



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

Citation: 2013 TMOB 21
Date of Decision: 2013-02-07

**IN THE MATTER OF AN OPPOSITION
by D & S Meat Products Ltd. to
application No. 1,448,084 for the trade-
mark PEAMEAL BACON OF CANADA
LTD. in the name of Peameal Bacon of
Canada Ltd.**

[1] On August 12, 2009, Peameal Bacon of Canada Ltd. (the Applicant) filed an application to register the trade-mark PEAMEAL BACON OF CANADA LTD. (the Mark) based on use of the Mark in Canada since at least as early as 1992 in association with “peameal-style bacon, namely, cured pork loin rolled in cornmeal” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 3, 2010.

[3] On August 3, 2010, D & S Meat Products Ltd. (the Opponent) filed a statement of opposition. The Applicant requested that an interlocutory ruling be made regarding the sufficiency of one paragraph within the statement of opposition. In response, the Opponent obtained leave to amend its statement of opposition (the amended statement of opposition is dated November 10, 2010). By letter dated February 9, 2011, the Registrar issued an interlocutory ruling confirming that the paragraph as amended was sufficient.

[4] The Applicant has filed and served a counter statement that denies each of the allegations set out in the statement of opposition.

[5] In support of its opposition, the Opponent filed affidavits from the following four individuals: Peter Daly (the Opponent’s Director of Sales); Dejan Milanovic (the Opponent’s President); Moritz Raeppe (a student assisting the Opponent’s law firm); and John Leadbetter (a butcher and owner of Leadbetter Meats). The Opponent subsequently obtained leave to file two additional affidavits from Mr. Daly; the first explains two corrections to his original affidavit, while the second is a replacement to the original affidavit with the errors corrected. In these circumstances, the only affidavit of Mr. Daly that I need consider is the last of the three – it is dated June 24, 2011 and includes Exhibits A-D.

[6] In support of its application, the Applicant has filed affidavits from Lou Albanese (the Applicant’s Chairman and CEO) and Carla Edwards (a secretary employed by the Applicant’s agent).

[7] None of the affiants was cross-examined.

[8] Both parties filed written arguments and were represented at an oral hearing.

[9] Subsequent to the oral hearing, the Opponent filed a letter dated December 17, 2012 in which it purported to “provide a fuller answer to a question the Hearing Officer asked during the hearing...” In response, the Applicant filed a letter dated December 20, 2012. I am disregarding the contents of both letters for the simple reason that I did not request that supplementary submissions be filed. I further note that pursuant to section 46(2) of the *Trade-marks Regulations*, SOR/96-195 additional written argument can only be filed with leave of the Registrar, which has been neither requested nor granted in the present case.

Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition

[11] The Opponent has pleaded the following grounds of opposition pursuant to the *Trade-marks Act*, RSC 1985, c T-13 (the Act):

- 1) section 38(2)(a)/30(b) – i) the application incorrectly states that the Applicant has used the Mark, when the Mark has not been used; ii) in the alternative, the application incorrectly states that the Applicant used the Mark when any such use has been by The Meat Factory Ltd of Stoney Creek, Ontario; iii) in the further alternative, the application incorrectly states that the Applicant has used the Mark since the alleged date of first use because, if the Applicant ever used the Mark, it only did so after the alleged date of first use and concurrently with The Meat Factory Ltd.
- 2) section 38(2)(b)/12(1)(b) – the Mark is not registrable since it is i) clearly descriptive of the character of the wares, namely, “Peameal-style Bacon, namely, Pork-loin rolled in cornmeal”, in association with which it is alleged to be used; and ii) clearly descriptive of the place of origin, namely “Canada”, of the wares, in association with which it is alleged to be used.
- 3) section 38(2)(b)/12(1)(c) – the Mark is not registrable since it is the English name of the wares, namely, “Peameal-style Bacon, namely, pork-loin rolled in cornmeal”, in association with which it is alleged to be used.
- 4) section 38(2)(b)/12(1)(e) – the Mark is not registrable as it is a mark the adoption of which is prohibited by section 10 because through ordinary and *bona fide* commercial use, the term “Peameal Bacon” has become recognized as designating i) the kind of wares, namely, “Peameal-style Bacon, namely, pork-loin rolled in cornmeal” or ii) the place of origin of the wares in the applied for application.
- 5) section 38(2)(d)/2 – the Mark is not distinctive since it fails to distinguish the Applicant’s wares from the wares of others, namely cured pork loin either rolled or coated or covered in cornmeal or cured pork-back either rolled or coated or covered in cornmeal, offered for

sale and sold by others including the Opponent and Quality Meat Packers Ltd. for the reasons aforementioned, and it is not adapted to so distinguish them.

