

IN THE MATTER OF AN OPPOSITION by LES PRODUCTIONS PRISMA INC. to application No. 769,257 for the trade-mark ANNA BANANA filed by Anna Banana-Frankham, carrying on business as BANANA PRODUCTIONS

On November 21, 1994, the applicant, Anna Banana-Frankham, carrying on business as BANANA PRODUCTIONS, filed an application to register the trade-mark ANNA BANANA based on use of the trade-mark in Canada: since August 1971 in association with “*Original artworks namely drawings, paintings, batik fabrics, and periodicals*”; since 1975 in association with “*Film and video tapes*”; since 1978 in association with “*Limited edition prints and books*”; since 1971 in association with services identified as the “*Public events, performances, workshops and entertainments*”; and since 1976 in association with “*Comedic/dramatic performances, provision of lectures relating to art history, and graphic design and production*”.

The applicant submitted an amended application on December 5, 1995 in which the first statement of services was amended to read “*Conception, organization and production of public contests to promote creative activity in the areas of visual arts, costume and performance; and conducting art workshops*”. While this amendment appears to have been accepted by the Examiner, the Trade-marks Office failed to notice this amendment when it advertised the present application in the *Trade-marks Journal* of June 12, 1996 on the basis of the original wording of the first statement of services identified above. As the amendment to the first statement of services complies with both Sections 31(e) and 32(e) of the *Trade-marks Regulations*, I have accepted this amendment to the present application.

Following the advertisement of the present application in the *Trade-marks Journal*, the opponent, LES PRODUCTIONS PRISMA INC., filed a statement of opposition on November 8, 1996, a copy of which was forwarded to the applicant on November 28, 1996. The applicant filed a counter statement in response to the statement of opposition on March 21, 1997 and subsequently requested and obtained a retroactive extension of time to serve a copy of the counter statement on the opponent. The opponent submitted as its evidence the affidavit of Susan Martinez and the statutory declaration of Claude Godbout while the applicant filed as her evidence the affidavit of

Anna Banana-Frankham. Both parties submitted written arguments and the opponent alone requested an oral hearing.

On March 27, 2000, Ernst & Young advised the Opposition Board that it had been appointed trustees in the bankruptcy of the opponent and requested that the oral hearing scheduled for April 20, 2000 be postponed by the Opposition Board. In her letter dated April 11, 2000, the applicant advised the Board that she did not consent to the postponement of the oral hearing. Ernst & Young did not identify any provisions in the *Bankruptcy Act* which would require the Registrar to postpone the oral hearing, nor did the trustee indicate in its letter of March 27 the length of the postponement being requested, bearing in mind that the Registrar has no inherent jurisdiction to stay opposition proceedings [see *Anheuser-Busch v. Carling O'Keefe Breweries of Canada Limited*, 69 C.P.R. (2d) 136, (F.C.A.)].

In *Clarco Communications Ltd. v. Sassy Publishers Inc.*, 54 C.P.R. (3d) 418, Denault, J. commented as follows concerning the assignment of an opposition proceeding at pages 426-427:

“In *Burns*, supra, at p. 225, an assignment of a right to sue for past infringements of a patent was held to be invalid on the basis that the right to sue for past infringement is a cause of action in tort the assignment of which is prohibited by common law. There is no question that the general principle that tort actions cannot be assigned is correct; however, the basis for this principle is a concern that such assignments would lead to champerty and maintenance. In *Fredrickson v. Insurance Corp. of British Columbia* (1986), 28 D.L.R. (4th) 414, 17 C.C.L.I. 194, [1986] I.L.R. 1-2100 (B.C.C.A.), McLachlin J.A. (as she then was) recognized that one exception to the general rule prohibiting the assignment of a bare cause of action in tort is the existence of a pre-existing commercial interest. She states at pp. 425-5 that: "the essential question to be considered in determining whether the assignment smacks of maintenance or champerty is whether the assignee possessed the requisite financial interest at the time of the assignment." At issue here is an assignment of the right to oppose a trade mark registration. The assignment indicates that, in addition to the opposition proceedings, Consolidated assigned to Matilda all rights, title and interest in the trade mark application for SASSY and the goodwill of the business symbolized by the trade mark for \$10 US and other consideration. Also, it appears that Consolidated and Matilda are affiliated. I am satisfied on the basis of the evidence before me that Matilda had a sufficient pre-existing financial interest in the trade mark to support the validity of the assignment and, as such, the assignment and subsequent substitution is valid. In my opinion, Matilda had standing to oppose the registration of the trade mark SASS within the meaning of s. 38(1) of the Trade-marks Act and Sassy has sufficient standing to continue the opposition before me.”

In the present case, any third party acquiring an assignment of the present opposition would not appear to have the requisite financial interest at the time of the assignment, bearing in mind that the

opponent has not relied upon any trade-mark or trade-name rights in its statement of opposition which could be assigned to a third party. Consequently, the grounds of opposition are not personal to the opponent and therefore the Registrar could not accept an assignment by the trustee of the present opposition proceeding to a third party.

Apart from the above, the issues raised in this opposition and the evidence adduced by the parties are not such that the preparation for an oral hearing would have been an onerous matter for the trustee or for a trade-mark agent representing the trustee, bearing in mind that the opposition decision is based on the pleadings of the parties and their evidence which is already of record. Moreover, I am mindful of the fact that this opposition has already been pending since June of 1996 and that the applicant would therefore be further prejudiced by the additional delay resulting from the postponement of the oral hearing. As a result, I concluded that the oral hearing should proceed on April 20, 2000, the date established by the Office letter of February 25, 2000, and advised the parties accordingly by way of an Office letter dated April 13, 2000. The trustee failed to attend the oral hearing on the scheduled date.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

- a) The present application does not comply with Section 30 of the *Trade-marks Act* in that the applicant has not used the trade-mark ANNA BANANA since the dates claimed in the application;
- b) The trade-mark ANNA BANANA is not registrable in view of Paragraph 12(1)(a) of the *Trade-marks Act* in that the trade-mark is primarily merely the name of an individual who is living, namely, the applicant herself.

