

IN THE MATTER OF AN OPPOSITION  
by London Drugs Limited  
to application No. 707, 484  
for the trade-mark **CHEF'S EDGE**  
filed by Alan S. Brooks

On June 19, 1992, Alan S. Brooks filed an application to register the trade-mark **CHEF'S EDGE**, for the wares "coffee; cooking and kitchen utensils, namely knives, pots and pans" and the services "operation of a retail outlet for the sale of coffee and cooking and kitchen utensils". The trade-mark was filed based upon use in Canada since August 1990. The mark was advertised for the purposes of opposition on March 10, 1993.

The opponent, London Drugs Limited, filed a statement of opposition on August 5, 1993, which was forwarded to the applicant on August 31, 1993. The first ground of opposition is not pleaded specifically but would appear to be two separate grounds of opposition. The first ground is under Section 30(b) of the Trade-marks Act R.S.C. 1985 c. T-13 (hereinafter, the Act) namely that the mark has not been used in Canada in association with the wares set forth in the application since the date set forth in the application, namely August 1990. The second ground of opposition would appear to be that the mark does not comply with the provisions of Section 30(i) of the Act, the opponent alleging that the applicant could not have been satisfied that it was entitled to use its mark in Canada while being aware of the previous registration in Canada by the opponent of its trade-mark **CHEF'S PRIDE** TMA 408,801. The third ground of opposition is that the trade-mark is not registrable pursuant to the provisions of Section 12(1)(d) of the Act as it is confusing with the opponent's trade-mark, namely **CHEF'S PRIDE** TMA 408,801. The fourth ground of opposition is that the mark is not distinctive of the wares of the applicant, in that it does not actually distinguish nor is it adapted to distinguish the wares and services of the applicant from the wares of the opponent, in that the applicant's trade-mark is confusing with the opponent's trade-mark. The applicant filed and served a counter statement on December 29, 1993 generally denying the opponent's allegations.

The opponent filed as evidence the affidavit of Leonard E. Marks, Vice-President, General Merchandising and Pharmacy of London Drugs Limited, together with a certified copy of the Canadian trade-mark registration for **CHEF'S PRIDE** TMA 408,801. The applicant filed as evidence the affidavit of Alan S. Brooks, the applicant in this matter. Both parties filed written arguments, but only the opponent was represented, by way of telephone, at the oral hearing.

With respect to the first ground of opposition, namely non-compliance with Section 30(b) of the Act, while the legal burden is upon the applicant to show that its application complies with Section 30 of the Act, there is an initial burden on the opponent in respect of its Section 30 grounds. In the decision in Joseph E. Seagram & Sons Ltd. v. Seagram

**Real Estate Ltd.** (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) Hearing Officer Troicuk stated (at p. 329)

To the extent, however, that the opponents rely on allegations of fact in support of their grounds of opposition pursuant to s. 29(a) and (b) and in so far as those facts are not self-evident or admitted, there is in accordance with the usual rules of evidence an evidential burden upon the opponents 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. I agree with the agent for the opponent that there is case law supporting the proposition that this evidence does not necessarily have to be filed by the opponent in order to meet the opponent's burden (see for example **Labatt Brewing Co. Ltd. v. Molson Breweries, A Partnership** (1996), 68 C.P.R. (3d) 216 at 230-232 (F.C.T.D.)). In my opinion, for the opponent's burden to be met by way of evidence filed by the applicant it must arise from the cross-examination of the applicant's witnesses, or be in the form of "self-evident or admitted" statements in the applicant's evidence. As an example, in the case of a proposed use mark, an applicant may be found to have met the opponent's evidential burden under Section 30 grounds if evidence is filed by the applicant clearly showing (or admitting) a date of first use that precedes the filing date of that application. In order to meet the initial burden on it, the opponent would merely have to plead the proper ground, and bring the inconsistency to the attention of the Registrar.

Returning to the present case, in the absence of "self-evident or admitted" statements by the applicant, it is unsatisfactory for the opponent to merely attack the quality of the applicant's evidence in order to meet its evidential burden. In addition, the failure of the opponent to cross-examine the applicant's affiant further reduces the weight I can give to the opponent's arguments in this respect (see **Biba Boutique Ltd. v. Dalmys (Canada) Ltd.** (1976), 25 C.P.R. (2d) 278 at 281(F.C.T.D.)). As no evidence has been filed by the opponent in support of its allegations, and there are no "self evident or admitted" facts in the applicant's evidence from which it may be concluded that the applicant has not used the trade-mark **CHEF'S EDGE** since the claimed date of first use (August 1990), the opponent has failed to meet the initial evidential burden upon it in respect of the s. 30(b) issue. I have therefore dismissed this ground of opposition.

