

IN THE MATTER OF AN OPPOSITION by Gainers, Inc. to
application No. 686,800 for the trade-mark SENSIBLE CHOICE &
Design filed by Robin Hood Multifoods Inc.

On July 31, 1991, Robin Hood Multifoods Inc. filed an application to register the trade-mark SENSIBLE CHOICE & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as June 1991 in association with "bakery mixes, muffin mixes and bread mixes" and in association with "promotional services, namely the provision of in-store displays, posters, point of sale materials relating to food products of others". At the examination stage, the applicant amended its statement of wares to cover: "bakery mixes and muffin mixes for sale to commercial bakeries".

The present application was advertised for opposition purposes in the Trade-marks Journal of March 18, 1992 and Gainers, Inc. filed a statement of opposition on April 29, 1992. The present application was re-advertised in the Trade-marks Journal of July 8, 1992 and Gainers Inc. submitted an amended statement of opposition in which it alleged the following grounds:

- (a) The present application does not comply with Section 30 of the *Trade-marks Act* in that: (i) the applicant does not intend to use the trade-mark on the wares and services set out in the application; (ii) the wares and services are not described in ordinary commercial terms, nor are the services proper subject matter for trade-mark protection; (iii) the applicant could not have been satisfied that it was entitled to use the trade-mark for the reasons set out in the remaining grounds of opposition;
- (b) The trade-mark SENSIBLE CHOICE & Design is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act* in that the trade-mark is confusing with the opponent's two registered trade-marks SENSIBLE EATING and SENSIBLE, registration Nos. 301,605 and 385,455;
- (c) The applicant is not the person entitled to registration of the trade-mark SENSIBLE CHOICE & Design in that, as of the filing date of the present application, the applicant's trade-mark SENSIBLE CHOICE & Design was confusing with the opponent's trade-marks referred to in the previous ground, as well as being confusing with trade-mark application No. 666,132 for the mark SENSÉ and with extension of wares application relating to registration No. 385,455 for the trade-mark SENSIBLE,

which trade-marks had previously been used in Canada by the opponent in association with a wide variety of wares including the wares covered in the said registrations and pending applications, namely:

<u>Reg'n/App'l'n No.</u>	<u>Wares</u>
301,605 entrées consisting of stroganoff, chinese style entrées, poultry, meat, sauces	Prepared packaged food in the nature of cabbage rolls, salisbury steak, swiss steak, stews, chicken a la k i n g , entrées, mexican style chicken cacciatore, pasta entrees, vegetables in gravies and/or
385,455	processed meats
Ext. of wares appl'n to reg'n. No. 384,455	prepared packaged foods in the nature of entrées
666,132	processed meats

(d) The trade-mark SENSIBLE CHOICE & Design is not distinctive in that it does not distinguish the applicant's products from the wares of others and, in particular, from the wares of the opponent.

In addition to the above, the opponent submitted in its amended statement of opposition that it sent a cease and desist letter to the applicant on September 25, 1991 requesting *inter alia* that the applicant cease all use of the mark SENSIBLE CHOICE and, as no response was received from the applicant, the opponent commenced an infringement action in the Federal Court of Canada against use of the mark SENSIBLE CHOICE & Design.

The opponent filed as its evidence the affidavit of Daniel L. Harrington while the applicant submitted as its evidence the affidavits of John Dienesch and Herb McPhail. The applicant alone filed a written argument and both parties were represented at an oral hearing. Further, subsequent to the oral hearing, the applicant amended its statement of services to cover the following:

"promotional services, namely the provision of in-store displays, posters, point-of-sale materials and other promotional materials relating to products made from applicant's bakery mixes and muffin mixes".

With respect to the first ground of opposition, there is an initial evidential burden on the opponent in respect of its Section 30 ground even though the legal burden is upon the applicant to show that its application complies with Section 30 of the Act [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. In the present case, the

opponent failed to adduce any evidence in relation to its Section 30 ground, nor have any of the statements made by Mr. Dienesch in his affidavit been challenged by cross-examination or contradicted by way of admissible evidence from the opponent. Furthermore, no submissions were made by the opponent in relation to this ground either by way of written argument or at the oral hearing. I have therefore dismissed the first ground for failure of the opponent to meet the evidential burden upon it.

