

**IN THE MATTER OF AN
OPPOSITION by Maison Cousin
(1980) Inc. to Application No. 813812
for the Trade-mark COUSINS Filed
by Cousins Submarines, Inc.**

I The Pleadings

Cousins Submarines, Inc. (the «Applicant») filed on May 29, 1996 an application, based on proposed use, to register the trade-mark COUSINS (the «Mark») in association with sandwiches, namely: submarine sandwiches; beverages, namely: carbonated beverages, coffee, milk and ice tea (the “Wares”) and restaurant services (the “Services”). The application was published on May 20, 1998 for opposition purposes.

Maison Cousin Inc. filed on October 20, 1998 a statement of opposition raising the following grounds of opposition:

a) The Mark is not registrable having regard to Subsection 12(1)(d) of the Trade-Marks Act (the “Act”) because it is confusing with the Opponent’s registered trade-mark MAISON COUSIN & DESIGN, certificate of registration number TMA130985 issued on May 10, 1963, in association with French bread, Canadian bread, crusty bread, whole wheat bread, diet bread, rolls, raisin bread, and all types of bread, of all descriptions and all forms in all cases; French pastries and cakes of all types, for all occasions, sandwich rolls, croissants, salad loaves, dry petit fours, diet loaves, pies of all types, buns of all types, puff pastries, wedding cakes, tiered cakes; cooked meats and meat pâtés of all types, pâtés de foie gras, garlic sausage, galantines, potted meats, salamis, meat in slices, tiered cakes for buffets, salads, sandwiches, and all deli items including frozen dishes; candy and chocolate in all forms, of all types and of all kinds, for all occasions. (The “Opponent’s Products”)

b) The Applicant is not the person entitled to the registration of the Mark having regard to Subsection 16(3)(a) of the Act because it is confusing with the Opponent’s previously used trade-mark MAISON COUSIN & DESIGN, certificate of registration number TMA130985 registered on May 10, 1963 in association with the Opponent’s Products

and with the trade-mark MAISON COUSIN¹⁹²¹ & DESIGN, application number 869625 filed on February 16, 1998 and used since at least as early as May 1987 in association with French bread, Canadian bread, crusty bread, whole wheat bread, diet bread, rolls, raisin bread, and all sorts of bread, of all description and all forms in all cases; French pastries and cakes of all types, for all occasions, bread rolls, croissants, salad breads, dry petit fours, diet breads, tarts of all sorts, buns of all sorts, puff pastries, wedding cakes, ornamental cake; frozen precooked bread, cheese bread, cookies of all sorts.

c) The Applicant's alleged Mark is not distinctive of the Applicant's Wares and Services and has not been adapted to distinguish the Applicant's Wares and Services from the wares of the Opponent. The Opponent has used its MAISON COUSIN & DESIGN and MAISON COUSIN¹⁹²¹ & DESIGN marks as trade-marks in Canada for several years in association with the Opponent's Products, bread rolls, ornamental cake, frozen precooked bread, cheese bread, and cookies of all sorts.

The Applicant denied in its counter statement the allegations contained in the statement of opposition. Both parties filed written submissions and a hearing took place where both parties were represented.

II The Evidence

The Opponent filed the affidavits of Mr. Michel Doyon and Ms. Micheline Tellier while the Applicant filed the affidavit of Mr. James A. Schrank. Only Mr. Schrank was cross-examined and the transcript was filed in the record.

Ms. Tellier has been a paralegal employed by the Opponent's agents. She filed as exhibit MT-1 a copy of the file wrapper of the application that led to the issuance of certificate of registration TMA130985 for the trade-mark MAISON COUSIN & Design as hereinafter reproduced:



hereinafter referred to as “COUSIN DESIGN”

She also filed the file wrapper of application number 869625 for the trade-mark MAISON COUSIN & Design, illustrated herein below that lead to the issuance of certificate of registration TMA523147:



Maison Cousin

hereinafter referred to as “COUSIN1921 DESIGN”

The other documents annexed to her affidavit relate to the Opponent’s corporate changes and after review of same I’m satisfied that the entity identified as the Opponent has proper standing to act as such and is the owner of the abovementioned trade-mark registrations.

