

IN THE MATTER OF AN OPPOSITION by Canus Fisheries Ltd. to application No. 775,978 for the certification mark GASPÉ CURE & Design filed by Association Québécoise de l'Industrie de la Pêche

On February 21, 1995, the applicant, Association Québécoise de l'Industrie de la Pêche, filed an application to register the certification mark GASPÉ CURE & Design, a representation of which appears below, based on use of the mark in Canada since February 16, 1995 by persons authorized by the applicant in association with "poissons salés". The applicant has stated in its application that it is a commercial association having a representative "sur la côte de Gaspé" and has claimed that the use of its certification mark is intended to indicate that the wares in association with which it is used conform to the following defined standard:

"le poisson salé faiblement a été transformé et produit sur la côte de Gaspé en respectant la méthode traditionnelle utilisée dans cette région, laquelle nécessite un temps de séchage à l'extérieur; et le produit fini satisfait aux normes de transformation et de qualité que le requérant peut fixer de temps à autre".

Further, the applicant disclaimed the right to the exclusive use of the maple leaf to the left of the drawing and the fleur-de-lis to the right of the drawing apart from the certification mark, as well as disclaiming the right to the exclusive use of the words AUTHENTIC CERTIFICATION, CURE and APPELLATION CERTIFIÉE apart from the certification mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of April 10, 1996 and the opponent, Canus Fisheries Ltd., filed a statement of opposition on May 28, 1996, a copy of which was forwarded to the applicant on June 17, 1996. The applicant responded

by filing and serving a counter statement on July 17, 1996. The opponent filed as its evidence the affidavit of Peter W. Stoddard while the applicant submitted as its evidence the affidavits of Réal Nicolas, Benoît Reeves, Jean-René Denis, Robert Langlois, Roch Lelièvre, Alphonse Gagnon, Armand Lachance and two affidavits of Jean-Paul Gagné, dated April 10, 1997 and June 26, 1997. The opponent filed a second affidavit of Peter W. Stoddard as evidence in reply. The applicant alone submitted a written argument and neither party requested an oral hearing.

The first ground of opposition is based on Paragraph 12(1)(e) and Section 10 of the *Trade-marks Act*, the opponent alleging that the trade-mark GASPÉ CURE & Design has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of salted fish more particularly defined and classified under *Fish Inspection Regulations*, C.R.C., C. 802, ss. 111 and 114, which Regulations were made pursuant to the *Fish Inspection Act*, R.S.C. 1985, c. F-12. The opponent further alleged that it produces “Gaspé Cure” under its “Fox River Brand” in accordance with the standards prescribed in the aforesaid *Fish Inspection Regulations* and has been producing Gaspé Cure in Canada since at least as early as 1987 and continues to use the designation Gaspé Cure to describe the kind and quality of salted fish produced by it.

As with other grounds of opposition under Subsection 12(1) and Paragraph 38(2)(b) of the *Trade-marks Act*, the legal burden is upon the applicant to demonstrate that its certification mark is registrable and therefore does not offend the provisions of Paragraph 12(1)(e) and Section 10 of the *Act*. However, there is an initial evidential burden on the opponent to establish the facts being relied upon by it in support of this ground. Furthermore, the material time for considering this ground is as of the date of decision. Paragraph 12(1)(e) and Section 10 of the *Act* provide as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
(e) a mark of which the adoption is prohibited by section 9 or 10;

10. Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

As noted in the *Petit Robert 2*, the Gaspé Peninsula is a peninsula which is situated in

southeastern Quebec between the mouth of the St. Lawrence River and Chaleur Bay. While the element GASPÉ is clearly descriptive of the place of origin of the applicant's wares, the issue is whether the certification mark GASPÉ CURE & Design, when considered in its entirety, offends the provisions of Paragraph 12(1)(e) and Section 10 of the *Trade-marks Act*. In this regard, the opponent has alleged that the words GASPÉ CURE refer to a type of fish product in the *Fish Inspection Regulations*. The *Fish Inspection Regulations* were last amended March 5, 1998 and, as of the date of this decision, Sections 111 and 114 provide as follows:

