IN THE MATTER OF AN OPPOSITION by Mr. Frostee Inc. to application No. 622,321 filed by Dickie Dee Ice Cream (Canada) Ltd., and presently standing in the name of UL Canada Inc.

On December 30, 1988, Dickie Dee Ice Cream (Canada) Ltd. filed an application to register the distinguishing guise, shown below, based upon use of the trade-mark in Canada since at least as early as March 26, 1981 in association with "frozen confections on sticks". At the examination stage, the applicant filed two affidavits of its President, Sidney Barish, pursuant to Section 32(1) of the Trade-marks Act in support of its claim to registration of its trade-mark as a distinguishing guise under Section 13(1) of the Act.

The present application was advertised for opposition purposes in the Trade-marks Journal of June 13, 1990 and, on July 13, 1990, Mr. Frostee Inc. filed a statement of opposition in which it alleged the following grounds of opposition:

(a) That the applicant's application does not comply with Section 30(a) of the Trade-marks Act in that the statement of wares is not in ordinary commercial terms and is broader than the specific wares with which the alleged mark has been used, if it has been used at all;

(b) That the applicant's application does not comply with Section 30(b) of the Trade-marks Act in that the alleged date of first use of the mark by the applicant is not correct;

(c) That the applicant's application does not comply with Section 30(i) of the Trade-marks Act in that the applicant knew at all material times that the alleged trade-mark was used by others and was not distinctive of it;

(d) That the applicant's trade-mark is not registrable in that it is contrary to Section 13 of the Trade-marks Act in that the alleged distinguishing guise was not distinctive of the applicant as of the filing date of the present application, nor was the evidence filed sufficient to establish such distinctiveness. The evidence filed does not relate to the alleged distinguishing guise claimed and does not show use of the alleged distinguishing guise by the applicant. In addition, the exclusive use by the applicant

would be likely to unreasonably limit the development of the frozen confection art or industry;

(e) That the applicant's trade-mark is not registrable in that it is contrary to Section 12(1)(b) of the Trade-marks Act in that it is merely a pleasing ornamental shape resembling a space shuttle and is therefore functional and incapable of functioning as a trade-mark or being recognized as such by the public;

(f) That the applicant is not the person entitled to registration of the alleged distinguishing guise in that, on the date when the applicant first used the alleged distinguishing guise, it had been previously used in Canada or made known in Canada by the opponent and other persons; and

(g) That the applicant's trade-mark is not distinctive and was not distinctive as of the applicant's filing date and is not now distinctive. In addition to the allegations set forth in the fifth ground, the shape which is the subject of the application was developed by an Italian company, Sidam S.R.L., which company produces moulds for the production of frozen confections. Moulds produced by Sidam S.R.L. and others were sold to a number of producers of frozen confection products who in turn produced confections bearing the shape shown in the application, or confusingly similar shapes, which products were sold in Canada at all material times.

The applicant served and filed a counterstatement in which it denied the allegations set forth in the statement of opposition. Further, during the opposition proceeding, the present application was assigned to Thomas J. Lipton Inc. which was, in turn, amalgamated with other companies under the name UL Canada Inc., the present applicant of record.

The opponent filed as its evidence the affidavits of Lynne Clayton, Generosa Castiglione and Hy Shapiro while the applicant elected not to file any evidence pursuant to Rule 44 of the Trade-marks Regulations. However, in its written argument and at the oral hearing, the applicant submitted that the two Barish affidavits form part of the evidence in this opposition in view of the decision of the Federal Court, Trial Division in Molson Breweries, A Partnership v. Registrar of Trade-marks et al, 41 C.P.R. (3d) 234. Further, the applicant submitted that it did not consider it necessary to present the Barish affidavits in the opposition as the opponent's fourth ground of opposition put in issue the sufficiency of its evidence insofar as establishing the distinctiveness of its distinguishing guise and that issue could only be assessed if the Barish affidavits were evidence in this proceeding.

