IN THE MATTER OF AN OPPOSITION by Parrish & Heimbecker, Limited to application No. 661,159 for the trade-mark EMPIRE KOSHER POULTRY & Design filed by Empire Kosher Poultry, Inc.

On June 27, 1990, the applicant, Empire Kosher Poultry, Inc, filed an application to register the trade-mark EMPIRE KOSHER POULTRY & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as 1975. The applicant disclaimed the right to the exclusive use of KOSHER and POULTRY apart from its trade-mark. During the opposition, the applicant amended its statement of wares to cover the following:

> "*kosher products namely, tray pack chicken breast, tray pack chicken cut up, tray pack chicken legs, tray pack chicken thighs, tray pack chicken wings, barbecue chicken, barbecue turkey, fried chicken patty nuggets, fried chicken breasts, fried chicken drums/thighs, fried chicken parts, turkey breast, young tom turkey (grade A frozen), young turkey (utility grade), rock cornish, stewing hen, young chicken (utility grade) frozen, young chicken (utility grade) fresh, cornish, mechanically deboned chicken, fryer chicken legs, frying chicken cut-ups*".

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of July 31, 1991 and the opponent, Parrish & Heimbecker, Limited, filed a statement of opposition on August 29, 1991. In its statement of opposition, the opponent alleged that the applicant has not used its trade-mark in association with the wares covered in the present application since the claimed date of first use. As its remaining grounds, the opponent pleaded 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 EMPIRE KOSHER POULTRY & Design is confusing with its registered trade-mark EMPIRE, registration No. TMDA 15714 covering “barrelled pork, chickens, bacon, sausage, lard,; fresh meats, cured meats, smoked meats, cooked meats; turkeys” which had been previously used in Canada by the opponent’s predecessors-in-title and continues to be used by the opponent.

The opponent filed as its evidence the affidavit of Thomas Grant McMahon which was subsequently replaced by the affidavit of Vernon Glen Ashley. Mr. Ashley was cross-examined on his affidavit, the transcript of the cross-examination and the responses to undertakings given during the cross-examination forming part of the opposition record. The applicant filed as its evidence the affidavits of J. Ronald Swanger and Barney Barenholtz and the statutory declaration of Donald Weidman. As evidence in reply, the opponent submitted the affidavits of Wayne Arnold and Dick Friesen. Both parties filed written arguments and both were represented at an oral hearing.

While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of the Section 30 ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. While the opponent has alleged that the applicant has not used its trade-mark since the claimed date of first use, the opponent has not filed any evidence in support of its Section 30(b) ground. Moreover, the applicant's evidence is not inconsistent with its claim that it has used its trade-mark in Canada since as least as early as 1975. As a result, I find that the opponent has failed to meet the evidential burden upon it in respect of its first ground and have therefore dismissed the first ground of opposition.

The only remaining issue for consideration in this opposition is whether there would be a reasonable likelihood of confusion between the applicant's trade-mark EMPIRE KOSHER POULTRY & Design as applied to the wares covered in the applicant's amended application and the opponent's trade-mark EMPIRE as registered and previously used in Canada. A photocopy of the opponent's registration for the trade-mark EMPIRE, registration N°. TMDA 15714, is annexed as an exhibit to the Ashley affidavit. The photocopy of the registration reveals that the trade-mark EMPIRE was registered April 25, 1911 and, as of the date when the photocopy was prepared, stood in the name of Parrish & Heimbecker Limited and covered the following wares: "*Barrelled pork, chickens, bacon, sausage, lard; Fresh meats, cured meats, smoked meats, cooked meats; Turkeys*". At the oral hearing, it was noted that registration N°. TMDA 15714 was amended as a consequence of Section 45 proceedings and presently covers only "Turkeys". Furthermore, the Ashley affidavit establishes prior use by the opponent and its predecessors of the trade-mark EMPIRE in association

primarily with turkeys, as well as evidence that it had not abandoned its mark as of the date of advertisement of the present application [July 31, 1991].

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 on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material dates. With respect to the ground of opposition based on Section 12(1)(d) of the ***Trade-marks Act***, the material date is the date of my decision [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)]. The material dates in relation to the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's claimed date of first use and the date of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's trade-mark EMPIRE as applied to "Turkeys" is inherently distinctive in that it is neither descriptive nor suggestive of the opponent's wares, nor does it possess any other apparent significance which would impact on its inherent distinctiveness. Likewise, the applicant's trade-mark EMPIRE KOSHER POULTRY & Design, when considered in its entirety, is inherent distinctive although the words KOSHER and POULTRY are descriptive of the character of the applicant's wares and therefore add no inherent distinctiveness to the mark. In this regard, the words KOSHER and POULTRY have been disclaimed by the applicant apart from its trade-mark.

