

IN THE MATTER OF AN OPPOSITION by Ralston Purina Company
to application No. 834,545 for the trade-mark BURGHAM PRO PLUS
filed by Burgham Sales Ltd.

On January 24, 1997, the applicant, Burgham Sales Ltd., filed an application to register the trade-mark BURGHAM PRO PLUS based on proposed use in association with the following wares:

“Pet supplies, namely aquarium pumps, filters, ornaments, gravel, plants; shampoos, grooming equipment, namely manicure sets, nail files, scissors, nail trimmers, combs, brushes, rakes, dematting tools, shedding tools, hair trimmers and grooming tables; toys, collars, and leashes.”

The application was advertised for opposition purposes on September 24, 1997.

The opponent, Ralston Purina Company, filed a statement of opposition on February 16, 1998. The first ground of opposition is that the applicant's application does not comply with s.30(a) of the *Trade-Marks Act*, R.S.C. 1985, c.T-13 (hereinafter the Act) because the application does not contain in ordinary commercial terms all of the specific wares in association with which the said mark is proposed to be used. This ground of opposition was subsequently withdrawn at the oral hearing stage. As its second ground of opposition, the opponent maintains that the application does not comply with s.30(e) of the Act because the applicant does not intend to use the proposed trade-mark but rather intends to use the trade-mark PRO PLUS which is the subject of application 782,247 filed May 8, 1995. The third ground of opposition is that, pursuant to s.12(1)(d) of the Act, the proposed trade-mark is not registrable in that it is confusing with the opponent's trade-mark registration TMA 346,960 for the trade-mark PRO PLAN used in association with pet food. The opponent's fourth ground of opposition is that the applicant is not the person entitled to register the proposed trade-mark under s.16(3)(a) of the Act in that as of the applicant's January 24, 1997 filing date, the proposed trade-mark was confusing with opponent's trade-mark registration TMA 346,960 for the trade-mark PRO PLAN. The final ground of opposition is that the applicant's proposed trade-mark neither distinguishes nor is adapted to distinguish the applicant's wares from the pet food marketed and sold in Canada in association with the opponent's trade-mark PET PLAN (*sic*).

The applicant filed and served a counter statement on April 16, 1998, in which it generally denied the allegations asserted by the opponent in its statement of opposition. As its evidence, the opponent submitted the affidavit of Louis P. De Pasqua, Secretary and Treasurer of Ralston Purina Canada Inc. The affidavits of Peter Schlichtmann, Director of Burgham Sales Ltd. and Stephen Dilworth, Trade-Mark Searcher employed by the applicant's agent, were

submitted as the applicant's evidence. In reply, the opponent submitted the affidavits of Robin Black, Regional Sales Manager for the Province of Ontario for Ralston Purina Canada Inc. and Debbie L. Valois, Employee of the opponent's agent. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As a preliminary matter, at the oral hearing the applicant's agent objected to the Black affidavit as not being proper reply evidence. The applicant's agent submitted that the opponent's evidence in chief (submitted by way of the DePasqua affidavit) was silent on the issue of use of either the mark BURGHAM PRO PLUS or PRO PLUS. Since this issue was not raised in the opponent's evidence in chief, the applicant did not consider it necessary to address this issue by way of its Rule 42 evidence. Given that neither of the applicant's affiants addressed the issue of use of either the mark BURGHAM PRO PLUS or PRO PLUS in their affidavits, and the fact that neither affiant was cross-examined on his affidavit, it is the applicant's submission that the opponent could not submit evidence of use of the applicant's PRO PLUS mark as evidence in reply.

The opponent's agent submitted that the reason Mr. Black's evidence had not been included in the opponent's evidence in chief is because it was not available at the time the opponent's evidence in chief was filed (*i.e.* November 16, 1998). In this regard, the opponent's agent submits that Mr. Black had not become aware of pet accessories sold by the applicant under the PRO PLUS trade-mark until four months before the swearing of his affidavit (*i.e.* November 15, 1999). He further submitted that Mr. Black's evidence was proper reply evidence since Mr. Schlichtmann stated at paragraph 5 of his affidavit that his company did intend to use the trade-mark BURGHAM PRO PLUS. It was also his submission that if the applicant had wished to submit additional evidence after the filing of the Black affidavit, it could have requested leave to do so under Rule 44(1) of the *Trade-Mark Regulations*.

