

IN THE MATTER OF AN OPPOSITION
by Kraft General Foods Canada Inc.
to application serial No. 600,297
for the mark CASINO DE FRANCE & Design
filed by Casino-Etablissements Economiques Du Casino Guichard-
Perrachon & Cie

On February 2, 1988, Casino-Etablissements Economiques Du Casino Guichard-Perrachon & Cie filed an application to register the mark CASINO DE FRANCE & Design, shown below, covering a number of food and beverage items. The application claims a priority filing date, namely December 18, 1987, pursuant to Section 34 of the Trade-marks Act, based on the applicant's filing of a corresponding trade-mark application in France.

There were several amendments to the application, the last amendment occurring about two weeks prior to the oral hearing. The application of record in issue in this proceeding is based on proposed use in Canada, disclaims the right to the exclusive use of the word "France", and covers the following wares:

The application was advertised for opposition purposes on June 21, 1989. The opponent Kraft General Foods Canada Inc. (then Kraft Limited) filed a statement of opposition on September 20, 1989, a copy of which was forwarded to the applicant on October 5, 1989. The applicant responded by serving, and filing, a counter statement generally denying each of the grounds of opposition.

The statement of opposition alleges, among other things, that the applied for mark is not registrable, pursuant to Section 12(1) (d) of the Act, because CASINO DE FRANCE & Design is confusing with the opponent's registered mark CASINO, regn. No. TMDA 38200, covering the following wares, namely

"cheese, dressings for salads, and condiments,
namely pickles and relishes, condiments
namely barbecue sauce,"

(see ground (d)), and that the applied for mark is not distinctive because it is not adapted to distinguish the applicant's wares from the opponent's cheese products, salad dressings, and condiments sold under the opponent's mark CASINO (see ground (e)).

In its written argument, the opponent advised that "the Applicant need direct its attention only to opposition issues (d) and (e)," referred to above, because "the Opponent has not been able to establish a factual background in support of the remaining grounds of opposition." The opponent further advised, in its written argument, that the remaining grounds pleaded in the statement of opposition "are not being dropped in case the opposition goes beyond the Trade-marks Office", presumably to appeal in the Federal Court. However, as the opponent did not withdraw any of its grounds of opposition, it may become necessary for me to consider each of the grounds pleaded in the statement of opposition.

The opponent's evidence consists of the affidavit of Fred L. Johnson, now retired, formerly Director of Business Affairs for Kraft Limited. Mr. Johnson also testified in two previous opposition proceedings involving his employer - see Kraft Ltd. v. Guichard Perrachon et Cie (1986), 11 C.P.R.(3d) 95, and Kraft Ltd. v. Guichard Perrachon et Cie (1986), 11 C.P.R.(3d) 134.

Mr. Johnson's previous affidavit evidence in the two above mentioned opposition cases is incorporated by reference into his present affidavit. Mr. Johnson was cross-examined on his evidence,

and a copy of the transcript of his cross-examination, including exhibits thereto, form part of the record in this proceeding.

The applicant did not file any evidence in support of its application. Both parties filed written arguments and both were ably represented at an oral hearing.

Mr. Johnson's evidence relating to the earlier oppositions is that the opponent enjoyed wide renown, in 1983, in both the consumer market and the food service market in Canada, as a source of cheese products, salad dressings, jams and candies. Sales figures for the opponent's above mentioned wares, in the period 1975 to 1982, adequately support Mr. Johnson's assertion that the opponent was widely known for those food products in 1983. However, the above evidence is too dated to be helpful to the opponent at the present time.

The opponent's mark CASINO has been in use in Canada since at least as early as 1928 for cheese and salad dressings. Sales of cheese products under the opponent's CASINO mark were about \$46,000 in 1957 increasing steadily to about \$3,356,000 in 1982. Sales of salad dressings under the opponent's CASINO mark, for the same time period, increased steadily from about \$100,000 to about \$211,000.

Mr. Johnson's more recent affidavit provides an update of the opponent's sales under its mark CASINO from 1983 on. Sales of the opponent's wares under the mark CASINO averaged about \$3.6 million for 1983-1986 inclusive, and averaged about \$9.2 million for the years 1987 and 1988. From the transcript of Mr. Johnson's cross-examination, it appears that from 1983 on almost all sales under the mark CASINO were for various types of cheese products, with some sales of salad dressings, pickles and relishes, and barbecue sauce.

