

**IN THE MATTER OF AN OPPOSITION
by Nabisco Ltd. and Nabisco, Inc. to application
No. 740,096 for the trade-mark SNACK 'N GO
filed by Hershey Canada Inc. and now standing
in the name of Johnvince Foods, a partnership**

On October 28, 1993, Hershey Canada Inc. filed an application to register the trade-mark SNACK 'N GO based on proposed use in Canada. The application currently stands in the name of Johnvince Foods, a partnership of Johnvince Foods Ltd., J. Pulla Ltd., R. Tabone Ltd. and V. Pulla Ltd. The application was amended to include a disclaimer to the word SNACK and was advertised for opposition purposes on June 15, 1994. The application as advertised covered “promotional services relating to confectionery, nuts, cocoa and peanut butter.” By letter dated October 17, 1996, the applicant sought to amend its statement of services by removing the word “confectionery” and that amendment was made of record on February 27, 1997.

The opponents, Nabisco Brands Ltd. (now Nabisco Ltd.) and Nabisco, Inc., filed a statement of opposition on November 15, 1994, a copy of which was forwarded to the applicant on February 6, 1995. The opponents were subsequently granted leave to amend their statement of opposition on January 9, 1996 and again on November 24, 1997. The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(a) of the Trade-marks Act because the application does not contain a statement in ordinary commercial terms of the specific services with which the trade-mark is proposed to be used.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with Nabisco Ltd.’s trade-marks SNACKS TO GO, SNACKS TO GO ANYWHERE ANYTIME and APPORTEZ-EN AVEC VOUS N’IMPORTE OU, N’IMPORTE QUAND registered under Nos. 470,559; 424,373 and 429,972 respectively, all for “biscuits; cookies; crackers; snack foods, namely pretzels, potato chips, bagel chips, cheese curls and tortillas.” The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the three registered trade-marks noted above previously used in Canada by the opponent Nabisco Ltd. The fourth ground is that the applicant’s trade-mark is not distinctive because it is confusing with the opponents’ trade-marks.

The fifth ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(i) of the Act in that the applicant could

not have truthfully made the statement that it was satisfied that it was entitled to use the applied for trade-mark in Canada. In this regard, the opponents alleged that Hershey Brands Inc. is a licensee of the opponents for certain trade-marks and was aware of the use and registration in the United States of the trade-mark SNACK 'N GO by the opponent Nabisco, Inc.

The applicant filed and served a counter statement. The applicant was subsequently granted leave to file an amended counter statement. The opponents' evidence comprises a certified copy of registration No. 470,559, an affidavit of A.N. Baggetta and a replacement for Exhibit C to the Baggetta affidavit. Mr. Baggetta was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record. The applicant's evidence consists of two affidavits of Ines Freeman and the affidavits of Jim Findlay, Helen Stenoff and Carol Luciani. Mr. Findlay and Ms. Stenoff were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The Opponents' Evidence

In his affidavit, Mr. Baggetta identifies himself as the Director of Regional Category Development at Nabisco Ltd. According to Mr. Baggetta, Nabisco Ltd. began using the three registered trade-marks SNACKS TO GO, SNACKS TO GO ANYWHERE ANYTIME and APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND in December of 1992 on display racks which were distributed to supermarkets, convenience stores and independent food stores. Display racks are located at more than 10,000 such establishments across Canada.

The display racks have side panels and a header card which feature the registered trade-marks. The racks contain snack-size packages of a number of the products of Nabisco Ltd. including RITZ and CRISPERS crackers; OREO, CHIPS AHOY, FIG NEWTONS, PEEK FREANS and SNACKWELL'S cookies and BITS & BITES, SUN UPS and CHEESE CURLS snacks. Most of the individual packages bear the house mark CHRISTIE next to the brand mark while some bear the house mark PEAK FREANS. The house mark CHRISTIE also usually appears next to the registered marks SNACKS TO GO, SNACKS TO GO ANYWHERE ANYTIME and APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND.

