

IN THE MATTER OF AN OPPOSITION  
by The Becker Milk Company Limited  
to application No. 656,918 for the mark  
DOLLY MADISON BAKERY & Design  
filed by Interstate Brands Company - Licensing Co

On May 9, 1990, the applicant, Interstate Brands Company - Licensing Co. (hereinafter "Interstate"), filed an application to register the trade-mark DOLLY MADISON BAKERY & Design, illustrated below, for use in association with the wares "cakes." The application is based on use and registration, under No. 1,456,719, of the mark in the United States of America. The subject Canadian application was subsequently amended to disclaim the right to the exclusive use of the word BAKERY apart from the mark as a whole.

The subject mark was advertised in the Trade-marks Journal issue dated November 27, 1991 after the applicant overcame an objection at the examination stage that the applied for mark was confusing with the mark DOLLY MADISON, registration No. 335,075, covering the wares "ice cream" and standing in the name of the current opponent namely, The Becker Milk Company Limited (hereinafter "Becker"). I note in passing that the Office did not notify Becker of the advertisement of the subject application as it might have done pursuant to Section 37(3) of the Trade-marks Act.

The Opponent filed its statement of opposition on March 27, 1992 and a copy was forwarded to the applicant on May 11, 1992. The applicant responded by filing and serving a counter statement.

The first ground of opposition is that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the Trade-marks Act, because the applied for mark DOLLY MADISON BAKERY & Design is confusing with the opponent's mark DOLLY MADISON regn. No. 335,075. The second ground of opposition is that the applicant is not entitled to register the applied for mark, pursuant to Section 16(2), because, at the filing date of the application (-May 9, 1990), the applied for mark was confusing with the mark DOLLY MADISON previously used and made known in Canada by the opponent in association with ice cream. The last ground of opposition is that the applied for mark DOLLY MADISON BAKERY & Design is not distinctive of the applicant's wares.

The opponent's evidence in chief consists of the affidavit of Robin Thrasher, Advertising Manager of the opponent company. The applicant's evidence consists of the affidavits of Ray Sandy Sutton, Vice President and General Counsel of Interstate; Dean Horner, student-at-law; and Christopher Dejardin, trade-mark searcher. The opponent did not file any evidence in reply. None of the affiants were cross-examined on their affidavits. Both parties filed a written argument and both were represented at an oral hearing.

Mr. Dejardin's affidavit serves to introduce into evidence, by way of exhibits, documents from various Trade-marks Office files. Exhibit A is a complete copy of trade-mark application file No. 481,055 for the trade mark DOLLY MADISON filed on January 19, 1982 by Seligo Food Corporation (hereinafter "Seligo"). Seligo's application covered the wares "ice cream, ice milk and frozen yogurt" and was opposed by Becker, the opponent herein. Seligo's application was eventually abandoned voluntarily, on December 4, 1986.

Exhibit B of Mr. Dejardin's affidavit shows that Seligo became a registered user of Becker's mark DOLLY MADISON, regn. No. 335, 075, on December 11, 1987.

Exhibit C is a copy of an affidavit (dated October 20, 1981) of Joseph Vangreen, Vice President of Seligo, submitted by Seligo in opposition to trade-mark application No. 448,233 filed by Becker (on December 21, 1979) for the mark DOLLY MADISON [see *Seligo Food Corp. v. Becker Milk Co.* (1984) 3 C.P.R.(3d) 506 (TMOB)]. Becker's application No. 448,233 eventually resulted in regn. No. 335,075 which is, of course, the registered mark relied on by Becker in the present proceeding.

Mr. Horner's affidavit serves to introduce into evidence, by way of exhibits, excerpts from several dictionaries, encyclopedias, and other texts, establishing that Dolly Madison (also spelt Dolley Madison) was an historical figure namely, the wife of James Madison, the fourth President of the United States of America. Also attached by way of exhibits are (i) a copy of United States trade-marks regn. No. 281,725 (registered on March 24, 1931) for the mark DOLLY MADISON, covering the wares ice cream, standing in the name of Philadelphia Dairy Products Company, Inc. and (ii) a copy of United States trade-marks regn. No. 657,517 (registered on January 21, 1958) for the mark DOLLY MADISON & Design, covering the wares ice cream, butter and cheese, also standing in the name of Philadelphia Dairy Products Company, Inc.

The determinative issue in this proceeding is whether the applied for mark DOLLY MADISON BAKERY & Design for cakes is confusing with the opponent's mark DOLLY MADISON for ice cream. Nothing turns on whether the date for deciding the issue of confusion is as of the date of filing the application (-May 9, 1990) respecting the ground of opposition alleging non-entitlement, the date of filing the opposition (-March 27, 1992) with respect to the ground alleging non-distinctiveness, or

the date of my decision with respect to the ground of opposition alleging that the applied for mark is not registrable.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark DOLLY MADISON BAKERY & Design and the opponent's mark DOLLY MADISON. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5) below:

- 6(5) In determining whether trade-marks . . . are confusing, the . . . Registrar . . . shall have regard to all the surrounding circumstances including
  - (a) the inherent distinctiveness of the trade-marks . . . and the extent to which they have become known;
  - (b) the length of time the trade-marks . . . have been in use;
  - (c) the nature of the wares, services or business;
  - (d) the nature of the trade; and
  - (e) the degree of resemblance between the trade-marks . . . in appearance or sound or in the ideas suggested by them.

