

IN THE MATTER OF AN OPPOSITION by McDonald's Corporation and McDonald's Restaurants of Canada, Limited to application No. 582,267 for the trade-mark CHOCO MACS filed by Foley's Candies Ltd.

On April 16, 1987, the applicant, Foley's Candies Ltd., filed an application to register the trade-mark CHOCO MACS based upon proposed use of the trade-mark in Canada in association with "chocolate bars and bite size pieces of chocolate".

The opponents, McDonald's Corporation and McDonald's Restaurants of Canada, Limited, filed a statement of opposition on November 28, 1988 in which they alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark CHOCO MACS is confusing with the following registered trade-marks owned by the opponent, McDonald's Corporation, and in respect of which McDonald's Restaurants of Canada, Limited, is a registered user:

<u>TRADE-MARK</u>	<u>REGISTRATION NO.</u>
MCDONALD'S	141,977
MCDONALD'S HAMBURGERS	141,978
MCDONALD'S & Design	141,374
MCDONALD'S & Design	176,783
BIG MAC	182,371
MCDONALDLAND & Design	218,993
BIG MAC & Design	219,423
RONALD MCDONALD	219,896
MCDONALD'S GOOD MORNING CANADA & Design	220,219
EGG MCMUFFIN	221,457
MACSUNDAE	221,486
RONALD MCDONALD	225,901
RONALD MCDONALD & Design	225,902
LITTLE MAC	230,837
MCHAPPY DAY	223,046
MCDONALD'S CARES & Design	243,165
BIG MACK'S	243,627
DOUBLE MAC	244,774
NOBODY CAN DO IT LIKE MCDONALD'S CAN	249,611

MCBOO	253,152
MCCHICKEN	254,922
MCDONALDLAND	256,841
BIG MAC ATTACK	258,246
MCDONALDLAND	259,357
RONALD MCDONALD HOUSE	259,608
MANOIR RONALD MCDONALD	259,611
ATTACK A BIG MAC	262,644
MCDONALD'S & Design	262,687
CHICKEN MCNUGGETS	268,261
MCDOLLAR	269,956
MAYOR MCCHEESE	271,945
RONALD MCDONALD HOUSE & Design	274,108
MC CHICKEN	275,398
MACPOULET	276,932
MCDONALDLAND FASHIONS COLLECTION & Design	277,094
MCRIB	279,507
MCBUCK	283,637
MCCOTE & Design	283,789
RONALD MCDONALD HOUSE & Design	286,141
MCDONUTS	287,330
MCCONE	287,732
MCMONEY	290,131
POULET MCCROQUETTES	295,104
MCDONALD'S, RONALD AND YOU	295,143
MCBARBEQUE	296,686
MCQ	296,687
MCDO	301,422
I'VE GOT A TASTE FOR MCDONALD'S	305,883
MCDONALD'S PLAYLAND	310,250
MCDONALD'S PLAYLAND & Design	310,251
MCCOLA	314,361
MCMILLIONS	316,743

MCD.L.T.	316,918
MCNUT	320,301
MCMUFFIN	321,522
MCNOGG	322,335
MAPLE MCCRISP	322,792
MCMILLION	322,909
CHICKEN MCSWISS	322,791
MCJOBS & Design	330,965
MAC FRIES	332,947
MCCHEDDAR	334,618
RONALD MCDONALD CHILDREN'S CHARITIES	335,462
PARTNERS IN SUPPORTING RONALD MCDONALD HOUSE	336,058

The opponents also relied upon the following pending trade-mark applications in challenging the applicant's entitlement to registration:

<u>TRADE-MARK</u>	<u>APPLICATION NO.</u>
MCDONUT	429,337
MCDONUTS	429,338
MCDONALD'S PLAYLAND	501,092
SAUSAGE MCMUFFIN	513,146
MCSNACK	526,017
MCPIZZA	539,009
MCBLIMP	553,091
MCPASS	562,699
MCSALAD	568,108
MCSTOP	568,109
MCDOME BURGER	572,832
MCKIDS	573,912
MCFRITTER	580,129
MCMASTERS	583,279

The applicant served and filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponents filed as their evidence the affidavit of Gary Reinblatt while the applicant submitted the affidavit of Kurt Gagel. Further, both parties submitted written arguments and both were represented at an oral hearing.

The main issue in this opposition is whether the applicant's trade-mark CHOCO MACS as applied to the wares covered in the applicant's application is confusing with one, or more, of the opponents' sixty-five registered trade-marks, or fourteen pending trade-mark applications, relied upon by the opponents in their statement of opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties, either as of the filing date of the applicant's application (the material date in respect of the non-entitlement ground of opposition) or as of the date of opposition (the material date in respect of the Section 12(1)(d) and non-distinctiveness grounds of opposition).

