

IN THE MATTER OF AN OPPOSITION by Culinar
Inc. to application No. 515,648 for the trade-mark
STUART ANDERSON'S filed by Saga Enterprises,
Inc.

On January 24, 1984, the applicant, Saga Enterprises, Inc., filed an application to register the trade-mark STUART ANDERSON'S based upon use and registration of the trade-mark in the United States of America in association with "restaurant services". The applicant claimed and was accorded the benefit of Section 14 of the Trade-marks Act, the applicant having relied upon the affidavit of Beverly J. Wootton in support of its Section 14 claim.

The opponent, Culinar Inc., filed a statement of opposition on August 6, 1985 in which it alleged that the applicant's trade-mark STUART ANDERSON'S is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user in Canada by the opponent and its predecessor-in-title, Stuart Ltée, of the registered trade-marks STUART & Design, registration No. 265,481, STUART & Design, registration No. 128,823 and STUART & Design, registration No. 128,825. The opponent further relied upon prior user by it and its predecessors-in-title, Stuart Limitée (previously named Compagnie de Biscuits Stuart Limitée) of the trade-mark STUART in association with cakes and pastries in challenging the applicant's entitlement to registration and the distinctiveness of the applicant's trade-mark.

During the opposition proceeding, the opponent requested and was granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition in order to make reference to prior user by its predecessor-in-title, Stuart Limitée, of the three registered STUART & Design trade-marks, as well as to include reference to a further predecessor-in-title, Stuart & Herbert Ltd., who had previously used the trade-mark STUART in Canada.

The applicant served and filed a counterstatement in which it denied the allegations of confusion asserted by the opponent in its statement of opposition.

The opponent filed as its evidence the affidavits of Robert Charbonneau and Jacques Perreault while the applicant, by way of its correspondence of April 12 and April 18, 1988, advised the Opposition Board that it did not wish to adduce any evidence in this opposition pursuant to Rule 44 of the Trade-marks Regulations.

The applicant alone submitted a written argument while both parties were represented at an oral hearing.

With respect to its Section 16 ground of opposition, there is a burden on the opponent in view of Sections 16(5) and 17(1) of the Trade-marks Act to establish prior user by it (and/or its predecessors-in-title) of the trade-marks being relied upon in the statement of opposition, as well as non-abandonment of the trade-marks as of the date of advertisement of the applicant's application in the Trade-marks Journal (March 6, 1985). With respect to the trade-marks identified in the statement of opposition, the most relevant is the trade-mark STUART as applied to cakes and pastries. Having regard to the Perreault affidavit, I am satisfied the opponent has met the burden upon it of establishing prior use of the trade-mark STUART in Canada in association with cakes and pastries, as well as non-abandonment of the trade-mark as the March 6, 1985.

In view of the above, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark STUART ANDERSON'S as applied to restaurant services and the opponent's trade-mark STUART as applied to cakes and pastries. 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 material dates with respect to the non-entitlement and non-distinctiveness grounds of opposition are the filing date of the applicant's application (January 24, 1984) and the date of the opponent's opposition (August 6, 1985) respectively.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark STUART ANDERSON'S as applied to restaurant services and the opponent's trade-mark STUART as applied to cakes and pastries possess little inherent distinctiveness, having regard to the name and surname significance associated with the trade-marks. The applicant in its written argument conceded that the opponent's trade-mark STUART had become well known in Canada in association with cakes and pastries as of either of the material dates in this opposition. Further, as the applicant failed to file any evidence in this opposition and did not indicate its intention to rely upon the Section 14 evidence filed during the examination stage of the application, the applicant's trade-mark must be assumed to have not become known to any extent in this country as of either of the material dates. Likewise, the length of time that the trade-marks have been in use is a further factor weighing in the opponent's favour in view of the opponent's evidence of use of the trade-mark STUART in Canada by it and its predecessors since 1920.

As to the nature of the wares and services of the parties, both trade-marks are broadly associated with the food industry although the applicant's trade-mark STUART ANDERSON'S is

applied to restaurant services while the opponent's trade-mark STUART is applied to food products which one might possibly find in a restaurant. Further, the Perreault affidavit establishes that the opponent operates restaurants in association with trade-marks other than the trade-mark STUART.

With respect to the nature of the trade associated with the applicant's restaurant services and the opponent's food products, I would note the following comments of the Member of the Opposition Board in Spectrum Foods Inc. v. Campbell Soup Co. Ltd., 15 C.P.R. (3d) 358, at pg. 361:

"...I would note that it is not uncommon for restaurants to also sell food products and for food and grocery stores to also provide services in the nature of a restaurant. Furthermore, the opponent's application No. 484,650 is for "restaurant services" which is a very broad term that could include not only the operation of a restaurant but also such restaurant-related services as the provision of food and supplies to restaurants. Since the applicant's proposed wares are of the type which could be sold not only to retail grocers but also to restauranteurs, there would appear to be a potential connection between the trades of the parties."

Likewise, in the present case, the applicant's "restaurant services" are so broad in scope as to include such restaurant-related services as the provision of food and supplies to restaurants. Further, the opponent's wares could certainly be sold to restaurants, as well as to grocery stores and supermarkets, the latter of which often provide services which could be characterized broadly as restaurant services.

As to the degree of resemblance between the trade-marks at issue, there is some similarity in sounding and appearance between the trade-marks STUART and STUART ANDERSON'S, and both trade-marks suggest the idea of a name or surname.

In its written argument, the applicant submitted that the opponent's trade-marks in association with bakery products are so well known in Canada that the ordinary consumer is not likely to confuse them with the trade-mark STUART ANDERSON'S for restaurant services. In this regard, the applicant has relied upon the decision of Jackett, P. in Imperial Oil Limited v. Superamerica Stations Inc., 47 C.P.R. 57. In my opinion, the Imperial Oil decision is not authority for the general proposition that a burden on an applicant in respect of the issue of confusion diminishes when considering the likelihood of confusion between the applicant's trade-mark and a well known or famous trade-mark. I had occasion to deal with a similar submission made by the applicant in Procter & Gamble Co. v. London Drugs Ltd., 23 C.P.R. (3d) 512, and commented as follows at pages 515 to 517:

Having regard to the above, and bearing in mind that the applicant failed to file any evidence in this opposition, I have concluded that the applicant has failed to discharge the burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks STUART and STUART ANDERSON'S as applied to the respective wares and services of the parties. Accordingly, the applicant is not the person entitled to registration of the trade-mark STUART ANDERSON'S.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF MARCH, 1990.

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