

**IN THE MATTER OF AN OPPOSITION by
Ralston Purina Canada Inc. and Ralston and
Purina Company to application No. 807,417
for the trade-mark MEDI CAL FELINE
REDUCING FORMULA filed in the name of
H.J. Heinz Company of Canada Ltd., and
now standing in the name of DML Foods
Canada Corp**

On March 19, 1996, Veterinary Medical Diets Inc. filed an application («the Application») to register the trade-mark MEDI CAL FELINE REDUCING FORMULA (the «Trade-mark») for pet food. The application was based on proposed use in association with dietary animal food.

On October 17, 1996 H.J. Heinz Company of Canada (the «Applicant») filed a request to amend the Register to identify it as the owner of, inter alia, the Application. On January 21, 1997 the Registrar issued a notice of confirmation of change in title by which it confirmed that the Applicant was entered as the owner of the Application.

On February 7, 1997, in response to the Examiner's Report dated October 10, 1996, the Applicant filed an amended application (« the Amended Application ») in which it disclaimed the right to the exclusive use of the words «FELINE» and «FORMULA» apart from the trade-mark and amended the description of the wares to «dietary pet food».. The Amended Application was advertised for opposition purposes in the July 2, 1997 issue of the *Trade-Marks Journal*.

The joint opponents, Ralston Purina Canada Inc. and Ralston Purina Company,(the «Opponents») filed a Statement of Opposition on August 28, 1997 and an Amended Statement of Opposition dated July 7, 1999 after permission to amend its Statement of Opposition was granted on September 22, 1999.The Applicant filed and served on January 12, 1998 a Counter Statement and on June 9, 2000, an Amended Counter Statement.

The statement of opposition lists five grounds of opposition that can be summarized as follow:

- a) The Application did not conform with the requirements of Sections 38(2)(a) and 30(a) of the Trade-Marks Act, R.S.C. 1985 c. T-13 (the «Act»),in that «dietary pet food» is not a statement in ordinary commercial terms of the specific wares in association with which the Trade-mark is proposed to be used.
- b) The Applicant's Trade-mark is not registrable because it contravenes Subsection 12(1)(b) of the *Act* in that the Trade-mark, whether depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of dietary cat food or the conditions of the production of a dietary cat food which employs, is produced from or contains a reducing formula and which dietary cat food either contains medicine in its formulation or does not contain medication in its formulation
- c) The Trade-mark does not distinguish the Applicant's pet food from the medical pet foods, medical diet pet foods, veterinary medical pet foods or veterinary medical diet pet foods of others including those of the Opponents, contrary to Section 2 of the *Act*.
- d) The Trade-mark is not registrable because it is the name in any language of any dietary feline food having a medical reducing formula contrary to Subsection 12(1)(c) of the *Act*
- e) The Applicant by itself or through a licensee does not intend to use the Trade-mark in Canada in the manner as applied for, the whole contrary to Subsection 30 (e) of the *Act*.

The Opponents filed as their evidence the affidavits of Marvin Zwikler., Student-at-Law, sworn May 5, 1998, Debbie L. Valois, an employee of the Opponents' agents, sworn June 10, 1998 and Michael Roach, Student-at-law, sworn June 9, 1998. As its evidence, the Applicant filed the affidavits of Peter M. Grieve, the Vice-President of the pet division of the Applicant, dated February 11, 1999. None of these affiants were cross-examined. No reply evidence was filed.

Both the Applicant and the Opponents filed written arguments and no oral hearing took place.

The Opponents withdrew in their written argument their first ground of opposition and as such shall not be dealt with in this decision.

Exhibit AA to the affidavit of Marvin Zwikler consists of his prior affidavit sworn on May 28, 1997, and filed in support of an opposition by the Opponents to Applicant's application No. 796,083 for the registration of the trade mark MEDI CAL and maple leaf design in association with pet food used in Canada since at least as early as November, 1990. Annexed to such prior affidavit were exhibits A to V. The grounds of opposition raised in application 796,083 were the same as the first three grounds of opposition described above. The Opposition Board, in such opposition proceedings, rejected the Opponents' opposition [see *Ralston Purina Canada Inc. v H.J. Heinz of Canada*, (2000), 6 C.P.R. (4th) 394]. I shall therefore refer to the analysis made by the Hearing Officer of the evidence filed by the Opponents in such opposition proceedings and determine if the conclusions reached are equally applicable to the present file. If that should be the case, I would therefore have to dismiss the Opponents' second and third grounds of opposition.

The following are the pertinent extracts of such decision:

«The opponents plead that the applicant's mark is not registrable in that the said mark, whether depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of pet food in association with which it is allegedly used. Without restricting the generality of the foregoing, the opponents state that the applicant's pet food is either clearly descriptive or deceptively misdescriptive of a medical pet food, a medical diet pet food, a veterinary medical pet food or a veterinary medical diet pet food.

