

**In THE MATTER OF AN OPPOSITION by  
Natrel Inc to Application No. 884768 for the  
Trade-mark HUNT'S TOURBILLON filed  
by Hunt Wesson Inc.**

**I      The Pleadings**

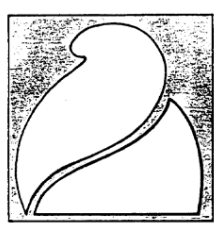
On July 16, 1998, Hunt Wesson, Inc filed an application, based on proposed use, to register the trade-mark HUNT'S TOURBILLON (the "Mark"), application number 884768, in association with food product, namely puddings and gelatine (the "Wares"). This application was subsequently assigned to ConAgra Grocery Products Company (the "Applicant").

On April 5, 2000, the application was advertised in the Trade-marks Journal for opposition purposes. On June 5, 2000, Natrel Inc filed a statement of opposition, a copy of which was forwarded on July 18, 2000, to the Applicant. There were successive assignments of the rights of Natrel Inc in this opposition to Agropur Cooperative and then from the latter to M.T.Y. Dairy Bars Inc. (The term "Opponent" shall be used throughout to refer to the entity who was the opponent at the relevant time).

The grounds of opposition can be summarized as follow:

- 1) The Application does not conform with the requirements of the provisions of Section 30 of the Trade-marks Act (the "Act") in that the Wares are not described in ordinary commercial terms;
- 2) The Mark is not registrable in view of the provisions of section 12(1)(d) of the Act in that it creates confusion with the Opponent's registered trade-marks:
  - i) TOURBILLON registered on September 15, 1989, under number TMA360323, in association with ice cream;
  - ii) Representation of a "tourbillon" as illustrated hereinafter, registered under number TMA414612 in

association with ice cream and for the services of the operation of dairy bars:



- 3) The Applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act in that, as of the Applicant's filing date, the Mark created confusion with the "tourbillon" design mark as illustrated above and the trade-mark TOURBILLON; and
- 4) The Mark is not adapted to distinguish the products of the Applicant from those of the Opponent in view of the confusion with the Opponent's trade-marks mentioned above.

In its counter statement filed on August 18, 2000, the Applicant denied the allegations contained in the Opponent's statement of opposition. Both parties filed written submissions and were represented at an oral hearing.

## **II The Opponent's evidence**

The Opponent's evidence consists of Mr Jean-Paul Clément's affidavit together with exhibits JPC-1 to JPC-11 inclusive. He described himself as "Chef Emballage Merchandising" of the Natrel division of Agropur Coopérative, the Opponent's predecessor in title.

The chain of title can be described as follows: By deed of assignments signed on March 1<sup>st</sup>, 2001, filed as exhibits JPC-3 and JPC-4, Agropur Coopérative acquired, as of December 1<sup>st</sup>, 2000, Natrel Inc's assets including the abovementioned registered trade-marks and the rights in this opposition. By deed of assignment dated December 7<sup>th</sup>, 2001, Agropur Coopérative transferred those rights and interests to Ultra'Lait Québec Inc, which changed its name on December 10, 2001, to M.T.Y. Dairy Bars Inc.

Copies of the pertinent web pages of the Strategis database, to establish that the Opponent is the registered owner of the trade-marks listed above, were also filed as exhibits.

Mr Clément alleges that licensees operate dairy bars under the trade-mark LA CRÉMIÈRE. Exhibit JCP-5 is a copy of a catalogue that includes under the heading “Garnitures à TOURBILLON”, a listing of the toppings, such as candies: M & M, SMARTIES, and chocolate bars: KIT KAT, COFFEE CRISP, that could be added on top of the ice cream sold by the licensees.

Exhibit JCP-6 is a copy of photographs taken in 1993 sent to the franchisees on which appears, on the top portion of the picture, the trade-mark TOURBILLON, while such illustration depicts containers that would appear to contain ice cream with different toppings. The containers bear the trade-mark LA CRÉMIÈRE and Design that is different than the “tourbillon” design trade-mark illustrated above, as appears from a representation of said design:

We have no information as to how that picture was used by the Opponent’ s franchisees in the operation of a dairy bar in association with the trade-mark LA CRÉMIÈRE.

Exhibit JCP-7 is a sample of a plastic bag on which is printed a rebate coupon bearing the trade-mark TOURBILLON. We have no information in the affidavit as to how many of these bags were in circulation, during which period of time they were in circulation (there is a sticker on

each bag providing the distribution period but such information does not form part of the affidavit) and in which area they were distributed.

