



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

Citation: 2011 TMOB 26
Date of Decision: 2011-02-15

**IN THE MATTER OF AN OPPOSITION
by D & S Meat Products Ltd. to
application No. 1,311,504 for the trade-
mark PEAMEAL BACON BACON in the
name of Peameal Bacon of Canada Ltd.**

[1] On August 2, 2006, The Meat Factory Limited (the Original Applicant) filed an application to register the trade-mark PEAMEAL BACON BACON (the Mark) based on proposed use for “bacon”. The right to the exclusive use of the words PEAMEAL BACON and BACON have been disclaimed apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 28, 2007.

[3] On April 12, 2007, D & S Meat Products Ltd. (the Opponent) filed a statement of opposition. On May 11, 2007, the Opponent filed a revised statement of opposition. On May 28, 2007, the Opponent filed a further revised statement of opposition.

[4] On June 18, 2007, the Original Applicant filed and served a counter statement in which it denied the Opponent’s allegations. It simultaneously requested that the statement of opposition be struck on the basis that it is invalid and improperly pleaded. By letter dated July 4, 2007, the Registrar of Trade-marks refused the request to strike the statement of opposition.

[5] On October 25, 2007, the Original Applicant requested the recordal of an assignment in favour of Peameal Bacon of Canada Ltd. Pursuant to the request, on November 21, 2007 the

Assignment and Renewal Section of the Canadian Intellectual Property Office entered Peameal Bacon of Canada Ltd. as the owner of the application. The term Applicant will be used to refer to Peameal Bacon of Canada Ltd. and The Meat Factory Limited collectively.

[6] On December 21, 2007, the Opponent filed yet a further revised statement of opposition. I confirm that by letter of February 27, 2008, the Opponent was granted leave to amend its statement of opposition.

[7] In January and February 2008, the Opponent filed affidavits in support of its opposition from the following four individuals: Peter Daly (the Opponent's Director of Sales); Sasha Milanovic (the Opponent's Vice-President); Dan Milanovic (the Opponent's President); and Robert Trought (manager of Ivanhoe Cheese Inc.).

[8] On April 3, 2008, the Applicant amended its application to restrict the wares to "peameal-style bacon, namely, cured pork loin rolled in cornmeal".

[9] In August 2008, in support of its application the Applicant filed an affidavit of Carla Edwards (a secretary employed by the Applicant's agent). The Opponent obtained an order for the cross-examination of Ms. Edwards on her affidavit and has filed a transcript of the cross-examination.

[10] As reply evidence, the Opponent filed a second affidavit of Peter Daly.

[11] The Applicant obtained an order for the cross-examination of Mr. Daly and has filed a transcript of the cross-examination together with an answer to an undertaking given during the cross-examination.

[12] Both parties filed written arguments. By letter dated March 8, 2010, the Applicant objected to the Opponent's written argument, claiming that it is merely a restatement of the various grounds of opposition and that it attempts to submit additional evidence. The Applicant has requested that the Opponent's written argument "be disregarded in its entirety or, at the very least, that all references to [additional evidence] be disregarded." I confirm that I am disregarding all references to any material that has not been properly introduced in this proceeding.

[13] An oral hearing was not requested.

Onus

[14] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Grounds of Opposition

[15] The Opponent has pleaded the following grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

- 1) s. 30(i) – the Original Applicant knew at the time of filing that it was not entitled to registration by reason of the facts set out in the statement of opposition; also, the disclaimer clause was included in bad faith;
- 2) s. 30(e) – the Original Applicant “did not have the intention to use the Mark by itself or through a licensee, or through itself and through a licensee”;
- 3) s. 12(1)(e)/10 – the Mark is a prohibited mark under s. 10 because the words PEAMEAL BACON BACON have by ordinary commercial usage become recognized in Canada as designating a kind, and/or quality, of a meat product;
- 4) s. 12(1)(b) – the Mark is not registrable in that it is, at the same time, both clearly descriptive and deceptively misdescriptive – PEAMEAL and BACON are dictionary words used in the trade to describe the product – BACON is the name of the product – PEAMEAL is a word used to describe BACON prepared in a particular manner, and coated with PEAMEAL – the Applicant’s product does not consist of or contain peameal;
- 5) s. 12(1)(c);

- 6) s. 16 – the Applicant is not the person entitled to registration of the Mark because “the alleged mark was in use by others in Canada for many years prior to filing” (although the Opponent referred to s. 16(1), the Applicant recognized in its written argument that this ground should have been pleaded under s. 16(3) and responded to it in that manner);
- 7) s. 2 – the Mark is not distinctive in that it does not actually distinguish the wares of the Applicant from the wares of others in Canada, and is not adapted to distinguish; in addition, the alleged trade-mark is not a trade-mark within the meaning of s. 2.

