

IN THE MATTER OF AN OPPOSITION by
U L Canada Inc. to application No. 677,947 for
the trade-mark UN-PETROLEUM JELLY filed
by Autumn-Harp, Inc.

On March 15, 1991, Autumn-Harp, Inc. filed an application to register the trade-mark UN-PETROLEUM JELLY based on use of the mark in Canada since at least as early as May 22, 1990, and also based on use and registration (under No. 1,597,097) of the mark in the United States of America, in association with the wares

"lubricating, moisturizing jelly for the skin."

The application was subsequently amended to disclaim the right to the exclusive use of the word JELLY apart from the mark as a whole, and to change the date of first use of the mark in Canada to February 12, 1990 [see Rule 36(c) of the Trade-marks Regulations regarding the latter amendment].

The subject application was advertised for opposition purposes in the Trade-marks Journal issue dated December 4, 1991. The original opponent namely, Chesebrough-Ponds (Canada) Inc., filed a statement of opposition on March 25, 1992, a copy of which was forwarded to the applicant on May 20, 1992. The applicant responded by filing and serving a counter statement. The original opponent subsequently amalgamated with other companies to form U L Canada Inc., the present opponent.

The first ground of opposition is that the mark UN-PETROLEUM JELLY is not registrable, pursuant to Section 12(1)(b), because it is clearly descriptive or deceptively misdescriptive of the applicant's wares. The second ground is that the mark is not registrable, pursuant to Section 12(1)(c), because it is the name in the English language of the applicant's wares. The third ground is that the applied for mark UN-PETROLEUM JELLY is not registrable, pursuant to Section 12(1)(d), because it is confusing with the opponent's registered mark UN (regn. No. 223,285) for lip gloss. The fourth ground is that the applied for mark is not registrable, pursuant to Section 12(1)(e), because it has become known in Canada as designating the kind or quality of the wares in respect of which registration is sought. The last ground is that the applied for mark is not distinctive of the applicant's wares "having regard to the Opponent's

and others extensive use of the phrase PETROLEUM JELLY to describe their products and the use to which the trade-mark UN has been put in Canada."

The opponent's evidence consists of the affidavits of Valerie J. L. Brown, Nelson S. Everhart III, Peter Gallagher, William (Bill) Langlois, Thomas M. Paikeday, and Maribel T. Rondilla. The applicant's evidence consists of the affidavit of Herbert McPhail. The Herbert affidavit initially filed with the Office was unsworn and undated, although it appears that a duly sworn version was served on the opponent. However, the applicant filed a duly sworn copy of the Herbert affidavit with the Office several days prior to the oral hearing. None of the affiants were cross-examined on their affidavit evidence. Only the applicant was represented at the oral hearing.

At page 10, paragraph two, of its written argument, the opponent indicates that it "will not press the issues of registrability under Sections 12(1)(d) and (e)." Accordingly, the third and fourth grounds of opposition are no longer in issue.

I will first consider the allegation that the applied for mark UN-PETROLEUM JELLY is not registrable because it is clearly descriptive or deceptively misdescriptive of the character or quality of applicant's wares namely, "lubricating, moisturizing jelly for the skin." In this context, the word "character" is taken to mean a feature, trait or characteristic of the wares and the word "clearly" is taken to mean "easy to understand, self-evident or plain" [*Drackett Co. of Canada v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. C.)]

For a word or phrase to be clearly descriptive, it must be material to the composition of the goods or products and refer to an intrinsic quality or characteristic of the product [*Provenzano v. Registrar of Trade-marks* (1977), 37 C.P.R.(2d) 189 (F.C.T.D.); (1978) 40 C.P.R. (2d) 288 (F.C.A.)].

Further, the issue arising from Section 12(1)(b) is to be decided from the point of view of an everyday user of the wares considering the mark in its entirety (as opposed to carefully

analyzing and dissecting the mark into its component parts) and as a matter of first impression [*Wool Bureau of Canada Ltd. v. Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25 at 27-28 (F.C.T.D.), *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 at 188 (F.C.T.D.)]. Where the trade-mark, such as the applicant's trade-mark UN-PETROLEUM, is not defined in any dictionary and is therefore a coined word, reference may be made to dictionaries in order to ascertain the meanings of the component parts of the trade-mark. In order for the trade-mark as a whole to be clearly descriptive of the character of the applicant's wares, it is the combination of words forming the mark that must have a meaning which is readily discernible.

The material time for considering the circumstances respecting a ground of opposition based on Section 12(1)(b) is as of the date of my decision [*Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992), 41 C.P.R.(3d) 234 (F.C.A.)]. The legal onus is on the applicant to establish that its mark is not clearly descriptive. There is an evidential burden on the opponent to adduce sufficient evidence which, if believed, would support its allegation that the applied for mark offends the provisions of Section 12(1)(b).

The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached after all the evidence is in and after the arguments are heard, then the issue must be decided against applicant [*Joseph E. Seagram & Sons v. Seagram Real Estate Ltd.* (1984), 3 C.P.R.(3d) 325 at 329-330 (TMOB); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.)].