Exhibits JCP-8 to JCP-11 inclusive are samples of promotional material used by the franchisees, on which appear the Opponent's trade-mark TOURBILLON and illustrating containers filled with ice cream and toppings, the containers bearing the trade-mark LA CRÉMIÈRE and Design as illustrated above.

None of the exhibits filed illustrate use of the trade-mark "tourbillon" design, as registered under number TMA 414612. The deponent alleges that the Opponent has spent between \$5000 to \$10000 per year to promote the products bearing the trade-mark TOURBILLON. Finally, the total sales of products bearing the trade-mark TOURBILLON for the period between 1996 and 2000 were approximately \$150,000.

### **III The Applicant's Evidence**

The Applicant filed the affidavit of Ms Girlie A Harrel, a legal assistant with the Applicant. She filed as Exhibit A to her affidavit a photocopy of the following registrations:

- a) HUNT'S SNACK PACK TOURBILLON, TMA449161; and
- b) HUNT'S SNACK PACK SWIRL, TMA446611

She states that the Applicant has been using in Canada the trade-mark HUNT'S SNACK PACK TOURBILLON in association with the Wares since at least as early as June 30, 1994. On some of the invoices filed, the word "tourbillon" appears but not the trade-mark HUNT'S SNACK PACK TOURBILLON. Moreover a trade-mark on an invoice does not necessarily equate to evidence of use of a trade-mark in association with wares. The sales figures for puddings and gelatine bearing HUNT'S SNACK PACK TOURBILLON were provided for the period between 1995 and 2000 inclusive. I shall discuss hereinafter the relevancy of this information in the context of this opposition proceeding.

#### **IV The Opponent's reply evidence**

The Opponent filed, as reply evidence, the affidavit of Mr André Casavant. Since 2001, he has been the Opponent's vice-president. He visited two Super C grocery stores in order to buy the products identified in the affidavit of Ms Harrel, but was not successful in locating any of them. He did find, however, two puddings, filed as AC-1 and AC-2, one bearing the trade-mark HUNT'S SNACK PACK and design and the other bearing the trade-mark HUNT'S SWIRLS TOURBILLON and design.

The deponent alleges that such evidence raises doubts as to use by the Applicant of the trade-marks HUNT'S SNACK PACK TOURBILLON and HUNT'S SNACK PACK SWIRL and in the accuracy of the Applicant's sales figures of puddings and gelatine bearing said trade-marks.

#### **V The law**

The Applicant has the legal onus to show that its application complies with the provisions of Section 30 of the Act, but there is, however, an initial evidential burden on the Opponent to establish the facts upon which it relied in support of its grounds of opposition. Once this initial burden is met, the Applicant still has to prove that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The first ground of opposition is dismissed as the Opponent failed to file any evidence to support said ground of opposition.

The material time for considering the issue of non-entitlement based on Subsection 16(3) of the Act is the filing date of the application (July 16, 1998) [See Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the statement of opposition (June 5, 2000) while registrability under 12(1)(d) must be assessed as of the date of my decision. [See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d)

*126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)]*

The main issue with respect to each remaining grounds of opposition raised in the statement of opposition is the likelihood of confusion between the Mark and the Opponent's trade-marks.

The likelihood of confusion must be assess from the point of view of an average consumer with an imperfect recollection of the Opponent's trade-marks and placed in contact with the Wares bearing the Applicant's Mark: would he think that the Wares originate from the Opponent?

The test for confusion is set forth in Section 6(2) of the Act and I must have regard to all the surrounding circumstances, including those listed in Section 6(5): the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R. (3d) 483 (F.C.T.D.)* and *Gainers Inc. v. Marchildon (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)*].

I shall dispose first of the third ground of opposition. The Opponent failed to adduce sufficient evidence to meet its initial burden with respect to this ground of opposition. The Opponent had to prove that it used its trade-marks prior to the filing date of the present application and that it did not abandoned such use as of the date of advertisement of the application in the Trade-Marks Journal [Sections 16(3) and (5) of the Act]. The term "use" is defined in Section 4 of the Act. I have no evidence that, at the time of transfer of property of ice cream at the various franchisees' locations, there was an association between the ice cream sold to the customer and the trade-mark TOURBILLON. There is no evidence that the display cards filed as Exhibits JCP-8 and JCP-9 were ever used by the franchisees and if so in what manner. The fact that they were delivered to the franchisees does not necessarily imply that they were put on display inside the premises in such a way that the customer could make an association between the ice cream

bought and the trade-mark TOURBILLON. Finally, there is no evidence of use of the trade-mark “tourbillon” design as illustrated above. Under these circumstances, this ground of opposition is also dismissed.

