



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

Citation: 2011 TMOB 120
Date of Decision: 2011-07-06

**IN THE MATTER OF AN OPPOSITION
by Cargill Limited to application
Nos. 1,343,134 and 1,343,139 for the
trade-marks THE ORIGINAL PRIME
RIB BURGER and GENUINE PRIME
RIB BURGER in the name of New Food
Classics, a partnership of NFC
Acquisition Corp., NFC Acquisition L.P.
and NFC Acquisition GP Inc.**

[1] On April 12, 2007, New Food Classics, a partnership of NFC Acquisition Corp., NFC Acquisition L.P. and NFC Acquisition GP Inc. (the Applicant) filed applications to register the trade-marks THE ORIGINAL PRIME RIB BURGER and GENUINE PRIME RIB BURGER, under Nos. 1,343,134 and 1,343,139 respectively. Both applications are based upon proposed use of the trade-mark in Canada in association with meats, namely burgers. The right to the exclusive use of the words PRIME RIB BURGER has been disclaimed apart from each of the marks.

[2] Application No. 1,343,134 was advertised for opposition purposes in the *Trade-marks Journal* of March 26, 2008, whereas application No. 1,343,139 was advertised August 13, 2008.

[3] Cargill Limited (the Opponent) filed a statement of opposition against each of the applications (on August 7, 2008 re application No. 1,343,134 and on October 10, 2008 re application No. 1,343,139). The Applicant filed and served a counter statement in respect of each application, in which it denied the Opponent's allegations.

[4] The parties filed identical evidence with respect to both applications: the Opponent filed affidavits of Gerald Gaunt and Jennifer Stecyk; the Applicant filed an affidavit of Cheng K. Lim. No cross-examinations were conducted.

[5] Only the Opponent filed a written argument. An oral hearing was not requested.

Onus

[6] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Grounds of Opposition

[7] The Opponent has pleaded the identical two grounds of opposition with respect to each application, namely:

- 1) the trade-mark is unregistrable under s. 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the Applicant's wares;
- 2) the trade-mark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish, the wares of the Applicant from the wares of others, including the Opponent, having regard to: (1) the fact that the trade-mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Applicant's wares; and/or (2) the use in Canada by others including, Loblaws Inc., Sobeys, M & M Meat Shops, TMF Food Services, Cara Operations Limited (carrying on business as Harvey's), A&W Foodservices of Canada Ltd. of the trade-mark or designation PRIME RIB in association with beef burgers.

The Opponent's Evidence

[8] Ms. Stecyk, a trade-mark searcher, provides dictionary definitions for “genuine”, “original”, “prime rib” and “burger”. She also provides a copy of the Canada Food Inspection Agency’s “Beef – Meat Cuts Manual”.

[9] Mr. Gaunt, an articling student, provides evidence of various burgers that he purchased that employ the words “prime rib”, namely:

- President’s Choice Thick & Juicy Prime Rib Burgers;
- M&M Prime Rib Beef Burgers;
- Master Choice Prime Rib Beef Burgers;
- Compliments Prime Rib Beef Burgers;
- Compliments Sensations Prime Rib Beef Burgers; and
- Fulton Market Burger Company’s Prime Rib Burger.

The Applicant's Evidence

[10] Mr. Lim has been employed by the Applicant since 1997 and was its Senior Project Manager when he swore his affidavit. His affidavit consists of a single page. After setting out his history with the Applicant, the remainder of Mr. Lim’s affidavit reads as follows:

New Food Classics is an award winning custom designer and manufacturer of value-added meat, poultry, seafood and meatless products. New Food Classics’ major product categories are value-added burgers and ground meats; convenience cooked products; portion control and value added meats products; and specialty products including appetizers, finger foods and seafood.

Currently, the trademarks have not commenced use in Canada.

New Food Classics’ major business is in private label. Therefore, point of sale advertisement and displays are not generated from our company.

The channels of trade for the burger are through retail, foodservices and distribution units.

I am not aware of any competitors using the terms “genuine” and “the original” in association with prime rib burgers.

Section 12(1)(b) Ground of Opposition

[11] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but 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 27-8 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.)].

[12] The material date that applies to a s. 12(1)(b) ground of opposition is the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.)].

[13] I note that the ordinary dictionary meaning of the words in an applied-for trade-mark can suffice to meet an opponent’s initial burden with respect to s. 12(1)(b) [see *Flowers Canada/Fleurs Canada Inc. v. Maple Ridge Florist Ltd.* (1998), 86 C.P.R. (3d) 110 (T.M.O.B.)] and therefore the Opponent has met its initial burden.

[14] Based on the Applicant’s disclaimer to the right of the exclusive use of the words PRIME RIB BURGER and Mr. Lim’s generic use of the term “prime rib burgers”, I assume that its position would be that it is the words “THE ORIGINAL” and “GENUINE” that render its marks registrable.

[15] “Original” and “genuine” are everyday words whose meaning would be readily known by the average Canadian. It seems quite apparent that the everyday consumer of hamburgers would react immediately to the words “genuine prime rib burger” as indicating that these burgers are

truly made from prime rib beef and to “the original prime rib burger” as indicating that these burgers come from the source that originally used prime rib for burgers.

[16] Turning to Mr. Lim’s affidavit, I see nothing that can serve to satisfy the Applicant’s legal burden. The mere fact that Mr. Lim is unaware of any competitors who use the terms “genuine” or “the original” in association with prime rib burgers does not mean that the applied for marks are not contrary to s. 12(1)(b). Descriptive words are the property of all. GENUINE PRIME RIB BURGER is a term that should be left available for the industry to use to accurately describe burgers that are made out of prime rib. THE ORIGINAL PRIME RIB BURGER should be available to describe whoever’s product was the first of this nature; there is no evidence that the prime rib burger originated with the Applicant - to the contrary, there is evidence that a number of parties sell prime rib burgers and no evidence that the Applicant has ever sold prime rib burgers. If prime rib burgers did not originate with the Applicant, then THE ORIGINAL PRIME RIB BURGER is deceptively misdescriptive; otherwise, it is clearly descriptive.

[17] For the foregoing reasons, I find that the Applicant has not met its legal burden with respect to the allegation that its trade-marks contravene s. 12(1)(b); that ground of opposition therefore succeeds with respect to both applications.

Distinctiveness Ground of Opposition

[18] A trade-mark that is clearly descriptive or deceptively misdescriptive is necessarily not distinctive [see *Canadian Council of Professional Engineers v. APA - The Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.) at p. 253]. It is however possible for a mark that is clearly descriptive to acquire distinctiveness through use or promotion. In the present case, I have already found the marks to be clearly descriptive or deceptively misdescriptive and the Applicant admits that it has not used or promoted the marks. The distinctiveness ground of opposition therefore succeeds with respect to each application.

Disposition

[19] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse both applications pursuant to s. 38(8) of the Act.

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