

**IN THE MATTER OF AN OPPOSITION
by Jivan Foods Inc./Aliments Jivan Inc. to
application No. 1,070,395 for the trade-
mark KISS THE COOK filed by Summer
Kitchen Fine Foods Inc.**

On August 9, 2000, Summer Kitchen Fine Foods Inc. (the “Applicant”) filed an application to register the trade-mark KISS THE COOK (the “Mark”) based upon use of the Mark in Canada in association with food products, namely sauces since at least as early as January 1998. The application was subsequently amended to rely upon use of the Mark in Canada in association with food products, namely cooking and grilling sauces since at least as early as May 1998. The right to the exclusive use of the word “COOK” has been disclaimed apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of September 26, 2001.

On February 26, 2002, Jivan Foods Inc./Aliments Jivan Inc. (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

The Opponent’s evidence consists of the declaration of Harry I. Ghosh. The Applicant obtained an order for the cross-examination of Mr. Ghosh but did not conduct a cross-examination.

The Applicant’s evidence consists of the affidavit of Mary Fabiano.

Neither party filed a written argument. An oral hearing was not requested.

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The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”). There is however an initial 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.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

Summary of Opponent's Evidence

Mr. Ghosh has been an officer and managing partner of the Opponent since its incorporation in 1999. The Opponent's business is described as the development, manufacture and marketing of delicious and nourishing gourmet prepared meals.

In 1999, the Opponent received brand development assistance from a Quebec government agency, which resulted in its adoption of the KISS THE COOK Design mark (hereinafter the "Opponent's Mark") shown below:



On October 16, 1999, the Opponent delivered sample pasta sauce bearing the Opponent's Mark to certain businesses. Its first sale was on October 22, 1999.

On November 4-7, 1999, the Opponent presented its pasta sauce in association with the Opponent's Mark at a trade show in Montreal.

In April 2000, the Opponent expanded its product line beyond pasta sauce into curries.

Mr. Ghosh attests that both the Opponent's sales and product line rapidly increased in 2000, when it sold 21,600 jars of product in association with its mark, worth approximately \$180,000. In 2000, 114 stores across Canada were carrying the Opponent's products. The stores in question included both specialty food stores and grocery stores.

In addition to promoting its wares at various trade shows, the Opponent has promoted them in Provigo and Metro grocery stores and Health Tree Natural Foods store in Montreal, in Sobeys grocery stores in Atlantic Canada, and in Pusateri's gourmet food store and Whole Foods Market stores in Toronto. The Opponent has spent at least \$59,000 on advertising the Opponent's Mark since its inception.

In 2000, the Opponent started its www.kissthecook.ca website; as of October 2002, its e-mail list had reached 300 subscribers.

In 2000 and 2001, the Opponent's products were reviewed in five French-language magazines/newspapers. No circulation figures have been provided, but I can take judicial notice that there would have been fairly substantial circulation of the article that appeared in the March 29, 2001 issue of *La Presse*. [See *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.).]

By 2002, the Opponent had secured a second national distributor and by September 2002 its products were being sold in 227 stores. In July 2002, the Opponent secured its first sale to the United States. In 2002, as of the end of October, the Opponent had sold 25,800 jars of KISS THE COOK Design products, with a retail value of approximately \$216,000.

The Opponent applied to register the Opponent's Mark on November 17, 1999. The Opponent was unaware of the Applicant's Mark until it was cited against the Opponent's trade-mark application on September 12, 2000.

Summary of Applicant's Evidence

Ms. Fabiano, the Applicant's President, has been responsible for the Applicant's products, including the KISS THE COOK sauces, since the Applicant was incorporated in 1996.

The Applicant developed its KISS THE COOK labels *etc.* in 1998. The labels of the KISS THE COOK sauce read, "For use on or off the fire, it transforms plain vegetables, stir fries, grilled meats and seafood into tantalizing dishes."

The first sale of the Applicant's sauce occurred on May 6, 1998 and gross sales revenue for that year amounted to \$2191. Sales in subsequent years were as follows: 1999 - \$3081; 2000 - \$1740; 2001- \$7342; 2002 - \$1867. Aggregate sales between May 6, 1998 and April 30, 2003 have been \$16,638.

