

**IN THE MATTER OF AN OPPOSITION by  
Quality Meat Group Ltd.  
to application No. 1,019,790  
for the trade-mark NORTH COUNTRY SMOKEHOUSE  
in the name of Macgregors Meat & Seafood Ltd.**

On July 22, 1999, De Groot Meat Products Ltd. filed an application to register the trade-mark NORTH COUNTRY SMOKEHOUSE. The application is based upon proposed use of the trade-mark in Canada in association with smoked and/or cooked meat & seafood. The applicant has disclaimed the right to the exclusive use of the word SMOKEHOUSE apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of October 4, 2000. The name of the trade-mark owner was subsequently changed to Macgregors Meat & Seafood Ltd. (hereinafter the applicant).

On March 1, 2001, Premium Brands Inc., filed a statement of opposition. The statement of opposition lists three grounds of opposition, namely registrability, entitlement and distinctiveness, all based on a likelihood of confusion with the trade-mark SMOKEHOUSE [sic], which it claims to have previously used and registered in association with wares that are similar to those of the applicant. Before proceeding, I will address the fact that the opponent's registration is for SMOKE HOUSE (two words) whereas it has sometimes referred to its mark as SMOKEHOUSE (one word). As the two versions are not substantially different and the deviation is not such as to deceive or injure the public, I conclude that use of SMOKEHOUSE

constitutes use of SMOKE HOUSE [*Nightingale Interloc Ltd. v. Prodesign Ltd. (1984)*, 2 C.P.R. (3d) 535 (T.M.O.B.)]. In the following discussion, I may use SMOKEHOUSE and SMOKE HOUSE interchangeably.

The applicant filed and served a counter statement.

The rule 41 evidence consists of the affidavit of Lois Brassart. The rule 42 evidence consists of the affidavits of Karen Thompson, Duncan Macgregor and Marta Siemiarczuk. There is also rule 43 evidence, namely a second affidavit of Lois Brassart.

Each party filed a written argument.

On October 18, 2004, Premium Brands Inc. assigned its rights in the SMOKE HOUSE trade-mark to Quality Meat Group Ltd. I shall refer hereafter to Quality Meat Group Ltd. as the opponent and to Premium Brands Inc. as the opponent's predecessor.

An oral hearing was held at which both the opponent and the applicant were represented.

### **Rule 41 Evidence**

#### ***Brassart Affidavit (No. 1)***

Ms. Brassart is the Marketing Manager of Premium Brands Inc. She provides a copy of Canadian trade-mark registration No. 176,511 for SMOKE HOUSE for cooked and smoked meats, fresh sausage, corned beef, bologna, salami, pastrami and wieners. She explains that the

opponent's predecessor "manufactures and markets a full line of top-quality fresh and prepared pork products, specialty meat and delicatessen items and convenience foods including frozen entrees and salads" and that it "supplies most leading-edge food service and wholesale and retail food companies in western Canada." Apparently, the opponent's predecessor first used SMOKE HOUSE with meat products in Canada as early as October 1, 1968. Ms. Brassart provides examples of labels used in 1984, 1989, 1991 and 2002. Annual gross sales of SMOKE HOUSE meat products in Canada for the years 1998 through 2001 exceeded two million dollars each year, which is the equivalent of 400,000 kilograms each year.

The opponent's predecessor advertised the SMOKE HOUSE trade-mark by means of advertising flyers and coupon offers delivered to households. A flyer used in 1987 has been provided. Ms. Brassart states that advertising expenditures related to the SMOKE HOUSE trade-mark amounted to \$100,000 in each of the years 1998 and 1999, \$10,000 in each of the years 2000 and 2001, and \$5,000 in the first quarter of 2002.

The opponent's predecessor also promoted its SMOKE HOUSE products at annual trade shows since as early as 1981. Ms. Brassart provides a copy of a catalog distributed at a trade show in 1982 and states that expenditures for trade show advertising were \$15,000 in each of the years 1998-2000 and \$2,000 in each of 2001 and 2002.

