



**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS**

**Citation: 2012 TMOB 40
Date of Decision: 2012-02-23**

**IN THE MATTER OF AN OPPOSITION
by Tritap Food Broker, A Division of
676166 Ontario Limited to application
No. 1,276,000 for the trade-mark BILLY
BOB'S JERKY in the name of Billy Bob's
Jerky Inc.**

[1] On October 13, 2005, Billy Bob's Jerky Inc. (the Applicant) filed an application to register the trade-mark BILLY BOB'S JERKY (the Mark). The application was filed on the basis of the Applicant's use in Canada since March 2004 in association with the following wares and services:

Food products namely beef jerky (the Wares).

Operation of a business dealing in the manufacture, distribution and sale of beef jerky products (the Services).

[2] The application was advertised for opposition purposes in the Trade-marks Journal of December 27, 2006.

[3] On July 9, 2007, Tritap Food Broker, A Division of 676166 Ontario Limited (the Opponent) duly filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant did not use the Mark since the date in the application;
- (b) contrary to s. 30(i) of the Act, the Applicant was well aware of the prior use and registration of the Opponent's trade-mark BILLY BOB'S and could not have been satisfied of its entitlement to use the Mark;
- (c) contrary to s. 12(1)(d) of the Act, the Mark is not registrable as it is confusing with registration No. TMA402,842;
- (d) contrary to s. 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of first use and on the filing date it was confusing with the Opponent's use of the BILLY BOB'S trade-mark; and
- (e) contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant.

At the hearing, the Opponent referred to the typographical error in the third ground of opposition which should have identified s. 16(1)(a) instead of s. 16(3)(a). Given the wording of this ground of opposition, it was clear that the Opponent was relying on s. 16(1)(a) and as such this typographical error is of no consequence.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavits of Joel Usher and Jaclyn M. Seidman. In support of its application, the Applicant filed the affidavits of Michelle Andersen and Robert Finley. Both parties filed a written argument. On November 15, 2010 an amended application from the Applicant was accepted wherein use by the Applicant and its predecessor-in-title was claimed. Only the opponent was represented at the hearing on January 23, 2012.

Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably

be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[7] The material dates with respect to the grounds of opposition are as follows:

- s. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(1) of the Act – the claimed date of first use in the application; and

- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Preliminary Issue: Admissibility of Evidence

Evidence Filed by Solicitor

[8] The Opponent filed an affidavit of Jaclyn Seidman, a barrister and solicitor employed by its agent. Ms. Seidman attended various stores to confirm the availability of the wares such as those applied-for or registered by the Opponent and performed Internet searches with the terms “beef jerky and rice” and “beef jerky and ketchup”. The Applicant argued that Ms. Seidman’s evidence should be disregarded as she is a solicitor for the Opponent and her evidence is contentious. If the content of her affidavit relates to uncontested issues it may be accepted. However, on contested issues, the situation is different [*Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada*, (2005), 43 C.P.R. (4th) 21 (F.C.)]. To the extent that Ms. Seidman reports the results of either her visits to stores or internet searches to demonstrate the potential overlap between the parties’ wares her evidence is inadmissible [*Campbell Soup Co. v. Fancy Pokket Corp.*, (2006), 56 C.P.R. (4th) 359 (T.M.O.B.) at 363].

Registrations Referenced at the Hearing

[9] At the hearing, the Opponent submitted that registration Nos. TMA776,611; TMA680,765 and TMA732,038, which are owned by third parties and cover seasoned and processed beef or jerky and various sauces and condiments, showed the overlap between the parties' wares. As I cannot have regard to information appearing on the register which is not filed by affidavit or certified copy, with the exception of verifying that properly pleaded trade-mark registrations and applications are extant, I will not take these registrations into account. [*Retail Royalty Co. v. Hawke & Co. Outfitters LLC* (2011), 94 C.P.R. (4th) 323 (T.M.O.B.) at para. 47].

Section 30 Grounds of Opposition

[10] The Opponent has pleaded that the application is contrary to s. 30(b) and 30(i) of the Act.

