Salad dressings
MOMENTS MAGIQUES	339,508	Puddings, yogurt, jams, compotes, mousse and custard
MAGIC MOMENTS	340,660	Puddings, yogurt, jams, compotes, mousse and custard

MAGIC MOMENTS MAGIQUES Design	343,622	Puddings, yogurt, jams, compotes, mousse and custard
MAGIC MOMENTS Design	340,181	Puddings
MIRACLE WHIP & Design	373,119	Salad dressings

The material time for considering the circumstances respecting the issue of confusion in relation to a Section 12(1)(d) ground is as of the date of my decision [see ***Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al***, 37 C.P.R. (3d) 413 (F.C.A.)]. Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark MAGIC WHIP and the registered trade-marks identified above, 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***. Moreover, 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 material date.

The applicant's trade-mark MAGIC WHIP possesses some degree of inherent distinctiveness when considered in its entirety even though the word WHIP is descriptive of the character of a "dessert topping" and has been disclaimed by the applicant apart from its trade-mark. The Usher affidavit establishes that U-Buy Discount Foods Limited, a related company of the applicant and the person identified in the registered user application which accompanied the present application, commenced use of the trade-mark MAGIC WHIP in Canada in October, 1991. According to Mr. Usher, the MAGIC WHIP product had, as of the date of his affidavit [March 23, 1994], been sold in each of the ten provinces in Canada with sales amounting to 125,000 units representing revenues in excess of $90,000. Thus, the applicant's trade-mark MAGIC WHIP has become known to a minor extent in Canada.

The opponent's registered trade-marks COOL WHIP as applied to "dessert toppings", DREAM WHIP as applied to "Powdered preparations for making dessert toppings, puddings, pie fillings. Dessert toppings" and WHIP 'N CHILL covering "Dessert mix" possess some measure of inherent distinctiveness when considered in their entireties despite the descriptive significance of the

word WHIP. Likewise, the opponent's marks MIRACLE WHIP and MIRACLE WHIP & Design possess some degree of inherent distinctiveness when applied to "Salad dressings" although the word WHIP may suggest to some consumers one possible step in the manufacture of the opponent's salad dressings [see ***Kraft General Foods Canada Inc. v. Edem Manufacturing Co.***, 40 C.P.R. (3d) 539, at p. 541]. Further, the opponent's trade-mark WHIP applied to "Salad dressings" and WHIPPED & Design are weak marks possessing relatively little inherent distinctiveness in that WHIP is suggestive of a step used in the production of salad dressing and "whipped"is suggestive of the consistency of its "Cream cheese. Margarine". On the other hand, the opponent's trade-marks MAGIC MOMENTS, MAGIC MOMENTS MAGIQUES Design and MOMENTS MAGIQUES covering "Puddings, yogurt, jams, compotes, mousse and custard" and MAGIC MOMENTS Design covering "Puddings" possess a greater degree of inherent distinctiveness than do its other marks.

The Hunter and MacDonald affidavits evidence very extensive sales and advertising of the opponent's MIRACLE WHIP product for over sixty years with more than twenty million jars of MIRACLE WHIP salad dressing being sold annually in Canada. Further, the Weagle affidavit evidences significant sales and advertising of the opponent's COOL WHIP, DREAM WHIP and WHIP 'N CHILL products in Canada. According to Mr. Weagle, COOL WHIP whipped topping in the frozen dessert topping section and DREAM WHIP dessert topping mix in the powdered dessert topping segment are the best selling products in their respective market segments in Canada. Thus, I am able to conclude that the trade-marks COOL WHIP, DREAM WHIP and WHIP 'N CHILL have become well known in Canada while the MIRACLE WHIP trade-mark has become very well known in Canada. The trade-mark WHIP has been used as a subsidiary mark on the opponent's MIRACLE WHIP product since 1981. However, and as pointed out by the Hearing Officer in ***Kraft General Foods Canada Inc. v. Edem Manufacturing Co.***, 40 C.P.R. (3d) 539, at p. 541, the appearance of the mark WHIP on the side of the lid of the opponent's product is relatively inconspicuous and there is no indication in the evidence that the opponent brings that mark to the public's attention in its advertising materials. Thus, as in the ***Edem Manufacturing*** case, I can only assume that the opponent's trade-mark WHIP has become known to a limited extent in Canada. Furthermore, no evidence has been furnished by the opponent relating to the extent to which its other trade-marks identified above have become known and I must assume for the purposes of this