In the Molson Breweries decision, Strayer, J. specifically stated at page 241 that "any evidence which the applicant wishes to have considered by the Registrar for purposes of his s. 12(2) claim must be presented in the opposition process and be subject to challenge there by the opponent". While Mr. Justice Strayer does not indicate what an applicant must do in order that its Section 32(1) evidence can be considered as being "presented" in an opposition, I consider that the applicant must at the very least advise the Registrar and the opponent of its intention to rely upon that evidence in the opposition and must serve a copy of the evidence on the opponent. In the present case, the applicant gave no indication at the evidentiary stage of its intention to rely upon the Barish affidavits

as evidence in this opposition and, as a result, did not serve copies of the affidavits on the opponent. Further, I do not consider that the opponent's Section 13(1) pleading brings the Barish affidavits into evidence in the opposition without the applicant at least indicating at the evidentiary stage its intention to rely upon those affidavits in the opposition. In view of the above, I have concluded that the Barish affidavits do not form part of the evidence in this proceeding.

Both parties submitted written arguments and both were represented at an oral hearing.

The first three grounds of opposition are based on Section 30 of the Trade-marks Act, the opponent alleging that: (i) the statement of wares, "frozen confections on sticks", is not in ordinary commercial terms and is broader than the specific wares with which the alleged mark has been used, if it has been used at all [Section 30(a)]; (ii) the date of first use of the mark by the applicant is not correct [Section 30(b)]; and (iii) the applicant knew at all material times that the alleged trade-mark was used by others and was not distinctive of it [Section 30(i)].

While the legal burden is upon the applicant to establish that its application is in compliance with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of each of the Section 30 grounds [see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see John Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293, at p. 298]. Further, the amount of evidence necessary to discharge an evidential burden on an opponent will vary, depending upon the issue to be decided [see, for example, Tune Masters v. Mr. P's Mastertune, 10 C.P.R. (3d) 84, at p. 89]. Finally, the material date in respect of the Section 30 grounds of opposition is as of the filing date of the application [see Hunter Douglas Canada Ltd. v. Flexillume Inc., 78 C.P.R. (2d) 212, at p. 220].

No evidence has been furnished by the opponent which would support its position that "frozen confections on sticks" is not a statement in ordinary commercial terms of the specific wares with which the applicant has used its trade-mark. Rather, in paragraphs 3, 5, 7 to 22 and 24 of his affidavit, Hy Shapiro uses the words "frozen confections" and "frozen confection products" to describe wares manufactured and/or sold by the opponent or others similar to those associated with the applicant's trade-mark. Further, the Castiglione affidavit has annexed to it photocopies of third party registrations in which the statements of wares include the following: "frozen confections on sticks"; "frozen confections on a stick"; and "frozen confections". As a result, it is apparent that

manufacturers and sellers of wares such as those covered by the present application would use the description "frozen confections on sticks", or a very similar description, to describe their wares. As a result, I have concluded that the opponent has failed to meet the evidential burden upon it in respect of the Section 30(a) ground which I have rejected.

As its second ground of opposition, the opponent has pleaded that the applicant's claimed date of first use of its distinguishing guise is not correct. In its written argument, the opponent submitted that the applicant did not present any evidence to show that its date of first use of the alleged distinguishing guise of March 26, 1981 was correct. However, the evidential burden is initially on the opponent to show that the applicant has not used its trade-mark since the claimed date of first use. In this regard, the opponent has relied upon certain exhibits to the first Barish affidavit to meet its evidential burden, the opponent submitting that the exhibits should be considered as admissions against interest by the applicant even if the Barish affidavits do not form part of the evidence in the opposition. In particular, the opponent argued that where an applicant fails to file evidence, the Registrar, in considering whether the opponent has met the evidential burden upon it, is entitled to refer to portions of the file record and have regard to admissions against interest made by the applicant.

In assessing a Section 30 ground where an applicant may not have filed evidence, the Registrar has, on occasion, referred to the file record and had regard to admissions against interest made by the applicant. However, the Barish affidavits were not intended to address the issue of the applicant's claimed date of first use and, in any event, the wrappers exhibited to the first Barish affidavit do not appear in certain instances to show accurate representations of the applicant's frozen confection on a stick. As a result, a number of the exhibits do not appear to constitute admissions against interest by the applicant. As a result, the opponent has not met the evidential burden upon it in respect of the Section 30(b) ground which I have dismissed.