As explained during the Baggetta cross-examination and as clarified by the reply to the undertaking given at page 17 of the Baggetta transcript, the snack products sold on the display racks are made by Christie Brown & Co. and Peak Frean Co. which are both divisions of Nabisco Ltd. According to Mr. Baggetta,

sales of snack products to retailers and distributors for sale on the display racks bearing the registered trade-marks totalled in excess of \$20 million for the period 1993 to 1995. Nabisco Ltd. also used its registered marks on advertisements for distributors and on promotional materials used in retail stores. Invariably, the advertisements, promotional materials and the header cards on the display racks associated the registered marks SNACKS TO GO, SNACKS TO GO ANYWHERE ANYTIME and APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND with the individual trade-marks used on the snack products and with the house mark CHRISTIE. Those materials also bore legends identifying the trade-marks used as being those of Nabisco Brands Ltd. (now Nabisco Ltd.).

The Applicant's Evidence

The two Freeman affidavits serve to introduce into evidence dictionary definitions for the word "snack" as well as some printouts from an Internet search. The Luciani affidavit presents the result of a state of the trade-marks register search for the word SNACK. Ms. Luciani's search results revealed that there are dozens of trade-marks incorporating the word SNACK and registered for food products, particularly those which could be characterized as snack foods. Apart from the marks at issue in the present case, Ms. Luciani did not locate any registered trade-marks incorporating both the words SNACK and GO.

In his affidavit, Mr. Findlay identifies himself as the National Account Manager with Johnvince Foods, the current applicant. On August 28, 1997, Mr. Findlay visited four chain stores in the Toronto area and purchased seven products in the nature of snack foods which bore trade-marks which include the word SNACK or SNACKS. Mr. Findlay states that, in view of his experience in the trade, he believes that these products would be available across Ontario in the various chains. However, on cross-examination, Mr. Findlay refused to answer questions about his experience. Given those refusals, I must conclude that Mr. Findlay does not have any such experience and his speculation about the availability of particular products throughout Ontario can be given no weight.

On cross-examination, Mr. Findlay stated that he was aware of the use of the applied for trade-mark SNACK 'N GO by the applicant on display boxes which each hold twelve bags of PLANTERS peanuts. According to Mr. Findlay, the display boxes identified Hershey Canada Inc. and that more recent boxes would identify JVF Canada (i.e. - Johnvince Foods, the current applicant). Mr. Findlay also stated that the boxes identified Nabisco as the owner of the PLANTERS trade-mark. Exhibit B to the Findlay cross-examination is a photocopy of a display box which identifies SNACK 'N GO as a trade-mark. It also identifies PLANTERS as a

registered trade-mark and indicates that the product is manufactured by Hershey Canada Inc. under license but does not identify Nabisco Ltd. as the trade-mark owner. Mr. Findlay conceded that his company was not offering any service to retailers in association with the SNACK 'N GO trade-mark when it sold them boxes of PLANTERS peanuts bearing that mark.

In her affidavit, Ms. Stenoff identifies herself as a salesperson with Johnvince Foods Limited. Like Mr. Findlay, she visited stores in the Toronto area and purchased food products bearing trade-marks which include the word SNACK or SNACKS. Although her affidavit is incomplete and somewhat unclear, on cross-examination she stated that she made purchases at two FOOD BASICS stores. Those purchases appear to have been made on July 22, 1996 and included six different products. Based on her knowledge of the trade, she stated her belief that the products she purchased would be available in the FOOD BASICS stores across Ontario. However, like Mr. Findlay, she refused to answer questions about her experience in the trade and thus her opinion about the province-wide availability of certain products can be given no weight.

The Grounds of Opposition

As for the first ground of opposition, the material time for considering the circumstances is as of the applicant's filing date: see the opposition decision in Style-Kraft Sportswear Ltd. v. One Step Beyond Ltd. (1993), 51 C.P.R.(3d) 271 at 274. Furthermore, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(a) of the Act: see the opposition decision in Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). However, to the extent that the opponents rely on allegations of fact in support of the first ground, there is an evidential burden on them to prove those allegations.

