

IN THE MATTER OF AN OPPOSITION by Gainers Inc. to
application No. 640,873 for the trade-mark WEST VIRGINIA filed
by Hygrade Food Products Corporation

On September 21, 1989, the applicant, Hygrade Food Products Corporation, filed an application to register the trade-mark WEST VIRGINIA based upon proposed use of the trade-mark in Canada in association with "fresh, canned, and smoked ham and bacon". The applicant disclaimed the right to the exclusive use of VIRGINIA apart from its trade-mark. The present application was advertised for opposition purposes in the Trade-marks Journal of February 26, 1992.

The opponent, Gainers Inc., filed a statement of opposition on March 17, 1992 in which it alleged that the applicant's trade-mark WEST VIRGINIA is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the applicant's wares or of the conditions of or of their place of origin, contrary to Section 12(1)(b) of the Trade-marks Act. The opponent also alleged that the applicant's trade-mark is not registrable and not distinctive in that the applicant's trade-mark WEST VIRGINIA is confusing with its registered trade-mark THE VIRGINIAN covering "processed meat", registration No. 386,277. Finally, the opponent alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark WEST VIRGINIA was confusing with the opponent's application for registration of the trade-mark THE VIRGINIAN, application No. 570,965, filed October 15, 1986, and covering "processed meat".

The applicant filed a counter statement in which it denied the opponent's grounds of opposition. Additionally, in its counter statement, the applicant identified several registered trade-marks containing the words VIRGINIA or VIRGINIANS which it asserted are on the Trade-marks Register in respect of various wares and services and are owned by persons other than the opponent.

The opponent filed as its evidence the affidavit of Alex Boyd who was cross-examined on his affidavit, the transcript of the cross-examination and the exhibit to the cross-examination forming part of the opposition record. The applicant submitted as its evidence the affidavit of Sandra Byrne.

Both the applicant and the opponent submitted written arguments and both parties were represented at an oral hearing.

With respect to the first ground of opposition, the material time for considering the circumstances relating to the ground of opposition based on Section 12(1)(b) of the Trade-marks Act is the date of my decision [see Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers, 41 C.P.R.(3d) 243 (F.C.A.)]. The issue is to be determined from the point of view of an everyday user or consumer of the applicant's wares. Furthermore, the trade-mark WEST VIRGINIA must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression [see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks, 40 C.P.R.(2d) 25, at pages 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks, 2 C.P.R.(3d) 183, at page 186].

While the opponent filed the Boyd affidavit as evidence in this opposition, that affidavit is directed to the opponent's use of its trade-mark THE VIRGINIAN. Accordingly, the opponent has not filed any evidence in support of its first ground of opposition. Nevertheless, from a review of dictionary definitions, I am able to determine that West Virginia and Virginia are states in the eastern United States and that "virginia ham", as defined in Webster's Third New International Dictionary, is a "flat lean hickory-smoked ham with dark red meat from a peanut-fed razorback hog". The dictionary entries which I have reviewed would support the conclusion that the word VIRGINIA, which has been disclaimed by the applicant apart from its trade-mark, is descriptive of the character or quality of the applicant's wares. Nevertheless, and even were I prepared to assume that the average Canadian consumer is aware of the state of West Virginia, there is no evidence in this opposition indicating that the applicant's wares originate from West Virginia or that West Virginia is known for "fresh, canned, and smoked ham and bacon". Accordingly, the trade-mark WEST VIRGINIA is not clearly descriptive of the place of origin of the applicant's wares. Likewise, there is no evidence which would support the conclusion that the applicant's trade-mark is clearly descriptive of the character, quality or conditions of production of its wares.

Assuming the applicant's ham and bacon do not originate from West Virginia, it is necessary

to consider whether or not the applicant's trade-mark is deceptively misdescriptive of the place of origin of the wares. At page 186 of the Atlantic Promotions decision, referred to above, Cattnach, J. commented as follows as to the test for ascertaining whether a trade-mark is deceptively misdescriptive of the place of origin:

"In my view the proper test to be applied to the determination as to whether a trade mark in its entirety is deceptively misdescriptive must be whether the general public in Canada would be misled into the belief that the product with which the trade mark is associated had its origin in the place of a geographic name in the trade mark."

In the present case, the opponent's evidence fails to establish that the general public in Canada would be misled into the belief that the applicant's wares had their origin in West Virginia. In this regard, there is no evidence that the average consumer of ham and bacon in Canada would be aware that West Virginia is known as a source of ham or bacon or is even a source of these wares. Thus, even if the average Canadian consumer were aware of the existence of the state of West Virginia, there is no evidence suggesting they might be misled by the applicant's trade-mark into the belief that the applicant's ham and bacon have their place of origin in West Virginia. As a result, I have concluded that the applicant's trade-mark WEST VIRGINIA is not deceptively misdescriptive of the place of origin of its wares. I have therefore rejected the first ground of opposition.

