

**IN THE MATTER OF AN OPPOSITION by Gaines Pet Foods Corp. to application No. 673,164 for the trade-mark PRIME CUTS filed by Tri-V Pet Foods Ltd.**

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On January 2, 1991, the applicant, Tri-V Pet Foods Ltd., filed an application to register the trade-mark PRIME CUTS based on proposed use in association with “dog food and cat food”. The applicant disclaimed the right to the exclusive use of the word PRIME apart from its trade-mark.

The application was advertised for opposition purposes in the *Trade-marks Journal* of December 30, 1992 and the opponent, Gaines Pet Foods Corp., filed a statement of opposition on March 1, 1993. During the opposition, the applicant amended its statement of wares to cover “canned dog food and canned cat food”.

The first ground of opposition is based on Section 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied that it was entitled to use the trade-mark for the reasons set out in the remainder of the statement of opposition. The opponent next alleged that the trade-mark PRIME CUTS is not registrable in view of the provisions of Section 12(1)(b) of the *Trade-marks Act* since the trade-mark, when depicted, written or sounded, was either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares in association with which it is proposed to be used. The third ground is that the trade-mark PRIME CUTS is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act* as it is confusing with the opponent’s registered trade-marks: GAINES PRIME, registration No. 165,241, covering “Dog food”; and PRIMA, registration No. 391,262, for “Pet food, namely dog food and cat food”. As its fourth ground of opposition, the opponent alleged that the applicant is not the person entitled to the trade-mark PRIME CUTS because it was, at the time the application was filed, confusing with the trade-marks GAINES PRIME and PRIMA, previously used by the opponent. Finally, the opposition alleged that the trade-mark PRIME CUTS is not distinctive because it is confusing with the opponent’s trade-marks referred to above.

The opponent submitted as its evidence the affidavit of Margaret Lobo, a legal secretary with the agents for the opponent, who has attached to her affidavit dictionary references for the words

“prime” and “cut”, as well as a brochure from the Beef Information Centre discussing the various grades of beef. The applicant’s evidence consists of the affidavits of Melissa Reisher, a trade-mark searcher, and Patricia Dixon, a secretary for the trade-mark agent’s for the applicant. The Reisher affidavit introduces into evidence copies of the following: the applicant’s registration for the trade-mark LEAN CUTS covering for dog and cat food; the opponent’s registration for the trade-mark GAINES PRIME; and two third party registrations for related wares containing the word PRIME. In her affidavit, Patricia Dixon states that she has owned pets and bought dog and cat food for 25 years and, during that time, she has purchased many different brands of pet food for her pets. According to Ms. Dixon, the ingredients in pet food are quite different from food for human consumption and she would never assume that meat of a quality fit for human consumption would ever be found in pet food. She also states that pet food and meat for human consumption are sold in different areas of the supermarket.

With regard to the first ground of opposition, the onus or legal burden is on the applicant to show that the present application complies with Section 30 of the *Trade-marks Act* [see *Joseph Seagram & Sons v. Seagram Real Estate*, 3 C.P.R. (3d) 325, at pp. 329-330]. However, the opponent has an initial evidentiary burden to submit sufficient evidence from which it could reasonably be concluded that the facts exist to support that ground. While the opponent’s evidence of dictionary listings for the word “prime” and “cut” and a brochure about beef is relevant to the Section 12(1)(b) ground, it is of no relevance to the assertion in the present application that the applicant is satisfied that it is entitled to “use” the trade-mark PRIME CUTS in Canada. Even if the applicant’s trade-mark PRIME CUTS were clearly descriptive of its wares, it would not be precluded from using the trade-mark in Canada. Further, the opponent’s evidence relating to its registrations for the trade-mark GAINES PRIME and PRIMA do not satisfy the opponent’s evidential burden as the applicant could have been satisfied that it is entitled to use the trade-mark PRIME CUTS in Canada. Even had the applicant been aware of the opponent’s trade-marks prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant is satisfied that it is entitled to use the trade-mark PRIME CUT in Canada on the basis *inter alia* that its mark is not confusing with the opponent’s trade-marks [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15

C.P.R. (2d) 152, at pg. 155]. Thus, even if the trade-marks at issue are found to be confusing during the course of this opposition proceedings, it does not necessarily establish that the applicant could not reasonably have believed that they were not confusing at the time of filing the application. As a result, I find that the opponent has not met its burden of proof and have therefore dismissed the Section 30(i) ground of opposition.

The second ground of opposition is based on Section 12(1)(b) of the *Trade-marks Act*, the opponent alleging that the trade-mark PRIME CUTS is, when depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the applicant's wares. The relevant date for considering this ground is the date of my decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243]. While the onus is on the applicant to prove that its mark is registrable, the opponent has an initial evidential burden to adduce sufficient evidence to support the truth of the allegation. In considering this ground of opposition, it is necessary to approach it from the point of view of the average consumer or user of the services. Also, in determining whether the mark PRIME CUTS is clearly descriptive as applied to "canned dog food and canned cat food", the trade-mark must not be dissected into its component elements but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade-marks*, 40 C.P.R. (2d) 25, at pp. 27 - 28; and *Atlantic Promotions Inc. v. Registrar of Trade-marks*, 2 C.P.R. (3d) 183, at p.186].