Mr. Doyon has been the Opponent’s executive vice-president. He filed, as exhibits MD-1 and MD-2 respectively, certifications of authenticity for registration numbers TMA130985 and TMA523147. It should be noted that the Opponent never saw fit to ask permission to amend its statement of opposition to add under its non-registrability ground of opposition (Section 12(1)(d)), certificate of registration TMA523147. I should also add at this stage that Mr. Doyon often refers to the word mark MAISON COUSIN but use of such registered or unregistered trade-mark was never alleged in the Opponent’s statement of opposition. I shall limit my analysis of the evidence to the grounds of opposition raised in the pleadings. Nowhere in its statement of opposition the Opponent indicated its intention to rely on other trade-marks than those specifically alleged in such pleading.

The affiant is alleging that the Opponent has been using the COUSIN DESIGN trade-mark since 1960 and the COUSIN1921 DESIGN trade-mark since May 1987. However these allegations constitute conclusion in law, as the term “use” is a legal term defined at Section 4 of the Act. The evidence filed by the Opponent falls short from supporting such statements for the reasons hereinafter set forth.

The only exhibits that bear the COUSIN DESIGN mark are copies of two different letterheads. There are however minor differences between the design appearing on each letterhead and the COUSIN DESIGN. In any event, trade-marks appearing on letterhead do not constitute prior use of a registered trade-mark in association with wares. There has been no packaging or labels bearing the COUSIN DESIGN mark filed in the record. As such I have no evidence of use of the COUSIN DESIGN mark in association with any of the Opponent’s Products.

Exhibit MD-5 consists of samples of packaging of various types of bread. Two of them, “two cheeses bread” and “Raisin bread” bear the COUSIN1921 DESIGN mark. The other samples bear either the circle design feature of the COUSIN1921 DESIGN mark or the stylized inscription of MAISON COUSIN appearing on the COUSIN1921 DESIGN trade-mark, which use of these modified versions of the Opponent’s trade-marks have not been alleged by the Opponent in support of its grounds of opposition. We have no information as to during which period of time the pertinent samples were used in Canada and to what extent.

Samples of advertising material were filed as Exhibit MD-4. This material is of little assistance to the Opponent as no date of use of such material was provided and the marks appearing on them are, in most instances, different than the COUSIN DESIGN and the COUSIN1921 DESIGN trade-marks.

Sales figures for the period of 1995 to 2000, and advertising expenditures incurred between 1997 and 1999 have been provided but reference is made in Mr. Doyon’s affidavit to the trade-mark MAISON COUSIN. Therefore there is no information on the extent of the promotion of the COUSIN DESIGN and COUSIN1921 DESIGN trade-marks. The Opponent has been one of the sponsors for two television programs aired on the TVA network but we have no evidence in the

record that the COUSIN DESIGN and COUSIN1921 DESIGN trade-marks were shown during those programs and to what extent those programs were viewed by the Canadian public.

The Opponent filed certificates of excellence obtained for its products but there is no connection between those awards and the COUSIN DESIGN and COUSIN1921 DESIGN trade-marks. It would appear from the content of the Doyon's affidavit that the trade-mark or trade-name MAISON COUSIN may have been known in Canada or at least in the province of Quebec but the Opponent did not allege use of such trade-mark or trade-name as a ground of opposition.

I should also mention that Mr. Doyon has filed invoices (exhibit MD-3), three of them bearing the COUSIN1921 DESIGN mark and referring to the sale of submarine sandwiches, but their issued dates are (September 1999 and January 2000) subsequent to the relevant dates associated with the grounds of entitlement and distinctiveness to be identified hereinafter.

Mr. Schrank has been the Applicant's Manager of Real Estate and Legal Affairs. It operates and franchises sandwich shops offering a variety of sandwiches and beverages in association with the Mark in the United States of America. Most of Mr. Schrank's affidavit relates to the Applicant's activities in the United States of America, which are not relevant to the issues raised in this opposition proceeding, except for the issue of co-existence of the parties' trade-marks in the United States of America to be discussed in more details hereinafter.

Mr. Schrank has filed a copy of US registration number 1925662 for the trade-mark MAISON COUSIN and design, owned by the Opponent, which is a slight variation of the COUSIN1921 DESIGN trade-mark. Mr. Schrank alleged that the MAISON COUSIN and design trade-mark and the COUSINS trade-mark have co-existed in the United States of America since 1992 without any instances of confusion to his knowledge.

