



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

Citation: 2012 TMOB 28
Date of Decision: 2012-02-08

**IN THE MATTER OF AN OPPOSITION by
Maple Leaf Consumer Foods Inc. / Les
Aliments de Consommation Maple Leaf Inc.
to application No. 1,285,751 for the trade-
mark GRIDDLE STACKERS in the name of
Kelbro Enterprises Inc.**

[1] On January 11, 2006, Kelbro Enterprises Inc. (the Applicant) filed an application to register the trade-mark GRIDDLE STACKERS (the Mark) based upon proposed use of the Mark in Canada in association with the following wares, as revised: “sandwich comprising one or more of the following: pancakes, egg, meat and cheese” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 13, 2008.

[3] On January 8, 2009, Maple Leaf Consumer Foods Inc. / Les Aliments de Consommation Maple Leaf Inc. (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) and 38(2)(b) of the Act, that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(b) and 38(2)(c) of the Act in view of the fact that the Mark is confusing with the trade-mark STACKERS of the Opponent, previously registered under No. TMA708,724 and

used in Canada by the Opponent in association with “prepackaged snacks comprising prepared meats, cheese and crackers”. However, the s. 16(3)(b) ground of opposition was voluntarily withdrawn by the Opponent at the oral hearing.

[4] The Applicant filed and served a counter statement denying the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed the affidavit of Brian Wernham, Senior Marketing Director of the Opponent, sworn September 11, 2009. In support of its application, the Applicant filed the affidavits of John Kelly, Secretary of the Applicant, sworn January 6, 2010; Michael Stephan, a Senior Investigator with the investigation firm King Reed & Associates Inc., sworn December 22, 2009; and Lisa Saltzman, Director of the trade-mark searching department with Onscope, a division of Marque d’or Inc., sworn December 15, 2009.

[6] Both parties filed written arguments and were represented at an oral hearing.

Onus

[7] 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 evidentiary 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the parties’ evidence

The Opponent’s evidence – the Wernham affidavit

[8] Mr. Wernham states that he has been with the Opponent for almost a year (as of the time of swearing his affidavit) and has held the position of Senior Marketing Director in charge of the STACKERS category, since September 1, 2008. As such, he states that he has “access to the

records of [the Opponent] relating to the sales, advertising and promotion of the food products offered for sale and sold by [the Opponent] in association with prepackaged snacks comprising prepared meats, cheese and crackers”.

[9] Mr. Wernham states that the Opponent is now the registered owner of approximately 136 trade-mark applications and registrations inherited from J.M. Schneider Inc. (J.M. Schneider) on January 1, 2006, which include the trade-mark STACKERS being the subject of application Serial No. 1,079,760, filed on October 23, 2000. Mr. Wernham attaches a copy of the particulars of such application obtained from the Canadian Trade-marks Database showing that this application stands under the name of the Opponent. As pointed by the Applicant in its written argument, the printout of application Serial No. 1,079,760 does not indicate that an assignment or other change of title document has been filed with respect to this application. However, the printout does indicate that this application matured to registration on March 4, 2008 under No. TMA708,724, which trade-mark registration corresponds to the one pleaded by the Opponent in its statement of opposition. I have exercised the Registrar’s discretion to check the register and confirm that the change of title from J.M. Schneider to the Opponent referred to by Mr. Wernham has been recorded by the Registrar.

[10] Mr. Wernham states that “J.M. Schneider” and “Schneider Foods” are now business names and trade-names of the Opponent. More particularly, he states that “J.M. Schneider” is registered in Alberta, British Columbia, Saskatchewan, Manitoba, Ontario, Nova Scotia, Prince Edward Island, and New Brunswick. “Schneider Foods” is registered in Alberta, British Columbia, Saskatchewan, Manitoba, Ontario, Québec, Nova Scotia, Prince Edward Island, New Brunswick, Nunavut, Northwest Territories, and Yukon Territories.