In my view, although I agree with the applicant's agent that it would have been preferable if the opponent had included the evidence of Mr. Black as its evidence in chief, the opponent's agent has sufficiently explained why it was not able to do so in the present case. Further, I consider that the marketplace evidence of use of the applicant's PRO PLUS mark rebuts Mr. Schlichtmann's statement at paragraph 5 of his affidavit that his company intended to use the trade-mark BURGHAM PRO PLUS. Also, as pointed out by the opponent's agent, had the applicant wished to submit additional evidence after the Black affidavit was filed, it could have requested leave to do so under Rule 44(1) of the Regulations. I therefore find that the affidavit of

Mr. Black constitutes proper reply evidence and is therefore admissible.

The opponent's second ground of opposition is based on the provisions of Section 30(e) of the Act. Section 30(e) of the Act reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing...
(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;...

The material time for assessing the applicant's compliance with s.30(e) is the filing date of the application. Although the legal burden with respect to this ground is on the applicant (see the opposition decisions in **Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.** (1984), 3 C.P.R. (3d) 325; **Canadian National Railway Co. v. Schwauss** (1991), 35 C.P.R. (3d) 90 (hereinafter **Schwauss**), and **John Labatt Ltd. v. Molson Companies Ltd.** (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)), there is an initial evidential burden on the opponent respecting its allegations of fact in support of a s. 30 ground. That burden may be lighter respecting the issue of non-compliance with s. 30(e) of the Act: see page 95 of the **Schwauss** decision and the opposition decision in **Green Spot Co. v. J.B. Food Industries Inc.** (1986), 13 C.P.R. (3d) 206 at 210-211 (hereinafter **Green Spot**).

The applicant's application formally complies with s. 30(e) of the Act since the required statement appears in the application. The issue then becomes whether or not the applicant has substantially complied with s. 30(e) -- *i.e.* is the applicant's statement that it intended to use the applied for trade-mark true?

The opponent's agent argued extensively about why it considers that the opponent has met its burden under s.30(e) in the present case. First, he explained the background of the BURGHAM PRO PLUS mark. In this regard, the opponent's agent pointed to the fact that prior to applying for the BURGHAM PRO PLUS mark, the applicant applied for the mark BURGHAM in 1978 for pet supplies, and for the mark PRO PLUS on May 8, 1995, also for pet supplies. In January of 1999, the applicant withdrew its PRO PLUS application, but did so without prejudice to any and all of its common law rights in the mark.

Next, the opponent pointed to the evidence it submitted by way of the Black affidavit. This marketplace evidence shows that on November 1st 1999, five different pet shampoo products and a pet breath freshening product sold by the applicant under the trade-mark PRO

PLUS were bought at a retail store by Mr. Black. The packages for such products were attached as Exhibits 1-6 to Mr. Black's affidavit and the opponent submits that the use shown on the packaging is that of PRO PLUS and not of BURGHAM PRO PLUS. The opponent's agent further submits that at the time the applicant applied to register the trade-mark BURGHAM PRO PLUS, it actually intended to use the mark PRO PLUS in the manner evidenced in the exhibits attached to Mr. Black's affidavit.

In making its submissions under this ground, the opponent referred to various jurisprudence, including the following passage from the decision in **Canadian National Railway v. Schwauss** (1991), 35 C.P.R. (3d) 90 at 95 (quoting from **Tune Masters v. Mr. P's MasterTune Ignition Services Ltd.** (1986), 10 C.P.R. (3d) 84 at 89):

[Cross on Evidence, 6th ed. (1985), at p.121]

“The most that can be said by way of generalisation is that a party's knowledge of essential facts may lessen the amount of evidence required to discharge an evidential burden borne by his adversary.”

As stated by Buckley L.J. in *Dunlop Holdings Ltd.'s Appl'n*, [1979] R.P.C. 523 at p. 544:

“Where the relevant facts are peculiarly within the knowledge of one party, it is perhaps relevant to have in mind the rule as stated in *Stephen's Digest*, which is cited at page 86 of *Cross on Evidence*:

In considering the amount of evidence necessary to shift the burden of proof, the court has regard to the opportunities of knowledge with respect to the facts to be proved which may be possessed by the parties respectively.”

"This does not mean", Sir Rupert continues, "that the peculiar means of knowledge of one of the parties relieves the other of the burden of adducing some evidence with regard to the facts in question, although very slight evidence will often suffice."

Although I agree with the general principles enunciated above, and although I agree with the opponent that the Black affidavit shows use by the applicant in the marketplace of the trade-mark PRO PLUS and not the applied for mark BURGHAM PRO PLUS, I am not satisfied that the evidence adduced in the present case is sufficient to meet the opponent's evidential burden under s.30(e). In this regard, I do not consider that marketplace evidence of use of a different trade-mark than the applied for mark by the applicant, three years after the date of filing, is sufficient by itself to cast doubt on the applicant's intention to use its proposed mark at the date it filed its application. In deciding this issue, I had regard to the following comments of Chairman Partington in **Green Spot, supra**, at p. 211:

“In the present case, it is apparent that the applicant alone would be aware of its intentions to use its trade-mark in this country and it elected not to file any evidence in this opposition proceeding, thus avoiding the possible scrutiny of such evidence by way of cross-examination. Accordingly, the evidential burden on the opponent to adduce evidence in support of the allegation set forth in its statement of opposition is less than would otherwise be the case in an ordinary situation”.

