

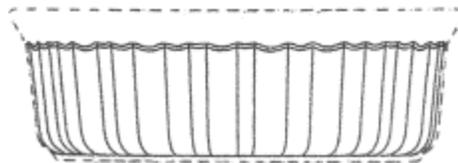
LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 191
Date of Decision: 2010-11-03

**IN THE MATTER OF AN OPPOSITION
by Modern Houseware Imports Inc. to
application No. 1,210,102 for the trade-
mark DISTINGUISHING GUISE II
DESIGN in the name of World Kitchen,
Inc.**

The Pleadings

[1] On March 11, 2004 World Kitchen, Inc. (the Applicant) filed application 1,210,101, later amended, to register the distinguishing guise described in the following words: the distinguishing guise consists of the fluted side wall with sharp joints between adjacent flutes and irregular intervals between flutes. The trade-mark is hereinafter reproduced:



(the Mark);

[2] The application covers cookware namely, baking dishes and covers, serving sets, quiche dishes, casserole dishes, roasters and ramekin dishes (the Wares). The Applicant claims use of the Mark since at least as early as March 24, 1980.

[3] On November 15, 2004 an examiner issued an office action indicating to the Applicant that, pursuant to s. 13 of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the Act), it was required to file evidence showing that the guise has been so used in Canada by the Applicant or its predecessors in title as to have become distinctive at the application filing date.

[4] In response to such office action, the Applicant filed the affidavit of James D. Wallace. Subsequent to the filing of an amended application and such evidence, the application was advertised on October 17, 2007 in the *Trade-marks Journal* for opposition purposes.

[5] Modern Houseware Imports Inc. (the Opponent) filed a statement of opposition on December 14, 2007. The Applicant filed a counter statement on March 31, 2008 denying all grounds of opposition listed below.

[6] The Opponent filed no evidence while the Applicant filed the affidavit of Jeffrey S.S. Lim. Only the Applicant filed a written argument and no oral hearing was requested.

The Grounds of Opposition

[7] The grounds of opposition pleaded are:

1. The Mark is not registrable having regard to the provisions of s. 2 and 38(2)(b) of the Act in that the fluted side wall with sharp joints between adjacent flutes and irregular intervals between flutes of the alleged distinguishing guise (as set out in the application) embodies a functional or utilitarian feature and is incapable of functioning as a trade-mark;
2. The Mark is not registrable having regard to the provisions of s. 13(1)(a) and 38(2)(b) in that the evidence filed by the Applicant during examination is insufficient to establish distinctiveness at the filing date of the application;
3. The Mark is not registrable having regard to the provisions of s. 13(1)(a) and 38(2)(b) in that, at the date of filing of the application, the Mark was not distinctive because of the use of similar product features in Canada by other parties, such parties including, but not limited to, the Opponent, Rubbermaid, Wal-Mart Canada and Trudeau Corporation;
4. The Mark is not registrable having regard to the provisions of s. 13(1)(b) and 38(2)(b) in that the exclusive use by the Applicant of the Mark by the Applicant would be likely to unreasonably limit the development of the cookware industry;

5. The application does not comply with the requirements of s. 30(b) in that the Applicant or its predecessors in title have not used the Mark since March 24, 1980, as claimed in the application;
6. The Mark is not distinctive within the meaning of s. 38(2)(d) having regard to the use in Canada by the parties referred to above of similar product features; and
7. The application does not comply with the requirements of s. 30(i) in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares in view of the foregoing.

Onus and Burden of Proof in Trade-marks Opposition Proceedings

[8] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Failure of the Opponent to meet its initial evidential burden

[9] As indicated earlier, the Opponent chose not to file any evidence in the record. Therefore it is obvious that the Opponent has not met its initial evidential burden with respect to the first, third, fifth and sixth grounds of opposition. There is no evidence that: the Mark embodies a functional or utilitarian feature; other parties have used similar product features in Canada; and the Applicant has not used the Mark in Canada since March 24, 1980. Therefore those grounds of opposition are dismissed.

[10] As for the seventh ground of opposition all that is required from the Applicant under s. 30(i) of the Act is to state in its application that it is satisfied that it is entitled to use the Mark in Canada. Once such statement is included in the application, as in the present case, this ground of opposition is likely to succeed only in exceptional cases such as when bad faith is proven [see

Sapodilla Co. Ltd. v. Bristol-Myers Co. (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As there is no evidence in the file of that nature, again this ground of opposition must fail.