[11] Mr. Wernham goes on to state that the STACKERS trade-mark has been used extensively in association with prepackaged snacks comprising prepared meats, cheese and crackers (sometimes hereinafter referred to as the STACKERS product) since at least as early as 1994. More particularly, Mr. Wernham states that J.M. Schneider, from whom the Opponent obtained the trade-mark STACKERS, has used such trade-mark throughout Canada continuously and extensively since 1994. As pointed out by the Applicant, the printout of the STACKERS trade-

mark filed as Exhibit A indicates that this application was filed on October 23, 2000 based on proposed use in Canada. A declaration of use was not filed until February 8, 2008. I agree with the Applicant that this is clearly inconsistent with the bald assertion of Mr. Wernham, who has only worked with the Opponent for one year before filing his affidavit and who only has access to the records of the Opponent and not the records of J.M. Schneider, that use of the STACKERS trade-mark commenced in 1994. As it will become apparent as I continue my review of Mr. Wernham's affidavit, I am not prepared to afford weight to Mr. Wernham's unsubstantiated statements of use of the STACKERS trade-mark dating as far back as 1994. However, I find that Mr. Wernham's affidavit does establish use of the STACKERS trade-mark dating at least as far back as 2007.

[12] Mr. Wernham states that sales of the STACKERS product have been substantial, including significant market penetration and consumer acceptance. While Mr. Wernham states that since 1994, the STACKERS product has been sold continuously and has done very well in the marketplace, he only provides sales for the years 2007 and 2008 as amounting to "2,274,592 kilos, and 2,103,215 kilos" respectively. As pointed out by the Applicant, Mr. Wernham does not indicate what this means in terms of dollars, or distribution across Canada. At the oral hearing the Opponent made representations as to what these kilo values amounted to in terms of dollars. However, as objected to by the Applicant at the hearing, such representations cannot be considered as the sales figures should have been filed as part of the Opponent's evidence. That said, I am nonetheless prepared to accept that there have been quite substantial sales made of the STACKERS product in Canada for the years 2007 to 2009 based on my review of the exhibits attached to Mr. Wernham's affidavit and my estimation of the approximate number of units sold, as explained below.

[13] In support of the above statements of use Mr. Wernham attaches the following exhibits:

- Exhibit B that consists of "a table setting out the volume of [the Opponent]'s STACKERS product, arranged by product variety and regions, sold for the years 2007, 2008 and 2009 to [the date of swearing his affidavit]". The "regions" are described as the provinces of Ontario and Québec, and the "Atlantic" and West" provinces. The numbers

of kilos for the years 2007, 2008 and 2009YTD amount to 2,274,592; 2,103, 215; and 1,075,283 respectively;

- Exhibit C that consists of “a chart setting out the National Grocery Banner Item Ranking for [the Opponent]’s STACKERS product for the period ending June 6, 2009.” In the description column of the table is a list of Schneider’s products, including “Schneider Lunchmate Stackers”, “Shneider Lunchmate Pizzas”, “Schneider Lunchmate Nacho Kit”, “Schneider Lunchmate Hot Dogs”, “Schneider Lunchmate Chicken Dunkers”, “Schneider Lunchmate Big Combo”, etc. Of the 37 items listed, only 7 refer to “Schneider Lunchmate Stackers”. While Mr. Wernham states that “[t]he chart details that STACKERS occupy 97.5% of market share, and has garnered 64,986,717 in total category dollar volume”, no definition of the meaning of the phrase is provided. It is also unclear what the source or author of that chart is. However, I note that dollar figures amounting to in excess of 31 million dollars are provided for the STACKERS product for the period ending June 6, 2009;
- Exhibit D that consists of “six packaging samples showing current varieties of the STACKERS product”. Upon review of these samples, I note that the STACKERS mark is displayed on the packaging followed by the trade-mark symbol designated by TM, appearing right after it. While the Applicant submits that the name of the Opponent does not appear on any of the sample packages provided, I note that the Opponent’s trade-name “Schneider Foods” followed by an address in Kitchener, Ontario does so appear. The weight indicated on the packaging is 355g for the “big combo super trousse” or 111g for what appear to be the regular size. Considering the weight value per unit in light of the numbers of kilos sold for the years 2007 to 2009, it can fairly be concluded that there have been substantial sales made of the STACKERS product in those years;
- Exhibit E that consists of examples of various promotional materials displaying varieties of the STACKERS product, which are included in the annual back-to-school promotions. Mr. Wernham explains that these promotions include a feature activity and a store display as well as in-store support materials such as bunker cards, danglers, posters, and other point-of-sale materials. Upon review of these promotional materials, I note that one of them is for the year 2000 and two are for the year 2006. The other materials are for the years 2007 and 2009 or are undated;