As the applicant's agent pointed out, the present case can be distinguished from the decision in **Green Spot** because the applicant in the present case filed evidence, and that evidence was of potential relevance to the s.30(e) issue. Accordingly, I do not consider that the opponent's burden would be less than would otherwise be the case in an ordinary situation. The opponent had the opportunity to scrutinize the applicant's evidence and to find out about the applicant's intentions to use its applied for mark by asking Mr. Schlietmann directly through cross-examination but it chose not to do so. Therefore, I do not consider the opponent's evidence of the fact that the applicant was using a different mark in the marketplace three years after the date of filing its application sufficient to meet its evidential burden of showing that the applicant had no intention of using the applied for mark. Consequently, this ground of opposition is unsuccessful.

The third, fourth and fifth grounds of opposition turn on the issue of confusion between the applicant's mark and the opponent's mark PRO PLAN, Registration No. TMA 346,960. 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 material dates for considering the issue of confusion with respect to the non-entitlement, non-distinctiveness and non-registrability grounds are, respectively, the date of filing of the application (*i.e.* January 24, 1997), the date of opposition (*i.e.* Feb. 16, 1998) and the date of my decision. In the circumstances of this case, nothing turns on which material date is chosen to assess the issue of confusion.

In applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including the following specifically set forth in s.6(5) of the *Act*: a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. I will review the evidence in light of these criteria and any other surrounding circumstances.

Considering initially the inherent distinctiveness of the marks at issue (s.6(5)(a)), the opponent's trade-mark PRO PLAN is inherently very weak when used in association with the registered wares. In this regard, the component PRO connotes the idea that the opponent's pet food is of professional quality (see **Association of Professional Engineers of Ontario v. Parametric Technology Corp.** (1995), 60 C.P.R. (3d) 269 (TMOB)), and the component PLAN

suggests that the wares are designed to meet the dietary needs of one's pet.

The applicant's BURGHAM PRO PLUS mark, on the other hand, possesses somewhat more inherent distinctiveness than the opponent's mark. Although the component PRO connotes the idea that the applicant's pet accessories are of professional quality, the component PLUS merely suggests that the wares are of some added benefit and the component BURGHAM adds a slight degree of inherent distinctiveness to the mark even though it may have some surname significance.

With respect to the extent to which the trade-marks have become known (s.6(5)(a)) and the length of time the marks have been in use (s.6(5)(b)), no evidence has been furnished by the applicant to show that it has yet commenced use of its trade-mark BURGHAM PRO PLUS in Canada. On the other hand, the DePasqua affidavit establishes that the opponent's PRO PLAN mark has become well known in Canada in association with pet food. In particular, Mr. DePasqua attests in his affidavit to sales of PRO PLAN pet food in excess of \$11,600,000, \$12,900,000, \$15,100,000 and \$16,700,000 for the fiscal years 1994 through 1997, respectively. Further, Mr. DePasqua states that his company first commenced selling PRO PLAN pet food in Canada under license in 1987. Thus, the extent to which the trade-marks at issue have become known and the length of time the marks have been in use both clearly weigh in the opponent's favour in relation to its trade-mark PRO PLAN.

As for the nature of the wares of the parties (para.6(5)(c)) and the nature of the trade associated with those wares (para.6(5)(d)), it is the applicant's statement of wares and the statements of wares covered in the opponent's registrations which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground (see **Mr. Submarine Ltd. v. Amandista Investments Ltd.**, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); **Henkel Kommanditgesellschaft v. Super Dragon**, 12 C.P.R.(3d) 110, at p.112 (F.C.A.); and **Miss Universe, Inc. v. Dale Bohna**, 58 C.P.R.(3d) 38,1 at pp.390-392 (F.C.A.)). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties may be useful (see **McDonald's Corporation v. Coffee Hut Stores Ltd.**, 68 C.P.R.(3d) 168, at p.169 (F.C.A.)). Furthermore, in assessing the likelihood of confusion between trade-marks in respect of a paragraph 12(1)(d) ground, the Registrar must have regard to the channels of trade which would normally be considered as being associated with the wares set forth in the applicant's application and with the

wares covered in the opponent's registrations.

