



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

Citation: 2013 TMOB 175
Date of Decision: 2013-10-15

**IN THE MATTER OF AN OPPOSITION
by Imperial Tobacco Canada Limited to
application No. 1,411,285 for the trade-
mark FLIP-TOP in the name of Philip
Morris Products S.A.**

FILE RECORD

[1] On September 18, 2008, Philip Morris Products S.A. filed an application to register the trade-mark FLIP-TOP, based on proposed use in Canada, in association with the following wares:

tobacco, raw or manufactured, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco and tobacco substitutes (not for medical purposes)

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 29, 2009 and was opposed by Imperial Tobacco Canada Limited on December 23, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on January 14, 2010, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of P. Claire Gordon. The applicant's evidence consists of the affidavits of Suzanna La Rose and Mary P. Noonan, as well as a certified copy of the file wrapper for the trade-mark BLUES, registration No. TMA270,151. The opponent's reply evidence consists of the affidavit of Kathleen Larone.

[4] Ms. Larone was cross-examined on her affidavit evidence. The transcript of her cross-examination forms part of the evidence of record. Both parties filed a written argument and both parties were represented at an oral hearing conducted on September 25, 2013.

STATEMENT OF OPPOSITION

[5] The grounds of opposition are succinctly pleaded and are shown in full below:

(a) Pursuant to paragraph 38(2)(a) of the Act [*Trade-marks Act*], the present application does not conform to the requirements of paragraph 30(e), since the applicant does not, either by itself or through a licensee, or by itself and through a licensee, intend to use the subject of this application as a trade-mark.

(b) Pursuant to paragraphs 38(2)(b) and 12(1)(b) of the Act, the subject of the present application is not registrable, since whether depicted, written or sounded, it either clearly describes or deceptively misdescribes the fact that the applicant's wares are sold in flip-top packaging.

(c) Pursuant to paragraph 38(2)(d) of the Act, the subject trade-mark is not distinctive, in view of the descriptive nature of the mark, and the fact that the mark will neither be used nor perceived as a trade-mark.

OPPONENT'S THEORY OF THE CASE

[6] The above pleadings are formalistic and reference the statutory language of the *Trade-marks Act*. The opponent sets out essentially the same allegations in clearer, informal language in paragraphs 4-8 of its written argument, shown below:

4. FLIP-TOP is a dictionary term defined as either a lid on a container or a container having such a lid, where the lid stays connected to the container when it is opened. Such a lid can be easily flipped open. There is no evidence in this opposition that the term can have any other meaning.

5. FLIP-TOP is a term widely used in the tobacco industry to describe packaging for tobacco products that has an attached lid that can be easily flipped open.
6. All manufacturers and distributors of tobacco products should be able to use the term FLIP-TOP in connection with tobacco products sold in this type of packaging.
7. The Opposed Trade Mark FLIP-TOP clearly describes a type of tobacco product packaging, and does so, on first impression, in a manner that is easy to understand.
8. The Opposed Trade Mark FLIP-TOP is not distinctive in relation to tobacco products. It is inherently not distinctive because of its descriptiveness. It is not "adapted to distinguish" and does not actually distinguish the Applicant's wares from those of others in that other traders already use the term FLIP-TOP in relation to tobacco products.

APPLICANT'S THEORY OF THE CASE

[7] The applicant's theory of the case is stated at paragraph 6 of its written argument:

The Applicant's trade-mark is a word mark to be used in association with raw and manufactured tobacco products . . . The specification of wares does not include packaging. The trade-mark FLIP-TOP is an arbitrary term when used with the associated wares. It does not refer to the material composition of the goods or to an obvious intrinsic quality of the goods such as a feature, trait or characteristic of the specified wares. Furthermore, there is no evidence that the Trade-mark will not or cannot be used as a trade-mark, as defined by the *Trade-marks Act*.

[8] Before addressing the issues raised in the statement of opposition, I will next review the parties' evidence, the evidential burden on the opponent to put its allegations into issue and the legal onus on the applicant to prove its case.

OPPONENT'S EVIDENCE

P. Claire Gordon

[9] Ms. Gordon is a law clerk with the firm representing the opponent. Her affidavit serves to introduce into evidence various exhibit materials, discussed below.

