



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

Citation: 2013 TMOB 111
Date of Decision: 2013-07-03

**IN THE MATTER OF AN OPPOSITION
by Dairy Farmers of Canada/ Les
Producteurs Laitiers du Canada to
application No. 1,436,278 for the trade-
mark HAM & CHEESERS in the name
of Del Monte Corporation**

I. Background

[1] Del Monte Corporation (the Applicant) applied to register the trade-mark HAM & CHEESERS (the Mark), based upon use in Canada since at least as early as January of 2004, in association with “pet food”.

[2] Dairy Farmers of Canada/ Les Producteurs Laitiers du Canada (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The application has been opposed on the grounds that: (i) the application does not conform to the requirements of section 30 of the Act; (ii) the trade-mark is not registrable as it is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it has allegedly been used; and (iii) the trade-mark is not distinctive within the meaning of section 2 of the Act.

[4] Both of the parties filed evidence and written arguments. No oral hearing was held.

[5] For the reasons that follow, all grounds of opposition are hereby dismissed.

II. Evidence

Opponent's Evidence

[6] The Opponent's evidence consists of the affidavit of Ian MacDonald and Exhibits IM-1-IM-6, dated December 1, 2010. Mr. MacDonald identifies himself as the National Director of Marketing and Nutrition for the Opponent, namely, Dairy Farmers of Canada/ Les Producteurs Laitiers du Canada ("DFC"). He states that DFC is a national policy, lobbying and promotional organization that represents a number of Canadian dairy farms. He further states that it is in DFC's interest to defend the terminology used to identify dairy products and their derivatives. DFC is mandated by the dairy producers to protect the use of terms such as milk, butter, cream and cheese.

[7] In paragraph 8 of his affidavit, Mr. MacDonald notes that cheese is usually made from fermented cow milk and he briefly outlines the cheese-making process. As Exhibits IM-1 and IM-2, Mr. MacDonald provides a couple of definitions for "cheese". According to these definitions, "cheese" is defined as "a food made from pressed curds of milk" and "a food made from milk, which can either be firm or soft and is usually yellow or white in colour".

[8] As Exhibit IM-3 to his affidavit, Mr. MacDonald has provided print-outs from DFC's website, which provide some further information about the history of cheese and how it is made.

[9] Mr. MacDonald has also attached excerpts from *The Food and Drugs Act*, the *Consumer Packaging and Labelling Act*, the *Dairy Products Regulations*, the *Food Products Act* (Quebec) and the Canadian Food Inspection Agency's 2003 *Guide to Food Labeling and Advertising* to his affidavit (see paragraphs 13 and 14 and Exhibits IM-4 and IM-5). He indicates that these excerpts are applicable to dairy products, including cheese. However, he does not specify how they are applicable.

[10] In paragraph 15 of his affidavit, Mr. MacDonald states that dairy products such as cheese are broadly used by Canadian consumers on a daily basis. In support of this statement, as Exhibit IM-6 to his Affidavit, Mr. MacDonald provides some statistics relating to dairy product consumption in Canada, including cheese.

[11] In paragraphs 16 to 18 of his affidavit, Mr. MacDonald makes some statements to the effect that the inclusion of the term “cheesers” in the Applicant’s trade-mark clearly describes or is clearly deceptive of the composition and nature of its associated wares. In particular, Mr. MacDonald is of the view that as a matter of first impression, the average consumer would likely conclude that the Applicant’s pet food is made of real dairy-based cheese or contains real dairy-based cheese. In paragraph 18, Mr. MacDonald states that during his 27 years of experience in the dairy business there is no doubt that the Applicant’s use of its trade-mark HAM & CHEESERS is misleading the average consumer on the components and the quality of the wares associated with it.

[12] I am of the opinion that Mr. MacDonald cannot properly be qualified as an expert in this proceeding. While I do not question Mr. Macdonald’s professional experience and integrity, it seems to me that an expert qualification necessarily includes independence from the parties on the outcome of the case [*Black Entertainment Television, Inc v CTV Limited* (2008) 66 CPR (4th) 212 (TMOB)]. Furthermore, since the statements in paragraphs 16 to 18 of Mr. MacDonald’s affidavit essentially amount to argument and/or personal opinion, I am not prepared to accord those statements any weight. Descriptiveness issues involve questions of fact and law which are to be determined by the Registrar.