opposition that they have not become known to any extent. Accordingly, the extent to which the trade-marks at issue have become known favours the opponent in respect of its trade-marks MIRACLE WHIP, COOL WHIP, DREAM WHIP and WHIP 'N CHILL. Likewise, the length of time the marks have been in use weighs in the opponent's favour to a significant extent.

The present application covers "dessert topping" which is identical to the opponent's "dessert toppings" covered in its registration for the trade-mark COOL WHIP and is closely related to "Powdered preparations for making dessert toppings, puddings, pie fillings. Dessert toppings" and "Dessert mix" associated with the opponent's registered trade-marks DREAM WHIP and WHIP 'N CHILL respectively. Moreover, from the evidence furnished by Mr. Usher, it would appear that the trade-mark MAGIC WHIP is being used in association with a dessert topping mix which, in fact, is directly competitive with the opponent's DREAM WHIP powdered preparations for making dessert toppings. As well, the applicant's dessert topping could be used on the opponent's MAGIC MOMENTS "puddings", such that these wares could be considered as being somewhat related.

While the applicant's dessert toppings differ from the opponent's salad dressing associated with its MIRACLE WHIP and WHIP trade-marks, there is some overlap between these wares in that certain of the magazine advertisements appended as exhibits to the MacDonald affidavit include dessert recipes for cakes, muffins, mousses and sauces which use the opponent's MIRACLE WHIP salad dressing. Further, according to Ms. MacDonald, advertisements featuring dessert recipes for cupcakes, brownies and mousse using MIRACLE WHIP salad dressing have appeared in the form of free standing inserts in Canadian magazines since at least 1973. Thus, the opponent's evidence points to its MIRACLE WHIP salad dressing as having uses which extend beyond what would normally be associated with a typical salad dressing. As for their respective channels of trade, I would expect the opponent's MIRACLE WHIP salad dressing and the applicant's dessert toppings to be sold in different sections of grocery stores, supermarkets or the like.

With respect to Section 6(5)(e) of the ***Trade-marks Act***, there is a fairly high degree of resemblance between the applicant's proposed trade-mark MAGIC WHIP and the opponent's registered trade-mark WHIP, the applicant having adopted the entirety of the opponent's registered

trade-mark as a component of its mark. There is also a fair degree of similarity in appearance and sounding between the applicant's mark and the opponent's registered trade-mark MAGIC MOMENTS. On the other hand, the degree of resemblance is less pronounced between the applicant's mark and the opponent's COOL WHIP, DREAM WHIP, WHIP 'N CHILL and MIRACLE WHIP trade-marks.

As a further surrounding circumstance in respect of the issue of confusion, the opponent has relied upon Mr. Usher's assertion that he is unaware of any instances of actual confusion between the trade-marks at issue. However, having regard to the relatively modest sales of the applicant's dessert topping, I do not consider the absence of evidence of actual confusion between the applicant's trade-mark and the opponent's trade-marks to be a particularly relevant surrounding circumstance in this proceeding.

As yet a further surrounding circumstance in respect of the issue of confusion, the opponent submitted evidence of the state of the register with respect to marks including the words WHIP as applied to food products and MAGIC as applied to *inter alia* dessert products, confectioneries and toppings, puddings, sauces and flavouring syrups. Exhibit A to the Sargeant affidavit together with the Elford affidavit support the conclusion that the word MAGIC has been adopted by a number of traders as a component of trade-marks applied to food products, thus diminishing the likelihood of confusion between the applicant's trade-mark and the opponent's MAGIC MOMENTS trade-marks.