- Exhibit F that consists of copies of nine invoices dated at or around January 1, 2008, issued by the Opponent to different retailers across Canada ordering different varieties of the STACKERS product.

[14] Mr. Wernham concludes his affidavit stating that he has “extensive experience in the food products business, particularly relating to [the Opponent]’s STACKERS lunch kits product line. The trade-mark STACKERS is well known in Canada and thus [he] confirm[s] that the applicant [sic] is entitled to the registration of the trade-mark STACKERS in association with the wares prepackaged snacks comprising prepared meats, cheese and crackers”. I am not affording weight to this personal opinion of Mr. Wernham. The distinctiveness of the Opponent’s STACKERS trade-mark involves questions of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding. Furthermore, the present case does not pertain to the Opponent’s entitlement to the registration of the STACKERS trade-mark, the validity of which registration is not in issue in this proceeding.

The Applicant’s evidence

The Kelly affidavit

[15] Mr. Kelly states that he is the Secretary of the Applicant and that he is also the President of Otter Valley Foods Inc. (Otter Valley), a wholly-owned subsidiary of the Applicant. Mr. Kelly states that Otter Valley functions as the operating company for the Applicant and the Applicant licenses the use of the Mark to Otter Valley.

[16] Mr. Kelly states that Otter Valley is a manufacturer of co-packed and private label frozen food, with international customers. The Applicant’s licenses use of the Mark to Otter Valley’s customers.

[17] Mr. Kelly states that the Applicant has used the Mark by itself and through its licensees in association with a frozen sandwich comprising one or more of the following: pancakes, egg, meat and cheese, in Canada since January 31, 2008 and in the United States since December 21,

2005. While Mr. Kelly states that he will refer to the product sold in association with the Mark as “frozen breakfast sandwiches”, I will refer to the said product as the Wares, that is how it has been defined in the instant application.

[18] More particularly, Mr. Kelly states that the Applicant manufactures the Wares sold in association with the Mark and the Wares are packaged and marked with the Mark and the mark of the private label company for whom they are made.

[19] Mr. Kelly states that sales to September 30, 2009 of the Wares in association with the Mark are in excess of \$963,000 CDN dollars in Canada and \$11,750,000 U.S. dollars in the United States.

[20] In support of the above statements of use, Mr. Kelly attaches the following exhibits:

- Exhibits A and B that consist of tables setting out respectively the Canadian and American sales to licensees of the Wares marked with the Mark;
- Exhibits C and D that consist of certified copies of the Applicant’s instant application and United States registration for the Mark respectively;
- Samples of packaging for the Wares displaying the Mark used in Canada by various third party licensees of the Applicant, namely:
 - i. Exhibit E that consists of three labels of M & M Meat Shops which products are sold across Canada at M & M Meat Shops’ retail locations. I note that the Mark is followed by the trade-mark symbol designated by TM, appearing right after it. The legend identifies the Mark as a trade-mark of the Applicant that is used under license, and is followed by the mention “PREPARED FOR/PRÉPARÉ POUR M & M MEAT SHOPS LTD. [...]”;
 - ii. Exhibit F that consists of a sample label of Egg Solutions which product is sold at various hotels, food service, and variety stores in Ontario. Again, I note that the Mark is followed by the trade-mark symbol designated by TM, appearing right after it. The legend identifies the Mark as a trade-mark of

the Applicant that is used under license, and is followed by the mention “Prepared for/Préparé pour EggSolutions [...]”; and

