

IN THE MATTER OF AN OPPOSITION by Great Pacific Industries Inc. to application no. 696,157 for the trade-mark THE BULK-PAK WAREHOUSE filed by 970007 Ontario Inc.

On January 6, 1992, the applicant, 970007 Ontario Inc., filed an application to register the trade-mark THE BULK-PAK WAREHOUSE based upon proposed use of the trade-mark in Canada in association with the following wares:

“Janitorial, cleaning and packaging supplies, namely, plastic garbage bags, detergents, paper towels, toilet paper and cleaning solutions”

and in association with the following services:

“Sale at wholesale and retail of janitorial supplies, garbage and disposal bags”

The application was subsequently amended to delete the services from the application and to disclaim the right to the exclusive use of the words “BULK-PAK” apart from the trade-mark.

The trade-mark was advertised for opposition purposes in the *Trade-marks Journal* of February 10, 1993 and the opponent, Great Pacific Industries Inc., filed a statement of opposition on July 12, 1993. As its first ground of opposition, the opponent alleged that the present application does not conform with the requirements of Section 30 of the *Trade-marks Act* in that the applicant did not really intend to use the words THE BULK-PAK WAREHOUSE as a trade-mark in association with the wares as described. Rather, the applicant intended to operate or have other persons operate a warehouse, store or other outlet under the name or designation THE BULK-PAK WAREHOUSE by selling or distributing the wares of third parties, and identified by the trade-marks or trade-names of such third parties and not any trade-mark of its own for such wares. The second ground is based on Section 12(1)(b) of the *Trade-marks Act*, the opponent alleging that the trade-mark THE BULK-PAK WAREHOUSE is not registrable in that it is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it is proposed to be used. Finally, the opponent alleged that the trade-mark THE BULK-PAK WAREHOUSE is not distinctive of the applicant because the element WAREHOUSE is common to many trade-marks and trade-names and, preceded by one or more descriptive words, the mark serves to clearly describe a place or facility which stores goods or where people may go to obtain such goods. Further, the words THE BULK-PAK WAREHOUSE are

clearly descriptive of a place or facility which stores bulk packs or bulk packages of goods or where people may go to obtain such goods. Finally, the use or advertising of the words THE BULK-PAK WAREHOUSE in association with the applicant's wares signify that the wares were obtained or available from a bulk pack warehouse and would not distinguish the applicant's wares from the wares or services of others operating a bulk pack warehouse storing or offering such wares in bulk packs.

On January 17, 1994, the applicant filed a lengthy counter statement in which it denied the opponent's allegations and attached a photocopy of sample packaging for garbage bags to show use of the mark. The opponent filed as its evidence the affidavit of Sheila McCabe, a legal secretary, who has attached to her affidavit copies of the Articles of Incorporation for 970007 Ontario Inc. and for The Bulk-Pak Warehouse Inc. The affiant also states that she telephoned operator information in Toronto and was informed that there were no listings for either company. As well, Ms. McCabe has annexed to her affidavit photocopies of dictionary listings for the words BULK, PACK and WAREHOUSE. The applicant elected not to file any evidence. However, the applicant alone filed a written argument and neither party requested an oral hearing.

The first ground of opposition is based on Section 30(e) of the *Trade-marks Act*, the opponent asserting that the applicant did not intend to use the trade-mark THE BULK-PAK WAREHOUSE in Canada. The material date with respect to the first ground is the filing date of the present application [January 6, 1992]. Further, the onus or legal burden is on the applicant to demonstrate that its application complies with the requirements of Section 30 of the Act [see *Joseph Seagram & Sons v. Seagram Real Estate* (1984), 3 C.P.R. (3d) 325, at pgs. 329-330]. However, there is an initial evidentiary burden on the opponent to adduce evidence which would support the truth of its allegations relating to this ground.

In the present case, the opponent has alleged that the applicant intended to operate or have other persons operate a warehouse, store or other outlet under the name or designation THE BULK-PAK WAREHOUSE by selling or distributing the wares of third parties and identified by the trade-marks and trade-names of such third parties and not any trade-mark of its own for such wares. In

effect, the opponent has alleged that the applicant does not intend to apply its trade-mark THE BULK-PAK WAREHOUSE to any of the wares covered in its application. Rather, according to the opponent, the applicant intends either to operate itself or have operated by another a warehouse under the trade-mark THE BULK-PAK WAREHOUSE and to sell wares through the warehouse bearing the trade-marks of third parties. Presumably, the opponent's argument is that such activities would not constitute use of the trade-mark THE BULK-PAK WAREHOUSE in association with wares but rather would constitute use of the trade-mark in association with services.

