

IN THE MATTER OF AN OPPOSITION by Rothmans,  
Benson & Hedges Inc. to application No. 641,090 for the  
mark NÉCESSAIRE-MINUTE filed by Imperial Tobacco Limited

On September 25, 1989, the applicant Imperial Tobacco Limited filed an application to register the mark NÉCESSAIRE-MINUTE based on intended use of the mark in Canada in association with

manufactured tobacco products, cigarette tubes and cigarette making kits.

The application was advertised for opposition purposes on July 4, 1990. The opponent Rothmans, Benson & Hedges Inc. filed a statement of opposition on November 2, 1990. The statement was amended twice as a result of objections raised by the board and a copy of the final amended statement was forwarded to the applicant on May 28, 1991. The applicant responded by filing and serving a counter statement.

The determinative issue in this case as defined by the pleadings is whether the applied for mark NÉCESSAIRE-MINUTE is clearly descriptive of the character or the quality of the applicant's wares and therefore not registrable in view of Section 12(1)(b) of the Trade-marks Act. That issue is to be decided from the point of view of an everyday user of the wares considering the mark in its entirety (as opposed to carefully analyzing and dissecting the mark into its component parts) and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade-marks (1978), 40 C.P.R. (2d) 25 at 27-28 (F.C.T.D.); Atlantic Promotions Inc. v. Registrar of Trade-marks (1984), 2 C.P.R. (3d) 183 at 188 (F.C.T.D.). The material time for considering the circumstances respecting a ground of opposition based on Section 12(1)(b) is as of the date of my decision: see Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992) 41 C.P.R.(3d) 234 (F.C.A.). The legal burden is on the applicant to establish that its mark is not clearly descriptive. Ordinarily there is an evidential burden on the opponent to adduce sufficient evidence which, if believed, would support its allegation that the applied for mark offends the provisions of Section 12(1)(b). However, an opponent need not necessarily adduce

evidence in a case such as this where the opponent's legal argument may be based entirely on the ordinary meaning of words. The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached after all the evidence is in and after the arguments are heard, then the issue must be decided against applicant: see Joseph E. Seagram & Sons v. Seagram Real Estate Ltd. (1984), 3 C.P.R.(3d) 325 at 329-330 (TMOB); John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.).

The opponent's evidence consists of the affidavit of Jean-Pierre Suys, an employee of the opponent company, and the affidavit of Thomas T. Reider. Neither of the above affidavits are particularly helpful in advancing the opponent's case. In this regard, I have disregarded opinion evidence in areas for which the affiants have not established either expert qualifications or the facts underlying such opinions, and I have given reduced weight to evidence regarding the interpretation of English and French words and phrases where such evidence appears to be based on the affiants' personal perceptions. The applicant's evidence consists of the affidavit of Melissa Reischer, trade-mark searcher. That evidence too is not helpful for reasons which will be discussed later. Both parties filed a written argument and both parties were represented at an oral hearing. At the oral hearing counsel for the opponent sought to bring to my attention a tobacco product and a cigarette tube allegedly comprising part of the applicant's INSTA-KIT product. As counsel for the applicant indicated that he did not object, I had regard to that material which is now of record in this file.

The opponent's evidence and argument may be summarized as follows. The primary meaning of the French word "nécessaire" is "necessary", however, the term is commonly used in French to refer to a kit. A kit in the context of the tobacco industry is understood to be comprised of cut tobacco, empty cigarette tubes and a mechanical combiner used to form the finished cigarette. At some time prior to February 27, 1992 (the date of execution of Mr.

Suys' affidavit), the applicant was actually selling such kits under the applied for mark NÉCESSAIRE-MINUTE. The primary meaning of the French word "minute" is a minute of time, however, the term is commonly used in French to mean "jiffy", "quick" or "instant." The average French speaking consumer would understand the term NÉCESSAIRE-MINUTE to describe an "instant kit" or a "quick kit." The conclusions urged by the opponent are that the term NÉCESSAIRE-MINUTE, when used in association with the applicant's wares, clearly describes a kit for the quick assembly of cigarettes, or that the term NÉCESSAIRE-MINUTE is an elliptical expression for the French phrase ""nécessaire pour fabriquer des cigarettes dans une minute" and is therefore not registrable.

The applicant's evidence and argument may be summarized as follows. The applied for mark NÉCESSAIRE-MINUTE is merely suggestive of a character or quality of the wares. The primary meaning of the word combination NÉCESSAIRE-MINUTE is "a necessary minute of time." Even if the term is understood by French speaking persons to mean a "quick kit", the primary meaning of that expression is a kit to make a quick, which is nonsensical. The secondary meaning of the term "quick kit" is "a kit which is quick". The conclusion urged by the applicant is that the applied for mark is not clearly descriptive of the applicant's wares because neither the primary nor the secondary meaning of the term NÉCESSAIRE-MINUTE have a readily discernable interpretation.

The applicant also relies on the state of the trade-marks register and has evidenced, *inter alia*, the following registrations: MINUTE (for food mixes), MINUTE WAX (for surface finishing preparations), MINUTE (for pizza sauce), MINUTE PIZZA (for pizza sauce and prepared pizza), REPAS MINUTE (for meat turnovers), MINUTE WAXER (for wax impregnated sponges and cloths), SALADE MINUTE (for packaged fresh vegetables), MINUTE-MATIN(for various breakfast entrees). The applicant submits that "refusal of the present application would result in an unexplained inconsistency in light of similar marks on

the register of trade-marks and such inconsistencies should be avoided." I do not consider that this latter submission has any merit in opposition proceedings. This board is not in a position to explain why particular marks were permitted to proceed to registration by the examination section of the Trade-marks Office, and in any event the legal burden or onus on an applicant is different at the examination stage: see Simmons I.P. Inc. v. Park Avenue Furniture Corp. (1994), 56 C.P.R.(3d) 284 at 288 (TMOB).

In my view, the phrase NÉCESSAIRE-MINUTE, used in association with manufactured tobacco products and cigarette tubes, suggests that the wares are compatible with a cigarette making kit. A suggestive mark is registrable, hence, the opponent's opposition is rejected with respect to the wares "manufactured tobacco products and cigarette tubes." Further, I find that it requires a mental exercise, albeit a minor one (see GWG Ltd. v. Registrar of Trade-marks (1981) 55 C.P.R.(2d) 1(F.C.T.D.)), to attribute to the applicant's kit those qualities which are intimated by the mark namely, that the kit can be used to make cigarettes quickly, or that the kit that is complete in having all the necessary material and devices to make cigarettes. In any event, I find that the mark NÉCESSAIRE-MINUTE does not have a plain, unambiguous meaning in relation to "cigarette making kits." It follows that the applied for mark is not clearly descriptive of the applicant's kits.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 28<sup>th</sup> DAY OF FEBRUARY, 1995.

Myer Herzig,  
Member,  
Trade-marks Opposition Board