- iii. Exhibit G that consists of samples of two labels of Exclusive Selections which product is sold to The Northern Company, who sells the product at its Northern Store locations from the Northern Stores website at *www.northernstores.ca*. Again, I note that the Mark is followed by the trade-mark symbol designated by TM, appearing right after it. The legend identifies the Mark as a trade-mark of the Applicant that is used under license, and is followed by the mention “Prepared for/Préparé pour The North West Company [...]”;
- Exhibit H that consists of a printout of the Northern Store locations from the website *www.northernstores.ca* ;
 - Exhibit I that consists of representative samples of invoices for Canadian and U.S. sales to licensees of the Wares in association with the Mark. The invoices pertaining to the Canadian sales are for the years 2008 and 2009 and were issued by Otter Valley;
 - Exhibit J that consists of copies of M & M Meat flyers for the year 2009 advertising the sale of the Wares in association with the Mark in Canada;
 - Exhibits K and L that consist of samples of labels for the Wares in association with the Mark used in the United States.

[21] I wish to mention at this point of my decision that the fact that the Mark is used and registered in the United States is not persuasive in this proceeding. Registration of the Mark in the United States is not binding upon the Registrar. Also, there is no evidence that the parties’ marks have coexisted in the American marketplace. My decision must be based on Canadian standards having regard to the situation in Canada [see *Quantum Instruments Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264 (T.M.O.B.)].

[22] Reverting to Mr. Kelly’s affidavit, Mr. Kelly states that in preparing his affidavit, it came to his attention that M & M Meat Shops packaging and internet website *www.mmmeatshops.com* use the GRIDDLE STACKER trade-mark without the “S”, although the Wares are properly advertised as “GRIDDLE STACKERS” in print advertisements. He states that he is in the

process of having M & M Meat Shops change its packaging and website to GRIDDLE STACKERS. While Mr. Kelly does not state expressly that the Applicant exercises control over the character and quality of the Wares, I am prepared to make such inference based on a fair reading of Mr. Kelly's affidavit as a whole and accompanying exhibits, which provide public notice of the fact that the use of the Mark is a licensed use and of the identity of the owner pursuant to s. 50(2) of the Act.

[23] Mr. Kelly states that he is not aware of any instances of confusion between the Mark used in association with the Wares and the Opponent's use of the STACKERS trade-mark in association with its product. He adds that he is not aware of any complaints from the Applicant's co-packaging and private label clients with respect to the use of the Mark on their products.

[24] Mr. Kelly further states that he is aware of the Opponent's product sold in association with the STACKERS trade-mark. However, he adds that he has only ever seen this product sold in association with the trade-marks SCHNEIDERS and LUNCH MATE rather than on its own. He further states that he has never seen the Opponent's product in the frozen food section of any of the retail outlets that he has visited.

The Stephan affidavit

[25] Mr. Stephan is a Senior Investigator with the investigation firm King Reed & Associates, who was retained by the Applicant's trade-mark agent to conduct a trade-mark investigation into the use of the word STACKER(S) in a trade-mark on food products in Canada.

[26] Mr. Stephan was asked to attend at each of the following grocery stores in Toronto or the Greater Toronto Area (GTA) - Loblaws, Sobeys, Costco, Metro, M & M Meat Shops, No Frills, Food Basics, Price Chopper, Fortinos, Longo's and Bruno's Fine Foods – to search for and note any food products with the word "STACKER(S)" in the product name or trade-mark. Mr. Stephan attaches to his affidavit one sample of each of the STACKER(S) product, namely "Schneiders Lunchmate Stackers" (that is the Opponent's STACKERS product); "Vlasic STACKERS Kosher Dills" (prepared for Pinnacle Foods Canada Corporation); and the

Applicant's GRIDDLE STACKERS [Exhibits A to D of his affidavit].