[16] I will only discuss three of the grounds of opposition further.

Section 12(1)(b) Ground of Opposition

[17] 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 C.P.R. (2d) 25 at 27-8 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. 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 C.P.R. 29 at 34 (Ex. Ct.)].

[18] The material date that applies to a s. 12(1)(b) ground of opposition is the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.)].

[19] The *Oxford Canadian Dictionary (Second Edition)* defines “peameal bacon” as “*n. Cdn* back bacon rolled in a coating of fine cornmeal.” It does not contain a definition for “peameal”, but it defines “back bacon” as “*n. Cdn & Brit.* round, lean bacon cut from the eye of a pork loin” and “bacon” as “*n.* cured meat from the back or sides of a pig.” The ordinary dictionary meaning of the words in the applied-for trade-mark suffices to meet the Opponent’s initial burden with

respect to the s. 12(1)(b) ground [see *Flowers Canada/Fleurs Canada Inc. v. Maple Ridge Florist Ltd.* (1998), 86 C.P.R. (3d) 110 (T.M.O.B.)].

[20] Additional evidence concerning the meaning of the words in the Mark has been provided by Mr. Daly, who has been engaged in the meat product industry in Canada from 1976 to 2007. In his first affidavit, he states that “peameal bacon” is neither “bacon” nor “peameal”. He says that it is a pork loin cured in brine and rolled in cornmeal and that “Canada Food regulations” have ordered that the only term to be used for this type of product is “cured pork back rolled in cornmeal.” He further states that regulations of the Canada Food Inspection Agency state that a product cannot be called “bacon” unless it is smoked, and “peameal bacon” is not smoked. Despite these regulations, Mr. Daly says that the term “peameal bacon” is “used universally through food markets, butcher shops, delis, restaurants, by the trade and the general public to refer to a product which is neither peameal nor bacon.”

[21] Mr. Daly also provides the history of the term “peameal bacon”. Apparently it originated in the 19th century; in the absence of refrigeration, it was found that if pork loins were pickled and rolled in peameal, they would have a long enough shelf life to be shipped from Canada to Europe. This meat became known as “peameal bacon” and apparently that name stuck even though cornmeal replaced the peameal many years ago.

[22] I note that the Applicant has not filed any evidence that contradicts Mr. Daly’s statements concerning the nature, meaning or history of “peameal bacon”.

[23] Mr. Daly has also provided pages from the website of the Original Applicant (Exhibit PD 7). Those pages use “peameal bacon” to refer to a type of food, e.g. a list of products reads “... Atlantic Salmon Fillets in Lemon White Wine Sauce, Veal Osso Buco, Peameal Bacon” and recommended menu applications state, “Peameal bacon is a great dinner item...” At the same time, the web pages contain references to Peameal Bacon™, Largest Producer of Peameal Bacon™, Peameal Bacon of Canada Ltd™, etc. It is trite to say that simply putting ™ after a generic term does not mean that term is no longer descriptive.

[24] Carla Edwards, a secretary employed by the Applicant's agents, has provided a printout of the *Meat Inspection Regulations*, 1990 that she obtained from the Internet, but she has not directed my attention to any particular section of that document.

[25] I agree with the Applicant that the Mark is not deceptively misdescriptive of the Wares because Canadian purchasers of bacon-type products understand that "peameal bacon" is pork loin rolled in cornmeal. I note that Mr. Daly's evidence supports that conclusion, e.g. during cross-examination, Mr. Daly agreed that, based on his experience, cured pork loin rolled in cornmeal is understood to be peameal-style bacon (see Questions 99 and 100, Daly Cross-examination).

[26] However, I disagree with the Applicant's contention that the Mark is also not clearly descriptive of its wares. Instead, because "peameal" is a type of bacon, each of the words in the Mark clearly describes the applied-for wares. A consumer, seeing the words PEAMEAL BACON BACON on a meat product, would expect the meat to be of the type that is known in Canada as "peameal bacon"; thus the Mark clearly describes the character of the wares. (A consumer, in my view, would be unaware of the technical requirements of the Canada Food Inspection Agency or other regulations.) I note that the Applicant even refers to its wares in its current statement of wares as "peameal-style bacon".

[27] The Applicant has argued that the Mark is not clearly descriptive because PEAMEAL BACON BACON is a unique linguistic construction that does not place legitimate competition at an undue disadvantage in relation to language that should be available for all to use. The Applicant relies upon *Pizza Pizza Ltd. v. Registrar of Trade Marks* (1992), 67 C.P.R. (2d) 202 (F.C.T.D.) [*Pizza Pizza*]. The *Pizza Pizza* decision was not an opposition decision; it was an appeal from the Registrar's decision to refuse an application during examination based on s. 12(1)(b). As such, the onus on the applicant in *Pizza Pizza* was lighter than it is on an applicant in an opposition. I also note that in *Pizza Pizza* the applicant had been using its mark for about a decade, as opposed to here where there has been no use of the Applicant's Mark, and the Court referred in the *Pizza Pizza* decision specifically to the evidence of extensive use and promotion of the applied-for mark. In addition, the applicant in *Pizza Pizza* provided evidence from a

linguistics expert as well as telephone survey evidence, which supported a conclusion that the mark being applied for, PIZZA PIZZA, had a distinguishable identity in the marketplace.

