

IN THE MATTER OF AN OPPOSITION by Effem Foods Ltd. to  
application No. 717,448 for the trade-mark FROM OVER 65 YEARS OF  
RESEARCH, A SUPERIOR STANDARD IN PET FOOD NUTRITION  
filed by Ralston Purina Company

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On November 26, 1992, the applicant, Ralston Purina Company, filed an application to register the trade-mark FROM OVER 65 YEARS OF RESEARCH, A SUPERIOR STANDARD IN PET FOOD NUTRITION based on proposed use in Canada in association with “pet food”. The application was amended to include a disclaimer to the words “A SUPERIOR STANDARD IN PET FOOD NUTRITION” and was subsequently advertised for opposition purposes in the Trade-Marks Journal of July 14, 1993.

The opponent, Effem Foods Ltd., filed a statement of opposition on December 10, 1993. The first ground of opposition is that, pursuant to s.38(2)(a), the application does not comply with the requirements of s.30 and s.2 of the *Trade-Marks Act*, R.S.C. 1985 c.T-13 (hereinafter the *Act*) in that the proposed trade-mark does not fall within the definition of “trade-mark”, but is “laudatory promotional language of a kind commonly used in the advertisement of pet foods”. As its second ground of opposition, the opponent maintains that the applied for mark does not comply with the requirements of s.30(a) of the *Act* as it does not contain a statement in ordinary commercial terms of the specific wares in association with which the mark will be used. The opponent alleges as its third ground of opposition that the application does not comply with the requirements of s.30(e) in that the applicant has no intention of using the proposed mark as a trade-mark. As its fourth ground of opposition, the opponent alleges that the application does not comply with the requirements of Section 30(i) in that the applicant could not have been satisfied at the date of the application as to its entitlement to use the proposed mark in association with pet food having regard to the clear descriptiveness or deceptive misdescriptiveness of the mark. The fifth ground of opposition is that the application is not registrable pursuant to s.38(2)(b) and s.12(1)(b) of the *Act* in that it is clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares. The final ground of opposition is that the trade-mark is not distinctive pursuant to s.38(2)(d) and s.2 of the *Act* as it does not distinguish the wares proposed to be used by the applicant from those of others.

The applicant filed and served a counter statement on March 23, 1994, in which it denied the allegations asserted by the opponent in its statement of opposition. As its evidence, the opponent filed the affidavits of Christopher Aide, Associate with the law firm representing the opponent and Robert W. White, Senior Vice President of the Audit Bureau of Circulations. The applicant elected not to file any evidence. Both the opponent and the applicant filed written

arguments and both were represented at an oral hearing.

With respect to the s.30 grounds of opposition, the onus or legal burden is on the applicant to show its compliance with Section 30 of the *Act* (see *Joseph Seagram & Sons v. Seagram Real Estate* (1984), 3 C.P.R. (3d) 325 at 329-330 and the decision in *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) (hereinafter *John Labatt*)). However, to the extent that the opponent relies on allegations of fact in support of its grounds of opposition, there is an evidential burden on the opponent to prove those allegations. To meet the evidential burden upon it in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist (see *John Labatt*, supra, at 298).

The first ground of opposition has not been pleaded in sufficient detail to allow the applicant to reply to it and is thus in contravention of Section 38(3)(a) of the *Act*. The opponent has not indicated which subsection of Section 30 has been contravened. Further, the opponent has not provided any support for its conclusion that the applied for mark is not a trade-mark as defined in Section 2 of the *Act*. Section 2 of the *Act* defines a trade-mark as follows:

“...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...”

The opponent submits that the applicant’s mark is not a trade-mark because it is “laudatory promotional language of a kind commonly used in the advertisement of pet foods”. In my view, however, the fact that a mark may be comprised, in part, of “laudatory promotional language” does not necessarily mean that the mark is unable to be used for the purpose of distinguishing or so as to distinguish the applicant’s wares from those of others. Thus, the first ground of opposition is unsuccessful.

Regarding the second ground of opposition under s.30(a), the test to be applied is whether the applicant has clearly set forth the wares as they are customarily referred to in the trade (see the opposition decisions in *Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int. 'l Ltd.* (1975), 23 C.P.R. (2d) 128 and *Pro Image Sportswear, Inc. v. Pro Image, Inc.* (1992), 42 C.P.R. (3d) 566 at 573). The opponent submits that the term “pet food” is not the term customarily referred to in the trade for pet food for **all** types of pets including birds, fishes and horses. However, the opponent has not submitted evidence to support this submission. The opponent’s

evidence only shows that the term “pet food” is customarily referred to both by the applicant and by others in the trade to describe pet food products specifically created for dogs or for cats. As I do not find that the opponent has met the evidential burden upon it respecting this ground of opposition, this ground of opposition is unsuccessful.

