

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


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Date of Decision: 2011-12-18

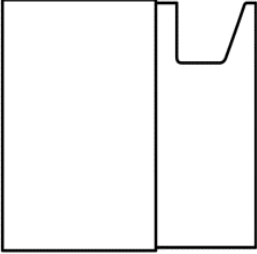
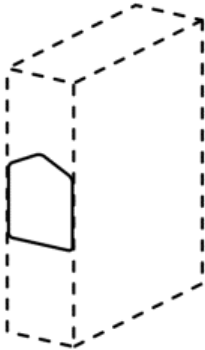
**IN THE MATTER OF THREE
OPPOSITIONS by JTI-Macdonald TM
Corp to application Nos. 1370832;
1370833; 1370841 for the design trade-
marks SLIDE PACK END; OPEN SLIDE
PACK; and SLIDE PACK KEYHOLE in
the name of Player's Company Inc.**

FILE RECORD

[1] On November 6, 2007, Player's Company Inc. filed three design trade-mark applications, shown in column one of Table 1 below, based on proposed use of the marks in Canada in association with "manufactured tobacco products." The application numbers and the applicant's names for its designs are shown in the second column of Table 1.

Table I

 A vertical rectangular design consisting of three stacked sections. The top section is a simple rectangle. The middle section is a rectangle with a pointed top edge, resembling a house or a peaked roof. The bottom section is a simple rectangle.	Application No. 1370832 Slide Pack End Design
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	<p>Application No. 1370833</p> <p>Open Slide Pack Design</p>
	<p>Application No. 1370841</p> <p>Slide Pack Keyhole Design</p>

[2] The subject applications were advertised for opposition purposes in the *Trade-marks Journal* issues dated August 20, 2008 and January 7, 2009 and were opposed by JTI-Macdonald TM Corp on January 14 and March 9, 2009. The Registrar forwarded copies of the statements of opposition to the applicant as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving counter statements generally denying the allegations in the statements of opposition.

[3] The opponent's evidence in each case consists of an affidavit of John Orange. Each affidavit is similar in nature and one cross-examination of Mr. Orange was conducted in respect of all three affidavits. The transcript of his cross-examination, exhibits thereto and answers to undertakings and questions taken under advisement form part of the evidence of record.

[4] The applicant's evidence consists of the affidavits of Louis-Philippe Pelletier. Each affidavit is similar in nature and one cross-examination of Mr. Pelletier was conducted in respect of all three affidavits. The transcript of his cross-examination and exhibits thereto form part of the evidence of record.

STATEMENT OF OPPOSITION

Opponent's Theory of the Cases

[4] The opponent's theory of the subject cases informs the individual grounds of opposition which are quite similar, or the same, for each opposition. As the grounds of opposition are better understood in the light of the opponent's theory of the cases, I have taken extracts from the opponent's written arguments (they are similar for each opposition), shown below, which highlight the opponent's theory:

In or around January of 2008, the Applicant began selling cigarettes in a particular package referred to as the "**Player's Slide Pack**". The Player's Slide Pack package comprises the following features:

- (a) an outer sleeve;
- (b) an inner compartment which contains the cigarettes and slides out of the outer sleeve to allow access to the cigarettes;
- (c) a "pentagonal keyhole" that is positioned on the side wall of the outer sleeve and into which a user inserts his/her finger to push the inner compartment out of the outer sleeve and access the cigarettes; and
- (d) a "slanted notch" at the top of the inner compartment that is exposed only when the inner compartment is pushed out of the outer sleeve that facilitates removal of the cigarettes.

The alleged trade-marks which are the subjects of the three above noted applications are depictions of various aspects of the Player's Slide Pack. The designs replicate the functional or utilitarian features of the Player's Slide Pack, including the "pentagonal keyhole" and "slanted notch" referenced above.

The Applicant is attempting to obtain protection by registration of a two dimensional trade-mark for the utilitarian three dimensional features of the Player's Slide Pack. The functional features of a product, however, are not the subject matter for a trade-mark registration.