As the opponent has not filed a written argument in this opposition, I can only assume that it is relying upon the copies of the Articles of Incorporation issued by the Ontario Ministry of Consumer and Commercial Relations to 970007 Ontario Inc. [effective January 2, 1992] and to The Bulk-Pak Warehouse Inc. [effective May 6, 1992]. The Articles of Incorporation of both companies identify Marc Koplowitz as being the only director and both companies have the same address of their registered office in Toronto. However, these documents do not appear to be of any relevance to the opponent's allegation that the applicant intended to operate or have other persons operate a warehouse, store or other outlet under the mark THE BULK-PAK WAREHOUSE which would be selling wares bearing the trade-marks of third parties. Even considering that the evidentiary burden on the opponent is slight in respect of the Section 30(e) ground, I have concluded that the opponent has failed to meet that burden in this case.

Considering next the Section 12(1)(b) ground of opposition, the relevant date for determining whether the trade-mark THE BULK-PAK WAREHOUSE is clearly descriptive as applied to the applicant's wares 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.)]. While the onus is on the applicant to prove that its mark is registrable, there is an initial evidentiary burden on the opponent to adduce sufficient evidence to establish the truth of the allegations relied upon by it in support of this ground. In considering this ground of opposition, the applicant's trade-mark THE BULK-PAK WAREHOUSE must be considered from the point of view of the average consumer or user of the applicant's wares. Also, in determining whether the mark THE BULK-PAK WAREHOUSE is clearly descriptive of the applicant's wares, the mark must not be dissected into its component

elements but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade-marks*, 40 C.P.R. (2d) 25, at pgs. 27 - 28; and *Atlantic Promotions Inc. v. Registrar of Trade-marks*, 2 C.P.R. (3d) 183, at p.186].

The opponent has alleged that the trade-mark THE BULK-PAK WAREHOUSE is not registrable in that it is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it is proposed to be used. The applicant has disclaimed the right to the exclusive use of the words “Bulk-Pak” apart from its trade-mark and has therefore effectively conceded that the words are either descriptive or otherwise not distinctive in relation to its wares. In support of its allegation that the word “WAREHOUSE” is descriptive of the wares in that all of the applicant’s wares could be used in or for a warehouse, the opponent filed dictionary references for “warehouse” which generally define the word as: “a building in which goods are stored, kept for sale or in bond; a wholesale or large retail store”. Even assuming that the applicant’s wares could be used in or for a warehouse, I do not agree that the word “WAREHOUSE” is clearly descriptive of a character or quality of the wares themselves. In any event, the opponent has not led any evidence which would support the conclusion that the words comprising the trade-mark have a combined meaning that is either clearly descriptive or deceptively misdescriptive as applied to the applicant’s wares. As a result, I find that the opponent has not met the evidentiary burden upon it in this instance and have therefore rejected this ground of opposition.

As its third ground of opposition, the opponent has alleged that the trade-mark THE BULK-PAK WAREHOUSE is not adapted to distinguish the wares of the applicant from the wares and services of others. The material date for assessing this ground is the date of filing the statement of opposition, that is, July 12, 1993 [see *Re Andres Wines Ltd. and E.J. Gallo Winery* (1975), 25 C.P.R. (2d) 126, at p. 130 (F.C.A.)]. Again, although the onus is on the applicant to prove that its trade-mark is distinctive, there is an initial burden on the opponent to adduce at least some evidence to support the truth of the allegations relied upon by it in support of this ground. In this case, the only evidence the opponent has submitted that has any bearing on this issue is the evidence of the incorporation of The Bulk-Pak Warehouse Inc. and the dictionary references to the words contained in the trade-mark. However, the dictionary references do not point to the trade-mark THE BULK-

PAK WAREHOUSE as a whole as being incapable of distinguishing the wares of the applicant from those of others. Furthermore, the mere incorporation of a company called The Bulk-Pak Warehouse Inc. is *per se* of no relevance to the distinctiveness ground in the absence of evidence that the corporate name has been used or otherwise brought to the attention of the public. As the opponent has failed to meet its evidentiary burden upon it, I have dismissed the non-distinctiveness ground of opposition.

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

DATED AT HULL, QUEBEC THIS 16th DAY OF OCTOBER, 1996.

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