111. The classes of salted fish are "light salted", "heavy salted" and "Gaspe Cure".

Gaspe Cure Slack Salted Fish

114. A Gaspe Cure slack salted fish shall be graded as

- (a) "Selected", if it is a reasonably thick, smooth-faced, well split fish, that is clean on back and face, has a somewhat translucent appearance, is free from liver, gut and salt on the surface, is free from blood stains and clots and, where it is hard dried, has an amber cast;
- (b) "Choice", if it is a fairly well split fish that is not sunburned, broken, slimy, or otherwise defective, whether or not it is slightly rough in appearance or shows slight blood stains and traces of salt on the surface;
- (c) "Standard", if it is a fish that is not a slink, whether or not that fish is rough-faced or poorly split, shows salt, blood stains, clots or liver stains or is slightly sunburned; or
- (d) "Commercial", if it is a fish that does not meet the requirements of paragraph (a), (b) or (c) but that is free from mould and slime and is not sour, heavily mutilated, heavily sunburned or heavily skin-heated.

Apart from the above, Peter W, Stoddard, Assistant Manager of the opponent, states in his first affidavit that his company has been producing GASPÉ CURE cod since about 1986, with the primary market being New York City and with smaller sales to Italy and Puerto Rico. According to Mr. Stoddard, during the time that the opponent has been producing and selling GASPÉ CURE cod, it has utilized the designation GASPÉ CURE to identify a specific product and a specific process and that officials of the Department of Fisheries and Oceans visited the opponent's facility in 1988 and subsequently granted the opponent permission to label its fish product as GASPÉ CURE without any indication that the product is from the Gaspé region. It would appear from the Stoddard affidavit including Exhibit C thereto that the opponent's products were intended primarily, if not exclusively, for the export market and therefore the extent to which the average Canadian consumer of salted fish would have become aware of the opponent's activities and its use of the designation GASPÉ CURE would have been very limited.

Initially, I would note that no evidence has been furnished by the opponent to show that the certification mark GASPÉ CURE & Design *per se* has become recognized in Canada as designating the kind or quality of salted fish. However, while the applicant's certification mark has not become recognized as designating a kind or quality of salted fish, Sections 111 and 114 of the ***Fish Inspection Regulations***, as well as the first Stoddard affidavit, arguably show that the mark GASPÉ CURE has become recognized in Canada as designating the kind or quality of salted fish. That being the case, the legal burden is upon the applicant to establish either that GASPÉ CURE has not, in fact, become recognized in Canada by ordinary and *bona fide* commercial usage as designating the kind or quality of salted fish or, in the alternative, that its certification mark GASPÉ CURE & Design does not so nearly resemble the mark GASPÉ CURE as to be likely to be mistaken for it.

Since the dominant element of the applicant's certification mark is the words GASPÉ CURE, I find that the applicant has failed to establish that the average consumer of salted fish might not mistake the applicant's certification mark for the mark GASPÉ CURE particularly when the applicant's mark is sounded. Consequently, to meet its legal burden in relation to the first ground, the applicant must establish that the designation GASPÉ CURE has not become recognized in Canada as designating the kind or quality of salted fish. In my view, the applicant's evidence tends to support the conclusion that the words GASPÉ CURE describe a particular kind or quality of salted fish. In his affidavit dated April 10, 1997, Mr. Gagne states as follows:

9. Au moins depuis le début de ce siècle, les producteurs de poisson salé de la côte de Gaspé ont employé et adopté la marque "Gaspé", "Gaspé" ou "Gaspé Cure" en liaison avec le poisson faiblement salé qu'ils transformaient et vendaient;

17. Au surplus, l'AQIP a adopté des normes définies relatives à la transformation et à la qualité du poisson salé de façon à ce que le poisson salé identifié au moyen de la marque de certification "Gaspé" et de la marque de certification "Gaspé et dessin" respecte la tradition de qualité qui caractérise le "Gaspé Cure";

19. L'exigence du séchage à l'extérieur est une composante essentielle dans le processus de transformation du poisson "Gaspé Cure", le tout tel qu'il apparaît des extraits pertinents des ouvrages annexés en liasse et identifiés au moyen de la cote Q-3;

32. L'AQIP est bien fondée à enregistrer la marque de certification susmentionnée en liaison avec du poisson salé puisque la marque "Gaspé" ou "Gaspé Cure" est étroitement associée au poisson salé transformé sur le côte de Gaspé et que l'AQIP est une association commerciale ayant un représentant dans cette région.