The functionality of the designs has two important implications: (1) the designs are "distinguishing guises"; and (2) based on the doctrine of functionality, the designs are not registrable. In light of these implications, the Applicant has tried to frame the alleged trade-marks differently. The Applicant has attempted to circumvent the doctrine of functionality by claiming that it intends to use the designs as two dimensional marks on the front panel of cigarette packages and/or promotional materials.

[5] The pleadings in the statements of opposition refer to a distinguishing guise which is one of four types of trade-marks referred to in the interpretation section of the *Trade-marks Act*:

“trade-mark” means

- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,
- (b) a certification mark,
- (c) a distinguishing guise, or
- (d) a proposed trade-mark

[6] For ease of reference, shown below is the definition of a distinguishing guise set out in s.2 of the *Act*, and the requirements to register such a mark, set out in s.13:

“distinguishing guise” means

- (a) a shaping of wares or their containers, or
 - (b) a mode of wrapping or packaging wares
- the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

13. (1) A distinguishing guise is registrable only if

(a) 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; and

(b) the exclusive use by the applicant of the distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry.

(2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.

(3) The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

(emphasis added)

Grounds of Opposition

- [7] 1. The first ground of opposition, pursuant to s.30 of the *Trade-marks Act*, alleges that (i) the applicant did not intend to use the applied for mark as a trade-mark within the meaning of s.2, (ii) the applied for mark is primarily functional and therefore cannot be a valid trade-mark.
2. The second ground alleges that (i) if the applied for mark is a trade-mark, then it is a distinguishing guise and has not been used by the applicant so as to have become distinctive as of the date of filing the application, as required by s.13(1)(a) of the *Act*, (ii) an exclusive grant to the applicant in the use of the

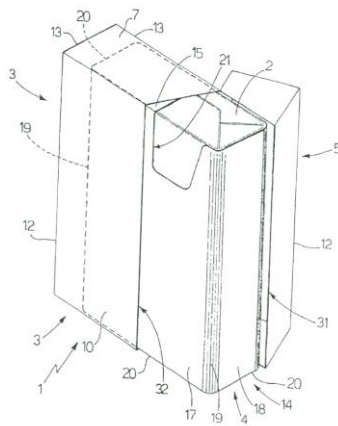
applied for mark is likely to unreasonably limit the development of the industry in the production, marketing and sale of manufactured tobacco products.

3. The third ground alleges that the applied for mark is not adapted to distinguish the applicant's wares because the mark "embodies features which are primarily functional . . ."

OPPONENT'S EVIDENCE

John Orange

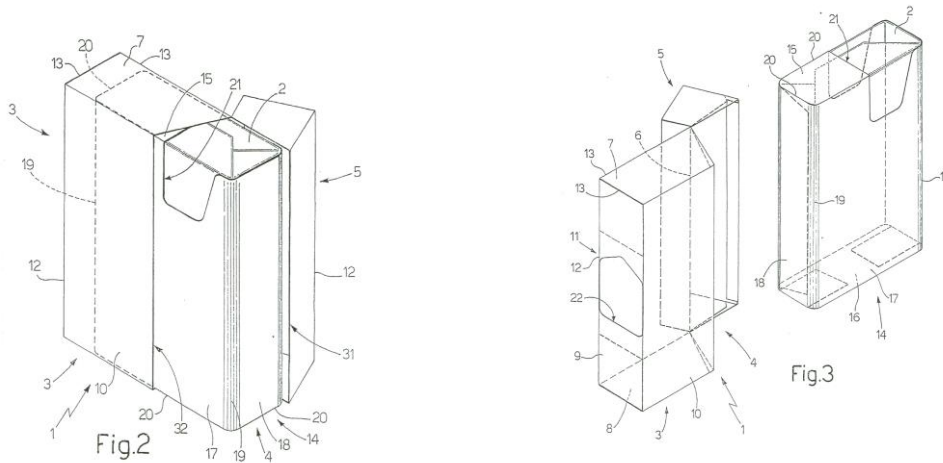
[8] Mr. Orange identifies himself as a patent agent employed by the firm representing the opponent. His affidavit serves to introduce into evidence a copy of Patent Cooperation Treaty application number WO 2004/028927 ("the 927 Patent"), owned by a third party, for "Rigid Side-Open Package for Tobacco Articles." The patent application is attached as Exhibit A to his affidavit. The diagram on the cover page of the patent, and the accompanying abstract, are shown below:



A rigid package (1) for tobacco articles, having a container (3) with an open end (4), and a lid (5) hinged to the container (3) to rotate between an open position and a closed position respectively opening and closing the open end (4); when the lid (5) is in the closed position, the container (3) is substantially parallelepiped-shaped and has two, respectively top and bottom, end walls (7, 8), and a lateral surface bounded by the end walls (7, 8) and having two, respectively front and rear, major lateral walls (10, 11), and two minor lateral walls (9); four longitudinal edges (12) are defined between the major lateral walls (10,11) and the minor lateral walls (9), and eight transverse edges (13) are defined between the lateral walls (9, 10, 11) and the end walls (7, 8); the lid (5) is hinged along a hinge (6) formed in the rear major lateral wall (11) and parallel to the longitudinal edges (12); and the lid (5) includes part of the

end walls (7, 8), part of the major lateral walls (10, 11), and a minor lateral wall (9). The articles are retained in an inner container (14) slidingly received within the outer container.

[9] Figures 2 and 3 of the 927 Patent are shown below:



[10] The description of the patent, at page 6, lines 14 to 22 and at page 10, lines 16 to 23, are shown below:

Number 1 in the accompanying drawings indicates as a whole a rigid cigarette packet for housing an orderly group 2 of cigarettes wrapped in a sheet of foil, and which comprises a cup-shaped container 3 having an open end 4. A cup-shaped lid 5 is connected to container 3 and hinged to container 3 along a hinge 6 (shown in Figures 3 and 5) to rotate, with respect to container 3, between an open position (Figure 2) and a closed position (Figure 1) respectively opening and closing open end 4.

A minor lateral wall 9 of container 3 has a hole 22 (Figure 3) shaped and sized to permit insertion of the user's finger, and which provides for assisting expulsion of container 14 from container 3, by the user applying pressure on the minor lateral wall 1.8 of container 14 facing hole 22 when container 14 is in said inserted position (Figure 1).

(emphasis added)

[11] After reviewing the above patent, Mr. Orange concludes that:

(i) "The subject trade-mark [No. 1370832] is nothing more than an end view of Figure 3 of the 927 Patent."

(i) “The subject trade-mark [No. 1370841] is simply a two-dimensional representation of this functional feature [hole 22 in Figure 3, above] and nothing more than a different version of Figure 3 of the 927 Patent.”

(iii) “The subject trade-mark [No. 1370833] is nothing more than a side view of Figure 2 of the 927 Patent, and represents primarily functional features.”

[12] Mr. Orange’s testimony at cross-examination is consistent with his affidavit evidence.

[13] The applicant submits that where Mr. Orange’s opinion evidence relates to the issue of functionality, such opinion evidence should be disregarded because he is an employee of the agent for the opponent. I agree with the applicant and I have disregarded such opinion evidence. However, from my own review of the 927 Patent, I agree with Mr. Orange’s observations that the subject applications appear to be two dimensional perspectives of the 927 Patent.

APPLICANT’S EVIDENCE

Loius-Philippe Pelletier

[14] Mr. Pelletier identifies himself as an employee of Imperial Tobacco Canada Limited (“ITCan”). From 2005 to 2008, Mr. Pelletier was a Brand Associate for his employer’s subsidiary company Player’s Company Inc (“Player’s”), the applicant herein.

