

IN THE MATTER OF OPPOSITIONS
by Willett Foods Limited to
applications Nos. 503,419 and
503,426 for the trade-marks
GREEN GROCER & Design and
GREEN GROCER & Design filed
by Greengrocer, Inc.

On May 12, 1983, the applicant, Greengrocer, Inc., filed an application to register the trade-mark GREEN GROCER & Design (illustrated below) based on proposed use in Canada with the services of the "operation of retail fruit and vegetable stores" and with the following wares:

packaged and bulk packed fresh fruits and vegetables; pre-packaged fruits and vegetables; pre-packaged fresh fruits and vegetables; foodstuffs, namely spices, herbs, flour, sugar, vinegar; salad dressings; potted, packaged and cut plants and flowers; packaging, namely boxes, bags, wrapping in roll form, sacks, baskets and trays; aprons.

On May 13, 1983, the applicant filed an application to register the trade-mark GREEN GROCER & Design (illustrated below) based on proposed use in Canada for the same wares and services noted above.

Both applications were amended to include a disclaimer to the words GREEN GROCER in respect of services and to the representation of the fruits and vegetables in respect of wares and services. The applications were both subsequently advertised for opposition

purposes on October 17, 1984.

The opponennt, Willet Foods Limited, filed essentially identical statements of opposition respecting the two applications on November 16, 1984. A copy of each statement of opposition was forwarded to the applicant on December 11, 1984. The first ground of opposition in each case is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with six registered trade-marks of the opponent all including the words MR. GROCER. The most pertinent of the marks is registration No. 292,446 for the trade-mark MR. GROCER & Design (illustrated below). All six registrations cover the following services:

operation of a retail supermarket and counselling
and assisting others in the operation thereof.

The second ground of opposition in each case is that the applicant is not the person entitled to registration because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark MR. GROCER and with the six registered trade-marks previously used in Canada by the opponent and its predecessor in title Dominion Stores Limited. The third ground in each case is that the applicant's trade-mark is not distinctive in view of the use and advertisement of the opponent's marks.

The applicant filed and served a counter statement in each case. As its evidence in each opposition, the opponent filed the affidavit of Lynda Doxsee. The applicant did not file evidence in either case. Both parties filed a written argument in each case and an oral hearing was conducted at which only the opponent was represented.

As for the second ground of opposition in each case, there was an evidential burden on the opponent to evidence use of at least one of its trade-marks prior to the applicant's filing date. Since the opponent failed to evidence any use of its trade-marks, the second ground in each case is unsuccessful.

As for the third ground of opposition in each case, there was an evidential burden on the opponent to evidence at least some reputation in Canada for one or more of its trade-marks. The opponent having failed to file evidence on point, the third ground in each case is also unsuccessful.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all

of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. Finally, as noted, the most pertinent of the opponent's marks in each case is the design mark registered under No. 292,447. Therefore, a consideration of the issue of confusion between that mark and each of the applicant's marks will effectively decide the outcome of the second ground of opposition in each opposition.

The opponent's registered mark is inherently weak since it comprises the descriptive word GROCER and a stylized representation of a grocer. The word GROCER has been disclaimed in the opponent's registration. The opponent has failed to evidence any acquired reputation for any of its marks.

The applicant's marks, too, are inherently weak. They both include (1) the words GREEN GROCER which are equivalent to the descriptive word "greengrocer", (2) a more natural representation of a grocer and (3) representations of various produce. There being no evidence from the applicant, I must conclude that neither of its marks has become known in Canada.

In the absence of evidence of use of any of the marks at issue, the length of time the marks have been in use is not a material circumstance in these cases. The services of the parties are essentially the same and presumably the trades would be similar.

As for Section 6(5)(e) of the Act, the opponent's mark does not resemble either of the applicant's marks to any great extent. The design component of the opponent's mark is quite different from the design aspect of each of the applicant's marks. All three marks contain the word GROCER but the opponent cannot claim any exclusivity in such a descriptive term. All of the marks suggest a similar idea, namely, a grocer or greengrocer but no trader can assert any exclusive rights in that particular idea.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my findings above, and particularly in view of the differences between the marks at issue and the absence of any reputation associated with the opponent's mark, I find that neither of the applicant's marks is confusing with the opponent's registered mark. In view of my previous comments, the first ground of opposition in each case is therefore unsuccessful.

In view of the above, I reject the opponent's oppositions.

DATED AT HULL, QUEBEC, THIS 16TH DAY OF FEBRURY 2006.

David J. Martin,
Member,
Trade Marks Opposition Board.