[10] Exhibit B is a copy of Section 1 (the Interpretation Section) of the *Tobacco*

Reporting Regulations (SOR/2000-273), which includes the following entry:

- "type of package"
 - « type d'emballage »
 - "type of package" includes each size of the following types of packages:
 - (a) in respect of bidis, cigarettes, kreteks and tobacco sticks,
 - (i) a slide and shell package,
 - (ii) a **flip-top** package, and
 - (iii) a soft package;
- (emphasis added)

[11] Exhibits D1 to D30 are printouts of web pages. The exhibits indicate that the term “flip-top” is commonly used to describe a type of container for cigarettes, that is, a type of packaging. For example, Exhibit D8 discusses “10 Ways To Reuse A Flip Top Box (Cigarette Pack);” Exhibit D14 notes that “The flip-top cigarette pack is one of the most successful pieces of packaging design in history.”

[12] Exhibits G and H are dictionary entries for the word “flip-top” from standard reference online texts. The entries are, as an adjective, “having or denoting a lid or cover that can be easily flipped open” and as a noun, “a lid on a container that stays connected to the container when it is opened.”

[13] Exhibits I to O are copies of Canadian patents for cigarette packages featuring “flip-top” lids. In particular, Exhibit I is a copy of a patent entitled FLIP-TOP BOX belonging to the applicant herein. The description portion of the patent reads, in part, as follows:

The invention relates to a **flip-top** box, in particular for cigarettes, with a lid and box part, the rear wall of which is linked to the rear wall of the lid part . . . Such **flip-top** or hinge-lid boxes are the most common cigarette boxes alongside soft-pack packs. . . More recently however, there have also been increasing numbers of **flip-top** boxes with chamfered longitudinal edges . . . With all these **flip-top** boxes, the problem arises that, in particular after frequent opening and closing, the lid does not remain automatically in the closed position, but opens somewhat.

(emphasis added)

APPLICANT'S EVIDENCE

Suzanna La Rose

[14] Ms. La Rose identifies herself as a Senior Reference Librarian employed by the agents for the applicant. Her affidavit serves to introduce into evidence dictionary entries for the words “tobacco,” “cigars,” “cigarettes,” “cigarillos” and “tobacco” from various standard reference print and online texts.

Mary P. Noonan

[15] Mary P. Noonan identifies herself as a trade-mark searcher employed by the agents for the applicant. Her affidavit serves to introduce into evidence the results of various searches of the trade-marks register.

[16] The first search found registered marks which include the components FLIP or TOP where the associated wares may be in packaging that can “flip” or have a “top.” Three marks were located: FLIP-PAC for pharmaceuticals; FLIP-A-MINT for candy; and “FLIP YOUR LID!!” for pizza.

[17] The second search found registered marks where a component describing packaging appears in the mark. Seventeen marks were located including, for example, STACK for stationery; BIG PAK for chewing gum; BLACK BOX for wine; and SIXPACK for auto parts. The majority of the marks contained the component PAK or PACK.

[18] The third search found registered marks in which a disclaimer is included in respect of packaging specified in wares. Eight marks were located. Three marks included the disclaimed component PACK or PAC; two marks included the disclaimed component CASE; one mark included the disclaimed component CUBE; and two marks included the disclaimed component BOX.

File Wrapper for the Trade-mark BLUES

[19] The file wrapper contains a decision of this Board in an opposition by RJR-MacDonald, Inc. against Imperial Tobacco Limited concerning the mark BLUES for use in association with tobacco products: the decision is reported in (1981), 67 CPR(2d) 246.

[20] I do not find that the Board's decision in the BLUES case provides guidance in the present case.

OPPONENT'S REPLY EVIDENCE

Kathleen Larone

[21] Ms. Larone identifies herself as an assistant at the law office representing the opponent. Her affidavit serves to introduce into evidence further dictionary entries for the word "flip-top."

[22] The applicant has objected that Ms. Larone's evidence is improper as it is not strictly confined to matters in reply and should have been proffered as evidence in chief. I agree with the applicant and therefore I have not had regard to Ms. Larone's affidavit.