[11] The s. 30(b) ground alleges that the Applicant had not used the trade-mark since the date stated in the application. As the Applicant amended its application to include use by its predecessor-in-title who was using the Mark as of March, 2004, the subject application complies with s. 30(b). As such, this ground of opposition is dismissed.

[12] The s. 30(i) ground alleges that the Applicant could not have been properly satisfied that it was entitled to use the Mark because the Applicant must have been aware of the Opponent's trade-mark. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith [see *Sapodilla Co. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the s. 30(i) ground is dismissed.

Section 12(1)(d) Ground of Opposition

[13] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. I have exercised my discretion to confirm that registration No. TMA402,842 for BILLY BOB'S is in

good standing [*Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. The registered wares are:

- (1) Packaged main meal mixes containing a pasta, rice or vegetable base, or combination thereof, rice and rice mixes, and stuffing mixes.
- (2) Condiments, namely, mustard and ketchup, packaged sauce mixes in both liquid and powder form, mashed potato mixes

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. In this case, I consider it appropriate to analyze the degree of resemblance between the parties' marks first.

6(5)(e) – degree of resemblance

[16] I find that the trade-marks at issue, when considered as a whole, visually and aurally resemble each other to a significant degree because the Mark contains the Opponent's mark in its entirety. Furthermore, the component JERKY is descriptive and cannot serve to distinguish the Mark [*Reno-Dépôt Inc. v. Homer TLC Inc.* (2009), 84 C.P.R. (4th) 58 (T.M.O.B.) at para. 58]. Having found the parties' marks highly similar, I must now assess the remaining surrounding circumstances to determine whether these factors are significant enough to shift the balance of probabilities in favour of the Applicant [*Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

s. 6(5)(a) - inherent distinctiveness and the extent to which each trade-mark has become known

[17] Both marks have a very low degree of inherent distinctiveness as BILLY BOB is likely to be perceived to be the first name of a real or fictitious person [*E. & J. Gallo Winery v. Terraustral S.A.*; 2011 CarswellNat 5397 (T.M.O.B.) at para. 22]. As such, the Opponent's mark is a weak mark. K. Gill and R.S. Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed., Carswell, at ps. 8-27-28 state:

Marks that have no inherent distinctiveness deserve the smallest ambit of protection. As such, geographic locations, personal and surnames, initials, descriptive terms, common prefixes, common symbols and even registered marks that have become generic are not inherently distinctive and should generally not be accorded a broad ambit of protection.

[18] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of Mr. Usher, Secretary of the Opponent, shows that the Opponent's BILLY BOB trade-mark has become known to some extent in Canada as the 2007-2008 annual sales of its registered wares in association with its trade-mark are in excess of 325,000 units and total approximately \$150,000 (paras. 6-7). The evidence of Mr. Finley, Director of the Applicant, shows that the Mark has become known to some extent in British Columbia as the revenue associated with the sales of the Wares and Services in association with the Mark totaled over \$600,000 from June 1, 2005 to September 30, 2008 (para. 28). As such, the marks of each party appear to be known to a similar degree.

s. 6(5)(b) - the length of time each trade-mark has been in use

[19] The Opponent's mark has been used in association with its registered wares since November 1991 (Usher affidavit, para. 3). As the Applicant's predecessor in title only began using its mark in 2004, this factor favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[20] Both parties submitted evidence directed at the nature of wares, services and trade. The Opponent submitted in its written argument that the Mark and the Opponent's mark are both "intended for use with food items, and moreover, food items which compliment each other". Although food items belong to the same general class of goods and are sold in the same stores,

