

**IN THE MATTER OF AN OPPOSITION
by Vienna Sausage Manufacturing Company
to application No. 698,331 for the trade-mark
VIENNA filed by Vienna Meat Products Limited**

On February 6, 1992, the applicant, Vienna Meat Products Limited, filed an application to register the trade-mark VIENNA based on use of the mark in Canada for wares and services by the applicant or its predecessor in title Franz Artaker trading as Vienna Meat & Sausage Company since October 9, 1962. In response to an objection raised by the Examiner pursuant to Section 12(1)(b) of the Trade-marks Act that the applied for trade-mark was clearly descriptive or deceptively misdescriptive of the place of origin of the applied for wares, the applicant claimed the benefit of Section 12(2) of the Act. The applicant was accorded the benefit of Section 12(2) for the provinces of Ontario, Quebec, Nova Scotia and Newfoundland. The application was advertised for opposition purposes on February 6, 1992.

The application was amended on December 8, 1997. A further revised application was forwarded on November 16, 1998 which was apparently not received by the Opposition Board. Shortly prior to the hearing, the applicant was notified of this deficiency and forwarded a copy of the further revised application. I accepted the further revised application at the oral hearing held on November 9, 1999. Consequently, the statement of wares now reads:

meat products, namely: weiners, bologna, meat roasts, meat loaf, meat pastes, spiced meats excluding salami, smoked and cooked hams, cold cuts excluding salami, patés, roast beef, cornbeef, pastrami, cooked sausages, smoked sausages namely smoked pork sausages, smoked beef sausages and smoked turkey sausages, kielbassa [sic], polish sausage and pepperoni, and specifically excluding vienna sausage.

The statement of services as twice amended now reads:

operation of a business dealing in the manufacture, processing, packaging, and wholesale and retail distribution and sale of meat products and meat by-products and specifically excluding vienna sausage and salami.

The opponent, Vienna Sausage Manufacturing Company, filed a statement of opposition on September 23, 1993 and a revised statement of opposition on December 17, 1993. A copy of the revised statement of opposition was forwarded to the applicant on March 17, 1994. The first ground of opposition reads as follows:

The application does not comply with the provisions of Section 30(i) of the Trade-marks Act in that the applicant's statement that it was entitled to use the trade-mark VIENNA in Canada was false. At the time the statement was made the applicant could not have been satisfied that it was entitled to use the trade-mark sought to be registered in Canada in view of its prior knowledge of the use by others of the trade-mark VIENNA, and variations thereof, in Canada in association with meats and services related to the preparation and packing of meat products.

The second ground reads as follows:

Trade-marks and trade names comprising or containing the word VIENNA are widely used by parties in the meat industry other than the applicant to describe or identify products sold or services performed by them. In view of such widespread use by third parties, the trade-mark sought to be registered is not distinctive of the applicant because it does not distinguish, nor is it adapted to distinguish, the wares and services of the applicant from the wares produced and services performed by others, including the opponent.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Hugh Adsett, Sivan Fox, Marion M. Bailey, Jennifer Stecyk and Michael F. Morgan. All five affiants were cross-examined on their affidavits and the transcripts of those cross-examinations, as well as the replies to undertakings given during the Fox and Morgan cross-examinations, form part of the record of the present opposition.

As its evidence, the applicant submitted an affidavit of Mike Latifi and relied on the affidavit of Paul Kawaja that had been submitted in support of the applicant's claim to the benefit of Section 12(2) of the Act. Both Messrs. Latifi and Kawaja were cross-examined on their affidavits and the transcripts of those cross-examinations and the replies to undertakings given form part of the record of this proceeding. The applicant subsequently requested leave to file as additional evidence a certified copy of the Trade-marks Office file for the opponent's application No. 648,017 for the trade-mark VIENNA BEEF & Design. The opponent was given an opportunity to object but did not do so. The applicant's request was then inadvertently overlooked. Consequently, I granted the applicant's request for leave at the oral hearing. Both parties filed a written argument and, as noted, an oral hearing was conducted on November 9, 1999 at which both parties were represented.