In this case, the applicant has disclaimed the right to the exclusive use of the word "PRIME" apart from its trade-mark so the applicant has effectively acknowledged that the word is, if not clearly descriptive of canned dog food and canned cat food, at least not distinctive in relation to such wares. The opponent's evidence supports this by showing various dictionary listings for "prime" indicating that some of its many meanings are "of the highest grade" and "choice". The dictionary references to "cut" show that it can mean "a slice of food" and "a piece (esp. of meat or cloth) cut off". Despite the fact that the opponent has not directly lead evidence showing a combined meaning for the words "prime" and "cuts", its evidence does indicate that the words are sometimes used in the same context, such that the average consumer might consider the words as suggesting "pieces

of the highest grade of meat”. Therefore, I find that the opponent has met its initial evidential burden of adducing some evidence to support the allegations made in respect of this ground.

In view of the above, the applicant must meet the legal burden upon it of showing that its trade-mark PRIME CUTS is registrable. In the present case, and even if a consumer were to conclude that the words PRIME CUTS suggested “pieces of highest quality meat”, I do not think that the average purchaser would, as a consequence, assume that the canned pet food contained such a product. Rather, and as pointed out by Patricia Dixon in her affidavit, canned pet food costs considerably less than quality meat for human consumption, such that the average purchaser would not believe that he or she was buying high quality meat when buying PRIME CUTS canned dog food or cat food. As a result, I do not find the trade-mark to be clearly descriptive when applied to the applicant’s wares. Moreover, I do not believe that the average purchaser of the applicant’s wares could be misled by the trade-mark PRIME CUTS into thinking that the applicant’s wares contain meat of the highest quality. Thus, the trade-mark PRIME CUTS is not deceptively misdescriptive of dog food or cat food. Rather, the average purchaser of the applicant’s wares would recognize the trade-mark PRIME CUTS as being a fanciful name for pet food and, at most, suggestive of the fact that the applicant’s wares are high quality pet food. I therefore find that the applicant has discharged the legal burden upon it in respect of the second ground which I have rejected.

The opponent also claims that the mark is not registrable in view of Section 12(1)(d) of the *Trade-marks Act* as it is confusingly similar to its registered trade-marks GAINES PRIME and PRIMA, referred to above. 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 material date for considering this ground which is the date of my decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al*, 37 C.P.R. (3d) 413 (F.C.A.)]. In assessing whether there would be a reasonable likelihood of confusion according to Section 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances including those set out in Section 6(5) of the *Trade-marks Act*. Also, in applying the test for confusion, one must bear in mind that it is a matter of first impression and imperfect recollection.

With regard to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark PRIME CUTS bears some minor degree of inherent distinctiveness even though it is suggestive of the fact that the applicant's wares are of high quality. Likewise, the opponent's trade-mark GAINES PRIME possesses some minor degree of inherent distinctiveness when considered in its entirety as the element GAINES possesses a surname significant and the word PRIME, as noted above, adds little inherent distinctiveness to the opponent's trade-mark and has been disclaimed by it in its registration. The opponent's trade-mark PRIMA possesses more inherent distinctiveness than either of the other trade-marks at issue although the word has somewhat of a laudatory significance in connection with pet food in suggesting that the wares are the best.

The extent to which the trade-marks at issue have become known and the length of use of the trade-marks favour neither party in this opposition as the applicant's trade-mark is based on proposed use and the only evidence that the applicant has commenced use of its trade-mark is a label from the applicant's canned dog food purchased by Ms. Dixon in a SAFEWAY store. Moreover, the opponent filed no evidence of use of either of its trade-marks.

The wares of the parties are overlapping and I would assume that the channels of trade of the parties could or would overlap.

With respect to the degree of resemblance between the trade-marks at issue in appearance or sound or in the ideas suggested by them, the trade-marks PRIME CUTS and GAINES PRIME bear relatively little similarity when considered in their entireties either in appearance or in sounding. Further, the trade-marks does not appear to convey similar ideas. Indeed, the only similarity between the trade-marks is the word "PRIME" which is not distinctive in relation to pet food and has been disclaimed by both parties apart from their respective trade-marks. As well, the word PRIME occupies a different position in each mark and the words GAINES and CUTS bear no similarity whatsoever. Furthermore, being the initial word in the opponent's trade-mark, it is likely that the average purchaser of the opponent's pet food would focus more on it than on the word PRIME.

In view of the above, and bearing in mind the lack of any measurable resemblance between

the trade-marks PRIME CUTS and GAINES PRIME, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion between these trade-marks.

With respect to the trade-marks PRIME CUTS and PRIMA, these marks bear little, if any, similarity in appearance or in sounding when considered in their entireties as a matter of immediate impression. Each trade-mark possesses somewhat of a laudatory connotation in that the trade-mark PRIME CUTS suggests quality pieces of meat and PRIMA suggests something which is the best. However, the specific ideas suggested by the two marks differ. Having regard to the differences in the resemblance of these trade-marks, I find them not to be confusingly similar when considered in their entireties. In view of the above, I have rejected the Section 12(1)(d) grounds of opposition.

With regard to the fourth ground of opposition based on non-compliance with Section 16(3)(a) of the *Trade-marks Act*, there is a burden on the opponent in view of the provisions of Sections 16(5) and 17(1) of the Act to establish its use of its trade-marks GAINES PRIME and PRIMA prior to January 2, 1991, the applicant's filing date, as well as to show that it had not abandoned its trade-marks at the date of advertisement of the present application [December 30, 1992]. As no evidence has been presented by the opponent relating to its use of either of its trade-marks in Canada, the opponent has failed to meet the initial burden upon it in respect of the Section 16(3)(a) ground. Similarly, the opponent has not met the initial evidentiary burden upon it in respect of the non-distinctiveness ground given the fact that no evidence of use or making known of either of the marks has been adduced by the opponent. Therefore, this ground must also fail.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject this opposition pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC this 4th day of December, 1996.

G.W. Partington  
Chairman  
Trade-marks Opposition Board