[15] Player’s SLIDE SERIES cigarettes are sold to consumers in Canada in a distinctive package. The package in the open position, shown below, is one of five photographs of the package comprising Exhibit A of Mr. Pelletier’s affidavit:



[16] Distinctive features of the cigarette package are (1) the pentagonal keyhole that is positioned on the side wall of the outer sleeve and (2) a slanted side notch on the inner compartment of the package, both visible in the above photograph.

[17] The size, shape and position of the pentagonal keyhole and the slanted side notch are arbitrary and were selected by the applicant to be unique and distinctive and to assist smokers in identifying the slide pack as a Player's product. From March 2008 to August 2008, ITCan spent in excess of \$750,000 to advertise the availability of Player's SLIDE SERIES cigarettes in magazines and on posters in adult-only establishments such as bars.

[18] The subject trade-mark applications represent the pentagonal keyhole, a side view of the slide package with the pentagonal keyhole visible and the package in the open position with the slanted side notch visible.

[19] Mr. Pelletier is not aware of any other party having used trade-marks in Canada similar to those shown in the subject applications. Mr. Pelletier has reviewed the 927 Patent filed as evidence in this proceeding. He is not aware of any "party in Canada other than Player's ever having promoted or sold cigarettes in cigarette packages such as those described in" the 927 Patent.

[20] Mr. Pelletier's testimony at cross-examination is consistent with his affidavit evidence.

WHAT ARE THE APPLIED-FOR MARKS?

[21] Based on my review of the evidence of record, summarized above, I am satisfied that the opponent has met the burden on it to put into issue whether the applied-for marks represent a distinguishing guise. The legal onus therefore falls on the applicant to show, on a balance of probabilities, that the three applied-for marks do not represent a distinguishing guise. In my view, the weight of the evidence indicates that the applicant intended to use, and that the applicant in fact began to use, a single mark rather than three different marks; that single mark is a three dimensional mark and it is a distinguishing guise. The applicant's distinguishing guise is a shaping of a container for "manufactured tobacco products," that is, cigarettes. The subject applications are in essence three different perspectives of a distinguishing guise. In one perspective the container is in the

“open” position (application No.1370833). The applicant’s distinguishing guise, in the “open” position, is shown in paragraph 15 above, together with other indicia of origin, decorative features and mandated health information. The applicant’s distinguishing guise shares features similar to those described in Patent 927. Whether certain aspects of the distinguishing guise are utilitarian features, and whether the mark as a whole is barred from registration by the doctrine of functionality, are questions separate and apart from the issue of whether the applicant has improperly applied for two-dimensional marks rather than for a distinguishing guise.

[22] In view of my finding that the proper subject of the trade-mark applications ought to have been a distinguishing guise, the opponent succeeds on the first branch of the first ground of opposition. In the event that it is possible to construe the three separate applications as constituting an application for a distinguishing guise (in my view it is not possible), then the applicant’s evidence filed herein is insufficient to establish that its mark was distinctive as of the filing date of the applications, that is, as of November 6, 2007. The opponent would succeed on the first branch of the second ground of opposition.

THE DOCTRINE OF FUNCTIONALITY

[23] Both parties in their written arguments and at the oral hearing made submissions on whether the applied-for marks were barred from registration by the doctrine of functionality. As I have found in favour of the opponent on the basis that the applied-for marks are in fact representations of a distinguishing guise, it is not necessary for me to address the remaining grounds of opposition which turn on the issue of functionality. Further, it may be preferable if I refrain from making findings on the issue of functionality. In this regard, nothing prevents the applicant (or others) from filing an application for a distinguishing guise having the same (or similar) features as the present mark, which application may result in an opposition proceeding where functionality will be in issue. If so, then this Board will have an opportunity at that time to examine the doctrine of functionality in the context of an application for a distinguishing guise.

DISPOSITION

[24] In view of my findings in paragraphs 21 and 22 above, the subject applications are refused. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office