As its second ground, the opponent alleged that the applicant's trade-mark SENSIBLE CHOICE & Design is not registrable in that it is confusing with its registered trade-marks SENSIBLE EATING and SENSIBLE, registration Nos. 301,605 and 385,455. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Section 6(5) of the Act. As well, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date for assessing a Section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)].

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark SENSIBLE CHOICE & Design is suggestive of the character or quality of the applicant's bakery and muffin mixes and its promotional services relating to products made from its mixes wares, that is, that the mixes are used for preparing food products for consumption by sensible consumers who are concerned about their health. Likewise, the opponent's trade-marks SENSIBLE EATING as applied to various kinds of prepared packaged food in the nature of entrees and SENSIBLE covering processed meats are suggestive of food products that are for consumption by sensible consumers who are concerned about their health. Accordingly, these marks possess a limited degree of inherent distinctiveness.

The Harrington affidavit establishes that the opponent's registered trade-mark SENSIBLE

has become known in Canada in association with processed meats. In particular, Mr. Harrington, Vice-President, corporate affairs of the opponent, attests to in excess of 1,175,000 kg. of SENSIBLE processed meats having been sold in Canada from 1991 to May of 1993. However, no evidence has been furnished by the opponent in respect of its use of the trade-mark SENSIBLE EATING and I must assume that the SENSIBLE EATING mark has not become known to any extent in Canada.

The Dienesch affidavit confirms that the applicant commenced selling its SENSIBLE CHOICE & Design bakery and muffin mixes in Canada in June of 1991 and, since their introduction, the applicant has sold more than 300,000 kg. of the SENSIBLE CHOICE & Design bakery mixes to in-store bakeries located within the bakery department of retail grocery stores and to donut shops or muffin outlets. As a result, the applicant's trade-mark has become known particularly to buyers and workers in bakery departments of grocery stores, and to owners and operators of donut and muffin shops and their employees.

The applicant has provided little evidence relating to its use of the trade-mark SENSIBLE CHOICE & Design in association the promotional services covered in its amended application. While Mr. Dienesch states that his company has distributed point of sale tent cards seen by consumers when they purchase SENSIBLE CHOICE & Design muffins which have been made by commercial bakeries from its mixes, the extent of distribution of such cards or any other promotional activities relating to the applicant's mixes are not disclosed by Mr. Dienesch. I must assume, therefore, that the trade-mark SENSIBLE CHOICE & Design has only become known to a minimal extent in Canada. In view of the above, the extent to which the trade-marks at issue have become known weighs in the opponent's favour.

The opponent has established use of its trade-mark SENSIBLE as applied to processed meats since July of 1991 but has not evidenced any use of its trade-mark SENSIBLE EATING. The applicant's evidence shows that it has used its trade-mark SENSIBLE CHOICE & Design in Canada since June of 1991 in association with its muffin and bakery mixes but has not furnished any evidence in support of its claimed date of first use of its trade-mark SENSIBLE CHOICE & Design

in association with its promotional services. Thus, the length of use of the trade-marks at issue does not favour either party in this proceeding.

The wares of the parties fall within the general category of food or food-related products although the applicant's mixes which are used for making muffins and other bakery products differ from the opponent's processed meats and its packaged entrées consisting of cabbage rolls, salisbury steak, swiss steak, stews, chicken a la king, stroganoff, chinese style entrées, mexican style entrées, chicken cacciatore, pasta entrées, poultry, meat, vegetables in gravies and/or sauces. Further, the applicant's promotional services relating to its muffin and bakery mixes bear no similarity to the opponent's processed meats and packaged entrées.

As for the nature of the trade associated with the wares of the parties, the applicant's bakery and muffin mixes are sold to commercial bakeries such as those situated in grocery stores and to donut and muffin shops. As a consequence, the applicant's bakery and muffin mixes bearing the trade-mark SENSIBLE CHOICE & Design are not normally seen by the average consumer. Furthermore, I would expect the applicant's wares to be advertised or promoted in publications which are directed to people working in the baking industry, as opposed to being advertised in consumer publications or on radio or television.