Applicant’s Evidence

[13] The Applicant’s evidence consists of the affidavit of Brad Hatt, sworn April 1, 2011. Mr. Hatt is the Director of DLM Foods Canada Corp. in Canada (DLM Foods). He states that DLM Foods is a wholly owned subsidiary of the Applicant and acts as its sales agent and distributor in Canada. Mr. Hatt states that the Applicant’s HAM & CHEESERS product has been sold continuously in Canada since January of 2004 either by the Applicant or its predecessor-in-title and that at all times since then, the packaging has featured the trade-mark HAM & CHEESERS.

[14] As Exhibit “A” to his affidavit, Mr. Hatt attaches an image of a package which has been used by the Applicant since 2006 for its pet food. The Applicant’s trade-mark HAM & CHEESERS is displayed thereon.

[15] Attached as Exhibit “B” to his affidavit, is a printout from the Applicant’s website showing how the Applicant advertises its HAM & CHEESERS pet food products.

[16] Mr. Hatt indicates that since the first sales in Canada, the Applicant’s product bearing the HAM & CHEESERS trade-mark has been and continues to be sold in a number of retailers across the country including grocery stores and pet stores such as Loblaws, Wal-Mart and others. The Applicant’s gross sales of its pet food products bearing the HAM & CHEESERS trade-mark in Canada have ranged between \$400,000 and \$600,000 for the years of 2006 to 2010. As Exhibit “C” to his affidavit, Mr. Hatt also attaches sample invoices from 2006-2010.

[17] As further evidence, the Applicant has provided certified copies of 25 registrations incorporating the words CHEESE, CHEESY, or CHEESER (or their phonetic equivalents) for a variety of food products that the Applicant submits are clearly cheese flavored. The Applicant has suggested that these registrations make it clear that variations of the word CHEESE are commonly used as part of trade-marks to describe food products that may have a cheese taste, but do not necessarily contain real cheese.

[18] I note that the Applicant has not submitted any evidence to confirm that the food products which are associated with these trade-marks are actually sold in the marketplace or that such products do not contain real cheese. However, in view of the number of marks which have been located by the Applicant, I am prepared to infer that at least some of them are in use in the marketplace [*Old Spaghetti Factory Canada Ltd v Spaghetti House Restaurants Ltd* (1999), 2 CPR (4th) 398 (TMOB)].

III. Analysis

[19] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Conformity – Section 30 of the Act

[20] The material date for considering the conformity of the application to the requirements of section 30 of the Act is the filing date of the application, namely April 28, 2009 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[21] I will address each of the individual grounds raised under section 30 of the Act in turn.

Section 30(b)

[22] The Applicant has alleged that the application does not comply with section 30(b) of the Act because the Applicant never used the trade-mark in association with the wares, did not use it continuously or used a trade-mark which differed from that which is covered in its application.

[23] Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [*Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[24] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. This burden may be met by reference not only to the opponent's evidence but also to the applicant's [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, in order to do so, it must show that the applicant's evidence is "clearly" inconsistent with the claims in the application [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB) at 565 -6, aff'd (2001), 11 CPR (4th) 489 (FCTD)].

[25] I cannot conclude that the Opponent has met its initial burden in respect of this ground, as it has not filed any evidence in support thereof, nor has it made any submissions to indicate how the Applicant's evidence could be considered to be clearly inconsistent with the claims in its application. This ground of opposition is therefore rejected.

Section 30(h)

[26] The Opponent has alleged that the application does not comply with section 30(h) because the trade-mark as used differs from that which is covered in the application. First, I note that a review of the Applicant's evidence suggests that the mark does, in fact, appear to be in use in the form in which it has been applied for [Hatt, Exhibit A]. Second, I note that even if that were not the case, the Mark at issue is a word mark, rather than a design mark. In view of this, section 30(h) is not applicable. Accordingly, this ground is also rejected.