With respect to the Section 30(i) ground, no evidence has been furnished by the opponent that the applicant knew at all material times that its trade-mark was used by others and was not distinctive of it. As a result, the opponent has failed to meet the evidential burden upon it in respect of this ground which I have also rejected.

The fourth ground is that the applicant's trade-mark is not registrable in view of Section 13(1) of the Trade-marks Act in that the alleged distinguishing guise was not distinctive of the applicant as of the filing date of the present application, nor was the evidence filed sufficient to establish such

distinctiveness. At page 240 of the Molson Breweries decision, referred to above, the learned trial judge stated that the onus of proving distinctiveness of its mark in opposition proceedings in order to claim the benefit of Section 12(2) remains on the applicant. Likewise, in the present opposition, the onus is on the applicant to establish that its distinguishing guise was distinctive as of the filing date of its application. As the Barish affidavits are not evidence in this opposition and as the applicant elected not to file any evidence in this opposition in support of its application, the applicant has failed to meet the onus or legal burden upon it of establishing that its distinguishing guise was distinctive and therefore registrable as of the filing date of its application. I have refused the applicant's application for failure to comply with the requirements of Section 13(1) of the Trade-marks Act.

Having concluded that the applicant's trade-mark is not registrable, I have not considered the remaining grounds of opposition.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November 1994.

G.W. Partington
Chairman
Trade marks Opposition Board.

However, a number of issues were argued by the parties at the oral hearing and I will comment briefly on them. The opponent submitted that the exclusive use by the applicant of its distinguishing guise would be likely to unreasonably limit the development of the frozen confection art or industry. However, Exhibit A to the Shapiro affidavit points to the fact that there are numerous mould configurations for frozen confections which can be purchased from the manufacturer of such moulds. As a result, I do not agree with the opponent's submission that the granting of a trade-mark registration to the applicant would have been likely to limit the development of the frozen confection art in Canada.

The opponent alleged that the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(b) of the Trade-marks Act in that the distinguishing guise is merely a pleasing ornamental shape resembling a space shuttle and is therefore functional and incapable of functioning as a trade-mark or being recognized as such by the public. In my view, these allegations do not support a ground of opposition based on Section 12(1)(b) of the Act and this ground is therefore contrary to Section 38(3)(a) of the Act. I would note, however, that a "distinguishing guise" includes a "shaping of wares" which, as a depiction of the wares, would appear to offend the provisions of Section 12(1)(b) of the Act. As a result, and in the absence of evidence showing that a distinguishing guise was distinctive as of the filing date of an application for its registration, such a distinguishing guise would not be registrable.

The opponent also alleged that the applicant is not the person entitled to registration of its distinguishing guise in that, on the date when the applicant first used the alleged distinguishing guise, it had been previously used or made known in Canada by the opponent and other persons. Having regard to the provisions of Sections 16(5) and 17(1) of the Act, there is a burden on an opponent in respect of a Section 16 ground to establish its prior use or prior making known of its trade-mark(s). Further, in view of the provisions of Section 17(1), an opponent may not rely upon use or making known of a trade-mark by third parties in challenging an applicant's entitlement to registration. As paragraphs 8, 9, 12 and 15 to 21 of the Shapiro affidavit attest to the sale in Canada of frozen confections by third parties, this evidence is of no relevance to a Section 16 ground. Further, while paragraphs 10, 11, 13 and 14 relate to sales involving the opponent, the opponent has not established that any of these sales occurred prior to the applicant's claimed date of first use. Accordingly, this ground of opposition would have been unsuccessful.

The opponent's final ground of opposition is that the applicant's trade-mark is not distinctive. In addition to the allegations set forth in the fifth ground, the opponent alleged that the shape which is the subject of the application was developed by an Italian company, Sidam S.R.L., which produces moulds for the production of frozen confections. According to the opponent, the moulds produced by Sidam S.R.L. and others were sold to a number of producers of frozen confection products who, in turn, produced confections bearing the shape shown in the application, or confusingly similar shapes, which products were sold in Canada at all material times. The material date in respect of a non-distinctiveness ground is as of the date of opposition, that is, July 13, 1990 [see Andres Wines Ltd. and E. & J. Gallo Winery, 25 C.P.R. (2d) 126, at pg. 130].

