



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

**Citation: 2013 TMOB 62**  
**Date of Decision: 2013-03-26**

**IN THE MATTER OF AN OPPOSITION  
by Image Intellectual Property Law  
Professional Corporation to application  
No. 1,475,543 for the trade-mark MRS.  
PAUL'S in the name of Pinnacle Foods  
Group LLC**

[1] On April 1, 2010, Pinnacle Foods Group LLC (the Applicant) filed an application to register the trade-mark MRS. PAUL'S (the Mark) based on use and registration of the Mark in the United States of America in association with frozen foods, namely fish and shell fish. The application was advertised for opposition purposes in the *Trade-marks Journal* of September 1, 2010.

[2] On November 1, 2010, Image Intellectual Property Law Professional Corporation (the Opponent) filed a statement of opposition against the application for the Mark. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[3] In support of its opposition, the Opponent filed an affidavit of Melissa Prado plus certified copies of the files from the Canadian Intellectual Property Office (CIPO) for the present application as well as for registration Nos. TMA422,878 and TMA216,273.

[4] The Applicant elected to not file any evidence and to not cross-examine Ms. Prado.

[5] Both parties filed a written argument and participated in an oral hearing.

## Grounds of Opposition

[6] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, RSC 1985, c T-13 (the Act) are reproduced below:

- (i) Pursuant to section 38(2)(b) of the [Act], the trade-mark MRS. PAUL'S is not registrable. In particular, MRS. PAUL'S is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years, contrary to section 12(1)(a) of the Act, and it has not been used in Canada by the applicant or its predecessor in title as to have become distinctive at the date of filing of the application or to acquire distinctive character at any relevant date.
- (ii) Pursuant to section 38(2)(d) of the Act, the trade-mark MRS. PAUL'S is not distinctive. In particular, it does not actually distinguish any wares or services from the wares or services of others, nor is it adapted so to distinguish them, as it is not in use with any wares or services in Canada, nor has it been at any identifiable point in time. The applicant and/or its predecessor(s) in title have twice failed to produce any evidence of use of the trade-mark in the face of a notice issued pursuant to section 45 of the Act, resulting in the expungement of trade-mark registration No. TMA,216,273 on February 22, 1991 and the imminent expungement of trade-mark registration No. TMA422,878, both for MRS. PAUL'S.

## Onus and Material Dates

[7] 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].

[8] The material dates for assessing each of the grounds of opposition are as follows: re the section 12(1)(a) ground, the date of filing of the application [*Calvin Klein Trademark Trust v Wertex Hosiery Inc* (2004), 41 CPR (4th) 552 (TMOB)]; and re the distinctiveness ground, the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

## Preliminary Comment

[9] The Opponent has evidenced that this is the third time that the Mark has been the subject of an application for registration. It was the subject of application No. 375,216 which was filed on May 14, 1974; that application issued to registration under No. TMA216,273 on September 24, 1976 but was expunged on February 22, 1991 for failure to provide evidence of use in Canada in response to a section 45 notice. A second application for registration of the Mark was filed on May 6, 1991 (application No. 681,451); that application issued to registration under No. TMA422,878 on February 4, 1994 but was expunged on February 28, 2011 for failure to provide evidence of use in Canada in response to a section 45 notice (the section 45 notice issued March 10, 2010).

[10] The Opponent submits that it is an abuse of the system for consecutive applications to be filed to register a trade-mark that cannot be maintained on the register due to lack of use. It submits that the legislators could not have intended that someone could maintain protection for a trade-mark that is the subject of a vulnerable registration simply by refiling. The Opponent classifies this as a loophole in the Act that ought to be closed. Of course, the Applicant disagrees.

[11] Whether or not consecutive replacement applications ought to be allowed is not a matter to be decided in opposition proceedings.

## Section 12(1)(a) Ground of Opposition

[12] In *Jurak Holdings Ltd v Matol Biotech Laboratories Ltd* (2007), 64 CPR (4th) 195 (TMOB), affd 69 CPR (4th) 321 (FC), Member Carrière summarized the test under section 12(1)(a) as follows, at paragraph 16:

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of Trade-marks) v. Coles Book Stores Ltd.*, [1974] S.C.R. 438, 4 C.P.R. (2d) 1, *Gerhard Horn Investments Ltd. v. Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 (F.C.T.D.), and *Standard Oil Co. v. Canada (Registrar of Trade Marks)*, [1968] 2 Ex.C.R. 523, 55 C.P.R. 49. As set out in those cases the test under s. 12(1)(a) is two fold:

- 1) The first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died;

- 2) If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the Mark is "primarily merely" a name or surname rather than something else.

[13] In order to meet its initial burden with respect to the first condition of the test, the Opponent relies on the fact that Ms. Prado located 9,492 Canadian telephone listings wherein the last name is "Paul". Ms. Prado provided four representative pages of her search results, with 50 results per page. The four pages list the names, addresses and telephone numbers of both male and female individuals with the surname Paul.