Petroleum jelly (otherwise known as petrolatum) is a neutral greasy substance, obtained from petroleum, practically odourless and tasteless and is insoluble in water. Petroleum jelly is used chiefly as a base for ointments and cosmetics, as a protective dressing (as for burns), and in lubricating greases [see Webster's Third New International Dictionary].

The opponent's evidence supporting the allegation that the phrase UN-PETROLEUM JELLY is clearly descriptive of the applicant's wares is found in the affidavit of Thomas M.

Paikeday. Mr. Paikeday has set forth in detail his background and expertise in the field of lexicography which, in my view, qualifies him as an expert in this area. Paragraph 3 of Mr. Paikeday's affidavit is shown below:

Expert opinion evidence in opposition proceedings is admissible only to assist the Registrar in reaching a decision, bearing in mind that it is the Registrar's decision, and not the expert's. As was pointed out by Mr. Justice Mahoney in *William H. Rorer (Canada) Ltd. v. Johnson & Johnson*, 48 C.P.R. (2d) 57, at pg. 62:

The adjudicator is not justified in adopting an opinion simply on the basis of an expert's expertise. He must know the facts and/or assumptions upon which the expert based his opinion so that he can assess both the validity of the opinion and the process by which it was reached.

Mr. Paikeday's evidence may be summarized as follows. The prefix "un" is normally applied to adjectives, participles and to nouns and adverbs derived from them, forming such words as unclarity and unhappiness. Words in the same form in which the noun is not derived from an adjective or participle include unrest, unease, and unconcern. The latter type of word formations "have been almost entirely restricted to those of an *abstract nature* [emphasis by Mr. Paikeday]."

Unlike the above examples, petroleum jelly is not abstract in meaning nor is it a derivative as discussed above. Rather, petroleum jelly is a concrete referent, that is, a term denoting a "thing" rather than a quality or an action. Concrete things have to exist in reality as

distinguished from existing in the mind. Examples of *un + concrete noun* are unshapes (appeared in print in 1843), unaddress (appeared in print in 1853), un-country (appeared in print in 1964) , and un-books (appeared in print in 1982) [see para. 5 of the Paikeday affidavit]. Mr. Paikeday notes that George Orwell's use of *unperson* in his 1949 book *1984* probably helped to popularize the combination *un + concrete noun*.

A comparable word formation of particular interest in the instant case is discussed in paragraph 6 of Mr. Paikeday's affidavit:

Owing to the scanty number of examples evidenced by Mr. Paikeday, I find it difficult to conclude that the word formation *un + concrete noun* has in fact become a generic feature of the English language (although the McPhail affidavit filed on behalf of the applicant indicates a popularity for the formation for trade-marks). In any event, in my view nothing turns on whether such phrases have become generic features of the English language. Mr. Paikeday notes, in paragraph 7 of this affidavit, that

"[i]n the abstract, negation or contradiction would mean the exact opposite, as *unbalance, unbelief*, etc. . . . [o]n the other hand, something that exists in reality is a complex of many characteristics or qualities . . . [s]o when one makes a negative statement about something concrete, only a particular characteristic or quality would be affected, not its entire existence."

Mr. Paikeday continues the discussion at pages 7, 11 and 12 of his affidavit:

I accept that the formation *un + concrete noun* stands for real and positive entities and that some such words, for example, *unperson*, may have entered into general usage and become dictionary words. However, it appears to me that, for the most part, the meanings of such formations are

only discernable by the context in which they are used.

I agree that the term "un-petroleum jelly" would be understood to mean a jelly generally like a petroleum jelly but not petroleum jelly and that the term describes a product having one or more features essentially different from petroleum jelly. I disagree with the conclusion that the mark UN-PETROLEUM JELLY is clearly descriptive. The term "un-petroleum" may describe a petroleum jelly that is not greasy, or not odourless, or not insoluble in water, or some combination of the foregoing attributes. There is also a reasonable possibility that the term "un-petroleum jelly" would be understood to describe a substance not obtained from petroleum, in other words, not of the same genus as petroleum jelly. In my view, describing what something is generally like is suggestive or, at best, descriptive but not clearly descriptive. It follows that the mark cannot be deceptively misdescriptive [see *Molson Companies Ltd. v. Carling O'Keefe Breweries of Canada Ltd.* (1981) 55 C.P.R.(2d)15 at 20 (F.C.T.D.)]. In view of the foregoing, the first ground of opposition is rejected.

With respect to the second ground of opposition, the term "un-petroleum jelly" is not a dictionary word. Even if the term "un-petroleum jelly" is generic to the English language, there is no evidence to support the opponent's allegation that it is the name of the substance comprising the applicant's wares which are referred to by the opponent as "a viscous white jell" [see para. 8 of the Everhart III affidavit]. The second ground of opposition is therefore rejected.

With respect to the third ground of opposition, there is no doubt that the opponent sells petroleum jelly under its mark VASELINE, and that the opponent's mark VASELINE has acquired a significant reputation in Canada. However, these circumstances do not support the allegation that the mark UN-PETROLEUM JELLY is not distinctive of the applicant's wares. The last ground of opposition is therefore rejected.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 21st DAY OF DECEMBER, 1995.

Myer Herzig,
Member,
Trade-marks Opposition Board