The Opponent's Evidence

The Adsett Affidavit

In his affidavit, Mr. Adsett states that he effected a number of purchases of meat products in May of 1994 in grocery stores in Ottawa. At one supermarket, he purchased a can of MAPLE LEAF Vienna sausage. At that same store, he purchased sliced meat identified as Vienna salami at the deli counter. At another supermarket, he purchased a package of SHOPSY'S OLD VIENNA all beef salami. At a downtown delicatessen, he purchased sliced meat identified as Vienna salami. On cross-examination, he stated that there was nothing to indicate the origin of the product in the two instances that he purchased sliced meat identified as Vienna salami.

The Fox Affidavit

In her affidavit, Ms. Fox states that she visited two retail establishments in Toronto that had the word Vienna in their names in September of 1994. One establishment was a delicatessen and restaurant where Ms. Fox purchased sliced meat that was identified as Vienna salami. The other establishment was a restaurant at which Ms. Fox was told they served meat products. On cross-examination, however, it became apparent that meat products were only served as part of a weekend brunch.

Ms. Fox also telephoned two establishments that had the word Vienna in their names. Ms. Fox provided details of her conversations with the individuals reached by phone but those details constitute inadmissible hearsay. The cross-examination of Ms. Fox illustrated the unreliability of relying on those details in this proceeding.

The Bailey Affidavit

In her affidavit, Ms. Bailey states that she conducted a computerized search of a database comprising federal and provincial corporate names and business names. Appended as an exhibit to her affidavit is a report showing the results of her search. A number of enterprises having the word Vienna in their names are listed but there is no explicit indication of the nature of the business conducted by those enterprises.

Ms. Bailey also telephoned three establishments located during her search and provided details of her conversations with the individuals she reached. Again, this evidence is inadmissible as being hearsay and the Bailey cross-examination transcript illustrates why the evidence is unreliable.

The Stecyk Affidavit

In her affidavit, Ms. Stecyk details the results of her examination of a number of telephone directories in three Canadian cities. She located nine entries which had the word Vienna in their names. However, she provided no evidence of how those names have been used, if at all.

The Morgan Affidavit

In his affidavit, Mr. Morgan details the results of his investigations at a number of Ottawa and area supermarkets and grocery stores in September and October of 1994. Mr. Morgan found that the canned product MAPLE LEAF Vienna sausage was widely available. In fact, on cross-examination, he stated that it was available in every supermarket he visited except one.

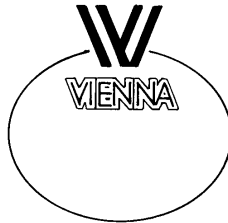
Mr. Morgan also located SHOPSY'S OLD VIENNA Traditional Salami sausages at three different locations. He also purchased sliced meat identified as Vienna salami at the deli section of several stores. At four of those locations, he noted that the deli counter display had one or more large sausages with labelling bearing the words "Vienna salami" and Brandt Meat Products and G. Brandt Meat Packers Limited as the source of the goods. He purchased the whole sausage at one of the locations and Exhibit I is the sausage casing with the labelling.

The Applicant's Evidence

The Kawaja Affidavit

In his affidavit (dated November 11, 1992), Mr. Kawaja identifies himself as the President of the applicant. By the date of his cross-examination (October 17, 1997), the applicant had been sold and Mr. Kawaja was no longer President of the company.

In his affidavit, Mr. Kawaja details the sales and advertising of the applicant's meat products in association with the trade-mark VIENNA. The applicant owns three registrations for trade-marks which include the word Vienna and the most recent registration (No. 365,090) is for the version of the applicant's mark (shown below) which has been used from about 1986 on.



Mr. Kawaja provides sales figures of the applicant's VIENNA meat products for the period 1978 to 1991 totalling about \$79 million. No breakdown by product line was provided. He did, however, provide a regional breakdown of sales for the years 1989 to 1991 for the provinces of Ontario, Quebec, Nova Scotia and Newfoundland in chart form appended as Exhibit F to his affidavit. The sales in Ontario ranged from 97% to 99% of the total for each year. Advertising expenditures for the period 1978 to 1991 were in excess of \$2 million. In reply to an undertaking given during his cross-examination, Mr. Kawaja provided copies of a number of documents supporting that level of expenditures.