Section 30(b) Ground of Opposition

[12] An opponent's initial burden under section 30(b) is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at p. 230]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is clearly inconsistent with the applicant's claims as set forth in its application.

[13] In the present case, the Opponent is relying on the Applicant's evidence to support its section 30(b) ground of opposition. In particular, it submits that Mr. Albanese's evidence does not demonstrate that the Applicant has used the Mark since 1992.

[14] Mr. Albanese attests that the Applicant was incorporated on January 29, 1992 and that The Meat Factory Limited is licensed by the Applicant to use the Mark. He further attests that pursuant to a licence agreement, the Applicant maintains care and control over the use of the Mark by The Meat Factory Limited. He provides as Exhibit B photographs of packaging that he says are representative of the manner in which the Mark has been used in Canada since 1992.

[15] On the basis of the foregoing evidence, I am dismissing the section 30(b) ground. Mr. Albanese's statements are not clearly inconsistent with the claims made in the application. In this regard, I note that the Opponent could have cross-examined Mr. Albanese if it wished to obtain further details concerning the Applicant's relationship with The Meat Factory Limited or when use of the Mark began. I see no reason to not accept that the use of the Mark by The Meat Factory Limited accrues to the benefit of the Applicant pursuant to section 50(1) of the Act. In addition, I am satisfied that Exhibit B shows use of the Mark in a manner that would satisfy section 4 of the Act. The packaging displays PEAMEAL BACON OF CANADA LTD. in a design format followed by TM/MC. It is true that LOU'S appears to the left above PEAMEAL BACON OF CANADA LTD. but given the separation between the two, I find that this qualifies

as use of two marks, not of a single combined mark. I note that this conclusion is reinforced by the fact that TM/MC also appears after LOU'S. The fact that the packaging does not display the Applicant's name but rather The Meat Factory Ltd. is not a concern given the application of section 50(1) of the Act. Finally, I will add that there is no requirement that the Applicant provide invoices from 1992.

Section 12(1)(b) Ground of Opposition

[16] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks*, 40 CPR (2d) 25 at 27-8 (FCTD); *Atlantic Promotions Inc v Registrar of Trade Marks*, 2 CPR (3d) 183 at 186 (FCTD)]. Character means a feature, trait or characteristic of the product and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34 (Ex Ct)].

[17] The material date that applies to a section 12(1)(b) ground of opposition is the filing date of the application [see *Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)].

[18] The *Oxford Canadian Dictionary (Second Edition)* defines "peameal bacon" as "*n. Cdn* back bacon rolled in a coating of fine cornmeal" and "back bacon" as "*n. Cdn & Brit.* round, lean bacon cut from the eye of a pork loin".

[19] I am satisfied based simply on the dictionary definition that the words PEAMEAL BACON in the Mark are clearly descriptive of the Wares; however, as emphasized by the Applicant, the Mark also incorporates the words OF CANADA LTD.

Although the Applicant has argued to the contrary, I do not see how OF CANADA cannot be clearly descriptive of the place of origin of the Wares. That leaves LTD.

The Opponent has directed me to *Worldwide Diamond Trademarks Limited v Canadian Jewellers Association* (2010), 82 CPR (4th) 435 (FC), affmd 91 C.P.R. (4th) 187 (FCA), which was an opposition proceeding in regard to the trade-mark THE CANADIAN DIAMOND REPORT, THE MARK OF A DIAMOND THAT IS MINED, CUT AND POLISHED IN CANADA & Design and two similar trade-marks. In his decision, Justice Kelen stated:

[48] Whether a trade-mark is clearly descriptive is a decision of first impression which requires the ascertainment of the immediate impression created by the mark as a whole in association with the product and by critically analyzing the individual words: *Molson Cos. v. Carling O'Keefe Breweries of Canada Ltd.*, [1982] 1 F.C. 275, 55 C.P.R. (2d) 15 (T.D.), per Justice Cattanach at para. 30. The decision-maker must also apply common sense in making its determination: *Neptune S.A. v. Canada (Attorney General)*, 2003 FCT 715, 29 C.P.R. (4th) 497, per Justice Martineau at paragraph 11.