The second ground of opposition is based on Section 30(i), the opponent alleging that the applicant could not be satisfied that it was entitled to use the trade-mark **CHEF'S EDGE** in Canada in association with the wares in the present application, having regard to the prior use and registration of the opponent's trade-mark. Even were the applicant aware of the opponent's trade-mark as of the filing date of their application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark **CHEF'S EDGE** in Canada on the basis *inter alia* that its mark

is not confusing with the opponent's trade-mark **CHEF'S PRIDE**. Thus, the success of this ground is contingent on a finding that the trade-marks at issue are confusing (see Consumers Distributing Co. v. Toy World Ltd. (1990), 30 C.P.R. (3d) 191 (T.M.O.B.) at p. 195; and Sapodilla Co. v. Bristol-Myers Co. (1974), 15 C.P.R. (2d) 152 (Reg. T.M.) at p. 155).

The third ground of opposition is based on Section 12(1)(d) of the Act, namely, that the applicant's mark **CHEF'S EDGE** used in association with the wares "coffee; cooking and kitchen utensils, namely knives, pots and pans" and the services "operation of a retail outlet for the sale of coffee and cooking and kitchen utensils", is not registrable given that it is confusing with the opponent's registration **CHEF'S PRIDE** TMA 408,801 used in association with "Plastic housewares, namely pitchers, baskets, cutlery trays, pails, counter top storage containers, utility carts; kitchen accessories, namely strainers, measuring cups, cutting boards; non-stick cookware, namely cookie sheets, loaf pans, muffin ties, pie plates, roasting pans; microwave cookware and accessories, namely potato bakers, steamers, bowls, pouch holders; dinnerware, namely dishes, plates, saucers, cups, bowls; cookware, namely pots, pans, frying pans, roasting pans; glassware, namely mugs, teapots, glasses, bowls, salad sets; salt and pepper holders; ceramic ware, namely cookie jars, pie plates; stainless steel cutlery; dish cloths, tea towels, pot holders, oven mitts, bar wipes, aprons, ironing board covers." The legal burden is on the applicant to prove that there would be no reasonable likelihood of confusion between the trade-marks at issue. The material date for considering the issue of confusion with a registered trade-mark is the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., (1991), 37 C.P.R. (3d) 413 (F.C.A.)).

In assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question within the scope of Section 6(2) of the Act, the Registrar may have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act.

Section 6(5)(a) concerns the inherent distinctiveness of the marks in question and the extent to which they have become known. The opponent's registered trade-mark is **CHEF'S PRIDE**. The applicant's mark is **CHEF'S EDGE**. Neither mark possesses much inherent distinctiveness as the word CHEF is suggestive of cooking or baking and the words PRIDE and EDGE are to some extent laudatory. The mark **CHEF'S PRIDE** suggests that the applicant's cookware is of a quality that a cook or chef would be proud to possess it. The mark **CHEF'S EDGE** suggests that a cook or chef would gain an advantage or edge over others in using the applicant's knives, pots and pans.

The agent for the opponent submitted that I should follow the reasoning of Opposition Board Member Martin in the decision Andres Wines Ltd. v. Les Vins La Salle Inc. (1984), 3 C.P.R. (3d) 272 at 275 (T.M.O.B) wherein he stated:

A further consideration in the present case is the disclaimer entered by the applicant during the prosecution of the application before the Trade marks Office. Such a disclaimer can arguably be taken to be an admission that the words in question are not independently registrable in respect of the applied for wares. The foregoing may constitute an admission that the words in question are either clearly descriptive or common to the trade.

This may, in some cases, be true. However, it would appear that the word EDGE clearly describes the wares “knives” only. In addition, besides being suggestive of knives, the word EDGE could also be construed as a play on words, in that the word EDGE suggests both an advantage to the user, and is an allusion to the knives themselves. This creative double meaning gives the mark added inherent distinctiveness. Finally, it is the mark as a whole that must be considered, and I do not perceive the trade-mark **CHEF’S EDGE** when considered as a whole, as lacking inherent distinctiveness as a result of the disclaimers of the words CHEF and EDGE.

With respect to the extent to which the marks have become known, the applicant has stated that annual sales of wares sold in association with the trade-mark **CHEF’S EDGE** were over \$300,000 for 1993 and over \$390,000 for 1994. It could be presumed that these sales occurred at the applicant’s retail outlet. However, this is not clearly stated, and any ambiguity in an affidavit must be resolved against the affiant. I find then that these figures cannot be applied to the use of the mark in association with the applicant’s services. With respect to wares, the applicant has claimed use in Canada since August 1990, and has provided samples showing how the mark is in use in the form of a sign outside the retail outlet, on bags, and on newspaper advertisements. While this may be sufficient to show use of the mark in association with services, showing a trade-mark on signs, bags and advertisements is insufficient to show use in association with wares. Section 4 requires that for a trade-mark to be deemed “in use” in Canada, it must be marked on the wares themselves or on their packaging, or in some manner associated with the wares. I find then that this promotion of the mark is not “use” in association with wares. Taking all of the applicant’s evidence into account, the use shown would appear to be more relevant to services than to wares. I may have been prepared to accept the bags marked with the trade-mark as showing use of the mark in association with coffee, as they appear to be coffee bags, and this is a common way of selling bulk coffee, but no evidence was submitted by the applicant to allow me to draw this conclusion. I note that the applicant’s own evidence in the form of newspaper advertisements show sales of other trade-marked goods at the applicant’s retail outlet, including the coffee of the Canterbury Coffee Corporation (see Brooks affidavit ex “D”) but do not refer to any wares marked with the applicant’s own trade-mark. After considering all of the evidence, I cannot conclude that the applicant’s mark has become known to any extent in association with wares. Although

there is sufficient evidence for me to conclude that the services are being performed in association with the trade-mark, I am unable to conclude to what extent the applicant's mark has become known in association with these services.