On cross-examination, Mr. Kawaja stated that he was aware of a product known as Vienna sausage. He also stated that he was aware of the SHOPSY'S OLD STYLE VIENNA product. He agreed that supermarkets such as Loeb and IGA sell Vienna salami and that it is a generic term. He was aware that Brandt Meat Products sells Vienna salami. He also conceded that the applicant never used the trade-mark VIENNA alone on product packaging.

The Latifi Affidavit

In his affidavit (dated December 11, 1995), Mr. Latifi identifies himself as the President of the applicant. He adopts the contents of Mr. Kawaja's affidavit and provides an update of the information in that affidavit from 1992 to 1995. Sales of VIENNA meat products during that period were about \$48 million. Annual advertising expenditures during that period were

in excess of \$300,000. Like Mr. Kawaja, Mr. Latifi was unaware of any use by the applicant of the trade-mark VIENNA alone.

Certified Copy of Trade-marks Office File

As noted, the applicant was granted leave to file a certified copy of the Trade-marks Office file for the opponent's application No. 648,017 for the trade-mark VIENNA BEEF & Design. During the prosecution of that application, the applicant's three trade-mark registrations were cited against it.

The Grounds of Opposition

The first ground does not raise a proper ground of opposition since the opponent did not allege that the applicant was aware that its trade-mark was confusing with the trade-marks of others comprising or including the word VIENNA. Thus, the first ground is unsuccessful. Even if the first ground had been adequately pleaded, the opponent failed to evidence use of any third party trade-marks comprising or including the word VIENNA for meat products as of the material time which is the applicant's filing date.

As for the second ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - September 23, 1993): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

As a preliminary matter, I have considered the applicant's contention that the second ground of opposition is restricted to reliance on third party uses of trade-marks and trade-names which include the word Vienna. It is the applicant's position that the opponent's

evidence only shows use of the word Vienna as part of generic or descriptive terms such as Vienna sausage and Vienna salami and thus cannot be relied on by the opponent. I disagree.

Although the second ground of opposition could have been more clearly worded, I consider that it is not restricted to third party uses of Vienna trade-marks and trade-names. In any event, it appears from the evidence that such terms as Vienna sausage and Vienna salami were arguably used by third parties as part of their trade-marks for such products. More importantly, it is apparent from the record that the applicant understood that the scope of the second ground of opposition included generic and descriptive uses of the word Vienna by third parties.

As another preliminary matter, I have considered the opponent's submission that the applicant has not evidenced use of its applied for trade-mark VIENNA. However, I consider that the use of the applicant's design mark illustrated above also constitutes use of the word mark VIENNA 'per se.' In this regard, see the decisions in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538 (T.M.O.B.) and Munsingwear Inc. v. Promafil Canada Ltee. (1992), 44 C.P.R.(3d) 59 (F.C.A.).

In the present case, the Fox, Bailey and Stecyk affidavits do not assist the opponent's case. The only item of note is Ms. Fox's observation that there was a delicatessen and restaurant in Toronto which operated under the name Vienna Gourmet. The fact that there was one delicatessen operating under a business name that includes the word Vienna does not affect the distinctiveness of the applicant's mark VIENNA used as a source of meat products and as a source of the business of selling such products.

On the other hand, the Adsett and Morgan affidavits provide some evidence to show that the terms Vienna sausage and Vienna salami are in common use for specific meat products at least within the Ottawa region. Although those affidavits evidence the affiants' observations after the material time, I consider that those observations are likely reflective of the situation as of that earlier date given that they were made not long after the material time.

Vienna sausage is defined in standard dictionaries as a short, slender frankfurter and the Adsett and Morgan affidavits evidence the widespread availability of such a product sold under the MAPLE LEAF trade-mark in the Ottawa region. Given the availability of that product in several supermarket chains in the Ottawa area, it is likely that the product would have been available in at least some other Ontario cities as well. As noted by the applicant, however, that product is somewhat different from the applicant's meat products since it is essentially a small hot dog rather than a typical sausage product.

On cross-examination, Mr. Kawaja conceded that Vienna salami is a generic term. The Adsett and Morgan affidavits also establish that Vienna salami is a generic term used for a particular type of salami sausage. Given Mr. Morgan's purchases and observations, I am able to conclude that the Vienna salami sold by Brandt Meat Products is readily available in several Ottawa supermarkets. Again, given its availability in several supermarket chains in the Ottawa area, it is likely that the product would have been available elsewhere in Ontario as well. This seems particularly so given that Brandt Meat Products is located in Mississauga, Ontario.