The first ground of opposition is based on Subsection 30(b) of the *Trade-marks Act*. While the legal burden is upon the applicant to show that her application complies with Subsection 30(b) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Subsection 30(b) ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*,

3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden on it in relation to 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]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the present application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

Apart from the above, I would note that the evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b) of the *Act* is a light one [see *Tune Masters v. Mr. P's Mastertune*, 10 C.P.R.(3d) 84, at p. 89]. Furthermore, Subsection 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed [see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership*, 67 C.P.R.(3d) 258, at p. 262 (F.C.T.D.)]. Finally, the opponent's evidential burden can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in her application.

In her affidavit dated August 26, 1997, Susan Martinez, manager of research operations of Intelpro Intellectual Property Services, states that she was asked to inquire regarding the use of the trade-mark ANNA BANANA in association with films, videotapes, books, periodicals and derivative products such as T-shirts and souvenirs. Ms. Martinez further claims that she called Ms. Anna Banana-Frankham on May 23, 1997 and that Ms. Anna Banana-Frankham answered the phone in such a way that the affiant had no indication if it was an office or a company. Ms. Martinez then states in paragraphs 7 to 9 as follows:

7. I asked her if she sold T-shirts with "ANNA BANANA" and she replied "No";

8. I asked her if she sold souvenirs or other objects with “ANNA BANANA” and she replied that she only sold stamps;

9. She told me she was in the custom stamp production and postage stamp business and that she did not have any other merchandise other than the stamps;

Apart from the opponent’s evidence being dated more than two and a half years subsequent to the applicant’s filing date [November 21, 1994], the material date for considering the Subsection 30(b) ground, the opponent’s evidence relates to the issue of use of the trade-mark ANNA BANANA in association with T-shirts, souvenirs or other objects, wares which are not even covered in the present application. Moreover, Ms. Martinez did not specifically ask Ms. Anna Banana-Frankham if she was selling or offering for sale videotapes, books or periodicals in association with her trade-mark or whether she was using her mark in association with “drawings, paintings, batik fabrics” or with any of the services covered in the present application. Thus, the opponent’s evidence is of no assistance in meeting the opponent’s evidential burden in relation to the first ground.

As noted previously, the opponent’s evidential burden can be met by reference not only to its own evidence, but also to the applicant’s evidence. However, while the opponent may rely upon the applicant’s evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant’s evidence is ‘clearly’ inconsistent with the applicant’s claims set forth in her application. After reviewing the applicant’s evidence, and bearing in mind that the opponent did not seek to cross-examine Anna Banana-Frankham on her affidavit, I have concluded that the applicant’s evidence is not clearly inconsistent with her claims that she has used the trade-mark ANNA BANANA in Canada in association with her wares and services since the dates of first use claimed in the present application. In this regard, I am mindful of the fact that the applicant is a sole proprietorship and that her use of the trade-mark ANNA BANANA has not been significant although such use has been continuous over the years and appears to have been in the normal course of trade. I have therefore dismissed the first ground of opposition.

The second ground of opposition is based on Paragraph 12(1)(a) of the *Trade-marks Act* which reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :
a) elle est constituée d'un mot n'étant principalement que le nom ou le nom de famille d'un particulier vivant ou qui est décédé dans les trente années précédentes;

The material time for considering a Paragraph 12(1)(a) ground of opposition is the date of my decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R.(3d) 243]. Further, the onus or legal burden is on the applicant to show that her applied for trade-mark is registrable. In considering the Paragraph 12(1)(a) ground, I have had regard to the following comments of Mr. Justice Cattanach in *Gerhard Horn Investments Ltd. v. The Registrar of Trade Marks*, 73 C.P.R. (2d) 23, at p. 30:

“The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is "primarily merely" a name or surname rather than something else.”

In the present case, the evidence of record establishes that ANNA BANANA is the name of the applicant and that the applicant resides in Canada. Thus, the first consideration for determining whether or not a word falls within the ambit of Paragraph 12(1)(a) of the *Act* has been satisfied.

The next issue is whether or not a majority of Canadians would recognize the mark ANNA BANANA as being “primarily merely” a name, rather than something else. Certainly, the existence of only one person in Canada having the name ANNA BANANA or, indeed, having the surname BANANA, confirms that BANANA is a rare surname. The Godbout declaration identifies the existence of a Dun & Bradstreet Canada listing in Stratford, Ontario for ANNA BANANA’S although this evidence is consistent with ANNA BANANA’S being either a trade or business name or a trade-mark. Thus, no other evidence has been adduced by the opponent which would point to the recognition in Canada of ANNA BANANA as a name or of BANANA as a surname. The opponent has therefore failed to establish that either a majority of Canadians or even a majority of Canadians in a significant area of Canada would recognize ANNA BANANA as a name [see *Nationwide Manufacturing Ltd. v. Robert Morse Appliances Ltd.*, 27 C.P.R. (3d) 112; and *Juneau*

v. Chutes Corp., 11 C.P.R. (3d) 260]. In my view, the average Canadian would be just as likely to react to the mark ANNA BANANA as being a coined term as opposed to being a name, bearing in mind the normal meaning which the average person would attribute to the word BANANA and to the alliteration created by the addition of the word ANNA. Accordingly, I have concluded that the applicant's trade-mark ANNA BANANA is not primarily merely the name of a living individual and have therefore rejected the Paragraph 12(1)(a) ground of opposition.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 25TH DAY OF OCTOBER, 2000.

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