As there is no evidence of use of the Opponent’s trade-marks for the reasons outlined above, the Opponent has also failed to meet its initial burden with respect to the fourth ground of opposition. It is, therefore, dismissed.

The Opponent has provided some evidence that it is the owner of the trade-marks TOURBILLON and the representation of a “tourbillon” and design, registration numbers TMA360323 and TMA414612. It might not be the best evidence as it did not file certificates of authenticity of those registrations but, in any event, I have discretion to verify the state of the Register when the registrability of a trade-mark is contested on the basis of likelihood of confusion with registered trade-marks. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11C.P.R. (3d) 410] I did use my discretion and can confirm that those registrations are in good standing and owned by the Opponent. Therefore, it has discharged its initial burden and as such the Applicant must convince the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent’s registered trade-marks at the abovementioned relevant dates [see *Sunshine Biscuits Inc. c. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53 and *Christian Dior, S.A. v. Dion Neckwear Ltd* [2002] 3 C.F.405].

I shall determine the likelihood of confusion, as of the date of my decision, between the Mark and the Opponent’s registered trade-mark TOURBILLON, certificate of registration TMA360323, as it would appear to be the best case scenario for the Opponent.

- a) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known.

The parties’ trade-marks are inherently distinctive as neither of them have an apparent meaning related to the parties’ respective wares and services.

The degree of distinctiveness of a trade-mark can be enhanced through its use. As discussed above, there is no evidence of use of the Opponent's registered trade-mark TOURBILLON. The Applicant, on the other hand, has not filed any evidence of "use" of the Mark, within the meaning of the provisions of Section 4 of the Act. The Applicant is arguing that it can rely on the Opponent's reply evidence to establish "use" of the terms "HUNT'S, SNACK PACK, SWIRL and TOURBILLON". The mark in issue is HUNT'S TOURBILLON. The exhibits filed by Mr Casavant established use of the trade-marks: HUNT'S SNACK PACK and design, HUNT'S SWIRLS TOURBILLON and design and HUNT'S SWIRLS and design. The dominant features of these trade-marks are the design format of the word SWIRLS and the script format of the words SNACK PACK. As such, I do not consider any of these exhibits to constitute "use" of the Mark. [See *Registrar of Trade Marks v. CII Honeywell Bull*, [1985] 1 F.C. 406, at 408]. Finally the sales figures mentioned in Ms. Harrel's affidavit, notwithstanding the fact that such information alone does not constitute evidence of use of the Mark, are not broken down by trade-mark. Therefore I cannot conclude that they represent sales figures of the Mark. I shall discuss the family of trade-marks argument raised by the Applicant in its written submissions under the heading additional surrounding circumstances.

In order for a trade-mark to be known, it has to be used in association with wares or services. As I do not have proper evidence of use of the respective parties' trade-marks in issue, I cannot conclude that one trade-mark is more known than the other.

In so far as the information contained on the certificate of registration TMA360323 that a declaration of use was filed on June 23, 1989, I refer to *Entre Computer Centers, Inc v. Global Upholstery Co (1992)*, 40 C.P.R. (3d) 427 (T.M.O.B.), where Board member Mr. David J. Martin stated that we can only infer from said information a "de minimis" use that is not sufficient to conclude that the trade-mark has become known.



- b) The length of time the trade-marks or trade-names have been in use.

Having already concluded that there is no proper evidence of use of the respective parties' trade-marks in issue, this factor does not favour any of the parties.

- c) The nature of the wares, services, or business.

The Opponent is arguing that puddings, gelatine and ice cream can be classified as snack food and as such there would be some overlap in the nature of the wares. The Applicant is taking the position that the Opponent's ice cream would be located in freezers while its pudding and gelatine would be on regular shelves of grocery stores. I do not think that the location of the Wares is a criteria to establish a difference in the nature of the wares. Puddings and ice cream are desserts and have both a dairy source. Therefore, this factor does favour the Opponent.

- d) The nature of the trade.