Regarding the third ground of opposition under s.30(e), the opponent did not provide any allegations of fact to support its conclusion that the applicant, at the date of filing the application, had no intention of using the proposed mark as a trade-mark. As the opponent has not met its evidential burden with respect to this ground, I find this ground of opposition is unsuccessful.

As for the fourth ground of opposition under s.30(i), the opponent has not adduced any evidence to show that the applicant could not have been satisfied that it was entitled to use the proposed mark in Canada. Therefore, I have no reason to doubt the applicant’s statement in its application that it was satisfied that it was entitled to use the trade-mark in Canada in association with pet food. Consequently, this ground of opposition is also unsuccessful.

With respect to the opponent’s fifth ground of opposition, Section 12(1)(b) of the *Act* reads as follows:

- 12. (1) Subject to section 13, a trademark is registrable if it is not...
  - (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin....

The material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) is the date of my decision: see the decision in *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992), 41 C.P.R.(3d) 243 (F.C.A.). Further, the issue is to be determined from the point of view of an everyday user of the wares considering the mark in its entirety and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R.(2d) 25 at 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R.(3d) 183 at 186. Finally, the onus or legal burden is on the applicant to show that its proposed mark does not offend the provisions of Section 12(1)(b).

While the legal onus is on the applicant to establish the registrability of the applied for mark, there is an evidential burden on the opponent to adduce sufficient evidence, which, if believed, would support its allegation that the applied for mark is clearly descriptive of the

applicant's wares. I am satisfied that the opponent has met this burden. In addition to filing various dictionary definitions for the words YEARS, RESEARCH, SUPERIOR, STANDARD, PET, FOOD and NUTRITION (see Aide affidavit, paras. 2-3 and Exhibits A-C), the opponent evidenced representative advertising in the pet food field of the applicant, the opponent and third parties (see Aide affidavit, paras. 4-10 and Exhibits D-J). Examples of descriptive phrases appearing in the advertising materials include:

“superior nutrition”  
“complete nutrition”  
“meeting the highest in nutritional standards and quality”  
“exhaustive nutritional research resulted in four unique formulations offering unsurpassed product performance”  
“the result is a dog food of the highest quality, with over 65 years of Purina pet nutrition research in every bag”  
“over 60 years of research at Purina has led us to develop the proper balance of nutrients...”,  
“after 30 years of research with dogs like yours, Purina Dog Chow brand dog food has become one of the most refined dog foods in the world, with continuous formulation enhancements over the past 20 years”,  
“...researchers at Ralston Purina have been able to draw upon over 65 years of research and all the resources of the world's largest facility devoted exclusively to pet care and nutrition research”

Both the Aide and the White affidavit provide circulation figures in Canada for the magazines in which the various advertisements appear.

The opponent submits that the facts in the present case are analogous to the facts in *Quaker Oats Co. of Canada Ltd. v. Ralston Purina Canada Inc.* (1987), 18 C.P.R. (3d) 114 (T.M.O.B.); *Effem Foods Ltd. v. Ralston Purina Canada Inc.* (1996), 74 C.P.R. (3d) 101 (T.M.O.B.); and, in particular, the opposition decision *Quaker Oats Co. of Canada Ltd. v. Ralston Purina Co.* (1989), 28 C.P.R. (3d) 157 (T.M.O.B.) (hereinafter *Quaker Oats v. Purina* (1989)). I agree. In each of these cases, the Board concluded that the applicant's laudatory promotional phrase was clearly descriptive of the character or quality of dog food or pet food. The decision in *Quaker Oats v. Purina* (1989) is of particular relevance because Board Member Martin considered the descriptiveness of a mark very similar to the mark in the present case. In arriving at the conclusion that the mark “FROM A LIFETIME OF RESEARCH, A NEW STANDARD IN PET FOOD NUTRITION” was clearly descriptive of the applicant's pet food wares, Board Member Martin stated the following at page 159:

“ Initially, it should be noted that the applicant has disclaimed the words “a new standard in pet food nutrition” apart from its applied for trade-mark. This is effectively an admission that those words are clearly descriptive of the character or quality of the wares”. The additional words “from a lifetime of research” would seem to do nothing more than clarify or qualify the subsequent descriptive phrase. In other words, they simply serve to indicate how the “new standard” was achieved.