The opponent has enjoyed sales of products bearing the trade-mark **CHEF'S PRIDE** in Canada in excess of a half a million dollars in the two years prior to swearing the affidavit. It would appear that although the applicant's mark is slightly more inherently distinctive, the opponent's mark has become known to a greater extent than the applicant's mark.

With respect to s. 6(5)(b) of the Act, the length of time the trade-marks have been in use, the opponent has not filed evidence confirming a first date of use. As the applicant's evidence does not refer to services, and is inconclusive with respect to use in association with wares, the length of time the marks have been in use is not a relevant consideration.

With respect to s. 6(5)(c) of the Act, the nature of the wares, I find that the opponent's wares, in particular cookware namely pots, pans, and stainless steel cutlery, are directly related to the applicant's cooking and kitchen utensils, namely knives, pots and pans, and to a lesser extent are related to the services of the operation of a retail outlet for the sale of cooking and kitchen utensils. With respect to s. 6(5)(d) of the Act, the nature of the trades, there is potential overlap in the channels of trade given that the wares are related.

As for s. 6(5)(e) of the Act, the degree of resemblance between the marks in appearance, sound and ideas suggested by the marks, I find that there is a some visual and phonetic resemblance between the marks of the parties. The idea suggested by the two marks are similar. However, much of this resemblance is simply due to the common use of the descriptive word CHEF'S. Although the marks are similar in many respects, the marks in their entireties are distinguishable to some extent by virtue of the differences in appearance and meaning between the words EDGE and PRIDE.

As a surrounding circumstance, the applicant made submissions in their written argument with respect to the state of the Canadian trade-marks register, in particular, the use of the word CHEF'S in association with "the food and kitchenware trades in Canada". However, this is not in evidence, as the affidavit of Linda Victoria Thibeault referred to by the applicant was not timely filed, and was thus not considered by the Registrar.

I agree with the agent for the opponent that there is case law indicating that a mark used in association with wares can be confusing with a mark used in association with services (see for example **Beachcombers Restaurant Ltd. v. Vita-Pakt Citrus Products Co.** (1976), 26 C.P.R. (2d) 282 (Reg. Of T.M.) and **Canadian Swiss Hotels Ltd. v. Wylie**

**Marketing Services Ltd.**(1976), 49 C.P.R. (2d) 139 (T.M.O.B.)). In these decisions, the wares were food products and the services were restaurant services. The marks were identical, or at least their inherently distinctive portions were. Such is not the case here. In my opinion, even if the opponent's housewares sold under the trade-mark **CHEF'S PRIDE** were available at a retail outlet operating under the applicant's trade-mark **CHEF'S EDGE**, I cannot conclude that it would be likely to lead to the inference that the opponent's wares were being manufactured or sold by the same person as that performing the applicant's retail store services.

The legal burden is on the applicant to show that there is no reasonable likelihood of confusion between the marks at issue. Any doubts are to be resolved against the applicant. In applying the test for confusion, it is a matter of first impression and imperfect recollection. It is not to be a side-by-side comparison of the marks. In view of my conclusions above, and particularly in view of the degree of resemblance between the marks and the similarities between the wares of the parties, I find that the applicant has failed to satisfy the burden on it to show that its mark is not confusing with the opponent's registered mark in respect of "cooking and kitchen utensils, namely knives, pots and pans." However, in view of the low inherent distinctiveness of the marks and the resulting narrow ambit of protection of the opponent's mark, and to a lesser extent the dissimilarities between the applicant's remaining wares and services and the opponent's wares, I find that the marks, when considered as a whole, are otherwise not confusing. The third ground of opposition is therefore successful but only with respect to the wares "cooking and kitchen utensils, namely knives, pots and pans" and is otherwise unsuccessful.

The fourth ground of opposition with respect to the distinctiveness of the applicant's mark was pleaded such that the success of this ground would be contingent on a finding that the marks are confusing. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case August 5, 1993. I find that the result under this ground would not differ materially from that above.

I refuse the applicant's application in respect of the wares "cooking and kitchen utensils, namely knives, pots and pans" and I otherwise reject the opponent's opposition. Authority for such a divided result may be found in **Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH** (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).

DATED AT HULL, QUEBEC, THIS 20 th DAY OF AUGUST, 1997.

Peter C. Cooke,  
Member,  
Trade-marks Opposition Board