There is evidence from Mr Casavant's affidavit that puddings can be purchased at grocery stores. It would appear that the Opponent's ice cream is sold at its franchisees' outlet operated under the trade-mark LA CRÉMIÈRE. There is, however, no restriction in the certificate of registration TMA360323 that would limit the sale of the Opponent's ice cream under the trade-mark TOURBILLON to the dairy bars operated by its franchisees under the trade-mark LA CRÉMIÈRE. (See *Cartier Inc. v. Cartier Optical Ltd. (1998)*, 20 C.P.R. (3d) 68 at 74 (F.C.T.D.) and *Senza Inc. v. Apparel Ventures, Inc. (2001)*, 14 C.P.R. 243 at 249 (T.M.O.B.)) Therefore, there is a possibility of overlap as ice cream, puddings and gelatine are all sold in grocery stores.

- e) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

With respect to this criterion, Mr. Justice Cattanach stated in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd. (1980)*, 47 C.P.R. (2d) 145, *conf.* 60 C.P.R. (2d) 70:

“Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

I will also refer to description of the test of confusion made by Mr. Justice Cattanach in *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975), 25 C.P.R. (2d) 1:*

«To determine whether two trade marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

In considering the similarity of trade marks it has been held repeatedly that it is not the proper approach to set the marks side by side and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression. I therefore propose to examine the two marks here in dispute not for the purpose of determining similarities and differences but rather to assess the attitude of the average reasonable purchaser of the wares as a matter of first impression.»

There is some resemblance between HUNT'S TOURBILLON and TOURBILLON, both visually and sound. The dominant feature of both marks is the word “tourbillon”. Mr Justice Linden in *United Artists Corp v. Pink Panther Beauty Corp (1998), 80 C.P.R. (3d) 247(F.C.A.)* made the following observation:

“While the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.”

In *Manufacturiers de Bas de Nylon Doris Ltée/Doris Hosiery Mills Ltd v. Victoria's Secret, Inc. (1991)*, 39 C.P.R. (3d) 131, the former Chair of the Trade-Marks Opposition Board, Mr. Gary Partington, was facing a similar situation where the applicant was trying to register the trade-mark VICTORIA'S SECRET over the opponent's registered trade-mark SECRET. On the issue of degree of resemblance, he concluded by stating:

“As for the degree of resemblance between the trade marks at issue, I consider there to be a fair degree of similarity between the applicant's trade mark VICTORIA'S SECRET and the opponent's registered trade mark SECRET in both appearance and sounding. I would also note that the applicant has included the entirety of the applicant's registered trade mark SECRET in its VICTORIA'S SECRET trade mark.”

[See to the same effect *Governor and Co of Adventurers of England trading into Hudson's Bay v. Hallmark Cards, Inc (2003)*, 30 C.P.R. (4<sup>th</sup>) 231 (TMOB)]

This factor does favour the Opponent.

f) Additional surrounding circumstances.

The Applicant is arguing, in its written submissions, that the term “Hunt’s” has been used to distinguish the Applicant’s wares from those of other traders for several years. I have already discussed the issue of “use” of the Applicant’s registered trade-marks referred to in Ms. Harrel’s affidavit. In its written submissions, the Applicant is raising the existence of other registered trade-marks incorporating the term “Hunt’s”. These registrations have not been identified in the Applicant’s counter statement or cited in the Applicant’s evidence. The Applicant is arguing that the Registrar can check the Register to determine the existence of the other registrations relied upon. I already referred to *Quaker Oats of Canada Ltd, supra*. However in the present situation, the Applicant would like to argue the existence of a family of trade-marks. Such fact must be established through its evidence. Moreover, when the Applicant is relying on a family of trade-marks, it must prove that each of the marks, part of said family of trade-marks, have been in use

in Canada. [See *McDonald's Corporation et al. v. Yogi Yogurt Ltd. et al. (1982)*, 66 C.P.R. (2d) 101 (FCTD)] There is no such evidence in the present record.

## **VI Conclusion**

My analysis of the evidence in the context of the criteria listed under Section 6(5) of the Act leads me to conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that its Mark would not lead to a likelihood of confusion with the Opponent's registered trade-mark TOURBILLON when used in association with the Wares. I reach this conclusion on the basis of the combination of the following factors:

- a) The degree of resemblance between the marks in issue; and
- b) The nature of the wares and the trade.

Having been delegated authority by the Registrar of Trade-marks by virtue of Subsection 63(3) of the Act, I refuse the application to register the Mark, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 15<sup>th</sup> DAY OF MARCH 2005.

Jean Carrière,  
Member,

Trade-marks Opposition Board