[11] As for the fourth ground of opposition, the Opponent did not explain why or how it considered that the exclusive use of the Mark by the Applicant would be likely to unreasonably limit the development of the cookware industry. The Opponent was required under s. 38(3) of the Act to provide some allegations of facts, which would later be supported by evidence [see *AstraZeneca AB v. Novopharm Ltd.* (2001), 15 C.P.R. (4th) 327 (F.C.A.);]. Accordingly, I dismiss the fourth ground of opposition because it has been insufficiently pleaded. Moreover the Opponent has not met its initial evidential burden to support such ground of opposition.

The Second Ground of opposition

[12] It is clear from the wording of s. 13(1) that the relevant date to determine if the Mark is a distinguishing guise is the filing date of the application, namely March 11, 2004. In its second ground of opposition the Opponent is arguing that the evidence filed at the examination stage was insufficient to establish distinctiveness of the Mark at the relevant date. I am dismissing this ground of opposition for the reasons thereafter set forth.

[13] Firstly, the Opponent has not provided any details as to why it considers the evidence filed at the examination stage to be insufficient. Therefore the ground of opposition is insufficiently pleaded. Secondly, the Opponent has not provided any facts in evidence to meet its initial burden of proof. Thirdly, assuming that the Opponent could have simply explained in a written argument the reasons why it thought the evidence filed at the examination stage was insufficient to establish the distinctiveness of the Mark at the relevant date, it failed to do so.

[14] Finally, if the wording of that ground of opposition is adequate by itself to consider reviewing the Examiner's decision, I refer to the following portion of the Registrar's decision in *Magill v. Taco Bell Corp.* (1990), 31 C.P.R. (3d) 221 at 226:

Initially, I would note that the Board can reconsider interlocutory rulings made during the course of an opposition proceeding where such rulings were made without jurisdiction (see *Simmons Ltd. v. A to Z Comfort Beddings Ltd.* (1987), 18 C.P.R. (3d) 84 (T.M. Opp. Bd.), at pg. 87). Further, a decision which has been made by an examiner in the exercise of the Registrar's discretion cannot be reviewed by the Board

unless there is a clear error of law or an error in the interpretation of the facts which were before the examiner at the time that he or she exercised the Registrar's discretion. Accordingly, if there is no error in law and if it has not been shown that the person who exercised the Registrar's discretion, misinterpreted the facts which were before him or her, that decision cannot be reconsidered in an opposition proceeding. Where, however, there has been an error in law or an error in the interpretation of the facts which resulted in a particular decision, the decision so taken is reviewable in opposition proceedings.

I have no indication from the Opponent as to how and why the Registrar would have committed an error in law or misinterpreted the facts contained in Mr. Wallace's affidavit filed at the examination stage.

[15] These reasons are sufficient to dispose of that ground of opposition. In the event that I am wrong and that I would have an obligation to review the evidence filed at the examination stage, I would have concluded the same way as the Examiner did for the following reasons.

[16] Mr. Wallace was the Vice-President, General Manager and Director of World Kitchen Canada (EHI) Inc., a wholly owned and licensee of the Applicant, at the time of execution of his affidavit on September 13, 2006.

[17] He alleged that the Applicant and its predecessors have marketed, distributed and sold the Wares in Canada which bear the distinguish guise described above since at least 1980. He provided a detailed list of the retail stores located across Canada where the Wares have been sold. He explained how the Wares were promoted and advertised across Canada in association with the distinguishing guise since at least 2001 and filed samples of such advertisements. He provided the Canadian sales figures for the Wares since 2001. They were in excess of \$7 millions on a yearly basis. Mr. Wallace stated that the Applicant was satisfied that the Mark was unique in the marketplace and that the distinguishing guise described in the application acquired distinctiveness in the trade and among the public.

[18] In a nutshell, I failed to see how the content of Mr. Wallace's affidavit was insufficient to establish the distinctiveness of the Mark at the filing date of the application.

The Applicant's evidence

[19] In view of the fact that the Opponent has not met its initial burden with respect to any of the grounds of opposition pleaded, it is not necessary for me to review the content of Mr. Lim's affidavit filed by the applicant in this opposition.

Disposition

[20] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office