Ms. Fabiano says that the Applicant sells its products directly through retail stores across Canada. Examples of these retailers are Beautiful Gifts, All The Best Breads, Holt Renfrew, Bloor Meat Market, William Ashley Limited, Worldwide Specialty Foods Inc., Pusateri's, Blackbird Catering, Elora General Store, Broadway Farm Market, Jubilee Fruit Market, and Flowers by Amber. The majority of the retailers offering the Applicant's products are located in Ontario.

The Applicant has promoted its products, including its KISS THE COOK sauces, at various shows, such as the Ontario Garden Show, the Bayview Support Network Christmas Show and Sale, the Cabbagetown Arts & Craft Show, One of a Kind Show and Sale, the Canadian Gift & Tableware Association Show, and the Canadian Fine Food Show, all of which appear to take place in Ontario.

The Applicant has expended \$27,797 on promoting its products, including its KISS THE COOK sauces, but it is not clear what percentage is attributable to the Applicant's Mark.

The Applicant purchased the domain name www.summer-kitchen.com in 2000 and pages from that website have been provided as of 7/28/03. These pages include advertisements for the KISS THE COOK sauces and offer those products for sale. However, no details have been provided as to how many Canadians have accessed the website.

Unsolicited articles that refer to the Applicant's KISS THE COOK sauces have appeared in magazines such as the July/August 2000 issue of *Style at Home, Canada's Decorating Magazine* and the Summer 2001 issue of the LCBO's *Food and Drink* magazine. (No circulation figures have been provided.)

Section 30 Grounds of Opposition

The Opponent has pleaded four grounds of opposition under s. 30 of the Act. The material date with respect to s. 30 is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

The legal burden on the Applicant to show that its application complies with s. 30 includes both the question as to whether or not the Applicant has filed an application which formally complies with the requirements of s. 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the Opponent relies on allegations of fact in support of its s. 30 grounds, there is an evidential burden on the Opponent to prove those allegations. [*Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.), affd 33 C.P.R. (3d) 454]

Section 30(a)

The Opponent has pleaded that the application does not comply with s. 30(a) because the Applicant did not provide a statement in ordinary commercial terms of the specific wares in association with which the Mark is alleged to have been used in that the term “cooking sauces” is unclear and not sufficiently specific.

No evidence or argument was filed to meet the Opponent’s initial burden with respect to its claim that the Applicant’s wares are not stated in ordinary, commercial terms. Accordingly, this ground of opposition is rejected.

Section 30(b)

The Opponent has pleaded that the application does not comply with s. 30(b) because the Applicant has not used the Mark in Canada in association with each of the general classes of wares “cooking sauces” or “grilling sauces” since the alleged date of first use or has abandoned its use.

The initial burden on an opponent respecting a s. 30(b) ground may be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company*

Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims as set forth in its application.

In the present case, the Opponent has not filed any evidence in support of the s. 30(b) ground of opposition; moreover, Ms. Fabiano's evidence supports the Applicant's claimed date of first use.

Regarding the Opponent's reference to there being two general classes of wares, I note that the Applicant originally filed simply for food products, namely sauces and subsequently further defined its wares as food products, namely cooking and grilling sauces. In this regard, I note that the product sold by the Applicant can be used for both cooking and grilling.

The s. 30(b) ground is dismissed because the Opponent has not met its initial burden.

Section 30(i)

The Opponent has pleaded that the application does not comply with s. 30(i) because the Applicant could not properly have been satisfied that it was entitled to use the Mark in Canada in association with the wares described in the application given the facts set out herein.

I do not see how the facts set out in the statement of opposition would prevent the Applicant from making the statement required by s. 30(i). Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases 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.) at 155.]

The s. 30(i) ground is therefore dismissed.