LEGAL ONUS AND EVIDENTIAL BURDEN

[23] As mentioned earlier, before considering the allegations in the statement of opposition, it is necessary to review some of the technical requirements with regard to

(i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[24] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be

concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

[25] Each of the grounds of opposition is based on the same premise, that is, that the term “flip-top” cannot function as a trade-mark because it refers to a type of packaging for tobacco products. While the applicant (in paragraphs 19 and 20 of its written argument) has raised some technical objections to some of the opponent’s evidence, in my view the opponent’s evidence taken as a whole suffices to meet the opponent’s evidential burden to establish that the term “flip-top” does in fact describe a type of packaging used for various products and in particular it is a type of packaging used for tobacco products. I therefore find that there are sufficient material facts to put each of the grounds of opposition into issue. I will begin with the ground of opposition alleging that the applied-for mark is not distinctive.

Third Ground of Opposition – Is the mark FLIP-TOP distinctive?

[26] The opponent has brought to my attention several decisions by this Board which deal with trade-marks which describe packaging. The first is the Board decision in *Plastic Packaging Products Ltd. v. Universal Electric Products Co. Ltd.*, (1964) 43 CPR 155 which deals with the mark BLISTER-PAC proposed for use in association with “electric Christmas tree lamps.” The Board summarized the objections to the proposed use mark at p.155:

The opponent submits that BLISTER-PAK as applied to “electric Christmas tree lamps” is not distinctive. A “blister-pak”, or “blister-packaging”, is a well-known type of packaging which is common to the trade. Therefore, the opponent submits that BLISTER-PAK should not be registered as a trade mark to the applicant nor to any other person since it is incapable of distinguishing one person's wares from those of others which are packaged in “blister-paks.” The opponent ventures to say that the Trade Marks Office would not register “foil-wrapped” or

“plastic-wrapped” as trade marks for electric Christmas tree lamps. The expression “blister-pak” is equally non-distinctive.

[27] The Board’s reasons for refusing the application are found at p.156:

I have considered the evidence on file, there being no oral hearing and have arrived at the decision that the trade mark BLISTER-PAK should not be registered as it is not distinctive. Evidence furnished by the opponent establishes clearly that it is a trade term applied to a certain method of packaging articles of various types and thus does not distinguish the wares of the applicant from those of others.

(emphasis added)

[28] I agree with the opponent that the present case is “on all fours” with the BLISTER-PAK case. It appears to me that the applicant would have to use its mark and show acquired distinctiveness for the mark before the applicant could meet the legal onus on it to show that its mark is distinctive of its tobacco products. In the circumstances of the present case, I conclude that the proposed use mark FLIP-TOP on packaging for tobacco products would be perceived as a reference to the package itself rather than as an identifier for the wares inside the package. The opponent therefore succeeds on the third ground of opposition alleging non-distinctiveness.

Second Ground of Opposition – Is the mark FLIP-TOP Clearly Descriptive?

Opponent’s Case Law

[29] Having found for the opponent on the third ground of opposition, it is not necessary for me to consider the remaining grounds. However, counsel for the opponent has also brought to my attention, at paragraphs 42 and 43 of its written argument, shown below, two relatively recent decisions of the Board that are pertinent:

42. . . . in *Canada Dry Ltd. V. McCain Foods Ltd.* (1988) 21 C.P.R. (3d) 99, the Trade-marks Opposition Board (per D.J. Martin) held that DRINKIN' BOX and BOITE A BOIRE were clearly descriptive of beverages since "as a matter of first impression, the everyday user of the applicant's wares upon seeing or hearing the applicant's trade mark DRINKIN' BOX would consider that reference is being made to a box-like container from which he could directly drink the contained beverage." The mark was clearly descriptive of the product, "the product in this case comprising the juice and the container."

43. Similarly, a mark can be clearly descriptive of wares when it describes the size of container in which the wares are sold. In *Ralston Purina Canada Inc. v. Effem Foods Ltd.* (1989), 24 C.P.R. (3d) 125,

the Trade-marks Opposition Board held that "MONEY SAVING VALUE SIZE" was descriptive of pet food since it immediately suggests that the applicant's product (or anyone's product, for that matter) is sold in a larger size which results in a saving of money to the purchaser. Either such is the case and therefore the trade mark is clearly descriptive or such is not the case and therefore the mark is deceptively misdescriptive. **These are also words which one could easily imagine other traders wishing to use to describe their products and thus should not be monopolized by the applicant in the absence of a showing of acquired distinctiveness.** (emphasis added)

Applicant's Case Law

[30] Counsel for the applicant has brought another "packaging" case decided by this Board to my attention. The case concerns the mark TWO BY SIX, based on proposed use in Canada, in association with brewed alcoholic beverages: see *John Labatt Ltd. v. Molson Cos. Ltd.* (1986) 9 CPR (3d) 385. The opponent objected that the mark was clearly descriptive, was the name of the wares, and was not distinctive of the applicant. The Board noted that the

third ground of opposition [distinctiveness] is phrased in general terms and must therefore be considered as being restricted to the opponent's previous allegations respecting its first two grounds of opposition.