The opponent's mark DOLLY MADISON possesses a relatively low degree of inherent distinctiveness since surnames and first names are weak in terms of distinctiveness. The design features of the applied for mark DOLLY MADISON BAKERY & Design add some distinctiveness to the applicant's mark, however, the mark as a whole remains relatively weak. The word BAKERY, which is disclaimed in the subject application, adds nothing to the distinctiveness of the applied for mark. Further, the inherent distinctiveness of the parties' marks are lessened to the extent that

Canadians would recognize the name Dolly Madison as an American historical figure. There is no doubt that the opponent's mark had acquired a significant reputation in Canada by the earliest material date May 9, 1990. In this regard, Mr. Thrasher's evidence is that the mark DOLLY MADISON is a house mark of the opponent Becker applied to ice cream products for sale in about 650 retail stores operated by Becker in Ontario. The mark was adopted by Becker in 1984 and used continuously since then. Due to the popularity of the product after its introduction in pre-packaged form, Becker "installed ice cream coolers in many of its stores to serve hand scooped DOLLY MADISON ice cream cones": see paragraph 7 of the Thrasher affidavit and the exhibits thereto. Becker's sales of DOLLY MADISON ice cream in Canada from 1988 to 1990 inclusive averaged about \$2.9 million annually. Sales in 1991 continued at the same level. The opponent advertises its mark through radio and print media, however, the extent of such advertising was not quantified.

Mr. Sutton's evidence establishes that the applied for mark DOLLY MADISON BAKERY & Design possessed a significant reputation for baked goods in the United States at all material times. However, there is no evidence that the applicant has sold any baked products under its mark in Canada. On the basis of Mr. Sutton's unchallenged evidence, I am prepared to infer that the mark DOLLY MADISON BAKERY & Design may possibly have been known in Canada at the *de minimis* level at all material times as a result of Canadians encountering the mark while travelling in the United States.

The length of time that the marks in issue have been in use in Canada favours the opponent, its use of the mark DOLLY MADISON dating from at least 1987 while the applicant has not evidenced any use of its mark DOLLY MADISON BAKERY & Design in Canada.

I consider that the nature of the parties' wares are fairly closely related. As noted by the opponent in its written argument, "[C]ake and ice cream are both popular dessert items, commonly served together."

The applicant's position is that the parties' channels of trade are distinct, as discussed in paragraphs 25-26 of its written argument:

It is clear from the evidence that until now the opponent has sold its ice cream product only through its own retail stores. However, there is nothing to preclude the opponent from selling its DOLLY MADISON brand ice cream through other retail outlets such as supermarket chain stores. More importantly, the opponent has not restricted its statement of wares to any particular channel of trade (neither has the applicant) and it is the statements of wares that govern in considering Sections 6(5)(c) and (d) of the Act. In other words, I am obliged to consider whether confusion would be likely if the opponent were to operate in any way open to it: see the decisions in *Mr.*

*Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). Therefore, to the extent that there is a similarity or overlap between the wares of the parties, there is also a potential for overlap in the natures of the trades.

With respect to Section 6(5)(e), the marks resemble each other to a high degree in all respects. The applicant's mark consists of the entirety of the opponent's mark together with fairly non-distinctive design matter and a non-distinctive word component (-the word BAKERY).

As a surrounding circumstance, the applicant submits that "concurrent use of DOLLY MADISON bakery goods with DOLLY MADISON ice cream in the United States has not lead to confusion in the United States." The applicant seeks to support its submission by relying on the affidavit of Joseph Vangreen and on Mr. Sutton's evidence. As discussed earlier, the Vangreen affidavit was filed on behalf of Seligo (*qua* opponent) in the matter of an opposition between Seligo and Becker. While the contents of the affidavit may possibly be relevant in proceedings wherein Seligo is a party, the affidavit is inadmissible for the truth of its contents (and cannot prejudice Becker) in the present proceeding. Other evidence to support the applicant's submission that the marks DOLLY MADISON for ice cream and for baked goods, respectively, co-exist without confusion in the United States is found in paragraph 11 of Mr. Sutton's affidavit:

Mr. Sutton's evidence does not quantify Seligo's sales under its marks in the United States, or provide information regarding Seligo's channels of trade in the United States. Further, Mr. Sutton does not explicitly state that he would have been informed of instances of actual confusion between Seligo's marks and Interstate's marks or that his organization has a mechanism for reporting instances of confusion to senior management. Even if I were prepared to accept, at face value, Mr. Sutton's assertion that there has been no confusion between the Seligo's marks and Interstate's marks in the United States, his evidence on this point is insufficient for inferences to be drawn with respect to the potential for confusion in this jurisdiction.

The applicant also attempted to rely on the Vangreen affidavit to support its submission that Becker's adoption of the mark DOLLY MADISON was not *bona fide* [in this regard, see also *Seligo*, above, at p.511]. However, the validity of Becker's registration for the mark DOLLY MADISON is not relevant in opposition proceedings: see *Sunshine Biscuits, Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R.(2d) 53 at 61 (F.C.T.D.).

Considering the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that at all material times the applied for mark is confusing with the opponent's mark DOLLY MADISON.



In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 30th DAY OF JANUARY, 1996.

Myer Herzig,  
Member,  
Trade-marks Opposition Board