[28] To put it another way, I do not accept that the *Pizza Pizza* decision stands for the proposition that a trade-mark cannot be held to be clearly descriptive simply on the basis that it includes the repetition of a word.

[29] I also note that in *101482 Canada Inc. v. Registrar of Trade Marks* (1985), 7 C.P.R. (3d) 289 (F.C.T.D.), Joyal J. provided the following restrictive interpretation of the *Pizza Pizza* decision:

17 There is also the case of *Pizza Pizza Ltd.*, supra. In my humble opinion, this case deals only marginally with the prohibition contained in s. 12(1)(b). It is actually concerned with s. 12(2) of the Act, which reads as follows:

12. (2) A trade mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

18 It may be noted that this subsection can only create an exception to the "descriptive" rule in so far as a mark has become distinctive *at the date of filing an application*. I cannot find sufficient evidence in the record to indicate that, as in *Pizza Pizza Ltd.*, the exception created by s. 12(2) of the Act should be applied...

[30] Of course, there is similarly no basis in the case at hand upon which the exception created by s. 12(2) could be applied.

[31] 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 s. 12(1)(b) ground of opposition therefore succeeds.

Section 2 Ground of Opposition

[32] The individual paragraph that pleads the non-distinctiveness ground of opposition does not itself set out sufficiently specific reasons for which the Mark is not distinctive. However, when that paragraph is read as part of the whole statement of opposition and in conjunction with the evidence of record, it is apparent that one of the bases on which the Opponent is submitting

that the Mark is not distinctive is that it is clearly descriptive [see *Novopharm Ltd. v. Astrazeneca AB* (2002), 21 C.P.R. (4th) 289 (F.C.A.)]. A trade-mark that is clearly descriptive of its associated wares is *prima facie* not distinctive. Hence, based on my finding under the s. 12(1)(b) ground of opposition, the distinctiveness ground of opposition also succeeds.

Section 30(e) Ground of Opposition

[33] As the application contains a statement that the applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with s. 30(e). However, the s. 30(e) ground of opposition can still succeed on the basis that the Original Applicant did not substantially comply with s. 30(e), i.e. because the statement that it intended to use the Mark was not true [see *Home Quarters Warehouse, Inc. v. Home Depot, U.S.A., Inc.* (1997), 76 C.P.R. (3d) 219 (T.M.O.B.); *Jacobs Suchard Ltd. v. Trebor Bassett Ltd.* (1996), 69 C.P.R. (3d) 569 (T.M.O.B.)].

[34] The material date for assessing a s. 30(e) ground of opposition is the application's filing date [see *Canadian National Railway Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 (T.M.O.B.) at 94]. An opponent's initial burden is typically lighter respecting the issue of non-compliance with s. 30(e) since the facts supporting no intention to use the Mark in Canada are particularly within the knowledge of the applicant [see *Molson Canada v. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.) at 334; *Canadian National Railway Co. v. Schwauss, supra*, at 95].

[35] The Opponent has met its initial onus with respect to this ground through the filing of a copy of the Agreement between The Meat Factory Limited and Peameal Bacon of Canada Ltd. dated September 17, 2007 (Daly affidavit, Exhibit PD 8). This document states that The Meat Factory Limited is hereby assigning all of its rights, title and interest in and to the application to register the Mark. However, the preamble to this assignment states that the parties are related, that as of August 2, 2006 The Meat Factory Limited had an intention to use the Mark in Canada but that intention was as a licensee of Peameal Bacon of Canada Ltd. rather than as a trade-mark owner, and that there was an inadvertent clerical error in the identification of the applicant at the time of filing the application. Based on this document, it appears that the s. 30(e) statement contained in the application when it was filed was not true.

[36] There is a procedure for an applicant to correct clerical errors in an application [see r. 33(1) of the *Trade-marks Regulations*, SOR/96-195]. However, that was not followed in this case. Rather the Original Applicant assigned the flawed application more than a year following its filing. While there was no *male fides* involved, the fact remains that the application as filed contained a false statement under s. 30(e). If the Applicant had succeeded in substituting Peameal Bacon of Canada Ltd. as the applicant, rather than assigning the application to it, perhaps the s. 30(e) ground would not have succeeded; however this was not done, and the s. 30(e) ground does succeed.

Disposition

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

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