The material date for considering a ground of opposition based on Paragraph 12(1)(b) is the date of decision [*Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (FCA)]. The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the average

purchaser of those wares. 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*, 40 C.P.R. (2d) 25, at pp. 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at p. 186].

While there is a legal burden upon the applicant to show that its mark is registrable, the opponents must first adduce sufficient evidence to support their claim that the mark is clearly descriptive.

Mr. Zwikler, an articling student with the law firm acting as agent for the opponents, has introduced multiple dictionary definitions of the words “medical”, “medicine” and “medicinal”. He proposes, and I agree, that a common definition of the word “medical” is: 1) of or pertaining to the science or practice of medicine in general; 2) having curative properties; 3) of or pertaining to conditions requiring medical (as opposed to surgical or obstetrics etc.) treatment or diagnosis. The practice of medicine can itself be defined as “the art or science of the preservation and restoration of health and of treating disease”. I do not think that there is much controversy over the meaning of the word “medical”. Moreover, “medical” is a common word that would be known to the average Canadian, including the average pet food purchaser. However, that is not the exact issue here. Rather, there are two issues. First, when written or sounded, is the applicant’s mark immediately recognized by the average purchaser (or dealer) of pet food as the word “medical”? Second, if it is, is the word “medical” clearly descriptive of the character or quality of pet food.

As shown above, the mark that is the subject of this opposition consists of the letters MEDI, followed by a maple leaf design which is in turn followed by the letters CAL. I confess that when I first saw the applicant’s mark, I did not react to it as being the word “medical”. Rather, I read it as being two groups of letters, with the latter being sounded as if it was the beginning of the word “calorie”, rather than as if it were the ending of the word “medical”. I appreciate however that I am not the “average purchaser of pet food” and I must resort to the evidence at hand to determine what the immediate impression on the average purchaser of pet food would be.

The opponents do not provide us with any evidence concerning how the average Canadian would respond to the applicant’s mark. The opponents do provide us with the dictionary definitions referred to above, as well as copies of certain pages of guides and manuals on veterinary care, and pamphlets promoting the applicant’s wares. The applicant has argued that there is no evidence that the veterinary manuals and guides circulate

in Canada, but I do not consider that to be significant. The point is that a pet's diet may be altered in an effort to maintain health or to attempt to manage a disease. This is not surprising given that people often alter their diets for similar reasons. Be that as it may, this does not mean that the average Canadian purchaser of pet food understands the applicant's mark to be the word "medical".

The opponents' affiant takes the position that the applicant presents its product formulas in a manner similar to that used by pharmaceutical companies. Such a comparison, whether valid or not, does not persuade me to believe that the average Canadian pet food buyer, upon seeing the applicant's mark, reacts to it as the word "medical".

The opponents have introduced copies of the applicant's product brochures, pointing out that the products are promoted as utilizing the most up-to-date nutritional information, ensuring superior digestibility and acceptability, and providing optimum nutrition for cats and dogs that is essential for their health and well-being. The brochures state:

"We know that nutrition plays a vital role in both the daily health maintenance and in the treatment of a wide variety of ailments that may affect your pet. We are dedicated to providing you with the best possible foods to help you manage your pet's nutritional needs."

Clearly the applicant's products are promoted as playing a role which, according to the definitions, could be described as a medical role. Therefore, if the mark is perceived by the relevant public to be the word "medical" when written or sounded, then the mark is arguably descriptive of a character of the wares. Of course whether it is clearly descriptive is another question.

However, the opponents' evidence does not address the issue of what the average Canadian pet food buyer considers the applicant's mark to be. The applicant does provide some evidence on this point, albeit not very strong evidence. In particular, Mr. Grieve, the Vice-President of the Martin Pet Foods Division of the applicant, attests that the applicant's trade-mark is pronounced with the emphasis on "DI" and "CAL" and has never been pronounced by his company as "medical". He goes on to say, "To the best of my knowledge, after consultation with my staff, I am not aware that any customer has pronounced our trademark as 'medical'." (see paragraph 10, Grieve affidavit)

The opponents have raised hearsay objections to Mr. Grieve's statements concerning the pronunciation by customers of the applied-for mark. Certainly I would have given the statements more weight had they been introduced by someone who deals directly with pet food purchasers or by survey evidence. However, I am not prepared to disregard Mr.

Grieve's statements concerning pronunciation altogether as they do stand uncontradicted, the opponents having chosen to neither cross-examine him nor to introduce either survey evidence or evidence from someone in the pet food industry.

I do not believe that the opponents have met their evidential burden with respect to the issue of descriptiveness. If they had, I would find that the applicant has met the onus on it to show that its mark is registrable because the applicant has refuted the opponents' argument that its mark would be perceived as being the word "medical".