The applicant's agent submitted that the nature of the wares in the present case are different. In this regard, he relied on the decision in **Prince Edward Island Mutual Insurance v. Insurance Co. of Prince Edward Island** (1999), 86 C.P.R. (3d) 342 (hereinafter "**PEI Insurance**"), wherein the fact that one party specialized in car insurance while the other did not sell car insurance was a factor that weighed heavily against any possibility of likelihood of confusion.

In my view, the present case can be distinguished from the decision in **PEI Insurance**. In **PEI Insurance**, there was evidence that the nature of the relevant services and trade were such that "the parties interact with the public, market, advertise and sell, emphasize their business goals and identities, all in a manner so as to distinguish one from the other". In the present case, there is no evidence that the wares or trades of the parties are different. In fact, the opponent has shown in the present case that it has displayed its mark on various types of pet accessories to promote its pet food. I therefore consider the wares of the parties in the present case to be related insofar as they both are for pets. Such being the case, and in the absence of evidence to the contrary, I would consider that the parties' channels of trade would presumably overlap.

With respect to s.6(5)(e) of the Act, the applicant's agent correctly pointed out that the first component of a trade-mark is generally the most important for purposes of distinction (see **Conde Nast Publications Inc. v. Union des Editions Modernes** (1979), 26 C.P.R. (2d) 183 at 188). He also correctly noted that the trade-mark must not be dissected into its individual components but rather must be considered as a whole (see **Compagnie Gervais Danone v. Astro Dairy Products** (1999), 87 C.P.R. (3d) 262).

In the present case, the only resemblance between the parties' marks is the common use of the non-distinctive component PRO. The first components of the marks are different and when the marks are considered as a whole, the applicant's BURGHAM PRO PLUS mark is quite different from the opponent's PRO PLAN mark both in appearance and in sounding. The ideas suggested by the parties' marks are also different as the opponent's mark suggests a meal plan designed by a professional to meet the dietary needs of one's pet while the applicant's mark suggests a product of professional quality with some added benefit.

As a further surrounding circumstance in assessing the likelihood of confusion between

the trade-marks at issue, the applicant has relied on Dilworth affidavit which introduces into evidence the results of a computer search conducted by the affiant on May 19, 1999, using the CD Name Search software and database system to locate active trade-mark applications and registrations that contain the component PRO in association with the wares pet food, animal feed or vitamins or pet related accessories. Mr. Dilworth has annexed as Exhibit A to his affidavit the report generated as a result of his search. He reviewed the search results and located 72 registrations that contain the component PRO in association with the wares pet food, animal feed or vitamins or pet related accessories. Attached as Exhibit B to his affidavit are copies of those 72 registrations.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in **Ports International Ltd. v. Dunlop Ltd.** (1992), 41 C.P.R. (3d) 432 and the decision in **Del Monte Corporation v. Welch Foods Inc.** (1992), 44 C.P.R. (3d) 205 (F.C.T.D.). Also of note is the decision in **Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.** (1992), 43 C.P.R. (3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present case, excluding the registrations standing in the name of the opponent, and those registrations where the component PRO is used as part of a word as opposed to as a prefix or suffix, the results of Mr. Dilworth's search revealed the existence of at least 30 relevant registrations for marks containing the prefix PRO standing in the names of different trade-mark owners and covering wares which are related to the wares of the parties. Given the number of relevant registrations uncovered by the search, I am prepared to find that at least some of these marks were in active use in the marketplace in Canada as of the material dates in this opposition. Thus, I am satisfied that consumers have become used to seeing PRO-prefixed marks in the field of pet food, animal feed or vitamins or pet related accessories.

The applicant also submitted marketplace evidence by way of the affidavit of Peter Schlichtmann who attached to his affidavit as Exhibits B,D,G, and I, copies of pet food bags for four products (at least three of which were purchased in Canada) which use marks which include the component PRO including: 1) PROFILE; 2) PRO-PET; 3) PRO PAC and 4) PRO NATURE. This marketplace evidence is additional support to the applicant's position that the component PRO is widely used in the pet product industry. In addition, the fact that 3 of these products appear to be owned by entities identified in the opponent's evidence as customers who purchase

the opponent's PRO PLAN pet food is further support that consumers and manufacturers alike are used to distinguishing between pet products that include the component PRO.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the fact that there is not a high degree of resemblance between the marks at issue and there is common use of trade-marks in the pet product industry that incorporate the component PRO, I find that the applicant has satisfied the onus on it to show that its applied for mark is not confusing with the opponent's registered mark PRO PLAN. The remaining grounds of opposition are therefore unsuccessful.

In view of the above, and pursuant to the authority delegated to me under s.63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 21st DAY OF August, 2001.

C. R. Folz
Member,
Trade-Marks Opposition Board