...

[56] Even if this Court were to accept that the word "Mark" has a diverse range of meanings within the 1,212,233 trade-mark and the proposed trade-marks in questions, **the single use of this word is not sufficient in and of itself to render the proposed trade-marks non-descriptive.** The proposed trade-marks therefore contain previously registered trade-marks which in the Court's view are by themselves clearly descriptive.
[emphasis added]

[20] LTD. is certainly not a dominant portion of the Mark and does not prevent the Mark from being clearly descriptive. To use Justice Kelen's words, I do not consider the single use of the non-distinctive abbreviation LTD. to be sufficient in and of itself to render the applied-for Mark non-descriptive.

I have not been directed to any case law where the registrability of an otherwise clearly descriptive mark hung on the addition of the word LTD. The Applicant has provided copies of ten registrations for trade-marks that include LTD. or LIMITED [Exhibit G, Edwards affidavit], but the registration of those third party marks does not mean that the present Mark is registrable. The Opponent submits that they are irrelevant.

It is trite law that each trade-mark application must be judged on its own merits. The ten third party registered marks are very different from the Mark. The Applicant made no submissions based on the state of the register in its written argument; at the oral hearing, the Applicant did

mention that there are other registrations that contain LTD. but did not provide any analysis of such evidence to demonstrate that those marks would have been found to be clearly descriptive of their associated wares/services but for the presence of LTD./LIMITED.

[21] I note that Mr. Justice Kelen dealt with a similar situation as follows:

[52] The applicant submits that the Registrar has registered 20 trade-marks that it submits contain many of the words present in the proposed trade-marks. To provide one example, the applicant holds trade-mark number 1,212,233 "THE MARK OF A DIAMOND THAT IS MINED, CUT AND POLISHED IN CANADA".

[53] While this Court has recognized that the Registrar must consider prior registrations when assessing descriptiveness (*Reed Stenhouse, supra; Imperial Tobacco, supra*) it is trite law that "if the Registrar has erred in the past, there is no reason to perpetuate that error": *Neptune S.A, supra*, at para. 22; *John Labatt, supra*, at para. 45; and *Sherwin Williams Company of Canada, Limited v. The Commissioner of Patents*, [1937] Ex. C.R. 205, [1938] 1 D.L.R. 318, per Justice Angers at paragraph 11.

[54] This Court cannot escape the conclusion that on first impression of the 1,212,233 trade-mark, the reader is notified of the inherent quality and characteristic of the ware, in this case a Canadian diamond that is mined, cut and polished in Canada and possesses a certificate or report or appraisal to authenticate its Canadian providence, as it in fact does.

[22] To paraphrase Justice Kelen, in the present case I cannot escape the conclusion that on first impression of the Mark, the reader is notified of the inherent quality and characteristic of the wares, namely peameal bacon from Canada.

[23] For the foregoing reasons, I find that the Applicant has not met its legal burden with respect to the allegation that its Mark is clearly descriptive and the section 12(1)(b) ground of opposition therefore succeeds.

Section 2 Ground of Opposition

[24] The material date for assessing distinctiveness is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[25] A mark that is clearly descriptive is necessarily not inherently distinctive. In the present case, there is insufficient evidence to find that the Applicant's Mark had become distinctive

through substantial use or promotion as of August 3, 2010. Although Mr. Albanese has provided substantial sales and advertising figures, as pointed out by the Opponent it is not clear that these relate to the Mark. This ambiguity arises from the definition in Mr. Albanese's affidavit of "peameal-style bacon, namely cured pork loin rolled in cornmeal" as "PEAMEAL BACON OF CANADA LTD. Product". Thus, sales figures for PEAMEAL BACON OF CANADA LTD. Product amount to sales figures for peameal-style bacon; it is not evident that all such sales were associated with the Mark (in this regard, I note that according to Mr. Albanese's Exhibit D the Applicant sells both branded and private label products).

[26] Accordingly, the distinctiveness ground of opposition succeeds.

Remaining Grounds of Opposition

[27] Given that the Opponent has already succeeded under two separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

Disposition

[28] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office