



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

Citation: 2012 TMOB 56
Date of Decision: 2012-03-23

**IN THE MATTER OF AN OPPOSITION
by Maple Leaf Foods Inc. to application
No. 1,378,130 for the trade-mark
OLDENHÄUSER filed by Lidl Stiftung &
Co. KG**

Introduction

[1] On January 7, 2008 Lidl Stiftung & Co. KG (the Applicant) filed application No. 1,378,130 to register the trade-mark OLDENHÄUSER (the Mark) based on registration and use in Germany. It was registered in Germany on August 18, 1997.

[2] The application, once amended, covers:

Meat, poultry, game; meat products, sausage products and small sausage products, namely meat loaf, meat paste, meat balls, pastrami, meat juices, blood sausages, frankfurters (meat only, not sandwiches), hamburgers (meat only, not sandwiches), hot dogs (meat only, not sandwiches) meat-based mousse, meat-based spreads, ham, bacon, salami, mortadella, bacon rinds, roast beef, corned beef, beef patties, sausage patties; meat preserves, sausage preserves and small sausage preserves; meat jellies; ready-to-serve meals, semi-ready-to-serve meals and salads, essentially consisting of meat, meat products, sausage, small sausages and/or poultry, also with the addition of bread and/or cheese and/or farinaceous pastes and/or potatoes and/or rice and/or vegetables; preserved, dried and cooked fruits and vegetables; cheese, cheese preparations, namely cheese fondue, cheese spreads, cottage cheese, cream cheese, cheese sauce and processed cheese. Sauces namely salad sauces, soy sauce, spaghetti sauce, fruit sauces, tartar sauce, tomato sauce, apple sauce, artichoke sauce, barbecue sauce,

cheese sauce, chili sauce, cranberry sauce, hot sauce, pizza sauce, ketchup, mustard, mayonnaise; vinegar, spices; bread, pastries; cereal preparations for alimentary purposes, namely cereal-based bars, cereal-based snack food, breakfast cereals, processed cereals (the Wares).

[3] The Applicant has stated in its application that the term OLDENHÄUSER is a coined word.

[4] The application was advertised on January 7, 2009 in the *Trade-marks Journal* for opposition purposes. Maple Leaf Foods Inc. (the Opponent) filed a statement of opposition on June 2, 2009 which was forwarded by the Registrar on June 18, 2009 to the Applicant. The latter denied all grounds of opposition in a counter statement filed on June 29, 2009.

[5] The Opponent filed as its evidence the affidavit of Adam J. Grogan while the Applicant filed the affidavit of Anne-Christine Boudreault.

[6] Only the Opponent filed a very succinct written argument and requested a hearing to which it was present.

The Grounds of Opposition

[7] The grounds of opposition pleaded by the Opponent can be summarized as follow:

1. The Mark is not registrable in view of s. 12(1)(d) of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the Act) since it is confusing with Opponent's registered trade-mark OVERLANDER certificate of registration TMA215,406 registered in association with cured meats, smoked meats and cooked meats; fresh meats;

2. The Applicant is not entitled to the registration of the Mark pursuant to s. 16(2)(a) of the Act in that at the filing date of the application it was confusing with the Opponent's trade-mark OVERLANDER previously used by the Opponent and its predecessor in title in Canada since at least as early as May 1971 in association with cured meats, smoked meats and cooked meats and since at least as early as July 20, 1976 in association with fresh meats;

3. Pursuant to s. 38(2)(d), the Applicant's Mark is not distinctive in that it does not distinguish nor is it adapted to distinguish the Wares from the wares of others and

in particular those of the Opponent having regard to, among other things, the Opponent's previous use in Canada of the trade-mark OVERLANDER in association with cured meats, smoked meats cooked meats and fresh meats.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceeding

[8] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) and *Wangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[9] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Registrability of the Mark under s. 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)];
- Entitlement to the registration of the Mark, where the application is based on use and registration abroad: the filing date of the application (January 7, 2008) [see s. 16(2) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (June 2, 2009) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Registrability of the Mark under s. 12(1)(d) of the Act

[10] Mr. Grogan is the Vice President of Marketing, Consumer Meat Products of Maple Leaf Consumer Foods Inc. (MLCF) a member the Opponent. He has been employed by MLCF since 1998 and has held this position since March 2007. He alleges that the Opponent is the owner of the trade-mark OVERLANDER, registration TMA215,406 which was registered on August 13, 1976. He filed a copy of the registration. I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11C.P.R. (3d) 410]. However the list of wares covered by such registration has been amended to delete “fresh meat” subsequent to a s. 45 proceeding. Therefore registration TMA215,406 now covers cured meats, smoked meats and cooked meats.

[11] Therefore the Opponent has met its initial burden of proof. As such the Applicant has the burden to prove, on a balance of probabilities, that the use of the Mark in association with the Wares is not likely to cause confusion with the Opponent’s registered trade-mark OVERLANDER. The test to determine this issue is set out in s. 6(2) of the Act. I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have 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.