Section 30(i)

[27] The Opponent has alleged that the application does not comply with section 30(i) because the Applicant's statement that it was satisfied of its entitlement to use the trade-mark was false because of "the content of the present opposition" and "the content of several federal and provincial laws related to dairy products".

[28] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155] or where there is a *prima facie* case of non-compliance with a federal statute [*Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[29] In this particular case, the Opponent has not identified the particular pieces of legislation which it is relying upon in its pleading. The Applicant contends that this contravenes section 38(3)(a) of the Act because the ground as pleaded is not set out in sufficient detail to enable it to reply thereto. I agree. However, I note that a deficiency in a pleading can sometimes be cured by the evidence [*Novopharm Ltd v AstraZeneca AB* 2002 FCA 387 (CanLII) (2002), 21 CPR (4th) 289 (FCA)].

[30] In this case, the Opponent has, in fact, filed excerpts of various federal and provincial statutes, regulations and guidelines as evidence (MacDonald, Exhibits IM4-IM5). However, the Opponent has not explained the relevance of these excerpts nor has it indicated whether they are even intended to support its section 30(i) ground of opposition.

[31] Even if these excerpts were to be sufficient to cure the deficiency in the Opponent's pleading, as noted by the Applicant, it is unclear how or if they would be applicable to the Applicant's "pet food" and the Opponent hasn't provided any detailed submissions in this regard. In view of this, I am unable to conclude that this is a *prima facie* case of statutory non-compliance.

[32] This ground of opposition is therefore rejected.

Registrability – Section 12(1)(b) of the Act

[33] The Opponent has pleaded that the Applicant's trade-mark is not registrable pursuant to section 12(1)(b) of the Act because it is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it has allegedly been used. More particularly, the Opponent has pleaded that the average consumer would be likely to believe that the wares associated with the Applicant's trade-mark HAM & CHEESERS are made of real dairy-based cheese or contain real dairy-based cheese.

[34] The material date for considering the registrability of the trade-mark under section 12(1)(b) of the Act is the filing date of the application, namely April 28, 2009 [*Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[35] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares or services. 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 [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) and *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (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 (ExCt)].

[36] The Opponent has not provided particularly detailed submissions regarding its section 12(1)(b) ground of opposition. Without detailed written submissions or oral representations at a

hearing, it is difficult for me to speculate about what the Opponent is relying upon in support of its position.

[37] Based upon the dictionary definitions, dairy statistics and other information which has been provided in the MacDonald affidavit in relation to the word “cheese”, the Opponent appears to be of the view that the average consumer would be aware of the meaning of the word “cheese”. Further, the Opponent appears to be taking the position that the consumers would be so familiar with cheese as a food product that as a matter of first impression, upon seeing the trade-mark HAM & CHEESERS, in the context of the Applicant’s pet food, he or she would assume that such products contain real cheese or are made of real cheese, when in fact that is not the case.

[38] According to the definitions provided by the Opponent, “cheese” is “a food made from pressed curds of milk” and “a food made from milk, which can either be firm or soft and is usually yellow or white in colour” (MacDonald, paragraphs 10 and 11 and Exhibits “IM-1” and “IM-2”). Mr. MacDonald outlines the process for making “cheese” in paragraph 9 of his affidavit and notes that it is usually made from fermented cow milk from which a portion of the water and lactose has been removed.

[39] The Applicant contends that the average consumer, upon seeing the trade-mark HAM & CHEESERS in association with “pet food” would not assume that the “pet food” is made from real dairy-based cheese or be deceived into thinking that it does. Rather, the Applicant is of the view that in the context of “pet food”, the trade-mark merely suggests that the Applicant’s products have a cheese flavor or taste.

[40] In support of this position, the Applicant submits that variations of the word CHEESE are commonly used as part of trade-marks to describe food products that have a cheese taste, but which do not necessarily contain real cheese. In this regard, the Applicant relies upon the 25 certified copies which it has provided for registrations for marks which contain the words CHEESE, CHEESY or CHEESER (or their phonetic equivalents), for a variety of food products.