To meet the evidential burden upon it in relation to a particular issue, an opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. At page 298 of the John Labatt decision, Mr. Justice McNair characterizes the evidential burden on an opponent as follows:

The evidential burden is the burden of adducing sufficient evidence to persuade the trier of fact that the alleged facts are true: see Sopinka and Lederman, *The Law of Evidence in Civil Cases* [Butterworths], 6th ed., pp. 107-08; Phipson *On Evidence*, 13th ed., para. 44-03; McCormick *On Evidence* [Hornbook Series, West Publishing Co.], 3rd. ed.,

pp. 946-48; and Thayer, Preliminary Treatise On Evidence at the Common Law (1898), ch. 9.

As for the test to be applied under Section 30(a) of the Act, the former Registrar of Trade-marks stated in Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd. (1975), 23 C.P.R. (2d) 128 that an applicant in its application “must clearly set forth wares or services as they are customarily referred to in the trade.” In this regard, reference may also be made to the opposition decision in Pro Image Sportswear, Inc. v. Pro Image, Inc. (1992), 42 C.P.R.(3d) 566 at 573.

In the present case, the applicant’s services are “promotional services relating to nuts, cocoa and peanut butter.” However, as revealed during the Findlay cross-examination, the applicant’s use of its trade-mark SNACK ‘N GO to date has been for wares, namely peanuts. Thus, on that basis alone, it appears that the applicant has not provided a statement in ordinary commercial terms of the wares or services with which it proposes to use its mark since it has identified services and its use to date appears to have been with wares.

Apart from the foregoing, the applicant’s statement of services does not appear to conform to the requirements of Section 30(a) of the Act because the applicant did not intend to provide “promotional services” to other parties. As conceded by Mr. Findlay on cross-examination, the applicant does not perform a service when it sells SNACK ‘N GO boxes of PLANTERS peanuts. Thus, it would appear that the proposed activity covered by the applicant’s statement of services is merely self-promotion and that does not qualify as a registrable service: see the opposition decision in Ralston Purina Co. v. Effem Foods Ltd. (1997), 81 C.P.R.(3d) 528 at 533-534.

In view of the above, I find that the opponents have satisfied the evidential burden on them to show that the applicant’s statement of services does not conform to the requirements of Section 30(a) of the Act. The applicant has failed to provide evidence to meet its legal burden on point. Thus, the first ground of opposition is successful.

The second ground of opposition is 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 the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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.

As for Section 6(5)(a) of the Act, Nabisco Ltd.'s three registered trade-marks **SNACKS TO GO**, **SNACKS TO GO ANYWHERE ANYTIME** and **APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND** all describe the nature of the associated wares, namely snack foods. Thus, the three registered marks are inherently weak. However, the opponents have evidenced fairly extensive use of those marks throughout Canada. Although the marks do not appear on the wares or their packages, their prominent appearance on the display racks qualifies as use for wares within the meaning of Section 4(1) of the Act. Furthermore, the marks have invariably been identified as trade-marks when used and have usually been associated with Nabisco Ltd.'s house mark **CHRISTIE** and its various product marks. Thus, I am able to conclude that Nabisco Ltd.'s three registered marks have become known to some extent in Canada.

The applicant's proposed mark **SNACK 'N GO** might be inherently distinctive if used in association with promotional services to be performed for others. However, the evidence suggests that the applicant will be using its mark for wares and for self-promotion. In that context, the trade-mark **SNACK 'N GO** is highly suggestive of the nature of the related products, namely that they are portable snack food items. Thus, the applicant's mark is inherently weak. There is no evidence as to the extent of use of the applicant's mark to date and I must therefore conclude that it has not become known at all in Canada.