### **Rule 42 Evidence**

*Karen Thompson*

Ms. Thompson, a trade-mark searcher, provides the results of searches that she conducted of

both the Canadian and U.S. trade-mark registers in 2002 for active trade-marks “which include the words SMOKE HOUSE for ‘food products’.” I will only discuss the Canadian results, as the opponent has not convinced me of the relevancy of the U.S. results.

Eleven marks were located in the Canadian search, of which only eight were registered. One of the eight is the mark relied upon by the opponent. Of the remaining seven, two are owned by one party for almonds, two are for restaurant services, one is for fish, one is for cheese and one is for the operation of a delicatessen. Apart from the differences in the wares, the case law makes it clear that no meaningful conclusions can be drawn about the state of the marketplace from such a limited number of registrations. [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. In any event, the evidence of Ms. Siemiarczuk is that four of the owners of the marks located in the Canadian search advised her that they no longer use their marks.

*Marta Siemiarczuk*

Apart from her evidence concerning enquiries that she made concerning the use of SMOKE HOUSE by third parties, Ms. Siemiarczuk also provides dictionary definitions of the word SMOKEHOUSE. The general definition is “a building or place in which meat, fish, etc., are treated with smoke”.

*Duncan Macgregor*

Mr. Macgregor, the applicant’s Chairman, says that the applicant is a manufacturer of beef,

salmon, chicken and other similar products. He provides pages from trade publications that exhibit ads that contain the word SMOKEHOUSE. However, none of these ads show use of the word SMOKEHOUSE in association with food products. Rather they refer to equipment used in the processing of food. Further, as trade publications, there is no reason to assume that the typical Canadian purchaser/consumer of meat would be familiar with such publications. Finally, the opponent has pointed out that these publications postdate two of the material dates and appear in the main to be U.S. publications (although the applicant has noted that at least some them contain Canadian subscription information).

#### **Rule 43 Evidence**

##### ***Brassart Affidavit (No. 2)***

In her second affidavit, Ms. Brassart simply provides evidence of the fact that the opponent's predecessor has commenced an expungement action against one of the third party registrations located in Ms. Thompson's search, namely the registration for GRIZZLY FUMOIR SMOKE HOUSE & Design for smoked fish.

#### **Likelihood of Confusion**

The material date for each of the grounds of opposition is as follows: registrability under paragraph 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]; entitlement under subsection 16(3) - the filing date of the application; distinctiveness - the date of filing of the statement of opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) 317 (F.C.T.D.) at 324].

While the ultimate legal burden is always upon the applicant, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of each of its grounds of opposition [see *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298]. The opponent has met its initial burden with respect to each of the grounds of opposition by providing a copy of its trade-mark registration, by showing ongoing use of its mark since before July 22, 1999 and by showing that its mark had become known sufficiently as of March 1, 2001 to negate the distinctiveness of the applied-for mark. Although the applicant has argued that the use shown by the opponent does not necessarily enure to the benefit of the opponent, I am satisfied by Ms. Brassart's evidence that any other names appearing on packaging are either the former name or a trading style of the opponent's predecessor. [see paragraph 3 of Brassart No. 1]

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has 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 in appearance or sound or in the ideas suggested by them. All factors to be considered under subsection 6(5) do not necessarily have equal weight.

The weight to be given to each depends on the circumstances [see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1966), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Both SMOKE HOUSE and NORTH COUNTRY SMOKEHOUSE are inherently weak trade-marks since each is suggestive of its associated products. Both suggest that the associated meat has been smoked in a smokehouse, in the applicant's case in a smokehouse located in the north of the country.

The applicant's mark has not become known to any extent whereas the opponent's mark has acquired some distinctiveness as a result of its use and promotion. Although the evidence shows that promotion of the opponent's mark has diminished over the years, the same cannot be said of its sales.