...The applicant submitted that its trade-mark does not clearly point to any particular characteristic

or quality of the applied for wares. However, I consider it likely that an average consumer would immediately react to the applicant's mark as an indication or description that the applicant's pet food is very nutritional. Even if the mark does not specifically point to the particular content of the wares, it is laudatory of the character and quality of the wares with respect to their overall nutritional content.

In assessing the issue arising pursuant to s.12(1)(b) of the Act, it is also useful to consider whether or not the applied for trade-mark comprises words or phrases that other traders in the field would likely wish to describe their products. The opponent's evidence essentially consists of representative advertising in the pet food field by the opponent, the applicant and third parties. Examples of descriptive phrases appearing in the advertising materials include "complete balanced nutrition", "complete and balanced nutrition", "superior nutrition based on complete testing" and "setting the standard for all cat foods". Given that context, it would seem reasonable to conclude that the applicant's proposed mark is comprised of nothing more than similar descriptive phrases that ought to be available for use by all traders in the pet food industry."

The applicant's agent submits that the three above mentioned opposition decisions were incorrectly decided because the Board in each instance only considered the descriptiveness of the disclaimed portion of the applicant's mark and not whether the applicant's mark **in its entirety** was clearly descriptive of the applicant's wares. The applicant's agent further submits that in the present case, the first portion of the applicant's mark (FROM OVER 65 YEARS OF RESEARCH) may be descriptive of the applicant itself but not the applicant's pet food wares. It is the applicant's submission, therefore, that the applied for mark in its entirety does not clearly describe the applicant's pet food wares.

I respectfully disagree with the applicant's submissions regarding this ground of opposition. First, I consider each of the above noted cases to have been correctly decided and right on point with the present case. Second, I find that the applicant's mark as a whole is clearly descriptive of the character or quality of the applicant's pet food wares, especially with respect to their overall nutritional content. As stated by Board Member Martin in *Quaker Oats v. Purina* (1989), *supra*, the fact that the applicant has disclaimed the words "a superior standard in pet food nutrition" apart from its applied for trade-mark is effectively an admission that these words are clearly descriptive of the character or quality of the applicant's wares. Further, although I agree with the applicant that the words "FROM OVER 65 YEARS OF RESEARCH" are not by themselves clearly descriptive of pet food, I find that when used in the context of the applicant's mark as a whole, they clearly describe how the "superior standard" of pet food nutrition was achieved.

In assessing the issue under s.12(1)(b) I have also considered whether or not the applied for trade-mark comprises words or phrases that other traders in the field would likely wish to use to describe their products. From the opponent's evidence, it would seem reasonable to conclude that the applicant's proposed mark is comprised of nothing more than similar descriptive phrases that ought to be available for use by all traders in the pet-food industry. I therefore find that the

applied for mark is a clearly descriptive phrase which any trader operating in the pet food industry in Canada would wish to use. As such, I find that it would be unfair to allow the applicant to claim a monopoly right to such a phrase: see *Nestle Entreprises Ltd. v. Effem Foods Ltd.* (1989), 28 C.P.R. (3d) 151 at 153 (T.M.O.B.) and *Imperial Tobacco Ltd. v. Benson & Hedges (Canada) Inc.* (1983), 75 C.P.R. (2d) 115 at 118 (F.C.T.D.). As I am not satisfied that the applicant has met the legal burden upon it to show that its mark is registrable, this ground of opposition is successful.

As for the opponent's sixth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Further, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. November 28, 1990): see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

Even though the issue of non-distinctiveness is decided as of the filing of the opposition, I consider that my conclusions above are equally applicable as of that earlier date. In view of my finding respecting the fifth ground of opposition, it follows that the applicant's trade-mark FROM OVER 65 YEARS OF RESEARCH, A SUPERIOR STANDARD IN PET FOOD NUTRITION is not distinctive because it is clearly descriptive of the character or quality of the applicant's wares. Consequently, this ground of opposition is also successful.

In view of the reasons stated above, and with the authority delegated to me under s. 63(3) of the Act, I refuse the applicant's application pursuant to s.38(8) of the Act

DATED AT HULL, QUEBEC, THIS 29<sup>th</sup> DAY OF SEPTEMBER 1997.

C. R. Vandenakker  
Hearing Officer  
Trade-Marks Opposition Board