Distinctiveness Ground of Opposition

The Opponent has pleaded as follows:

The applied-for word mark KISS THE COOK is not distinctive of the Applicant within the provisions of Section 2 of the Act because it does not actually distinguish, nor is it adapted

to distinguish, the wares of the Applicant from the wares of the Opponent sold in association with its trade-mark KISS THE COOK Design as set out in Paragraph 3 herein. To the extent that there may have been any alleged non-abandoned use of any similar trade-mark by the Applicant in the marketplace, which fact is in any case denied, such use was of a design mark that would not have been confusing with the Opponent's distinctive trade-mark KISS THE COOK Design. Further, the applied-for word mark is not distinctive of the Applicant in view of the Applicant's non-use or abandonment of its mark, and in view of the distinctiveness of the Opponent's mark KISS THE COOK Design acquired through extensive use in the marketplace.

Paragraph 3 referred to above reads as follows:

The Opponent has used the trade-mark KISS THE COOK Design in Canada, continuously and up to the present, since at least as early as October 15, 1999 in association with the wares: Prepared foods, namely meals, sauces, soups, pies, sausages, pizzas where the meat has been replaced with textured vegetable proteins including gourmet innovations in soya proteins; other gourmet foods and condiments, prepared and easy to prepare; dehydrated and packaged food products that are easy to prepare; institutional and food service industry food offerings.

I have had some difficulty in understanding the above pleading but have concluded that the Opponent is arguing that the word mark KISS THE COOK is not distinctive because it is confusing with the Opponent's KISS THE COOK Design mark. However, the Opponent also asserts that any KISS THE COOK Design mark that the Applicant may claim to have been using is not confusing with the Opponent's KISS THE COOK Design mark, presumably on the basis that the designs would serve to distinguish the two KISS THE COOK Design marks from each other. I assume that this convoluted pleading has arisen in response to the fact that the Applicant's claimed date of first use predates that of the Opponent; the Opponent is presumably concerned about avoiding an admission that its mark is confusing with a prior mark. Whatever the reason for the form of pleading, I think it would require an usual fact situation (such as state of the marketplace evidence showing that many parties use KISS THE COOK) for a KISS THE

COOK Design mark to not be confusing with another KISS THE COOK Design mark when both are used with respect to prepared food.

I note that the Applicant uses a design comprising two heads wearing BBQ/chef hats in association with its Mark. Such a design may not be confusing with the design portion of the Opponent's Mark, but that is not the issue in these proceedings.

An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *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.)]. However, when the opponent is the junior user, as is the case at hand, it can only rely on the use or promotion that it made of its mark prior to learning of the senior mark. Mr. Justice Shore discussed this with regard to the decisions in *George Weston Ltd. v. Humpty Dumpty Foods Ltd.* (1989), 24 C.P.R. (3d) 454 (F.C.T.D.) and *Kimberly-Clark of Canada Ltd. v. Molnlycke AB* (1982), 61 C.P.R. (2d) 42 (F.C.T.D.) in paragraph 37 of his decision in *Remo Imports Ltd. v. Jaguar Cars Ltd.* (2006), 47 C.P.R. (4th) 1 (F.C.T.D.) [2007 FCA 258], as follows:

... In *Humpty Dumpty*, Mr. Justice Martin found that the Opposition Board should not have considered the applicant's (junior user's) use of its mark after the opponent's (senior user's) co-pending application for the same mark had been cited against the junior user's proposed use application, including junior user's use prior to the material date for considering the non-distinctiveness basis of opposition (i.e. the date the opposition was filed):

...I would also allow this appeal on the grounds that the chairman should not have received the evidence of the [junior user] with respect to the use of its proposed trademark after the [junior user] had received the notice of May 10, 1985, from the Trade marks Office that its proposed mark would not appear to be entitled to registration in view of the co-pending and conflicting application of the [senior user.]

In *Molnlycke* [FN226] [the Court held]:

The obvious fallacy in accepting the date of opposition proceedings as the effective date for the consideration of the rights between the parties rather than the date of the filing of the opposition would permit the circumstances being varied in the interval to

strengthen the position of one of the parties... (Emphasis added)

In the present case the [junior user] had been informed of the unlikelihood of its application being allowed because of the apparent confusion with the [senior user's] application. *It then set out to strengthen its case by the generation of evidence to show that it had a prior claim and stronger claim by reason of usage.* In the words of the court in the *Molnlycke* case these are circumstances which should not have been considered and, in my view, for the same reason, the evidence of the [junior user's] activities which occurred after the notice of May 10, 1985, should not have been considered by the chairman.