With respect to the inherent distinctiveness of the trade-marks at issue, I consider that the applicant's trade-mark CHOCO MACS when considered in its entirety is inherently distinctive as applied to chocolate bars and bite size pieces of chocolate even though the word CHOCO is at least suggestive of chocolate. Certain of the opponents' trade-marks such as MCDONALD'S, RONALD MCDONALD, and the design trade-marks including these words, are weak marks which possess little inherent distinctiveness while the opponents' trade-marks comprising or including the word MCDONALDLAND do possess some inherent distinctiveness. Further, a number of the opponents' marks including the MC or MAC prefix in combination with a food identifier do possess some measure of inherent distinctiveness, as do the opponents' marks which include the prefix MAC or MC in combination with a word or words which are descriptive of food products. The former group of trade-marks include such marks as MACSUNDAE, EGG MCMUFFIN, MCCHICKEN, MACPOULET, MAYOR MCCHEESE, MCRIB, MCCOTE & Design, MCDONUTS, MCCONE, MCCOLA, MCNUT, MCMUFFIN, MCNOGG, MAC FRIES, MCDONUT, MCPIZZA, MCFRITTER, MCSALAD and SAUSAGE MCMUFFIN while the latter group is represented by the trade-marks MCSNACK, MCBARBEQUE, POULET MCCROQUETTES, MAPLE MCCRISP, CHICKEN MCSWISS, MCCHEDDAR and CHICKEN MCNUGGETS. Other of the opponents' trade-marks are inherently distinctive in relation to the food products or restaurant services covered in the respective registration or pending application, including the trade-marks BIG MAC, BIG MAC ATTACK, MCHAPPY DAY, BIG MACK'S, MCBOO, ATTACK A BIG MAC, MCQ, MCDO,

MCD.L.T., MCMILLION and MCMILLIONS. Finally, the opponents have a group of marks possessing some inherent distinctiveness but covering wares unrelated to those of the parties, including the trade-marks LITTLE MAC, DOUBLE MAC, MCBUCK, MCDOLLAR, MCMONEY and MCJOBS.

Considering the extent to which the trade-marks at issue have become known, the applicant's trade-mark CHOCO MACS had not become known as of the filing date of its proposed use application. Further, while the applicant has used the trade-mark CHOCO MACS in Canada since February 10, 1988, there is no indication in the Gagel affidavit as to the extent to which the trade-mark had become known prior to the date of opposition (November 28, 1988). On the other hand, a number of the opponents' trade-marks are very well known in Canada either in association with the operation of the opponents' fast food restaurants or in association with the food products sold in those restaurants. In particular, the opponents' evidence establishes that the trade-marks MCDONALD'S, BIG MAC, EGG MCMUFFIN, MCCHICKEN, CHICKEN MCNUGGETS and MCD.L.T. are quite well known in Canada. On the other hand, the Reinblatt affidavit does not establish that such trade-marks as MACSUNDAE, LITTLE MAC, DOUBLE MAC, MCDONUTS, MCCONE, MCCOLA, MCNUT or MCNOGG have become known to any extent as of the material dates in this opposition. Likewise, the length of time that the trade-marks at issue have been in use clearly favours the opponents, particularly in respect of those of their trade-marks which are well known in Canada.

As for the respective wares of the parties, the applicant's chocolate bars and bite size pieces of chocolate are snack food products generally which could be purchased either for immediate or later consumption while the opponents' registrations cover a number of ready to eat food products, such as hamburgers, cheeseburgers, french fried potatoes, fish sandwiches, coffee, milk, milk shakes, hot chocolate, carbonated soft drink beverages, fried chicken, apple pie, food combination sandwiches, sundaes, cookies, pork sandwiches, doughnuts, ice cream cones, nuts, pastries and salads. With respect to their wares, the opponents have noted that their chocolate milk shakes, chocolate chip cookies, hot chocolate and hot fudge sundaes either contain chocolate or are chocolate flavoured, further increasing the degree of similarity between their wares and those of the applicant. However, the fact that certain of the opponent's wares may be chocolate flavoured or may contain chocolate is not a particularly relevant consideration in respect of the issue of confusion between the trade-marks at issue.