[41] The Applicant contends that the use of these marks on food products has shaped consumers’ backgrounds and experiences regarding variations of the word CHEESE, such that

the average purchaser would not, on first impression necessarily believe that the Applicant's pet food sold under the trade-mark HAM & CHEESERS contain real cheese.

[42] At this point, I wish to reiterate the importance of not dissecting a mark into its component elements and carefully analyzing each element when doing a s. 12(1)(b) analysis. The Mark must be considered in its entirety. In this case, the Mark is HAM & CHEESERS. It does not simply consist of the word CHEESE, but rather is composed of a combination of the word HAM, which is readily recognizable in the English language, an ampersand and the term CHEESERS, which is essentially a coined word.

[43] The fact that a trade-mark consists of a coined word or a combination of words that does not appear in a dictionary does not by itself prevent a trade-mark from being found to be clearly descriptive or deceptively misdescriptive [*Oshawa Group Ltd v Registrar of Trade-marks* (1980), 46 CPR (2d) 145 (FCTD) and *Clarkson Gordon v Registrar of Trade-marks* (1985), 5 CPR (3d) 252 (FCTD)]. However, as stated by Mr. Justice Reed in *Clarkson Gordon*, "it will always be more difficult to prove that such words are clearly descriptive of a character or quality of the product to which they relate than is the case with 'uncoined' words".

[44] It is important to take into account that the trade-mark in its entirety must also be considered within the context of its associated wares. In this case, the wares are "pet food".

[45] In my view, the mere fact that consumers are familiar with the meaning of "cheese" and with "cheese" as a food product does not necessarily lead to the conclusion that the coined expression HAM & CHEESERS would upon first impression, lead the average pet food consumer to believe that the Applicant's products contain or are made of real dairy cheese, as asserted by the Opponent. There is a difference between "human food" and "pet food" and in the context of "pet food", I find it reasonable to conclude that the trade-mark HAM & CHEESERS would more likely suggest to consumers that the Applicant's products may perhaps have a ham and cheese flavor or a ham and cheese taste. I am therefore of the view that the trade-mark is not clearly descriptive.

[46] For a trade-mark to be considered deceptively misdescriptive, the mark must mislead the public as to the character or quality of the wares and services. The mark must be found to be

descriptive so as to suggest the wares or services are or contain something that is not the case. The purpose of the prohibition with respect to deceptively misdescriptive trade-marks is to prevent the public from being misled [*Atlantic Promotions, supra*; and *Provenzano v Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (FCTD)].

[47] Since I have found that the Mark would not lead consumers to believe that the Applicant's products contain or are made from real dairy based cheese, it follows that the Mark cannot be said to be deceptively misdescriptive, as the Mark would not lead consumers to believe that the Applicant's pet foods contain something which they may or may not.

[48] In view of the foregoing, this ground of opposition is rejected.

Distinctiveness – Section 2 of the Act

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

[50] The following statement of Mr. Justice O'Keefe in *Canadian Council of Professional Engineers v. APA – Engineered Wood Association* 2000 CanLII 15543 (FC), (2000), 7 CPR (4th) 239 (F.C.T.D.) at para. 49 is particularly relevant to the case at hand:

While it may be true that a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive, it is not correct to hold that merely because a mark is adjudged *not* to be either purely descriptive or deceptively misdescriptive, it is therefore distinctive.

[51] Having found that the Applicant's trade-mark is neither clearly descriptive nor deceptively misdescriptive, it would therefore normally still be appropriate for me to go on to consider the Opponent's distinctiveness ground of opposition. However, in this case, the Opponent's pleading under section 2 of the Act is limited to an allegation that the Applicant's trade-mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the wares of the Applicant from those of others, since, whether depicted, written or sounded, the

trade-mark is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it is alleged to have been used.

[52] Since I have already determined that the Mark is neither clearly descriptive nor deceptively misdescriptive and since the Opponent's pleading is strictly limited to this allegation, I do not find it necessary to give any further consideration to this ground. This ground of opposition is therefore also rejected.

IV. Disposition

[53] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Cindy Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office