[27] Mr. Stephan also attended at a Burger King and a Wendy's locations to look for food products and materials that contain the word "STACKER(S)". He attaches to his affidavit the following exhibits:

- Exhibit F that consists of materials from Burger King for BKTMSTACKER burger that was advertised as Combo No. 10 on the menu at the Burger King location including the wrapper for the BKTMSTACKER, the receipt of purchase and printouts of the BKTMSTACKER from the *www.burgerking.ca* website including the description of the BKTMSTACKER product and nutritional information. The packaging for the product indicates that it is available as a double, triple or quad (number of patties in the "stacker"), and contains the slogan "How do you stack up?" The packaging also contains a box with BKTMSTACKER at the top and under it the words: "You might be looking at this BKTMSTACKER saying, 'It's piled so high with meat, cheese and bacon, I want to climb it.' Don't. Just eat it";
- Exhibit G that consists of materials from Wendy's for a Stack AttackTMDouble Cheeseburger, including the wrapper for the burger, the receipt of purchase of the "Stack Attack Value Meal", a photo image of the signage at the restaurant, and printouts from Wendy's Canada website *www.wendys.ca* of the Stack AttackTMDouble Cheeseburger description and nutritional information.

The Saltzman affidavit

[28] Ms. Saltzman is Director of the trade-mark searching department with Onscope and was retained by the Applicant's trade-mark agent to conduct a trade-mark register search in Canada as well as a distinctiveness character search including a GoogleTM search for the word STACKER(S) for food or services.

[29] The trade-mark register revealed nine trade-marks containing "stacker" or "stackers" in association with food wares or services, including the Applicant's Mark and the Opponent's

STACKERS mark. More particularly, the following third party trade-mark registrations were revealed by Ms. Saltzman's search:

- LAMB WESTON STACKERS & DESIGN (TMA632,312) registered on February 8, 2005 in the name of ConAgra Foods Packaged Foods Company, Inc. in association with frozen processed hash brown potato patties, excluding ready-to-eat snack foods;
- Rack Stacker (TMA749,131) registered on September 30, 2009 in the name of Steen M. Elmy in association with animal feed and animal feed supplements;
- SANDWICH STACKERS (TMA645,988 registered on August 18, 2005 and TMA628,707 registered on December 20, 2004); STACKERS (TMA639,109 registered on May 4, 2005); and SUPER STACKERS (TMA593,273 registered on October 23, 2002), all in the name of Pinnacle Foods Corporation in association with pickles.

[30] The distinctiveness character search revealed dictionary definitions of "stacker" and "stackers", including the WWWebster definition of stacker as "to arrange in a stack". The search report further includes, among others, printouts of recipes for:

- "My Hash Brown Stackers Recipe" and "Reuben Stackers Recipe" printed from the website *www.groupprecipes.com*;
- "Grilled Eggplant Stackers" and "Fruit Roo-up Stackers Recipes" printed from the website *http://recipes.sparkspeople.com*;
- "Sweet potato stackers" printed from the website *www.bbcgood food.com*;
- "Raisin Bagel Stackers Recipe" printed from the website *www.tasteofhome.com*;
- "Eggplant Stackers Recipe" printed from the website *www.theworldwidegourmet.com*;
- "Veggie Cracker Stackers Recipe" printed from the website *www.everydayhealth.com*;
- "Eggplant Stackers" and "Garden Vegetable Salad Stacker" printed from the website *www.tastebook.com*.

Analysis

Section 30(i) ground of opposition

[31] The Opponent has pleaded that the application does not comply with the requirements of s. 30(i) of the Act in view of the fact that:

[...] the Opponent's trade-mark has been adopted, filed, registered and used prior to the date of filing of [the Applicant's application]. Hence, the Applicant knew, is deemed to have known, or should have known of the Opponent's trade-mark and therefore could not have been satisfied that it was, or is entitled to, use the [Mark] in Canada, in association with the [Wares].

[32] This ground, as pleaded, does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the Opponent's STACKERS trade-mark at the time of filing the application for the Mark does not preclude it from making the statement in its application required by s. 30(i) of the Act.

[33] Even if the ground had been properly pleaded, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. As acknowledged by the Opponent at the oral hearing, there is no such evidence in the present case.

[34] Accordingly, the s. 30(i) ground of opposition is dismissed.