While the legal burden is upon the applicant to establish that its trade-mark is distinctive, there is an initial evidential burden on the opponent in respect of this ground of opposition. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., referred to above].

The amount of evidence necessary to discharge an evidential burden on an opponent will vary depending upon the issue to be decided. However, in the present case, it would appear that all the relevant facts in respect of the non-distinctiveness ground were available to the opponent.

In order to discharge the evidential burden upon it in respect of its non-distinctiveness ground, the opponent must show that it could reasonably be concluded that persons other than the applicant have made the applicant's distinguishing guise known in Canada to such an extent as to have acquired at least some minimal reputation in Canada. Provided that the opponent has met this burden, the presence of the legal burden on the applicant means that, if after all the admissible

evidence filed in the opposition is considered, a determinate conclusion cannot be reached, the issue must be decided against the applicant. Accordingly, and even assuming that the opponent has met the evidential burden upon it, I still must be satisfied, based upon all the admissible evidence in the opposition, that the trade-mark relied upon by the opponent has become sufficiently known in Canada that the applicant's trade-mark could not have been distinctive of the applicant's wares as of the material date.

From the Shapiro affidavit, it would appear that frozen confections bearing configurations similar to the applicant's distinguishing guise have been imported from the United States of America and sold in Canada by the opponent and others prior to the date of opposition. That being the case, the opponent has arguably met the initial burden upon it in respect of this ground of opposition. However, even accepting that the opponent has met the evidential burden upon insofar as establishing some minimal reputation in respect of the frozen confections sold by it and by third parties in this country, I must determine whether the opponent's evidence is such that I could conclude that the sale of frozen confections in Canada by the opponent and by third parties has been such that the applicant's trade-mark did not distinguish its wares from those of others as of the date of opposition. In this regard, the Shapiro affidavit is silent as to any measure of sales either by the opponent or third parties of frozen confections having a configuration similar or identical to the applicant's distinguishing guise. While I assume that the opponent would want the Registrar to infer from the number of persons involved in importing such frozen confections into Canada that there were extensive sales of such products in this country, I am not prepared to do so. Certainly, the affiant could have provided at least an estimate as to sales of frozen confections by the opponent and possibly by companies with which Mr. Shapiro was previously associated. Further, I would note that the periods during which the sales referred to by Mr. Shapiro occurred several years prior to the material date and their relevance to the distinctiveness issue may be even more questionable. In failing to provide more details as to the sales referred to in the Shapiro affidavit, I am left with the impression that such sales by the opponent and by third parties were minimal in nature.

I see no reason why it should not be possible to register a product having a distinctive shape under the Industrial Design Act and, at a later date, protect the shaping of the wares as a distinguishing guise under the Trade-marks Act. In seeking registration for a distinguishing guise under the Section 13 of the Act, an applicant must met the requirements of Section 13 of the Act.

In the present instance, the opponent has raised an issue as to the validity of the Industrial Design registration obtained by Sidney Barish.

Even though the decision in the Molson Breweries case was rendered subsequent to the Rule 44 stage in this opposition. However, the applicant relied upon the Molson Breweries decision in its written argument [see paragraph 35., page 10 of the applicant's written argument] and could have sought leave of the Registrar pursuant to Rule 46(1) of the Trade-marks Regulations to "present" the Barish affidavits at that time.

The first affidavit of Sidney Barish dated April 5, 1989 establishes that the applicant and its licensee, Dickie Dee Ice Cream Limited, have distributed and sold frozen confections on sticks throughout Canada since 1981 through a distribution network comprising fifteen hundred authorized vending carts. According to Mr. Barish, the authorized vendors have prescribed territories or routes over which they sell Dickie Dee products, as well as attending local sports events, cultural events, festivals, exhibitions, carnivals and fairs. Mr. Barish also states that he obtained Industrial Design registration No. 48059 [March 30, 1981] for a frozen confection with a distinctive shape, a representation of which appears below, and that the applicant and its licensees have been the exclusive producers, distributors and vendors of frozen confections in the design shape of the Industrial Design registration since 1981.