For the foregoing reasons, I dismiss the Paragraph 12(1)(b) ground of opposition.»

The affidavit of Mr. Grieve filed in these proceedings does contain the same allegations with respect to the pronunciation of the trade-mark MEDI CAL.

The Trade-mark doesn't have the maple leaf design between the words «MEDI» and «CAL» as in the mark covered by application 796083 but the block letters format of the Trade-mark contains a space between those words. As can be seen from the above extract, the Hearing Officer didn't consider the maple leaf design as an essential element to conclude that the trade-mark MEDI CAL and maple leaf design was not descriptive of the character of the wares. It should be noted that the description of the wares in the Amended Application is different than the wares covered by application 796083. The fact that the wares in the Amended Application are described, as "dietary animal food" as opposed to "pet food» in application 796083 does not, in my opinion, constitute a distinguishing element that would lead me to conclude differently, on the issue of descriptiveness, from the Hearing Officer' decision herein above described

There are however additional facts that must be considered. The Trade-mark contains the additional words «FELINE», «REDUCING» and «FORMULA». Moreover the Amended Application contains a disclaimer for the exclusive use of the words FELINE and FORMULA apart from the Trade-mark. The additional words do not render the Trade-mark, when viewed in its totality, clearly descriptive or misdescriptive of the wares covered by the Amended Application. For these reasons, I dismiss the second ground of opposition raised by the Opponents in these opposition proceedings.

I shall now turn to the third ground of opposition. The material date with respect to the non-distinctiveness ground of opposition is the date of filing of the opposition, namely August 28, 1997 [*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) 413 at 424 (F.C.A.)]. The legal onus lies on the Applicant to show that the Trade-mark is adapted to distinguish or actually distinguishes its wares from the wares of others throughout Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985)*, 4 C.P.R. (3d) 272 (TMOB)]. However, there is an initial evidential burden on the Opponents to prove the allegations of fact supporting this ground of opposition.

The following is a pertinent extract of the Board's decision in *Ralston Purina* cited above on the issue of distinctiveness:

«The opponents have submitted that the applicant's trade-mark does not distinguish the applicant's pet food from the medical pet foods, medical diet pet foods, veterinary medical pet foods or veterinary medical diet pet foods of others including those of the opponents. There is no evidence of any other party, including the opponents, selling "medical pet foods, medical diet pet foods, veterinary medical pet foods or veterinary medical diet pet foods", let alone any evidence that either vendors or purchasers refer to pet food by such terminology. Prior to September 18, 1996, the applicant's sales of MEDICAL & Design pet food exceeded \$10 million, while its associated promotional expenses exceeded \$1 million (paragraphs 24 and 25, Grieve affidavit). I am satisfied that as of the material date the applicant's trade-mark did distinguish its pet food from any type of pet food of others. I therefore dismiss the ground of opposition based on non-distinctiveness.»

The Opponents didn't file any evidence to support their allegations that the Applicant's Trade-mark is not adapted to distinguish the Applicant's dietary cat food from dietary cat food of others, including theirs if any, which may follow a «medical feline reducing formula».

Moreover, Mr. Grieve, in his affidavit filed with respect to the Amended Application as the Applicant's evidence, does mention that the Applicant and its predecessor in title has used the Trade-mark since July, 1996. In paragraph 26 of his affidavit Mr. Grieve states that Applicant's sales of pet food in association with the Trade-mark since July 1996 have been in excess of One Million dollars (\$1,000,000) and has spent in excess of \$100,000 in advertising and promotion

for such product (paragraph 26 of his affidavit). Mr Grieve also states in his affidavit that to the best of his knowledge after consultation with his staff, he is not aware of any other pet food called «feline reducing formula». The Opponents have not contradicted this evidence

In view of the absence of evidence filed by the Opponents and the existence of some evidence filed by the Applicant supporting the fact that the Trade-mark is adapted to distinguish the Applicant's dietary cat food from dietary cat food of others, which may follow a medical feline reducing formula, I also dismiss Opponents' third ground of opposition.

The fourth ground of opposition is based on Subsection 12(1)(c) of the Act in that the Trade-mark is not registrable because it is the name in any language of any dietary feline food having a medical reducing formula. There is obviously an overlapping with the previous grounds of opposition based on non-distinctiveness and descriptiveness of the Trade-mark. The Opponents failed to file any evidence to support their contention that the Trade-mark is the name in any language of « any dietary feline food having a medical reducing formula». Moreover the prohibition contained in Section 12(1) (c) of the Act is narrower in scope than those contained in Section 12(1)(b) [see *3HO Foundation v. Maharishi Int'l T.M. Corp.* (1983), 74 C.P.R. (2d) 186]. Having already ruled that the Opponents failed to discharge their initial burden of proof with respect to the descriptiveness of the Trade-mark and in view of the absence of evidence to support the present ground of opposition, I also dismiss the fourth ground of opposition.