At the oral hearing, the opponent submitted that there would be a potential overlap in the channels of trade of the parties in that the applicant distributes tent cards to commercial bakeries for use as point of sale items and therefore may be seen by consumers when they purchase SENSIBLE CHOICE & Design muffins which have been made by the commercial bakeries. While this evidence is of little relevance to the registrability of the applicant's trade-mark as applied to its muffin and bakery mixes, it does disclose the manner in which the applicant has used its trade-mark in association with its promotional services. In particular, the trade-mark SENSIBLE CHOICE & Design would appear in association with muffins or other bakery items being offered for sale in the in-store bakery section of grocery stores or supermarkets and the bakery section might well be located in close proximity to the delicatessen section or meat counter where the opponent's

SELECTION prepared meats are being displayed for sale. Moreover, Mr. Harrington states that the opponent's wares are advertised by coupon and contest promotion which include the use of contest entry forms, in-store posters and mobiles, together with the distribution of coupons on cereal boxes. Thus, the opponent's advertising and promotion of its wares might well overlap the applicant's promotional services which are being provided in the same grocery store or supermarket.

The applicant has adopted the entirety of the opponent's trade-mark SENSIBLE and the trade-marks SENSIBLE CHOICE & Design and SENSIBLE are therefore very similar in appearance and in sounding, as well as in the ideas suggested by them. As well, the trade-marks SENSIBLE CHOICE & Design and SENSIBLE EATING are similar in appearance, sounding and in the ideas suggested by them.

As a further surrounding circumstance in respect of the issue of confusion, the applicant relied upon evidence of the state of the register and evidence relating to the marketplace. However, the McPhail search disclosed the existence of only one registration other than the trade-marks of the parties which included the word SENSIBLE as applied to food products. This evidence is therefore of no relevance to the issues in this opposition. In paragraph 12 of his affidavit, Mr. Dienesch refers to a few instances where packaging of food products includes reference to the word 'sensible' and has provided exhibits of such packaging. However, this evidence merely confirms my view that the trade-marks at issue are suggestive and I have already taken this into consideration in assessing the inherent distinctiveness of the trade-marks at issue.

Having regard to the above, and even bearing in mind the degree of resemblance between the applicant's trade-mark SENSIBLE CHOICE & Design and the opponent's registered trade-marks, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in view of the differences in the applicant's bakery and muffin mixes and the opponent's processed meats and prepared entrees and the nature of the trade associated with these wares. On the other hand, I am not satisfied that the applicant has met the legal burden upon it in respect of the services covered in its application in that there would appear to be an overlap in the nature of the trade associated with the applicant's services and the opponent's SENSIBLE processed meats. I have

therefore dismissed the Section 12(1)(d) ground as it applies to the applicant's wares but find that it is successful in relation to the applicant's services. As a result, I will only consider the remaining grounds of opposition in relation to the applicant's wares.

The third ground is based on Section 16 of the Trade-marks Act, the opponent alleging that the applicant's trade-mark SENSIBLE CHOICE & Design was confusing with the opponent's trade-marks SENSIBLE, SENSIBLE EATING and SENSÉ which had previously been used in Canada, as well as being confusing with the opponent's previously-filed trade-mark application for the trade-mark SENSÉ and a previously-filed extension of wares application for the trade-mark SENSIBLE, registration No. 384,455 covering prepared packaged foods in the nature of entrees.

Considering the Section 16(1)(a) ground, there is an initial burden on the opponent in view of the provisions of Sections 16(5) and 17(1) of the *Trade-marks Act* to establish its prior use and non-abandonment of its trade-marks SENSIBLE, SENSIBLE EATING and SENSÉ in Canada. In this regard, the opponent has not met this burden in respect of any of its trade-marks in that the Harrington affidavit attests only to use of the trade-mark SENSIBLE and such use appears to have commenced subsequent to the applicant's claimed date of first use of June, 1991.