The length of time that either mark has been used in Canada clearly favours the opponent given that the applicant appears to have not used its mark to date while the opponent claims use for over 30 years.

The parties' wares overlap and there is no reason to assume that the channels of trade would not also overlap.

Although there are differences between the marks when viewed and sounded, the idea suggested by each is similar, namely that the products have come from a smokehouse. Although the first component of a mark is often considered more important for the purpose of distinction, when a

word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4<sup>th</sup>) 109 (T.M.O.B.)]. Although the words NORTH COUNTRY do serve to distinguish the applicant's mark somewhat from the opponent's mark, they may simply suggest that a different style of smokehouse (or a smokehouse in a different part of the country) has been used.

A further surrounding circumstance to be considered is the evidence of the state of the register but, further to my discussion earlier, the evidence here is insufficient to make any meaningful inferences. Similarly, I do not consider the applicant's evidence of the state of the marketplace to be a significant surrounding circumstance because such evidence, apart from being hearsay, is very limited and postdates the dates that are material with respect to the distinctiveness and entitlement grounds of opposition.

Similarly, I attach little weight to Mr. Macgregor's evidence of references to smokehouses in trade magazines for several reasons. First, there is no evidence that Canadian consumers, as opposed to members of the meat industry, are aware of the use of smokehouse equipment in the preparation of food. Secondly, there is no evidence of the extent of distribution of these magazines in Canada, if any. Thirdly, the magazines postdate the dates that are material with respect to the distinctiveness and entitlement grounds of opposition.



Having considered all of the surrounding circumstances, these are my conclusions. Regarding the distinctiveness ground, the applicant has not satisfied its legal onus to show that as of March 1, 2001, its mark was adapted to distinguish or actually distinguished its wares from the wares of the opponent throughout Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)]. There is no evidence of use of “smokehouse” in a non-trade-mark sense in either the Canadian marketplace or even in industry publications as of March 1, 2001. I find that the applicant has not met its onus to establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between NORTH COUNTRY SMOKEHOUSE and SMOKE HOUSE as applied to the wares at issue as of March 21, 2001.

The applicant has taken the opponent’s mark in its entirety. Although it has added words in front of the opponent’s mark, these additions are not particularly distinctive. The applicant argues that the opponent’s mark is not entitled to a broad scope of protection but I believe that if I were to find that there was no likelihood of confusion in the present case then I would be enforcing an overly narrow scope of protection. The applicant could have applied to the Federal Court for expungement of the opponent’s registration if it was of the view that the words SMOKE HOUSE are not distinctive of the opponent’s meat (the validity of the opponent’s registered trade-mark is not in issue in the present proceedings). Just because a trade-mark is inherently weak does not mean that it cannot have acquired sufficient distinctiveness to prevent the registration of another trade-mark. Given the absence of any use by the applicant that might support a conclusion that the marks can peacefully coexist without confusion, in view of the lengthy use of the opponent’s mark for identical wares, I conclude that a consumer, who has an

**imperfect recollection of the opponent's mark, might reasonably infer that NORTH COUNTRY SMOKEHOUSE meat shares the same source as SMOKE HOUSE meat.**

**I also note that because the applicant has applied for a word mark, we have no way of knowing if the applicant would use NORTH COUNTRY SMOKEHOUSE in a manner that would emphasize the words SMOKEHOUSE over the words NORTH COUNTRY, which would result in an increase in the likelihood of confusion with the opponent's SMOKE HOUSE mark.**

**The factors to be considered pursuant to subsection 6(5) did not alter significantly between the dates of July 29, 1999 and March 1, 2001. Therefore, the opponent also succeeds under the entitlement ground of opposition, for the reasons discussed above.**

**Disposition**

**Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to the provisions of subsection 38(8) of the *Act*.**

**DATED AT TORONTO, ONTARIO THIS 9th DAY OF DECEMBER, 2004.**

**Jill W. Bradbury  
Member  
Trade-marks Opposition Board**