

IN THE MATTER OF AN OPPOSITION by Thomas J. Lipton Inc.
to application No. 509,253 for the trade-mark SOUPER CUP filed by
Boyd Coffee Company

On September 9, 1983, the applicant, Boyd Coffee Company, filed an application to register the trade-mark SOUPER CUP based upon use in Canada since at least as early as August, 1982, as well as use and registration of the trade-mark in the United States of America, in association with "instant, dry soup mix".

The opponent, Thomas J. Lipton Inc., filed a statement of opposition on April 18, 1988, and was subsequently granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition. In its amended statement, the opponent alleged that the applicant's trade-mark is not registrable in that it is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares.

The applicant served and filed a counterstatement in which it asserted that its trade-mark is neither clearly descriptive nor deceptively misdescriptive of the character or quality of its wares.

The opponent filed as its evidence the affidavit of Jane Clark while the applicant filed as its evidence the affidavit of Gay Owens. As evidence in reply, the opponent submitted the affidavit of Susan Burkhardt.

Both parties submitted written arguments and both were represented at an oral hearing.

The issue as to whether the applicant's trade-mark SOUPER CUP is clearly descriptive of the applicant's wares must be considered from the point of view of the average consumer or user of the wares associated with the trade-mark. Further, in determining whether a trade-mark is clearly descriptive of the character or quality of the wares associated with it, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression (see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks, 40 C.P.R. (2d) 25, at pgs. 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks, 2 C.P.R. (3d) 183, at pg. 186).

The relevant date for considering the ground of opposition based on Section 12(1)(b) is as of the filing date of the applicant's application (September 9, 1983). In this regard, reference may be made to the decisions in Oshawa Group Ltd. v. Registrar of Trade Marks, 46 C.P.R. (2d) 145, at pg.

147 and Carling Breweries Limited v. Molson Companies Limited et al, 1 C.P.R. (3d) 191, at pg. 195. While I am mindful of the decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (F.C.A. No. A-263-89, dated June 24 1991, yet unreported), I consider that decision to be authority for the proposition that the material date for considering a Section 12(1)(d) ground of opposition is the date of my decision. I do not, however, consider the Park Avenue decision to be authority for the proposition that the material time for any ground relating to the registrability of a trade-mark, including a Section 12(1)(b) ground, is the date of decision. Indeed, such a position would appear to be directly in conflict with the express wording of Section 12(2) of the Trade-marks Act which provides that a trade-mark which is not registrable by virtue of Section 12(1)(b) is registrable if it has been so used in Canada as to have become distinctive as of the date of filing of an application for its registration.

While the legal burden is on the applicant to establish the registrability of its trade-mark, there is an evidential burden on the opponent in respect of its ground to adduce sufficient evidence which, if believed, would support the truth of the allegations set forth in the statement of opposition relating to the alleged non-registrability of the trade-mark SOUPER CUP. It is therefore necessary in the present case to consider the opponent's evidence in order to determine whether the opponent has met the evidential burden upon it.

The Clark affidavit establishes that the word SOUPER is essentially the phonetic equivalent of the word "super". The applicant, on the other hand, submitted that the word SOUPER in the French language is a noun meaning "dinner" or "supper". However, considering the applicant's trade-mark SOUPER CUP in its entirety in association with a soup mix, I seriously doubt that such would be the immediate impression of the average Canadian consumer. Further, no evidence has been adduced by the applicant in support of its submission that the average Canadian would react to the trade-mark SOUPER CUP as applied to soup mix by thinking that the applicant's mark comprises the French word "souper" in combination with the English word CUP.

In Thomas J. Lipton, Ltd. v. Heldon Foods (1980) Ltd., 10 C.P.R. (3d) 517, I commented on the registrability of the trade-mark SUPERCUP as applied to "packaged dry powder beverages, namely, coffee, soup mixes, hot chocolate, and non-alcoholic beverages, namely, flavoured drinks" as follows at pages 520 to 522:

The applicant submitted that the trade-mark SUPERCUP differed from its trade-mark SOUPER CUP. However, I consider that the average Canadian would consider the applicant's trade-mark SOUPER CUP as applied to "instant, dry soup mix" to be the phonetic equivalent of SUPERCUP. As a result, I consider my comments in the SUPERCUP case to be equally applicable to the applicant's trade-mark SOUPER CUP.

The applicant submitted that the state of the register disclosed the existence of a number of marks including the element CUP and that it was incumbent on the Registrar in view of the decision of the Federal Court, Trial Division in Canadian Parking Equipment Ltd. v. Registrar of Trade Marks, 34 C.P.R. (3d) 154 to reconcile the existence of these marks on the register in determining whether or not its trade-mark is registrable under Section 12(1)(b) of the Act. However, the Parking Equipment case related to a refusal by the Registrar at the examination stage to permit the applicant's trade-mark AUTOMATIC PARKING DEVICES OF CANADA to proceed to advertisement. I do not, however, consider that the Opposition Board is in a position to explain why certain marks

identified by an applicant in its evidence were permitted by the examination division of the Trade-marks Office to proceed to registration. Further, I do not consider that the Board could, in relation to the Section 12(1)(b) ground, have regard to those marks which were registered after the filing date of the applicant's application. On the other hand, I certainly consider it incumbent on the Opposition Board to be consistent in the decisions which it renders and to explain why it is not following a previous decision which is of relevance to the case at hand. In the present case, there is no evidence that any of the marks referred to by the applicant in its state of the register evidence were the subject of opposition proceedings. On the other hand, the opponent has referred to the previous decision of the Opposition Board in the Heldon Foods case, referred to above, where I refused the trade-mark SUPERCUP as being clearly descriptive of the function or quality of packaged dry powdered beverages, namely, coffee, soup mixes, hot chocolate, and non-alcoholic beverages, namely, flavoured drinks.

In view of the above, I have concluded that the applicant's trade-mark is contrary to s. 12(1)(b) of the Trade-marks Act and therefore not registrable. As a result, I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF November, 1991.

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