With respect to the allegation of confusion between the applicant's trade-mark SENSIBLE CHOICE & Design and the opponent's pending extension of wares application for the registered trade-mark SENSIBLE, this application was filed October 23, 1991, subsequent to the claimed date of first use, and is therefore of no relevance to a ground of opposition based on Section 16(1)(b) of the *Trade-marks Act*. The opponent also relied upon its application for registration of the trade-mark SENSÉ which was filed September 12, 1990. As this application was pending as of the date of re-advertisement of the present application [July 8, 1992], the opponent has met the initial burden upon it under Section 16(5) of the Act. Accordingly, the legal burden is upon the applicant to demonstrate that there would be no reasonable likelihood of confusion between its trade-mark SENSIBLE CHOICE & Design as applied to the wares covered in the present application and the opponent's trade-mark SENSÉ as applied to processed meats as of the date of first use claimed in the present application [June, 1991]. As in the case of the Section 12(1)(d) ground, the Registrar

must have regard to all the surrounding circumstances including those specifically enumerated in Section 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark SENSIBLE CHOICE & Design as applied to bakery mixes and muffin mixes for sale to commercial bakeries and the opponent's trade-mark SENSÉ as applied to processed meats are suggestive of the character or quality of the respective wares of the parties, that is, that they are for consumption by the sensible consumer who is concerned about his or her health. In this regard, the applicant's trade-mark SENSÉ is the French word meaning 'sensible'. Accordingly, these marks possess a limited degree of inherent distinctiveness.

No evidence has been furnished by the opponent relating to its use of the trade-mark SENSÉ and, as of its claimed date of first use, it would not appear that the applicant had yet commenced use of the trade-mark SENSIBLE CHOICE & Design. As a result, neither the extent to which the trade-marks have become known nor the length of use of the trade-marks SENSÉ and SENSIBLE CHOICE & Design are relevant surrounding circumstances in assessing the likelihood of confusion between the trade-marks at issue as of the applicant's claimed date of first use.

The applicant's bakery mixes and muffin mixes for sale to commercial bakeries differ from the opponent's processed meats. As for the nature of the trade associated with the trade-marks SENSÉ and SENSIBLE CHOICE & Design, the applicant's commercial bakery mixes are identified as being for sale to commercial bakeries while the opponent's processed meats would be sold to the average consumer of food products through grocery stores, supermarkets, or the like. As a result, there would not appear any overlap in the respective channels of trade of the parties.

The trade-marks at issue bear no similarity either in appearance or in sounding, but do suggest similar ideas, the applicant's trade-mark SENSÉ being the French word meaning 'sensible'.

In view of the above, and considering the differences in the wares and the nature of the trade associated with the wares of the parties, I have concluded that the applicant has met the legal burden upon it in respect of the issue of the likelihood of confusion between the trade-marks SENSIBLE CHOICE & Design and SENSÉ. The Section 16(1)(b) ground is therefore unsuccessful.

The final ground of opposition relates to the alleged non-distinctiveness of the applicant's trade-mark SENSIBLE CHOICE & Design. The material date for considering the non-distinctiveness ground is as of the date of opposition [July 27, 1992]. As the opponent has not pleaded any facts in support of this ground, the non-distinctiveness ground is limited to the allegations of confusion between the applicant's trade-mark SENSIBLE CHOICE & Design as applied to bakery and muffin mixes for sale to commercial bakeries and the opponent's trade-marks SENSIBLE, SENSIBLE EATING and SENSÉ. However, having concluded that there would be no reasonable likelihood of confusion between these trade-marks, and considering that the material date for assessing this ground does not materially alter the conclusions reached in relation to the surrounding circumstances which are of relevance to the issue of confusion, I find that this ground of opposition is also unsuccessful.

In view of the above, the applicant's trade-mark SENSIBLE CHOICE & Design as applied to its promotional services is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act*. I therefore refuse the applicant's application in relation to "promotional services, namely the provision of in-store displays, posters, point-of-sale materials and other promotional materials relating to products made from applicant's bakery mixes and muffin mixes" and otherwise reject the opponent's opposition to registration of the trade-mark SENSIBLE CHOICE & Design in relation to the applicant's "bakery mixes and muffin mixes for sale to commercial bakeries" pursuant to Section 38(8) of the *Trade-marks Act*. In this regard, I would note the finding of the Federal Court, Trial Division in respect of there being authority to render a split decision in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492.

DATED AT HULL, QUEBEC THIS 19th DAY OF FEBRUARY, 1996.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.