Industrial Design Registration No. 48059

In his second affidavit, Mr. Barish has provided a breakdown by province and the Yukon Territory of the number and sales dollar value of frozen confections bearing the present distinguishing guise. The total number of units sold as of the date of the second Barish affidavit [November 13, 1989] exceeds 11,500,000 having a retail value in excess of $8,500,000. Further, according to the affiant, the total amount spent on advertising the frozen confections bearing the

present trade-mark is approximately $250,000. As the applicant's wares are sold to the public by way of vending carts and would therefore be distributed primarily in the summer months, as well as being sold individually rather than in packages containing several units, I have concluded that, in the absence of any evidence to the contrary, the volume of sales of the applicant's frozen confections bearing the distinguishing guise has been relatively significant. The issue, however, is whether the sales evidenced by the applicant is such as to establish that, as of December 30, 1988, the applicant's trade-mark was distinctive of its wares.

With respect to this ground, the opponent has alleged that the Barish affidavits do not relate to the alleged distinguishing guise claimed and do not show use of the alleged distinguishing guise by the applicant. As pointed out by the opponent, the representations of the applicant's wares on certain of the specimen wrappers annexed as exhibits to the first Barish affidavit appear to vary from the applicant's distinguishing guise. However, the wrappers in certain instances do not appear to be an attempt to accurately depict the shape of the frozen confection. Rather, the wrappers in certain cases attempt to portray the frozen confection more as a space shuttle, a bomb or the like. As a result, I am not convinced that the representations on certain of the wrappers reflect a variation in the shaping of the frozen confection itself. In any event, the majority of the wrappers and point-of-sales advertising include representations which are quite similar to the applicant's distinguishing guise.

The opponent has also pointed to the fact that the wrappers identify entities in addition to the applicant or, in one instance, other than the applicant. However, most of the wrappers identify the frozen confections as being manufactured by a third party for the applicant or its licensee, Dickie Dee Ice Cream Limited. While I suspect that Palm Dairies Limited identified in Exhibit D4 may also be one of the unnamed licensees referred to in the Barish affidavit, the affiant should have clarified that such was the case in his affidavit. Further, Mr. Barish does state that the wares bearing the applicant's trade-mark are sold exclusively through the Dickie Dee vending carts which would associate the trade-mark with the applicant rather than with the manufacturer of the frozen confection.

the appearance of which is used for the purpose of distinguishing or so as to distinguish the wares manufactured or sold by a person from those manufactured or sold by others. As a shaping of wares, I would consider the distinguishing guise to be a depiction of the wares and therefore clearly descriptive of the wares.

the applicant's distinguishing guise would appear to be contrary to Section 12(1)(b) of the Trade-marks Act.

I would note, however, that Section 12(1) of the Trade-marks Act is "Subject to section 13" and Section 13 contemplates a distinguishing guise being registrable only if it has been so used in Canada by the applicant or its predecessor as to have become distinctive as of the date of filing an application for its registration. That being the case, a distinguishing guise which would offend the provisions of Section 12(1)(b) of the Act should otherwise be registrable in view of the provisions of Section 12(2) of the Act if the evidence adduced pursuant to Section 32(1) of the Act shows that the trade-mark was distinctive as of the applicant's filing date. Section 12(2) provided that a trade-mark that is not registrable by reason of Section 12(1)(a) or (b) is registrable if it has been so used in Canada as to have become distinctive at the date of filing an application for its registration. Having concluded that the applicant has failed to show that its trade-mark was distinctive as of the filing date, the applicant's trade-mark would not appear to be registrable in view of the provisions of Section 12(1)(b) of the Act.

From the opponent's evidence, oit would appear that the granting of a trade-mark registration to the applicant may limit the importation into Canada of frozen confections which have been manufactured in the United States of America pursuant to a design patent accorded in that country. However, I do not see that as being a limitation on the development of the frozen confection art in Canada.