The Ashley affidavit establishes that the opponent's trade-mark EMPIRE has become relatively well known in Canada in association with turkeys with sales by the opponent and its predecessors, Gainers Inc. and Swift Canadian Co. Limited, from 1973 to 1991 inclusive exceeding 183,000,000 pounds. I would note that the photocopies of the opponent's specimen invoices identify the volume of turkey being sold by the opponent and its predecessors in pounds. On the other hand, the Barenholtz affidavit attests to approximately $1,830,000 in sales in Ontario and Quebec by Kofman-Barenholtz Foods Limited, a distributor of the applicant, of the applicant's wares in

association with the trade-mark EMPIRE KOSHER POULTRY & Design from 1990 to 1993 inclusive. Thus, based on the evidence of record, the extent to which the trade-marks at issue have become known clearly favours the opponent in this proceeding. Likewise, based on the evidence of the parties, the length of use of the trade-marks of the parties favours the opponent in this opposition in that the applicant's trade-mark EMPIRE KOSHER POULTRY & Design has been used in Canada since 1978 [paragraph 3 of the Weidman statutory declaration] whereas the opponent's evidence establishes that it has used its trade-mark EMPIRE since at least 1973.

The trade-marks at issue are very similar in appearance and in sounding although the marks do not suggest any readily apparent idea in common other than whatever idea might be conveyed by the element EMPIRE. Moreover, it is noted that the applicant's trade-mark incorporates as its dominant element the entirety of the opponent's mark EMPIRE. As a result, the only remaining criteria which Section 6(5) of the ***Trade-marks Act*** specifically requires that I consider apart from any other surrounding circumstances are the nature of the wares of the parties and their respective channels of trade.

With respect to the wares covered in the present application, the applicant has pointed out that there are important differences in the kosher poultry process compared to non-kosher poultry and meats. Kosher poultry is prepared according to very specific rules in that the process of slaughtering an animal requires that it be done in a certain fashion by a ritually trained slaughterer who says prayers and then completes the slaughtering process in a particular manner. The product is then examined for flaws, cleaned, salted and packed in ice or kept in cold for a period of time in accordance with religious law. The process for preparing the animals for market continues under religious supervision. The recognition by the purchasing public assures that the product is strictly kosher and this assurance is extremely important for religious Jewish people since they never eat non-kosher meat or poultry, unless faced with a life threatening situation. Producing kosher products means extra time of preparation and special installations which result in extra cost. Kashruth restrictions apply to the diet and treatment of poultry, as well as to the slaughtering and processing. Quality control and Rabbinic supervision are required at every stage of growing and production of the applicant's poultry. The applicant is a totally integrated kosher poultry producer and processor.

It does not appear that the opponent sells kosher turkeys although the opponent's registration covers turkeys which could be either kosher or non-kosher. Further, and to the extent that the opponent's turkeys are non-kosher, there would be differences in the wares of the parties. However, there is a potential overlap in the channels of trade through which the wares of the parties could travel. In this regard, the Ashley affidavit points to the opponent's turkeys being sold to the public in supermarkets and other food stores while the Barenholtz affidavit and Weidman statutory declaration attest to the applicant's products being sold to consumers through retail stores, independent stores, delis and caterers. Nevertheless, according to both Weidman and Barenholtz, the applicant's kosher meat and poultry products are displayed in a different place than the non-kosher meat and poultry and the kosher meat and poultry are specifically identified as such while kosher frozen foods are segregated from non-kosher frozen foods. Furthermore, while the Friesen affidavit attests to the affiant having purchased the applicant's KOSHER EMPIRE POULTRY & Design turkey breast in an IGA store in Winnipeg, the affidavit is silent as to whether the applicant's wares were segregated from non-kosher poultry being sold in the same store or whether the opponent's EMPIRE turkeys were being sold in that store..

With respect to the wares of the parties, I would expect the average consumer of the applicant's kosher poultry and meat products to be discriminating purchasers who would not be confused by the trade-marks at issue as applied to the respective wares of the parties. On the other hand, I am of the view that the average consumer who is aware of the opponent's EMPIRE turkeys and who is not Jewish might well conclude that kosher meat and poultry bearing the trade-mark EMPIRE KOSHER POULTRY & Design is another line of products being produced by the opponent. While it might well be that a producer of non-kosher meat and poultry products would not produce a line of kosher meat and poultry products, I certainly have my doubts that the average consumer who may not necessarily be Jewish and who might still encounter the applicant's wares in the marketplace would be aware that such may be the case.

The applicant has relied upon there being no evidence of actual confusion between the trade-marks at issue despite the concurrent use of the trade-marks of the parties over an extended period of time. However, from the applicant's evidence, it would appear that its wares are segregated from

non-kosher products in the marketplace, thus minimizing the likelihood of there being instances of actual confusion. Furthermore, it is unlikely that the average Jewish consumer who would be purchasing the applicant's wares would be confused and, even if the average non-Jewish consumer were to encounter the applicant's wares in the same supermarket or grocery store as the opponent's wares, he or she would have no reason to purchase kosher meat or poultry and would therefore not be concerned even if he or she were to think that it is another line of EMPIRE turkeys or poultry being marketed by the opponent.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the ***Trade-marks Act***, I refuse the applicant's application.

DATED AT HULL, QUEBEC THIS 25th DAY OF SEPTEMBER,1996.

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