As well, Armand Lachance, a specialist in the area of maritime fishing since 1958, states in his

affidavit:

5. Le “Gaspé Cure” est un poisson salé et séché produit en Gaspésie depuis plusieurs générations;
6. Le “Gaspé Cure” se distingue des autres poissons salés produits dans d’autres régions en raison principalement de l’influence des conditions climatiques propres à la péninsule gaspésienne;
7. En effet, le “Gaspé Cure” est un poisson faiblement salé, séché presque totalement à l’air libre, dont la lente maturation se fait dans les conditions climatiques propres à la péninsule gaspésienne: soit ensoleillement, air sec et frais, vents du nord-ouest et absence de brouillard;
8. Le vieillissement naturel qui en résulte donne au poisson salé séché “Gaspé Cure” un goût unique et une saveur très fine qui en fait un produit haut-de-gamme recherché par les consommateurs;

Further, in their affidavits, each of the affiants Réal Nicolas, Benoît Reeves, Jean-René Denis, Robert Langlois and Roch Lelièvre state the following:

12. L’authentique poisson salé “Gaspé Cure” est, à ma connaissance, uniquement produit par des transformateurs originaires de la côte de Gaspé.
13. L’expression “Gaspé Cure” est, à ma connaissance, traditionnellement réservée et utilisée pour le poisson salé transformé sur la côte de Gaspé et qui répond à des caractéristiques bien définies.
22. L’exigence du séchage à l’extérieur est une composante essentielle dans le processus de transformation du poisson “Gaspé Cure”.

Having regard to the applicant’s own evidence, I have concluded that GASPÉ CURE has become recognized in Canada as designating a kind or quality of salted fish product and that such recognition has occurred by ordinary and *bona fide* commercial usage of the mark GASPÉ CURE in Canada. As a result, and since the applicant’s certification mark so nearly resembles the mark GASPÉ CURE as to be likely to be mistaken for it, I find that the applicant has failed to meet the legal burden upon it in respect of the first ground of opposition. As a result, the applicant’s trademark GASPÉ CURE & Design is not registrable in view of Paragraph 12(1)(e) and Section 10 of the *Trade-marks Act*.

The allegations of fact relied upon by the opponent do not support the second ground of opposition which is based on Paragraph 38(2)(c) of the *Trade-marks Act*. Subsection 16(1) of the

Act is the relevant section which relates to the issue of the present applicant's entitlement to registration of the certification mark GASPÉ CURE & Design and it provides as follows:

16. (1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of those wares or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with
- (a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;
 - (b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
 - (c) a trade-name that had been previously used in Canada by any other person.

In the present case, the opponent has not relied upon a pending trade-mark application or upon a previously used "trade-mark" or "trade-name" in challenging the applicant's entitlement to registration. Rather, the opponent has referred to the use by others of the designation GASPÉ CURE which the opponent has submitted is a term which describes the kind or quality of a salted fish product. Thus, this ground is dismissed as being contrary to Paragraph 38(3)(a) of the *Trade-marks Act*.

The third ground of opposition is based on Paragraph 38(2)(d) and Section 2 of the *Trade-marks Act*, the opponent alleging that the certification mark GASPÉ CURE & Design is not distinctive of the wares of those persons authorized by the applicant to use the certification mark, nor is it adapted to distinguish the wares of those persons from the wares of the opponent which has used the designation GASPÉ CURE in Canada in association with a particular kind and quality of salted fish produced in accordance with the above-noted subsections of the *Fish Inspection Regulations*. However, as noted above, the opponent's activities appear to have been restricted to the export market and are therefore of little relevance in showing that the applicant's certification mark is not distinctive in Canada. I have therefore rejected the final ground of opposition.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 12th DAY OF NOVEMBER, 1998.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.