The majority of the opponent's sales for its cheese and salad

dressing products are in large sizes (for example, 2 to 5 kilogram packages for cheese) to restaurants, hotels, and institutions who use the products in the preparation of food sold to customers. The opponent's cheese products are also sold through "deli" sections of retail food outlets.

I will first consider the ground of opposition pursuant to Section 12(1)(d), namely, that the applied for mark CASINO DE FRANCE & Design is not registrable because it is confusing with the opponent's registered mark CASINO covering the wares cheese, salad dressings, and condiments. In this regard, as the opponent did not evidence its registration, I have exercised the Registrar's discretion to verify the details of regn. No. 38200 pleaded in the statement of opposition - see Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at 411-12 (TMOB). The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision - see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.); Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 (TMOB).

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark CASINO DE FRANCE & Design and the opponent's registered mark CASINO. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, the issue must be decided against the applicant - See John Labatt Ltd. v. Molson Companies Ltd. (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.)

With regard to Section 6(5)(a), the opponent's mark CASINO

possesses a high degree of inherent distinctiveness, as there is no connection between the word "casino" and the wares specified in the opponent's registration. The applied for mark CASINO DE FRANCE & Design is not as inherently distinctive as the mark CASINO because the phrase "de France" strongly suggests that the applicant's wares originate in France, or that they are in some type of French style. I infer from the opponent's evidence that its mark CASINO is known to a fairly wide extent in the food service industry, and to a lesser extent to the general public, in association with cheese products. There is no evidence that the applied for mark CASINO DE FRANCE & Design is known to any extent.

The length of time that the marks have been in use weighs in favour of the opponent.

The wares covered in the subject application are different than the wares specified in the opponent's registration. However, both parties' wares fall into the same broad general category of food (and beverage) products. It might be argued that the markets of the parties would differ in that the opponent's sales are mostly directed to the food service industry, while the applicant's sales might focus on the general public through retail food outlets. However, neither the subject application nor the opponent's registration contains such distinctions in the specification of wares and that is what governs - see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc. 2 C.P.R.(3d) 361 at 372 (F.C.T.D.), 12 C.P.R.(3d) 110 at 112 (F.C.A.); Mr. Submarine Ltd. v. Amandista Investments Ltd. 19 C.P.R.(3d) 3 at 10-11 (F.C.A.). Neither is there any evidence that the opponent intends to limit its sales to the food service industry. Quite to the contrary, there is some evidence that the opponent does in fact market its wares to the general public through retail outlets. In view of the above, and in the absence of evidence to the contrary, I conclude that the parties' food and beverage products, including beer and wine, would be travelling through essentially the same, or

overlapping, channels of trade.

With respect to Section 6(5)(e), there is a high degree of resemblance between the marks in issue. The applicant has apportioned the whole of the opponent's mark and added essentially non-distinctive matter.

At the oral hearing, the applicant relied, inter alia, on John E. Fetzer, Inc. v. Tiger Brand Knitting Co. (1989), 26 C.P.R.(3d) 551 (F.C.T.D.) and on Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R.(3d) 483 (F.C.T.D.). In both cases, above, the Court found in favour of the trade-mark applicant, reversing decisions of this Board finding in favour of the opponent. In Tiger Brand, the applied for mark was DETROIT TIGERS & Design, while the opponent relied on a number of marks including TIGER. In Clorox, the applicant's mark was K.C. MASTERPIECE & Design, while the opponent relied on its mark MASTERPIECE. Although there are some parallels that may be drawn between the above cases and the present case, the above cases are distinguishable from the present case. In Tiger Brand, the Court noted (at p. 555) that "these are different looking logos, pitched to different consumers in different settings and with different channels of distribution." Those circumstances do not apply in the instant case. In Clorox, the Court found (at pp. 489-490) that the opponent's mark MASTERPIECE was descriptive of the quality of the wares and only entitled to a narrow measure of protection. By contrast, in the instant case I have found that the opponent's mark CASINO possesses a high degree of inherent distinctiveness.

Considering the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applicant has not satisfied the legal burden on it to show that there would be no reasonable likelihood of confusion between the applied for mark CASINO DE FRANCE & Design and the opponent's registered mark CASINO. The opponent therefore succeeds

on its ground of opposition pursuant to Section 12(1)(d) and I need not consider the remaining grounds. I would add, however, that I agree with the applicant's submissions that the opponent has failed to meet its evidential burden respecting the grounds pleaded in paragraphs 1(a) to 1(c), inclusive, of the statement of opposition.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MARCH , 1993.

Myer Herzig,
Member,
Trade-marks Opposition Board