[14] The Applicant submits that the evidence does not satisfy the Opponent's initial burden because there is no evidence of any married female who would be referred to as Mrs. Paul. However, it seems to me that it is a matter of common sense to accept that if there are 9,492 individuals with the last name of Paul then at least one of these individuals will be either i) a woman who has married a Mr. Paul and who is therefore referred to as Mrs. Paul or ii) a married man whose wife would be referred to as Mrs. Paul. The Applicant submitted that this was an unacceptable leap of logic, but I consider it to be a straightforward inference. In this regard, I note the following direction from the Federal Court at paragraph 48 in *Ontario Teachers' Pension Plan Board v Attorney General of Canada* (2011), 89 CPR (4th) 301, affd 99 CPR (4th) 213 (FCA):

In *Neptune S.A. v Canada (Attorney General)*, 2003 FCT 715 (*Neptune S.A.*), Justice Martineau stated that the decision maker must not only consider the evidence at his or her disposal but also common sense in the assessment of the facts. Therefore, in assessing the validity of a proposed trade-mark, one must consider not only the evidence but have regard to common sense.

[15] The Applicant noted that the trade-mark examination section of CIPO has not objected to the Mark under section 12(1)(a). However, the examination section does not have before it evidence that is filed by parties in an opposition proceeding and a decision by the examination section of CIPO is not binding on this Board [*Interdoc Corporation v Xerox Corporation* (November 25, 1998 TMOB (unreported), application No. 786,491)].

[16] In support of its position that MRS. PAUL'S is objectionable under section 12(1)(a), the Opponent points to the following comments concerning MR. CHRISTIE'S in *Procter & Gamble Inc v Nabisco Brands Ltd* (1988), 22 CPR (3d) 303 (TMOB) at pages 305-306:

With respect to the second and third grounds of opposition, the MacKendrick affidavit establishes that Christie is a common surname in Canada. Furthermore, that affidavit establishes that many males have the surname Christie. Thus, the possessive form Mr. Christie's is a name or surname. And given the numbers of individuals having the surname Christie and the absence of any other common meaning for the word, Mr. Christie's would be perceived by the average Canadian as primarily merely the name or surname of a living individual.

[17] The Applicant submits that the above comments are *obiter dicta* because the trade-mark at issue in the *Procter & Gamble* case was actually MR. CHRISTIE'S CRISP 'N CHEWY. Whether or not the quote above is *obiter dictum*, I consider it to express a sound and useful approach.

[18] The Applicant also submits that the *Procter & Gamble* case is distinguishable from that at hand because it was based on evidence that there were male individuals with the surname Christie, who could be referred to as Mr. Christie, whereas there is no evidence in the present case that the female individuals who have the surname Paul could be referred to as Mrs. Paul, because there is no evidence that they are married. I have already expressed my view on the need to evidence that one of the thousands of Paul individuals is part of a married couple.

[19] As I have found that the Opponent has met its initial burden with respect to the first part of the test under section 12(1)(a), I now turn to the second part of the test pursuant to which I must determine if in the mind of the average Canadian consumer the Mark is "primarily merely" a name or surname rather than something else.

[20] The parties agree that Paul is a common first name. The Applicant argues that because "PAUL" has more than one meaning, the average Canadian consumer would not necessarily respond to the Mark as a surname. In support, it refers to *Anglo Canadian Housewares LP v Glaskoch Jr GmbH & Co KG* (2006) CarswellNat 5375 (TMOB). That opposition proceeding dismissed a section 12(1)(a) ground of opposition because the evidence supported a conclusion that the average Canadian would not perceive the word LEONARDO as primarily merely a surname or name of an individual but rather as a first name. However that case is distinguishable on several bases. Unlike the present case, in *Anglo Canadian Housewares* there was evidence that the majority of references to LEONARDO was as the first name of an individual. More importantly, whereas the word LEONARDO was not accompanied by anything that would

suggest that it was a surname rather than a first name, the inclusion of the title MRS. in the Mark makes it clear that PAUL is being used in a surname sense.

[21] The Opponent has met its initial burden under section 12(1)(a) and the Applicant has failed to meet its legal burden because I am not satisfied on a balance of probabilities that the average Canadian consumer as of April 1, 2010 would have responded to the Mark as something other than the name or surname of a living individual. The section 12(1)(a) ground of opposition therefore succeeds.

#### Distinctiveness Ground of Opposition

[22] To the extent that the distinctiveness pleading relies simply on the lack of use of the Mark, the pleading does not raise a valid ground of opposition. While the Applicant elected to not file evidence showing that the Mark is in use in Canada, the Applicant is not required to have used the Mark in Canada given that the application is based solely on use and registration of the Mark in the United States of America. If one considers only the wording contained in paragraph (ii) of the pleadings, then the distinctiveness ground is dismissed.

[23] However, if one reads the facts alleged under paragraph (i) of the pleadings into the distinctiveness pleading, then the pleading becomes that the Mark is not inherently distinctive because it is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years. As pointed out by the Opponent, there is no evidence that the Applicant has ever used or promoted the Mark in Canada and therefore no evidence that the Mark had acquired distinctiveness in Canada as of November 1, 2010. In these circumstances, the fate of the distinctiveness ground would be tied to the fate of the section 12(1)(a) ground, with the result that the distinctiveness ground would also succeed.

[24] I note that a similar outcome occurred in *Jurak Holdings* where Member Carrière concluded as follows in regards to a distinctiveness ground of opposition, at page 206:

As the Mark consists primarily merely the name of an individual who has died within the last thirty years and in the absence of evidence that would prove that the Mark acquired distinctiveness at the relevant date, I conclude that the Mark could not served [*sic*] to distinguish the Wares from the wares and services of others. The fourth ground of opposition is therefore maintained.

Disposition

[25] 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.

---

Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office