The second ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent asserting that the applicant's trade-mark WEST VIRGINIA is confusing with its registered trade-mark THE VIRGINIAN. The material date for assessing a Section 12(1)(d) ground is the date of my decision [see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (F.C.A.)]. As its third ground, the opponent alleged that the applicant is not the person entitled to registration in view of the provisions of Section 16(3)(b) of the Trade-marks Act in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-mark THE VIRGINIAN in respect of which an application for registration had previously been filed in Canada under application Serial No. 570,965.

While the opponent has not filed a copy of its registration or pending application as evidence, the Registrar does have the discretion to check the register in order to confirm the existence of the

registration relied upon by the opponent [see Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd., 11 C.P.R. (3d) 410]. In doing so, I noted that application Serial No. 570,965 matured to registration No. 386,277 for the trade-mark THE VIRGINIAN on July 5, 1991 and that the opponent's registration is still in force and covers "processed meats". As application No. 570,965 was not pending as of the date of advertisement of the present application (February 26, 1992), the opponent has failed to meet the requirements of Section 16(4) of the Trade-marks Act in relation to the third ground of opposition. I have therefore dismissed this ground.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue in respect of the Section 12(1)(d) ground, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, 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 date of decision.

Considering initially the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark WEST VIRGINIA possesses little inherent distinctiveness in view of the geographic significance of the mark. Likewise, the registered trade-mark THE VIRGINIAN as applied to "processed meats" which would include ham is highly suggestive of these wares, bearing in mind the dictionary meaning of the expression "virginia ham", referred to above. Accordingly, the trade-mark THE VIRGINIAN is a weak mark possessing little inherent distinctiveness.

No evidence has been furnished by the applicant that its trade-mark WEST VIRGINIA has become known to any extent in Canada in association with bacon or ham. On the other hand, the Boyd affidavit establishes that the trade-mark THE VIRGINIAN has become known to some extent in this country as applied to smoked ham. Further, the length of use of the trade-marks at issue does weigh in favour of the trade-mark THE VIRGINIAN.

The applicant's bacon and ham are overlapping with the opponent's "processed meats" and, in the absence of any evidence to the contrary, I would expect that the channels of trade of the parties

would likewise overlap. With respect to the channels of trade associated with the opponent's wares, I would note that the opponent sought to rely upon the re-examination of Alex Boyd from the transcript of Mr. Boyd's cross-examination. However, the re-examination of Mr. Boyd clearly raised matter which was not covered during the cross-examination and was correctly objected to by the applicant's agent during the cross-examination. I have therefore ignored the re-examination portion of the transcript of Mr. Boyd's cross-examination.

There is some similarity in appearance and sounding between the trade-marks WEST VIRGINIA and THE VIRGINIAN although the trade-marks suggest different ideas. In particular, the applicant's mark refers to the state of West Virginia while the trade-mark THE VIRGINIAN identifies a native or resident of the state of Virginia.

As an additional surrounding circumstance in respect of the issue of confusion, the applicant has adduced evidence relating to the existence of twenty-two registrations for trade-marks including the words VIRGINIA OR VIRGINIANS. However, all but five of the registrations cover wares or services unrelated to the wares of the parties. In view of the limited number of relevant trade-marks referred to by the applicant, and absent use of any of the five registered trade-marks in Canada, little weight can be accorded the opponent's state of the register evidence.

Having regard to the inherent weakness of the trade-mark THE VIRGINIAN, and absent evidence that the trade-mark has acquired some measure of notoriety in Canada, I am of the view that it should be accorded a narrow ambit of protection. Accordingly, and as there is but a limited degree of resemblance between the trade-marks at issue, I have concluded that there would be no reasonable likelihood of confusion between the trade-mark WEST VIRGINIA and the registered trade-mark THE VIRGINIAN. I have therefore rejected the opponent's Section 12(1)(d) ground of opposition.

The fourth ground of opposition relating to the alleged non-distinctiveness of the applicant's trade-mark is founded on an allegation of confusion between the applicant's trade-mark WEST VIRGINIA and the registered trade-mark THE VIRGINIAN which the opponent claims that it has used in association with "processed meats". However, no evidence has been furnished by the

opponent that it has used the trade-mark THE VIRGINIAN in Canada, as opposed to the use being by Kretschmar Inc., its wholly-owned subsidiary and the owner of the registration for the trade-mark THE VIRGINIAN. Accordingly, I have dismissed the final ground of opposition.

In view of the above, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF JUNE, 1995.

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