The length of time the marks have been in use favors the opponents. As for the natures of the wares, services and trades of the parties, as previously noted, it appears that the applicant has miscast its application and that it intends, in fact, to use its trade-mark **SNACK 'N GO** for wares rather than services. Those wares are the same type as sold by the opponent Nabisco Ltd. in association with its three marks **SNACKS TO GO**, **SNACKS TO GO ANYWHERE ANYTIME** and **APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND**. The evidence suggests that the trades of the parties would be the same, namely grocery stores and convenience stores.

As for Section 6(5)(e) of the Act, there is a high degree of resemblance between the applicant's mark **SNACK 'N GO** and the registered mark **SNACKS TO GO** in all respects. Both marks comprise three elements commencing with the word **SNACK** and ending with the word **GO**. Both suggest the idea of portable snack food items. The degree of resemblance with the registered mark **SNACKS TO GO ANYWHERE ANYTIME** is somewhat less and there is little resemblance between

the applicant's mark SNACK 'N GO and the registered mark APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND.

The applicant submitted that an additional surrounding circumstance in the present case is the state of the register evidence introduced by the Luciani affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

As noted, the Luciani affidavit establishes that there are a relatively large number of registered marks for food products in the nature of snack food items which include the word SNACK or SNACKS. Thus, I am able to conclude that a number of these marks would be in active use in the marketplace and that consumers would therefore be more likely to differentiate such marks based on their other components. As also noted, however, Ms. Luciani was unable to locate any third party registrations for trade-marks incorporating both the words SNACK and GO.

The Findlay and Stenoff affidavits serve to some extent to underscore the conclusion arising from the Luciani affidavit. The purchases by Mr. Findlay and Ms. Stenoff in the Toronto area provide some additional evidence to show that the word SNACK or SNACKS is a common component of snack food trade-marks. Again, as noted, Mr. Findlay and Ms. Stenoff were unable to locate any snack food products bearing a trade-mark comprising the word SNACK and the word GO.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the extent of use of Nabisco Ltd.'s trade-marks and the resemblance between the wares, services, trades and marks of the parties and notwithstanding the common adoption of trade-marks incorporating the word SNACK by other traders, I find that I am left in a state of doubt respecting the issue of confusion between the applicant's mark and the registered trade-marks SNACKS TO GO and SNACKS TO GO ANYWHERE ANYTIME. Since the legal burden is on the applicant, I must resolve that doubt against it. Thus, the second ground of opposition is also successful insofar as it is based on the first two registered marks.

As for the registered mark **APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND**, in view of the low degree of resemblance between that mark and the applicant's mark, I find that those two marks are not confusing. Thus, the third aspect of the second ground of opposition is unsuccessful.

The third and fourth grounds of opposition also turn on the issue of confusion between the marks of the parties, the only significant difference being the material time for considering the circumstances. For the entitlement ground the material time is the applicant's filing date and for the ground of non-distinctiveness it is the filing of the opposition (i.e. - November 15, 1994): see 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) 412 at 424 (F.C.A.).

My findings respecting the second ground of opposition are, for the most part, applicable to the third and fourth grounds. Thus, I find that the applicant has failed to show that its mark is not confusing with the first two registered trade-marks as of the filing date of the present application and as of the filing of the opposition. The third and fourth grounds are therefore successful insofar as they are based on the first two registered marks. As for the registered mark **APPORTEZ-EN AVEC VOUS N'IMPORTE OU, N'IMPORTE QUAND**, the applicant's mark is not confusing with it and that aspect of the third and fourth grounds is unsuccessful.

As for the fifth ground, it does not raise a proper ground of opposition. First, it should be noted that the opponents alleged that Hershey Brands Inc. was aware of the use and registration of the trade-mark **SNACK 'N GO** in the United States rather than the original applicant Hershey Canada Inc. Even if the opponents had alleged that the original applicant had been aware of the use and registration of **SNACK 'N GO** in the United States by Nabisco, Inc., that fact would not have precluded Hershey Canada Inc. from truthfully making the statement that it was satisfied that it was entitled to use its mark in Canada. Thus, the fifth ground is unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC THIS 28th DAY OF OCTOBER, 1999.

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