The opponents' registrations also cover restaurant services which differ from chocolate bars

and bite size pieces of chocolate. Nevertheless, the opponents submitted that the applicant's wares could be sold through fast-food outlets, there being no limitation in the applicant's statement of wares to preclude that possibility. However, no evidence has been adduced by the applicant that either chocolate bars or pieces of chocolate are sold in restaurants and, in the absence of such evidence, I am not prepared to conclude that the sale of chocolate bars would normally be considered a part of the services normally rendered by a restaurant. Accordingly, there appears to be little similarity either in the wares or services of the parties, or in the respective channels of trade associated with their wares and services.

In assessing the likelihood of confusion between trade-marks in respect of a Section 12(1)(d) ground of opposition, the Registrar must have regard to the channels of trade which would normally be associated with the wares (or services) set forth in the applicant's application since it is the statement of wares (or services) covered in the application rather than the applicant's actual trade to date which determines the scope of the monopoly to be accorded to an applicant should its trade-mark proceed to registration (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pp. 10-12 (F.C.A.)). Thus, absent a restriction in the statement of wares set forth in its trade-mark application as to the channels of trade associated with those wares, the Registrar cannot take into consideration the fact that an applicant may only be selling its wares through a particular type of retail outlet or through a particular channel of trade when considering the issue of confusion (see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 2 C.P.R. (3d) 361, at pg. 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at pg. 112 (F.C.A.)). As a result, the applicant's submissions that the trade-mark CHOCO MACS is associated with the applicant's trade-name FOLEY'S on its packaging and that its chocolate bars and bite size pieces of chocolate are marketed through "supermarkets and wholesale outlets" are of no relevance to the Section 12(1)(d) grounds of opposition.

As to the degree of resemblance between the trade-marks of the parties, the opponents have not specifically relied upon one, or more, of their trade-marks in respect of the issue of confusion. Rather, in their written argument, the opponents state:

"The trade marks of the opponents involve the syllables MC or MAC alone or in combination with other syllables. The opponents' evidence shows that they have established a family of MC or MAC formative trade marks related to their restaurant services, food products and other wares and services. The MC or MAC formatives are also often combined with descriptions of food products such as CHICKEN McSWISS, MacPOULET, McRIB and McMUFFIN to name but a few. The applicant's trade mark also involves the use of the formative MAC in combination with the description of a food product, namely CHOCO. Therefore, it is respectfully submitted that the degree of resemblance between the trade marks is great.

CHOCO MACS is so similar in concept to the family of MC or MAC trade

marks now owned by McDonald's Corporation that there is nothing to distinguish the marks in terms of the ideas suggested by them. Therefore, it is respectfully submitted that the applicant's trade mark is likely to cause confusion with the opponents' trade marks, and therefore, the applicant is not the person entitled to registration and the application should be refused."

In McDonald's Corporation et al v. Silcorp Ltd./ Silcorp Ltée, 24 C.P.R. (3d) 207, Mr. Justice Strayer considered a similar argument as was presented by the present opponents in the appeals before him. In response, the learned trial judge noted the following at pages 212-213 of the reported reasons for judgment:

Also, at page 217, Strayer, J. commented on the opponents' submission relating to their alleged family of trade-marks:

The agent for the opponents sought to distinguish the Silcorp decision from the present case on the basis that the three trade-mark applications of the applicant being considered by Mr. Justice Strayer only covered restaurant services and not food products. However, one of the applicant's trade-marks in issue in that case, namely, the trade-mark MAC'S SNACKS Design, covered food products essentially identical to those covered in the opponents' registrations.

Considering those trade-marks of the opponents which include the element MAC standing alone in combination with other elements, the registered trade-marks LITTLE MAC and DOUBLE MAC both cover "electric food cookers for domestic use", wares which are completely unrelated to the applicant's wares, and neither trade-mark has been shown to have acquired any measure of a reputation in Canada. Further, the registered trade-marks BIG MAC ATTACK and ATTACK A BIG

MAC cover "restaurant services" and neither trade-mark has been shown to be in use in association with such services in Canada. As well, there is little, if any, evidence of use of the registered trade-mark BIG MAC & Design covering specially prepared carry-out type foods. The only remaining registered trade-mark of the opponents which includes the element MAC standing alone is the trade-mark BIG MAC which, as noted above, is certainly well known in Canada in respect of hamburger sandwiches. However, while I find there to be at least some similarity in appearance and sounding between the trade-marks BIG MAC and CHOCO MACS, the wares associated with these marks is such as to negate any reasonable likelihood of confusion between them.

Having regard to the above and, in particular, to the differences in the wares and services of the parties and the respective channels of trade associated with the applicant's chocolate bars and pieces of chocolate and the opponents' restaurant services and food products, and bearing in mind the comments of Mr. Justice Strayer referred to above, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue. Accordingly, I have rejected the opponents' opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF APRIL 1991.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.