Section 12(1)(d) ground of opposition

[35] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark STACKERS identified above, which was registered on March 4, 2008. I have exercised the Registrar's discretion to confirm that such registration is in good standing as of today's date.

[36] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's STACKERS trade-mark.

[37] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[38] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

[39] Neither mark is inherently strong since, in the context of their associated wares, they are both suggestive of a food product that is "arranged in a stack", especially the Opponent's mark given that it consists of that word only. The word "GRIDDLE" suggests for its part that the Applicant's sandwiches have been cooked using a griddle.

[40] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. As per my review of the Kelly affidavit, the Applicant has commenced use of the Mark in Canada on January 31, 2008. Considering both the sales figures and the specimens of advertising provided by Mr. Kelly, I find it reasonable to conclude that the Mark has become known to some extent in Canada.

[41] Turning to the Opponent's use and promotion of the STACKERS trade-mark, the Wernham affidavit does not establish continuous use of the STACKERS trade-mark in Canada in association with prepackaged snacks comprising prepared meats, cheese and crackers since at least as early as 1994 as alleged by Mr. Wernham. However, as per my comments above, the Wernham affidavit does establish quite extensive use of the STACKERS trade-mark in Canada in association with such wares since at least as early as 2007. That said, I am not prepared to go as far as agreeing with the Opponent's contention that the STACKERS trade-mark *per se* has acquired a significant degree of distinctiveness and become well-known within the general population in Canada as the Wernham and Stephan affidavits evidence that the STACKERS trade-mark has always been used in close proximity to the SCHNEIDERS® LUNCHMATE® trade-marks of the Applicant. Given the suggestive or descriptive connotation of the word STACKERS and the fact that the location of such word under the words "SCHNEIDERS LUNCHMATE" is in the same location and font size as the words "pizza", "bagels", "s'mores", and "nachos" on other "SCHNEIDERS LUNCHMATE" products [see Exhibit E to the Wernham affidavit], it may be that the Opponent's advertising efforts and sales have generated considerably more awareness to the said other marks than to the STACKERS mark.

[42] In conclusion on the factor of the inherent distinctiveness of the marks and the extent to which they have become known, I would acknowledge that each of the marks at issue has been used to some extent in Canada, more so as regards the Opponent's mark STACKERS. Although this use may have helped to increase the acquired distinctiveness of the marks at issue, more so in the case of the Opponent's mark, I am of the view that they nonetheless remain weak marks. The evidence on file does not allow me to conclude that any of the marks at issue are so well known that one party is significantly and conclusively favoured over the other in the overall assessment of this first factor.

[43] The length of time the trade-marks have been in use also does not significantly favour one party over the other given that the Opponent has only shown use of its mark starting one year prior to the Applicant's use of the Mark.

[44] As for the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. The Opponent's registration covers "prepackaged snacks comprising prepared meats, cheese and crackers" whereas the Applicant's application is for "sandwich comprising one or more of the following: pancakes, egg, meat and cheese". While there are differences in the exact nature of the parties' wares in that the Wernham affidavit further evidences that the Opponent's wares consist of refrigerated lunch kits whereas the Kelly affidavit establishes that the Applicant's Wares consist of frozen breakfast sandwiches, the statements of wares do not include such particulars. As such, I agree with the Opponent that the nature of the parties' wares overlaps to some extent. Furthermore, as evidenced by the Wernham, Kelly and Stephan affidavits, both products are directed toward the same consumer base and travel through the same or overlapping channels of trade.

[45] Turning to the degree of resemblance between the marks, I find there is a fair degree of resemblance between the parties' marks owing to the common element "STACKERS". However, considering the suggestive or descriptive connotation of that word in the context of the parties' wares, the significance of this shared component is diminished, particularly in view of the fact that the first portion of the Mark is made of the word GRIDDLE, which I find dominates the Mark. This brings me to consider as a surrounding circumstance, the state of the register evidence and/or distinctiveness character search submitted by way of the Saltzman and Stephan affidavits.