The applicant also argued that the state of the register evidence submitted by way of Exhibit B to the Sargeant affidavit, together with the Messer affidavit, supports the conclusion that the word WHIP has been adopted as a common component of trade-marks applied to dessert toppings. As well, the applicant has relied upon the Usher affidavit which points to marketplace use of trade-marks including the word WHIP as applied to various dessert food products. In particular, Mr. Usher attests to his awareness of such dessert food products as NUTRIWHIP and NUTRIWHIP LITE-LÉGER dessert topping mixes, NO NAME DESSERT WHIP whipped topping product, RICH'S RICH WHIP whipped topping product, and WHIP IT stabilizer for Whipped Cream product. Additionally, Mr. Usher has annexed to his affidavit specimens, or photocopies or

photographs of specimens, of packaging associated with these products. The NUTRIWHIP product is similar to the applicant's dessert topping and the opponent's DREAM WHIP product and the NO NAME DESSERT WHIP whipped topping is similar to the opponent's COOL WHIP dessert topping. The RICH WHIP product is also a whipped topping although it is distributed in an aerosol container. On the other hand, the WHIP IT stabilizer differs from the dessert toppings of the parties. Furthermore, the fact that Mr. Usher has not indicated a familiarity with more of the trade-marks identified in the results of the Sargeant and Messer searches certainly suggests that many of the third party marks may not be in use in Canada.

The evidence of third party usage of the marks NUTRIWHIP, NO NAME DESSERT WHIP and RICH WHIP limits to some extent the scope of protection which ought to be accorded the opponent's marks. On the other hand, the opponent's evidence points to there having been very extensive use of its trade-marks DREAM WHIP and COOL WHIP, as well as its WHIP 'N CHILL and MIRACLE WHIP marks, thus strengthening the opponent's argument that there would be a reasonable likelihood of confusion between the applicant's mark and any one of its trade-marks, including its DREAM WHIP trade-mark which is applied to a product which is directly competitive with the applicant's MAGIC WHIP dessert topping.

As a further surrounding circumstance in respect of the issue of confusion, the opponent submitted that the manner in which the applicant was packaging its MAGIC WHIP dessert topping is such as to increase the likelihood of confusion between the applicant's trade-mark and the opponent's DREAM WHIP trade-mark. On the other hand, the applicant submitted evidence of the manner in which third parties market their dessert toppings in the marketplace in order to show that some of the points of similarity between its packaging and the opponent's packaging were also common to packaging used by third parties for their dessert toppings. In my view, this issue is one which should be addressed in a passing off action rather than in an opposition proceeding where the Registrar is considering the likelihood of confusion between trade-marks. As a result, I am of the view that little weight ought to be accorded to the manner of packaging by the parties and others in the marketplace as a surrounding circumstance in this proceeding.

Having regard to the above, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark MAGIC WHIP as applied to a dessert topping and the opponent's trade-mark DREAM WHIP as applied to a dessert topping mix. In addition to there being some degree of resemblance between these trade-marks, the opponent has established that there has been significant use of the trade-mark DREAM WHIP as applied to dessert toppings, that it is the largest seller in the marketplace in its product category, and that it would be sold side-by-side with the applicant's MAGIC WHIP dessert topping in the marketplace. Moreover, the opponent has demonstrated that it has made significant use of its trade-marks COOL WHIP and WHIP 'N CHILL as applied to dessert related products, as well as MIRACLE WHIP in association with a salad dressing; and this evidence far outweighs any significance which could be accorded to either the state of the register evidence or marketplace evidence which has been adduced in this opposition.

In view of the above, and 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 22nd DAY OF JANUARY, 1997.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.