It has been established during his cross-examination that there has been no delivery of submarine sandwiches bearing the Mark in Canada. The Applicant's restaurant services include offering for sale and selling sandwiches, salads, soups, cookies and soft drinks. The Applicant advertised on radio, television and newspapers but there is no evidence of spill over advertising in Canada.

III The Law

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of such grounds of opposition. Once this initial burden is met, it shifts to the Applicant who must prove that the particular grounds of opposition should not prevent registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The material time for considering the issue of non-entitlement based on Subsection 16(3) of the Act is the filing date of the application (May 29, 1996) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (October 20, 1998) while registrability under 12(1)(d) must be assessed as of the date of my decision. [See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 at 424 (F.C.A.)] The difference in the material dates will not be a factor in this case. The sole issue with respect to each ground of opposition raised by the Opponent in its statement of opposition is the likelihood of confusion between the Mark and the Opponent's trade-marks COUSIN DESIGN and COUSIN1921 DESIGN when used in association with their respective wares and services listed above.

In *Miss Universe, Inc. v. Bohna (1995)* 58 C.P.R. (3d) 381 Mr. Justice Décarý stated:

“To decide whether the use of a trade mark or of a trade name causes confusion with another trade mark or another trade name, the court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague recollection of that other mark or name, the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class. (See s. 6(2), (3) and (4) of the Act; *Rowntree Co. v. Paulin Chambers Co.*, [1968] S.C.R. 134; *Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd.* (1981), [55 C.P.R. \(2d\) 39](#), 36 N.R. 71 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), [19 C.P.R. \(3d\) 3](#) at pp. 9-10, [1988] 3 F.C. 91, 16 C.I.P.R. 282

(C.A.), Thurlow C.J. and Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975), [25 C.P.R. 1](#) at p. 12 (F.C.T.D.), Cattnach J.

(...)

For a likelihood of confusion to be found, it is not necessary that the parties operate in the same general field or industry, or that the services be of the same type or quality. Trade marks for wares and services of one quality intended for one class of purchasers may be confusing with trade marks for wares and services of a different type or quality, intended for a different class of purchasers. (See *Bagagerie SA v. Bagagerie Willy Ltée*, supra.)”

The relevant portions of Section 6 of the Act are:

(2) The 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.

(...)

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

(b) The length of time the trade-marks or trade-names have 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 or trade-names in appearance or sound or in the ideas suggested by them.

It has been established that the criteria listed in section 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc.* (1992), [41 C.P.R. \(3d\) 483](#) (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), [66 C.P.R. \(3d\) 308](#) (F.C.T.D.)].

I shall now apply these principles to the evidence summarized herein below.

- (a) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known.

The Mark and the Opponent's trade-marks COUSIN DESIGN and COUSIN1921 DESIGN are inherently distinctive when used in association with the parties' wares and services described above.

The deficiencies in the Opponent's evidence identified herein above prevent me to conclude that the COUSIN DESIGN is known to some extent in Canada. There is minimal evidence of use of the trade-mark COUSIN1921 DESIGN in association with bread. Therefore this factor does favour the Opponent in so far as COUSIN1921 DESIGN is concerned.

- (b) The length of time the trade-marks or trade-names have been in use.

There is no evidence of use of the Mark in Canada by the Applicant while there is some limited evidence of use of the COUSIN1921 DESIGN in association with bread. This factor does favour the Opponent.

- (c) The nature of the wares, services or business and
- (d) The nature of the trade.

The Applicant argues that, because there is no evidence of use of the COUSIN DESIGN mark, I should disregard the wares listed under such registration. This position might be true with respect to the ground of opposition based on Section 16(3) of the Act (non-entitlement of the Mark because of prior use of a confusingly similar trade-mark), but it does not hold when assessing the registrability of the Mark in view of a likelihood of confusion with a registered trade-mark.

With respect to the Opponent's certificate of registration TMA130985, there is an overlap between submarine sandwiches on one hand and sandwiches on the other hand. There is also an overlap between submarine sandwiches and bread.

