

SECTION 45 PROCEEDINGS
TRADE-MARKS: CLASSIC and CLASSIQUE
REGISTRATIONS NOS.: 336,071 and 336,073

On May 8, 1992, at the request of Messrs. Riches, McKenzie & Herbert, the Registrar forwarded Section 45 notices to the Pillsbury Company, the registered owner of the above-referenced trade-mark registrations.

The trade-marks CLASSIC and CLASSIQUE were registered on January 8, 1988. The wares covered by each registration are: "frozen and canned vegetables".

In response to the notices, the registrant furnished in each case the affidavit of Dan Dubreuil. Each party filed a written submission and was represented at an oral hearing.

Having reviewed the evidence, I am satisfied that there were sales made of the wares during the two-year period preceding the date of the notice. The invoices confirm that sales were made during the relevant period and the packaging and the cardboard carton show the manner the trade-marks CLASSIC and CLASSIQUE were associated with the wares pursuant to Section 4(1) of the Trade-marks Act.

However, the requesting party submits that the words CLASSIC and CLASSIQUE as appearing on the packagings and cardboard cartons submitted in exhibits are not being used as trade-marks in association with the registered wares; that the subject trade-marks are being used in a descriptive or generic sense; in the alternative, it submits that the use shown is not use of the trade-marks CLASSIC and CLASSIQUE per se, and therefore not use of the trade-marks as registered. It refers to the legend appearing in the upper right hand corner of the package of Exhibit "A" and submits that while the legend indicates that an asterisk will be used to identify registered trade-marks, an asterisk does not appear beside the words CLASSIC and CLASSIQUE.

Concerning the appearance of the trade-marks on the lower central portion of the packagings and on the cardboard cartons, I cannot agree that the word CLASSIC in the phrases "BROCCOLI CARROT CLASSIC" and "PEA CAULIFLOWER CARROT CLASSIC" and the word CLASSIQUE in the phrases "BROCOLI ET CAROTTES CLASSIQUE" and "POIS CHOUX-FLEURS ET CAROTTES CLASSIQUE" are merely used as descriptive and generic terms rather than as trade-marks.

It is true that an asterisk appears on the packagings to identify the registered trade-marks GREEN GIANT and GEANT VERT and other trade-marks, and that such treatment was not given to CLASSIC and CLASSIQUE appearing on such packagings; however, as pointed out by the registrant, the use of an asterisk or any other indicia to identify a trade-mark on a packaging is not necessary in law. The fact that a mark is so identified or is not so identified does not affect the use of the mark. However, I do agree that where such a notation appears it is a factor that favours the owner.

The requesting party has submitted that the perception of the public would be that the words CLASSIC and CLASSIQUE are part of the description of the products in that they would identify the combinations of vegetables as combinations which have stood or have survived the test of time. However, the words "CLASSIC" and "CLASSIQUE" have no clear meaning in association with vegetables. Consequently, I am not satisfied that the words CLASSIC and CLASSIQUE would be perceived as such and in the absence of evidence to that effect, I cannot agree with the conclusion of the requesting party.

Concerning the requesting party's argument that to be used as a trade-mark a word must be used as an adjective, there is no such requirement in the Trade-marks Act. Furthermore, concerning its argument that generally a trade-mark appears before the name of the product, there is no evidence to that effect. Furthermore, even if such were the case, it would not be conclusive.

As to whether the use as shown is use of the trade-marks "CLASSIC" and "CLASSIQUE" per se, in considering the issue I had regard to the opposition decision Nightingale Interloc Ltd. v. Prodesign Ltd., 2 C.P.R.(3d) 535 wherein at page 538 Hearing Officer Troicuk has viewed the jurisprudence on the matter as establishing two basic principles:

Principle 1

Use of a mark in combination with additional material constitutes use of the mark per se as a trade mark if the public, as a matter of first impression, would perceive the mark per se as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing (see e.g., Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. et al. (1971), 1 C.P.R. (2d) 155 at p.163, [1971] F.C. 106), or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name: see e.g., Carling O'Keefe Ltd. v. Molson Cos. Ltd. (1982), 70 C.P.R. (2d) 279 at pp. 280-1, applying Bulova Acutron Trade Mark, [1969] R.P.C. 102 at pp.109-10.

Principle 2

A particular trade mark will be considered as being used if the trade mark actually used is not substantially different and the deviations are not such as to deceive or injure the public in any way.... In general, however, this principle would appear applicable only where the variations are very minor.

The present situation is governed by the first principle.

The Federal Court of Appeal decision Registrar of Trade-marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull, S.A. 4 C.P.R.(3d) 523, illustrates the application of the first principle. In considering whether the use of the composite mark CII HONEYWELL BULL constituted use of the registered trade-mark BULL, the Court stated as follows (at p. 525):

"That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used".

The Court concluded that use of the composite mark was not use of the registered mark BULL per se.

Here, as noted by the requesting party, the words CLASSIC and CLASSIQUE appear on the packaging and cardboard in the same size and style of lettering as the words pea, cauliflower, carrot, etc. However, the terms "pea, cauliflower, carrot" are clearly descriptive of the content of the product being sold. Thus, in the circumstances the public would perceive the wording "Pea Cauliflower Carrot Classic" and other similar wording as referring to the registrant's CLASSIC or CLASSIQUE brand of vegetables.

Furthermore, I am of the view that the reference to "Pea Cauliflower Carrot Classic" in the recipe shown on the registrant's packaging, lends some support to my conclusion as it tends to emphasize or draw to the consumer's attention that it is the registrant's "CLASSIC" or "CLASSIQUE" brand of mixed vegetables that is required for the recipe and not just any "pea cauliflower carrot" combination of vegetables.

The requesting party has relied on various Section 45 and opposition decisions wherein the principles enunciated in the Nightingale case and in the CII Honeywell Bull case were followed. However, all of the cases relied upon (except one) can be distinguished on the basis that in those cases the additional matter did not consist of "descriptive matter" as in the present case. Concerning the Opposition decision Canadian Olympics Association v. Driver's Advocate Paralegal Services Inc., 39 C.P.R.(3d) 284 there were factors in that case that are not present here.

Accordingly, in view of the above and in view of the evidence furnished, I conclude that use of the trade-marks CLASSIC and CLASSIQUE has been shown is association with the registered wares and within the relevant period.

Consequently, registrations Nos. 336,071 and 336,073 will be maintained in compliance

with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 7th DAY OF February, 1995.

D. Savard
Senior Hearing Officer
Section 45 Division