[31] The Board further noted that

the opponent's evidence only serves to establish that the term "2x6" or "two by six" has an accepted meaning within that segment of the packaging industry specializing in the packaging of beer. Within that specialized trade, the term "two by six" refers to particular package sizes used to accommodate two rows of six bottles or cans of beer. However, the opponent's evidence fails to establish that the average consumer ascribes any meaning to the phrase "two by six" in association with brewed alcoholic beverages.

(emphasis added)

[32] The Board rejected the first two grounds of opposition and, as the third ground was derivative of the first and second grounds, the third ground alleging non-distinctiveness was also rejected.

[33] In the instant case, the third ground of opposition alleging non-distinctiveness is not derivative of the other grounds. Rather, it stands alone in alleging that the mark FLIP-TOP will not be perceived as a trade-mark. Further, in the instant case, there is evidence that “flip-top” packaging is not restricted to a particular product.

[34] Counsel for the applicant has also brought to my attention several Federal Court cases which unequivocally state that “for a word to be clearly descriptive, it must be material to the composition of the goods or product.” see, for example *Provenzano v. Registrar of Trade Marks* (1977) 37 CPR (2d) 189 (FCTD), affirmed 40 CPR (2d) 288 (FCA). However, none of the Court cases relied on by the applicant deal with packaging. Further, in *S. C. Johnson & Son, Ltd. et al. v. Marketing International Ltd.* 44 CPR (2d) (1979) 16 at p.25 (SCC), the Court noted that a mark may fall within the prohibition of s.12(1)(b), that is, be clearly descriptive, if it describes the “effect” of the wares. It appears, then, that the condition set in *Provenzano* for finding that a mark is clearly descriptive may not be entirely complete. Nevertheless, counsel for the applicant has made me doubt whether the above mentioned *Canada Dry* and *Ralston Purina* cases were correctly decided under s.12(1)(b).

[35] Even if the principle of *stare decisis* does not apply to administrative tribunals such as this Board following its own decisions, I consider that I am obliged, by the principle of comity of decision making, to follow previous decisions of this Board unless I can find that they are clearly wrong. While I have doubts, I am unable to find that the two above-mentioned *Canada Dry* and *Ralston Purina* cases are clearly wrong in concluding that the marks therein contravened s.12(1)(b). I therefore would have followed the reasoning in the above-mentioned cases and found that the mark FLIP-TOP is clearly descriptive of the applicant’s wares.

State of the Register Evidence

[36] I would also mention that the applicant has submitted, at paragraph 43 of its written argument, that the many third party registered marks descriptive of packaging located by Ms. Noonan (see paragraphs 15-18, above) indicate that such marks are

acceptable if those marks are not descriptive of the wares specified in the application. I do not agree that such an inference may be drawn, for reasons explained by this Board in *Simmons I.P. Inc. v. Park Avenue Furniture Corp.* (1994) 56 CPR(3d) 284 at 288:

In the *Reed Stenhouse* decision [(1992), 45 C.P.R. (3d) 79, 57 F.T.R. 317, 36 A.C.W.S. (3d) 119 (T.D.)], Jerome A.C.J. pointed out that it was incumbent on the Registrar in refusing an application at the **examination stage to reconcile his refusal** "to some extent" in view of the existence on the trade marks register of somewhat similar marks. However, **I do not consider that the Associate Chief Justice's comments apply to **opposition proceedings****: see the opposition decisions in *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M. Opp. Bd.) at p. 277, and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M. Opp. Bd.) at p. 386. The Opposition Board is not in a position to explain why a particular mark was permitted to proceed to registration by the examination section of the Trade Marks Office. Such a decision may have resulted because the examiner did not have the benefit of the type of evidence filed in an opposition proceeding or because the onus or legal burden is different at the examination stage.

(emphasis added)

DISPOSITION

[37] In view of the foregoing, the application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office