Finally the Opponents allege that the Applicant by itself or through a licensee does not intend to use the Trade-mark in Canada in the manner as applied for. To support this ground of opposition the Opponents did refer to paragraphs 7 and 10 of Mr. Grieve's affidavit, which read as follow:

«7.The MEDI-CAL trade-mark has never been used or displayed by Heinz as the word «medical», nor was it so used or displayed by VMD. The words MEDI and CAL have always been separated by an hyphen, other symbol, or by a red maple leaf.

10. The MEDI-CAL & Design mark («MEDI-CAL Logo») has been used continuously in Canada by VDM and subsequently by Heinz since it was adopted by VMD in 1990. The words MEDI and CAL are always separated by the red maple leaf. The MEDI-CAL Logo appears on the packaging of all formulas and brands in the MEDI_CAL family, including on the MEDI CAL FELINE REDUCING FORMULA brand. It also appears on the MEDI-TREATS brand of pet food sold by Heinz. I discuss the MEDI-TREATS trade-mark later in my affidavit.»

These allegations refer to the MEDI CAL and maple leaf design trade-mark and not the Trade-mark.

The Opponents further state that Exhibits H and I to Mr. Grieve's affidavit illustrate the use by the Applicant of the Trade-mark. First there is an eleven point maple leaf design appearing between the words MEDI and CAL and the symbol ® appears after these words. Any follow on words associated with it would clearly describe a characteristic of the product. As such the Applicant would not using the Trade-mark in the manner as actually applied for.

In *Bacardi & Co Ltd v. Jack Spratt Mfg. Inc. (1984)1 C.P.R. (3d) 122* the Board faced a similar argument from the opponent with respect to the use by the Applicant of BIANCARDI as opposed to the applied trade-mark BIAN-CARDI. The Board stated:

«...the applicant asserted that at the time of filing its trade mark application, the applicant intended to use the trade mark BIAN-CARDI and denied the allegation that it is in fact using the trade mark BIANCARDI but that, even [page125] if the applicant is using the word "Biancardi" in association with wearing apparel, then applicant is in fact using a trade mark which is substantially the same as the trade mark BIAN-CARDI and, in fact, constitutes use of the trade mark BIAN-CARDI within the scope of s. 4 of the Trade Marks Act....

The material time for assessing the applicant's compliance with s. 29(e) of the Act is as of the filing date of the applicant's appli- [page126] cation although this does not preclude consideration of evidence arising subsequent to the filing date of the applicant's application as adduced by the opponent. As for the burden of proof respecting this ground of opposition and having regard to the decision in *Playboy Enterprises, Inc. v. Germain (1979), 43 C.P.R. (2d) 271* at pp. 275-6, I consider that the

initial burden is upon the opponent to adduce sufficient evidence as to the applicant's intention not to use the trade mark sought to be registered as to raise doubts as to the applicant's intention and thereby shift the burden to the applicant to support its claim to its intention to use the trade mark sought to be registered. As such, the initial burden is upon the opponent to pursue all reasonably available channels of investigation in an attempt to determine whether the applicant has complied with the provisions of s. 29(e) of the Trade Marks Act. However, and bearing in mind that it is difficult to prove a negative and certainly more so where the applicant's application is based upon an intention to use its trade mark in Canada, I consider the initial burden upon the opponent in such a case to be far less severe than in the situation where an applicant's application is based upon use of its trade mark in this country under s. 29(b) of the Act.

... While I am of the opinion that a change in the applicant's trade mark from BIANCARDI to BIAN-CARDI alters the distinctive character of the trade mark in changing it from a surname to one which no longer constitutes a surname and thus constitutes an alteration to the distinctive character of the trade mark, I consider that use of the trade mark BIANCARDI constitutes use of the trade mark BIAN-CARDI within the scope of s. 4(1) of the Trade Marks Act.»

I shall therefore consider the Applicant's evidence even if Mr. Grieve's affidavit is subsequent to the filing date of the Application. I do not consider the addition of the maple leaf design between the words MEDI and CAL and the symbol ® after the word CAL as altering the distinctive character of the Trade-mark. I consider the use of MEDI CAL® FELINE REDUCING FORMULA and maple leaf design as use of the trade-mark MEDI CAL FELINE REDUCING FORMULA within the scope of Section 4 of the Act. As such the fifth ground of opposition is also dismissed.

Accordingly, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I dismiss the Opponents' opposition pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 8 DAY OF AUGUST 2003.

Jean Carrière
Hearing Officer
Trade-marks Opposition Board