The Adsett and Morgan affidavits also provide some evidence of the use of the trade-mark SHOPSY'S in association with a product called OLD VIENNA Traditional Salami. This product, too, was available through several Ottawa area supermarket chains which makes it likely that it was also sold elsewhere. Again, this seems particularly so given that the casing for that product identifies Shopsy's Foods' location as Weston, Ontario.

Given that the terms Vienna salami and Vienna sausage have been shown to be generic for specific meat products, given that salami is a type of sausage and given that Vienna salami and Vienna sausage have been shown to be available in a number of locations, I find that the opponent has met its evidential burden to show that the use of the word VIENNA for sausage products in general would not serve to distinguish any one trader's products from those of another. On the other hand, the opponent has not shown use of the word Vienna for any of the remaining products in the applicant's statement of wares. Thus, it has not met its evidential burden for the remaining wares.

The applicant contends that its sales and advertising are of such an extent that the presence of the applicant's VIENNA trade-mark in the marketplace overwhelms any third party presence using the generic terms Vienna salami and Vienna sausage. Although the applicant's sales figures are fairly impressive, neither Mr. Kawaja nor Mr. Latifi provided a breakdown of those figures by specific product line. Thus, I cannot conclude that a significant portion of those sales were of sausage products such that consumers would have been overwhelmingly educated to the trade-mark significance of the word VIENNA when used with such products.

The applicant further contended that the file history for the opponent's application to register its trade-mark VIENNA BEEF & Design operates as a form of estoppel precluding the opponent from arguing that the applicant's trade-mark is not distinctive. I disagree. That file history includes submissions by the opponent seeking to overcome citations of the applicant's three registrations wherein the opponent emphasized the inherent weakness of the marks at issue and argued that small differences would distinguish between the marks. While such submissions may wed the opponent to a position that the marks of the parties are weak, it does not prevent the opponent from relying on evidence of the marketplace activities of others which may affect the distinctiveness of the applicant's mark. Furthermore, it is in the public interest for the Opposition Board to examine such evidence to avoid the registration of non-distinctive trade-marks.

In view of the above, I find that I am left in a state of doubt respecting the issue of distinctiveness in relation to the applicant's wares that qualify as sausages. Thus, I must resolve that doubt against the applicant in respect of those wares. As for the applicant's services and its remaining wares, I find that the opponent has failed to meet its evidential burden. Thus, the second ground of opposition is successful in part. Had the opponent provided reliable evidence of more widespread use of Vienna as part of the business names of retail outlets selling meat products, the second ground might also have been successful in relation to the "retail distribution and sale of meat products and by-products" included within the applicant's statement of services.

I consider that a useful analogy in the present case can be made to the words **Black Forest** which appear in the evidence as a generic term for a type of ham. In the usual course, the words **Black Forest** could not serve to function as a trade-mark when used with different types of ham. They could, however, likely serve to function as a trade-mark for other classes of meat.

In passing, I wish to note that although the applicant was accorded the benefit of Section 12(2) of the Act for Ontario, Quebec, Nova Scotia and Newfoundland, the Kawaja affidavit would only appear to support such a claim for the province of Ontario. The regional breakdown of sales for the years 1989 to 1991 provided in Mr. Kawaja's affidavit shows that 97-99% of annual sales were made in Ontario. However, the sufficiency of the applicant's claim to the benefit of Section 12(2) was not raised as an issue in the statement of opposition and I am therefore precluded from ruling on it: see Imperial Developments Ltd. v. Imperial Oil Ltd. (1984), 79 C.P.R.(2d) 12 at 21 (F.C.T.D.).

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application in relation to the following wares:

cooked sausages, smoked sausages namely smoked pork sausages,
smoked beef sausages and smoked turkey sausages, kielbassa [sic],
polish sausage and pepperoni

and I reject the opponent's opposition in relation to the services and the remaining wares.

Authority for such a divided result may be found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).

DATED AT HULL, QUEBEC, THIS 14th DAY OF DECEMBER, 1999.

David J. Martin,
Member,
Trade Marks Opposition Board.