[See also *Courtyard Restaurant Inc. v. Marriott Worldwide Corp.*, 2006 CarswellNat 5371 (T.M.O.B.).]

In the present case, Mr. Ghosh has attested that the Opponent became aware of the Applicant's Mark on September 12, 2000 and so I must assess whether the Opponent's Mark had become sufficiently known as of September 12, 2000 to negate the distinctiveness of the Mark as of the material date. The evidence of Mr. Ghosh that pre-dates September 12, 2000 is summarized below:

- October 16, 1999, 12 jars of KISS THE COOK Design pasta sauce were delivered to a food manufacturing/distribution company in Dorval, Quebec, with the intent to develop overseas export business to Taiwan
- October 16, 1999, a sample jar of KISS THE COOK Design pasta sauce was delivered to a high-end gourmet food retail store located in Montreal; this was followed up with another sample jar on October 21; on October 22, 1999 this store purchased 60 jars from the Opponent
- October 22, 1999, 12 jars were sold to Les Saveurs D'ici, followed by 12 more jars on December 15, 1999
- November 4-7, 1999, the KISS THE COOK Design pasta sauce was promoted at the Salon de la Gastronomie in Montreal, which is a trade show directed to the general public; 102 jars were sold
- November 5, 1999, 4 jars were shipped to Elco Fine Foods Inc., Canada's largest specialty food distributor
- November 19, 1999, 24 jars were sold to Marché Mont Casino

- January 7, 2000, 600 jars of KISS THE COOK Design pasta sauce were sold to Elco Fine Foods Inc.
- January 18, 2000, 3 cases (?) of KISS THE COOK Design pasta sauce was sold to Fleur Sauvage
- February 2000, the Opponent promoted its KISS THE COOK Design pasta sauce at the Salon Rendez-Vous Trade Show in Montreal
- March 17-18, 2000, the Opponent promoted its KISS THE COOK Design products at a Provigo grocery store in Montreal
- March 21, 2000, 24 jars of KISS THE COOK Design pasta sauce were sold to Marché Mont Casino
- April 14, 2000, 600 jars of KISS THE COOK Design curry were sold to Elco Fine Foods Inc.
- April 18, 2000, the Opponent promoted its KISS THE COOK Design products at the Gourmet International trade show in Montreal
- April 19-22, 2000, the Opponent promoted its KISS THE COOK Design products at Pusateri's food store in Toronto
- April 30 and May 1-2, 2000, the Opponent promoted its KISS THE COOK Design products at the Canadian Fine Food Show held in Toronto
- May 9, 2000, 2 jars (or cases?) were sold to Fleur Sauvage
- August 4-20, 2000, the Opponent promoted its KISS THE COOK Design products at the Fêtes Gourmandes Internationales de Montreal exhibition, at which 92 jars were sold
- August 16 and May 31, 2000, the Opponent issued an unknown number of e-mail newsletters

Based on the foregoing, I find that the Opponent has met its initial burden, primarily through its promotion of its KISS THE COOK Design products in Montreal. I also find that the Applicant's word mark KISS THE COOK was not capable of distinguishing the source of its cooking and grilling sauces from the source of the KISS THE COOK Design pasta sauces in Montreal as of February 26, 2002. Although the Applicant's Mark may be distinctive of its wares in parts of Canada, its application cannot proceed to registration if it is not distinctive, or capable of being distinctive, across Canada. The distinctiveness ground of opposition therefore succeeds.

I have noted that the Applicant did sell at least \$72, \$39 and \$39 worth of its KISS THE COOK sauces in the Montreal area in 1999, 2000 and 2001 respectively, but that does not change the outcome of the distinctiveness ground.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 29th DAY OF AUGUST 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board