[46] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992),

43 C.P.R. (3d) 349 (F.C.A.)].

[47] I agree with the Opponent that the number of registrations revealed by Ms. Saltzman's state of the register search is, in itself, insufficient to draw inferences about the state of the marketplace. However, that evidence must be regarded together with the evidence of use of the word STACKER(S) in the marketplace introduced by way of the Stephan affidavit, which shows use of at least one of the third party trade-mark registrations for STACKERS revealed by the state of the register search in association with pickles, as well as use of the word STACKER or STACK in association with burgers [see Exhibits B, F and G to the Stephan affidavit]. Ms. Saltzman's distinctiveness character search further shows that the word STACKER(S) is a commonly and descriptively used term in the food industry [see Exhibit 4 to the Saltzman affidavit enclosing numerous printouts of recipes]. Given this evidence, I find it may be inferred that consumers are accustomed to making fine distinctions between trade-marks incorporating the descriptive word STACKER(S) in the marketplace, as further supported by the lack of confusion between the parties' marks despite two years of coexistence.

[48] Indeed, another surrounding circumstance that must be considered in the instant case is the lack of confusion between the marks despite their fairly substantial use and coexistence in Canada in overlapping channels of trade for two years. As stated in *Dion Neckwear, supra*:

With respect to the lack of evidence by the opponent of actual confusion, the Registrar expressed the view that an opponent does not need to file that kind of evidence. This is true in theory, but once an applicant has filed some evidence which may point to unlikelihood of confusion, an opponent is at great risk if, relying on the burden of proof the applicant is subject to, it assumes that it does not need to file any evidence of confusion. While the relevant issue is "likelihood of confusion" and not "actual confusion", the lack of "actual confusion" is a factor which the courts have found of significance when determining the "likelihood of confusion". An adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent. (See *Pink Panther Beauty Corp. v. United Artists Corp.*, [1998], 80 C.P.R. (3d) 247 (F.C.A.) ; *Multiplicant Inc. v. Petit Bateau Valton S.A.* (1994), 55 C.P.R. (3d) 372 (F.C.T.D.); *Bally Schuhfabriken AG/Bally's Shoe Factories Ltd. v. Big Blue Jeans Ltd.* (1992), 41 C.P.R. (3d) 205 (F.C.T.D.); *MonSport Inc. v. Vêtements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.).)

Conclusion regarding the likelihood of confusion

[49] Having considered all the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties' marks. I reach this conclusion primarily because the marks at issue are weak marks and have peacefully coexisted for two years without any instances of confusion. Further, the Applicant has shown that the word STACKER(S) is commonly and descriptively used in the food industry. Thus, I find that the differences existing between the parties' marks and the nature of the wares should be sufficient to avoid a likelihood of confusion.

[50] Accordingly, the s. 12(1)(d) ground of opposition is dismissed.

Non-distinctiveness ground of opposition

[51] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish and is not adapted to distinguish the Applicant's Wares from the wares of the Opponent sold in association with the trade-mark STACKERS.

[52] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition, in this case January 8, 2009, its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. The Opponent has met this burden.

[53] The difference in relevant dates affects to some extent my analysis above under the s. 12(1)(d) ground of opposition in that the length of time that the parties' marks have coexisted is reduced to one year as of January 8, 2009, and that the Stephan and Saltzman affidavits both postdate such material date. However, I note that except for registration No. TMA749,131, the third party registrations revealed by Ms. Saltzman's state of the register search were all registered prior to January 8, 2009. I further note that according to the information disclosed on at least one of the printouts of recipes attached as Exhibit 4 to the Saltzman affidavit, the word STACKERS has been used descriptively prior to January 8, 2009, in that it has been used as a

generic word of the English language that is commonly understood to mean “to arrange in a stack”.

[54] I still find that the differences existing between the parties’ marks and the nature of the wares should be sufficient to avoid a likelihood of confusion. I am of the opinion that the addition of the word GRIDDLE in the Mark is sufficient to distinguish between the marks because of their low distinctiveness.

[55] Accordingly, the non-distinctiveness ground of opposition fails.

Disposition

[56] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office