they may also be intrinsically different [*Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd.* (1981), 55 C.P.R. (2d) 39 at 44 (F.C.A.); *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) at 490]. I consider this to be the situation here. Beef jerky is a stand alone snack food which can be consumed directly after purchase. In contrast, none of the Opponent's registered wares are snack foods. Furthermore, none of the Opponent's wares could be consumed directly after purchase. The Opponent's mixes require preparation and the Opponent's condiments must be added to or paired with other food [*Loblaws Inc. v. Tritap Food Broker* (1992), 3 C.P.R. (4th) 108 (T.M.O.B.) at 115-116]. The Opponent relies on Ms. Seidman's affidavit attaching various recipes for beef jerky or recipes using beef jerky as an ingredient. I have already ruled that Ms. Seidman's evidence is inadmissible. Even if I had accepted the recipes as admissible, it would not have persuaded me that the nature of the parties' wares overlaps since all it shows is that a few such recipes exist. This evidence does not prove nor result in the inference that consumers understand beef jerky, rice and ketchup to be of a similar nature. Second, the Opponent argues that the parties wares compliment each other because both may be spicy or hot flavoured. The Opponent's registration, however, does not entitle it to a monopoly over all spicy or hot products.

[21] The Opponent also argued that the nature of trade overlaps. Mr. Usher states that the Opponent sells its wares to department stores, dollar stores and grocery stores (para. 4). Mr. Finley states that the Wares are sold at a variety of locations including grocery stores, liquor stores, delis, convenience stores, golf courses and restaurants (para. 11). Therefore, there is some overlap in the nature of trade. Given that the nature of the parties' products are different, I find it likely that they would be sold in different sections of grocery stores, convenience stores and the like. I note that if I had found Ms. Seidman's evidence admissible it would not have assisted the Opponent to a great extent as it does not show the parties' wares being sold in close proximity.

[22] Finally, I find that the Services are of a different nature than the Opponent's wares given that they concern the manufacture, distribution and sale of an unrelated food type.

surrounding circumstances

[23] The Applicant submitted the evidence of Michelle Anderson an employee of its agent, which concerned the co-existence of identical or similar third party trade-marks for use in association with food products. I do not consider this evidence relevant as one cannot infer from it the state of the marketplace or the general mindset of consumers as to the potential relationship between the parties' wares [*Societe Anonyme des Eaux Minerales d'Evian, S.A. v. Marcon*; 2010 CarswellNat 2538 (T.M.O.B.) at para. 22].

conclusion

[24] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. In view of the fact that the Opponent's mark consists of a first name and is a weak mark, the differences between the Opponent's wares and the Wares and Services are sufficient to eliminate a likelihood of confusion. Accordingly, this ground of opposition is dismissed.

Section 16(1)(a) Ground of Opposition

[25] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the BILLY BOB'S trade-mark. The Opponent has the initial evidential burden to prove prior use of its trade-mark in Canada as of the date of first use claimed in the application and that such use was not abandoned at the advertisement date of this application. The Applicant argues that a related company to the Opponent used the BILLY BOB'S trade-mark and its use does not enure to the benefit of the Opponent. It was open to the Applicant to cross-examine Mr. Usher if it wished to explore what it perceived as the deficiencies in his affidavit, but it chose not to [*Service Experts Inc. v. Pope & Sons Refrigeration Ltd.* (2011), 93 C.P.R. (4th) 313 (T.M.O.B.) at para. 12]. I find that the evidence provided by Mr. Usher is sufficient to find that the use of the BILLY BOB'S trade-mark enured to the Opponent [*Billy Bob's Jerky Inc. v. Tritap Food Broker*; 2010 CarswellNat 1950 (T.M.O.B.) at paras. 12-14].

[26] For the reasons set out in the discussion of the s. 12(1)(d) ground of opposition, I do not find that the Mark was confusing with the Opponent's BILLY BOB'S trade-mark as of the relevant date (March 2004).

Distinctiveness

[27] The Opponent has pleaded that the Mark does not distinguish the Wares and Services from the Opponent's wares. The conclusion reached on the issue of likelihood of confusion between the Mark and the Opponent's trade-mark under the s. 12(1)(d) ground of opposition is equally applicable to this ground of opposition. Consequently the Mark is adapted to distinguish and actually distinguishes the Wares and Services from the Opponent's wares. Accordingly, this ground of opposition is also dismissed.

Disposition

[28] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office