As for the channels of trade, there is no restriction in the application that the submarine sandwiches would be exclusively sold in the Applicant's restaurants. Therefore the parties' wares could eventually be sold in the same places. [See *Cartier Inc. v. Cartier Optical Ltd. (1998)*, 20 C.P.R. (3d) 68 at p.74] Therefore on the ground of non-registrability, this factor favours the Opponent only in so far as submarine sandwiches are concerned, while for the other grounds, there is no evidence of use of the COUSIN DESIGN and COUSIN1921 DESIGN by the Opponent prior to the respective relevant dates.

e) The degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

The degree of resemblance must be assessed from the point of view of the average consumer who has a vague recollection of the Opponent's marks and is confronted with the Applicant's Mark: would he think that the Wares or Services bearing the Mark emanate from the Opponent?

In *Smithkline Beecham Corporation v. Pierre Fabre Médicament*, (2001) 11 C.P.R. (4th) 1 the Federal Court of Appeal ruled that if there is a risk of confusion in either of the country's two official languages, a trade-mark cannot be registered. As the word portions of the Opponent's marks are French words, I will concentrate on the likelihood of confusion in the minds of a French-speaking consumer.

In *Molson Breweries, Apartnership v. John Labatt Ltd*, 3 C.P.R.(4th) 543 and in *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co. (1999)* 2 C.P.R.(4th) 103, Mr. Gary Partington, as he was Chairman of the Trade-marks Opposition Board, did refer to a dictionary to determine the meaning of a word, even though the pertinent extracts were not part of the evidence filed. I have looked into the Petit Robert Dictionary and found the following definition for the word 'maison':

«4. Entreprise commerciale, industrielle. Maison de commerce. Établissement, firme.... »

Therefore the word portion « Maison Cousin » means the "Cousin establishment or business". The word "maison" simply puts emphasis on the word "cousin". Moreover, there is some degree of

resemblance in sound between the Mark and the word portion of COUSIN DESIGN and COUSIN1921 DESIGN trade-marks. I will take judicial notice of the well known fact that a French speaking person would not pronounce the “s” at the end of the word “cousins” and therefore its pronunciation in French is identical to the pronunciation in French of the word “cousin”.

f) Additional surrounding circumstances

The Applicant is arguing that I should take into consideration the fact that there has been co-existence of the marks in issue in the United States of America without any instances of confusion. The fact that a mark is registered in a foreign country does not necessarily imply that there has been use of such mark in that country. In the absence of at least evidence of use of the COUSIN DESIGN and COUSIN1921 DESIGN marks in the United States of America, I am not prepared to consider such fact as a relevant circumstance in the determination of the likelihood of confusion between the Mark and the Opponent’s abovementioned trade-marks.

The Opponent is arguing that consideration should be given to the fact that there is ample evidence of use of the word trade-mark MAISON COUSIN. To accept such proposition would be to allow the Opponent to do indirectly what he is not permitted to do directly, namely to rely on its use of the word mark MAISON COUSIN as a ground of opposition which has not been specifically pleaded in its Statement of Opposition.

IV Conclusion

On the basis of the evidence filed and the grounds of opposition pleaded, I come to the conclusion that the Opponent has not discharged its initial onus of proof with respect to the second and third grounds of opposition. It failed to file any relevant evidence of use of its trade-marks COUSIN DESIGN and COUSIN1921 DESIGN in association with the wares listed above prior to the relevant dates associated with such grounds of opposition and identified above. Therefore grounds of opposition two and three are dismissed.

The Opponent's initial burden with respect to the first ground of opposition is minimal. The filing of the certificates of registration of its trade-marks COUSIN DESIGN and COUSIN1921 DESIGN is sufficient to shift the burden on the Applicant who must then convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks in issue. I am not convinced, after the analysis made above of the relevant factors to be taken into consideration in this case, that the Applicant has discharged such burden with respect to submarine sandwiches. My conclusion is based on my findings discussed above with respect to the nature of the wares and the trade as well as the degree of resemblance in sound between the Mark and the word portion of the COUSIN DESIGN and COUSIN1921 DESIGN marks. Therefore I maintain the first ground of opposition only in so far as submarine sandwiches are concerned.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, and applying the principles enunciated in the case of *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH (1986) 10 C.P.R. (3d) 482*, I refuse, pursuant to Subsection 38(8) of the Act, the Applicant's application for the registration of the Mark, only with respect to sandwiches, namely: submarine sandwiches and I reject the opposition in so far as the other wares and services are concerned.

DATED, IN MONTREAL, QUEBEC, THIS 4th DAY OF JANUARY 2005.

Jean Carrière,
Member,
Trade-mark Opposition Board