[12] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[13] The Mark is a coined word and is therefore inherently distinctive when used in association with the Wares. The Opponent’s trade-mark OVERLANDER is found in the Canadian Oxford Dictionary as appears from an extract filed by Anne-Christine

Boudreault, an articling student employed by the Applicant's agent's firm. It is defined as "A group of people who journeyed overland from Ontario to the Cariboo goldfields in British Columbia in 1862". Even though it is a word in the English dictionary, it has no association with the wares covered by the Opponent's registration.

[14] The distinctiveness of a trade-mark may be enhanced through use or promotion in Canada. There is no evidence of use of the Mark in Canada in the record. I shall now summarize the Opponent's evidence of its use of the trade-mark OVERLANDER in Canada.

[15] Mr. Grogan states that MLCF manufactures and sells OVERLANDER branded meat products in Canada pursuant to a trade-mark license agreement with the Opponent. The Opponent exercises direct or indirect control of the character or quality of the wares distributed and sold in Canada by MLCF in association with the trade-mark OVERLANDER. He refers throughout his affidavit to the Opponent and MLCF as Maple Leaf. Any use of the Opponent's trade-mark OVERLANDER by MLCF is deemed use of such trade-mark by the Opponent in virtue of the provisions of s. 50 of the Act. Consequently I shall simply refer hereinafter to the Opponent and will only make a distinction between the Opponent and MLCF if deemed necessary.

[16] Mr. Grogan alleges that the Opponent has been using the trade-mark OVERLANDER in Canada continuously since as early as May 1971 on cured, smoked and cooked meats. He alleges that the trade-mark is imprinted directly onto product labels which are then affixed to the goods. He filed samples of actual product labels bearing the trade-mark OVERLANDER.

[17] Mr. Grogan provides the Opponent's yearly sales figures by province for the years 2003, 2004 and 2005 which have been in excess of 14 million dollars. He also furnished the total tonnage sales during 2006, 2007 and 2008 of products sold in Canada in association with the trade-mark OVERLANDER.

[18] Mr. Grogan states that the Opponent sells its goods under the trade-mark OVERLANDER to grocery retailers and distributors throughout Canada such as

Loblaws, Sobeys, Safeway and others. He also provides a list of total kilograms of product sold by customer for the period 2003, 2004 and 2005. He states that the Opponent advertises the OVERLANDER brand to Canadian consumers by placing advertisements in flyers which are available in grocery stores and distributed by mail. He filed an assortment of point of sale advertising materials used in 2004, 2005, 2006, 2007 and 2009 on which appear products bearing the trade-mark OVERLANDER.

[19] Mr. Grogan also filed samples of invoices issued to customers for the sale of products in Canada for the years 2003, 2004, 2005, 2007, 2008 and 2009 bearing the trade-mark OVERLANDER. Those products are identified on the invoices by the letters “OV”.

[20] I conclude that the Opponent’s trade-mark OVERLANDER is known in Canada.

Length of time the trade-marks have been in use

[21] From the evidence described above, this factor clearly favours the Opponent.

Nature of the wares, services, or business; the nature of the trade

[22] In general, when considering the nature of the wares and trade of the parties, it is the statement of the wares in the application that governs. [See *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)] Evidence of the actual trades of the parties could be useful in reading the statement of wares with a view of determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [See *McDonald’s Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.)]. The Applicant failed to produce any evidence on the nature of its trade. There is definitely some overlap in the parties’ respective wares in so far as various types of meat is concerned. I have to presume that, in the absence of evidence from the Applicant to the contrary, at least for the various types of meat, they would be sold through the same channels of trade as those used by the Opponent and more fully described hereinbefore. Therefore this factor also favours the Opponent.

The degree of resemblance

[23] In its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 S.C.C. 27 the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under s. 6(5) of the Act is often the degree of resemblance between the marks. One must look at the marks in their totalities and should not dissect each one of them into its components.

[24] The only common feature between the marks in issue is that they begin with the letter O. Phonetically and visually they are different. Moreover, the Mark being a coined word, the diaeresis on the letter A gives it an exotic connotation.

[25] In all, this factor favours the Applicant.

[26] From this analysis, I conclude that the Applicant has met its burden to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trade-mark OVERLANDER as the Mark is inherently distinctive and there is no degree of resemblance between the marks in issue except for the fact that they begin with the letter O, which is not sufficient in itself to state that there is some resemblance between the marks.

[27] I therefore dismiss the first ground of opposition.

The Remaining Grounds of Opposition

[28] The other grounds of opposition are based on the likelihood of confusion between the Mark and the Opponent's trade-mark OVERLANDER. The only difference between the registrability ground of opposition based on s. 12(1)(d) on one hand and entitlement based on s. 16(2)(a) and distinctiveness of the Mark based on s. 2 of the Act on the other hand, is the relevant date associated with those other grounds of opposition. Those earlier dates would not have an impact on my analysis of the criteria listed under s. 6(5) of the Act.

[29] Consequently the second and third grounds of opposition are also dismissed.

Disposition

[30] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject pursuant to s. 38(8) of the Act the opposition to the registration of the Mark.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office