

SECTION 45 PROCEEDINGS
TRADE-MARK: MAN'S HEAD-CAPTAIN DESIGN
REGISTRATION NO.: 387,999

On October 28, 1998, at the request of Messrs. Ogilvy Renault, the Registrar forwarded a Section 45 notice to Pacific Foods Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark MAN'S HEAD-CAPTAIN DESIGN (shown below) is registered for use in association with the following wares: imitation crab and surimi based seafood.



In response to the notice, the affidavit of William G. Hansen together with exhibits has been furnished. The requesting party alone filed a written argument and each party was represented at the oral hearing.

As raised by the requesting party, the sole issue in this case is whether the mark shown to be in use constitutes use of the registered trade-mark.

The various versions in use are shown below:

The requesting party argues that as stated in *Honey Dew Ltd. v. Rudd & Flora Dew Co.*, [1929] 1 D.L.R. 449:

The practice of departing from the precise form of a trademark as registered is objectionable and is very dangerous to the registrant.

Further, relying on *Registrar of Trade-mark v. Compagnie Internationale pour l'Informatique CII Honeywell Bull, Société Anonyme et al*, 4 C.P.R. (3d) 523, it submits that the question is not whether the public was deceived as to the origin of the goods, but whether by identifying its wares in such manner the registrant made use of the registered trade-mark SEA-CAPTAIN DESIGN. As stated in *CII Honeywell Bull*, supra, that question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. The practical test to be applied in order to resolve a case of this nature is to compare the trade-mark as it is registered with the trade-mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

The requesting party then indicated that such test was accepted in other cases such as *Promafil Canada Ltée v. Munsingwear Inc.*, 29 C.P.R. (3d) 44.

It submitted that in the mark as used, the words BARNACLE BILL are the dominant elements and would be the “identifier” by which the customer would order the product and consequently, the public would not identify the goods as having the same origin.

The registrant, on the other hand, submits that the mark as registered is used in its entirety; that an unaware purchaser would not be led to think different sources and that at most it would think that the words BARNACLE BILL is another trade-mark of the registrant. It relies on several cases such as *J.H. Munro v. T. Eaton Co.*, 2 (C.P.R.) 229; *Saccone & Speed Ltd. v. RTM*, 67 C.P.R. (2d) 119; and *M. Melachrino and Co. v. The Melachrino Egyptian Cigarette Co. and*

U. Melachrino, [1887] RPC, Vol. IV, No. 9, page 215, which the requesting party distinguished from the present case. It also relied on the cases Honey Dew and Promafil, supra.

I agree with the principles enunciated in the cases relied upon by the parties. I also agree with the registrant that in the mark as used the trade-mark as registered remains recognizable and has not lost its identity. The trade-mark as registered is used in its entirety and with additional matter namely the words “BARNACLE BILL’S” which words appear in the banner immediately below the representation of the sea captain.

The fact that “BARNACLE BILL’S” may be perceived as the name of the sea captain and the fact that a purchaser may order the product by referring to the words BARNACLE BILL’S does not prevent the public from also perceiving the sea captain as one of the trade-mark being used on the packaging. The sea captain design is very prominent on the packaging and in my view generates its own independent impression from the reading matter. Looking at the packaging, I would say that the public would perceive several trade-marks being used namely the trade-mark MAN’S HEAD-CAPTAIN DESIGN, the trade-mark BARNACLE BILL’S, and the composite mark MAN-HEAD-SEA CAPTAIN DESIGN together with the words BARNACLE BILL’S.

In the case *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 the following was stated at page 538:

Use of a mark in combination with additional material constitutes use of the mark per se as a trade mark if the public, as a matter of first impression, would perceive the mark per se as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing (see e.g., *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. et al.* (1971), 1 C.P.R. (2d) 155 at p. 163, [1971] F.C. 106), or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name: see e.g., *Carling O’Keefe Ltd. v. Molson Cos. Ltd* (1982), 70 C.P.R. (2d) 279 at pp. 280-1, applying *Bulova Accutron Trade Mark*, [1969] R.P.C. 102 at pp. 109-10.

Applying this approach, I conclude that the registrant has used the “MAN’S HEAD-CAPTAIN DESIGN” per se as a trade-mark. The design here, which is the registered trade-mark, is such that it would create its own independent impression in the minds of the public. As already stated,

the trade-mark has not lost its identity and remains recognizable in spite of the differences between the form in which it is registered and the form in which it is used. (*CII Honeywell Bull, and Munsingwear, supra*).

In view of the above, I conclude that the trade-mark registration ought to be maintained.

Registration No. 387,999 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT HULL, QUEBEC, THIS 18th DAY OF APRIL, 2001.

D Savard
Senior Hearing Officer
Section 45 Division