

IN THE MATTER OF AN OPPOSITION by Burns Philip Canada
Inc. to application No. 633,262 for the trade-mark TOP SHELF filed
by Geo. A. Hormel & Company

On June 13, 1989, Geo. A. Hormel & Company filed an application to register the trade-mark TOP SHELF based upon use and registration of the trade-mark in the United States of America in association with "main dish entrees consisting primarily of beef, pork, chicken and fish with vegetables, noodles and/or rice as the main ingredients". The applicant also based its application upon proposed use of the trade-mark in Canada and making known of the trade-mark in Canada since October 24, 1988 in association with "food entrees containing vegetables, pasta, fish, poultry and meat". However, the applicant deleted the proposed use and use and registration abroad bases for registration prior to its application being advertised for opposition purposes in the Trade-marks Journal on June 27, 1990.

The opponent, Burns Philip Canada Inc., filed a statement of opposition on July 10, 1990 in which it alleged the following:

- (a) That the applicant's application is not in compliance with Section 30 of the Trade-marks Act in that the applicant has not made known its trade-mark in Canada pursuant to Section 5 of the Trade-marks Act and further that the applicant has falsely declared that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares covered in its application;
- (b) That the applicant is not the person entitled to registration in view of Section 16(3)(a) of the Trade-marks Act since on the date when the opponent filed its application for registration of the trade-mark TOP SHELF under application No. 618,723 based upon proposed use of the trade-mark in Canada in association with "frozen meats and shelf stable meats of all kinds with or without vegetables, frozen or canned vegetables of all kinds", the opponent's trade-mark was not confusing with a trade-mark that had previously been used or made known in Canada by any other person and more particularly by the applicant as such made known is denied by the opponent;
- (c) That the applicant's trade-mark is not distinctive in that the applicant had not made its trade-mark known in Canada, as claimed in the present application, such that the applicant's trade-mark TOP SHELF cannot distinguish the applicant's wares from the opponent's wares associated with its trade-mark TOP SHELF which the opponent proposes to use in Canada, having regard to the opponent's trade-mark

application filed November 8, 1988.

The applicant filed a counter statement in which it denied the allegations set forth in the statement of opposition. As well, with respect to the second ground, the applicant pleaded that Section 16(3)(a) of the Act is not relevant to that ground of opposition. However, if the opponent is successful in challenging the applicant's claimed date of making known, the applicant's priority date would effectively be its filing date and the opponent would then have properly pleaded a ground of prior entitlement based on its alleged earlier filed application for the trade-mark TOP SHELF. While the opponent did not evidence its application, in accordance with the opposition decision in McKiel v. Random House, Inc., 45 C.P.R. (3d) 550, at page 552, I have checked the Registrar's records and have confirmed the information relating to its application for the trade-mark TOP SHELF set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Margo L. Nightingale who was cross-examined on her affidavit, the transcript of the cross-examination forming part of the opposition record. The applicant elected not to file any evidence.

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

Initially, I would note that the opponent has failed to allege any facts which would support a ground of opposition under Section 16(1) of the Trade-marks Act. Further, the opponent has not adduced any evidence relating to the alleged non-distinctiveness of the applicant's trade-mark TOP SHELF and has therefore failed to meet the evidential burden upon it in respect of this ground. I have therefore rejected the second and third grounds of opposition.

The only remaining grounds of opposition are based on Sections 30(c) and 30(i) of the Trade-marks Act. The material date with respect to the Section 30 grounds of opposition is as of the filing date of the applicant's application. Further, while the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of the Section 30 ground (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330). To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. In John Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293, at page 298, Mr. Justice McNair characterised the evidential burden on an opponent as follows:

"The evidential burden is the burden of adducing sufficient evidence to persuade the trier of fact that the alleged facts are true: see Sopinka and Lederman, *The Law of Evidence in Civil Cases* [Butterworths], 6th ed., pp. 107-08; Phipson *On Evidence*, 13th ed., para. 44-03; McCormick *On Evidence* [Hornbook Series, West Publishing Co.], 3rd. ed., pp. 946-48; and Thayer, *Preliminary Treatise On Evidence at the Common Law* (1898), ch. 9."

As no evidence has been furnished by the opponent that the applicant falsely declared in its application that it was entitled to use the trade-mark TOP SHELF in Canada, the opponent has failed to meet the evidential burden upon it in respect of the Section 30(i) ground of opposition. I have therefore rejected this ground. As a result, the only remaining ground is that based on Section 30(c) of the Act, the opponent alleging that the applicant had not made its trade-mark TOP SHELF known in Canada since October 24, 1988.

In Molson Breweries, A Partnership v. Pernod Ricard, Société Anonyme, 40 C.P.R. (3d) 102, at pages 106-107, Dubé, J. commented as follows with respect to the burden on the opponent to lead evidence in support of its Section 30(b) plea:

"In the instant case, Molson has ascertained a negative fact, namely, the accuracy of which is peculiarly within the knowledge of Pernod Ricard. The burden on Molson to lead evidence in support of its allegation is thus a light one: John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293, 36 F.T.R. 70 (T.D.); Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R. (3d) 84 (T.M. Opp. Bd.); Canadian Council for Professional Engineers v. Ontario Corp. No. 407,736 (1987), 15 C.P.R. (3d) 551 (T.M. Opp. Bd.), and Nekoosa Packaging Corp. v. AMCA International Ltd. (1989), 27 C.P.R. (3d) 153, 30 F.T.R. 127, 26 C.I.P.R. 206 (T.D.)."

While the Pernod Ricard decision relates to a Section 30(b) ground of opposition, the principle enunciated in that decision concerning the burden on an opponent to lead evidence is equally applicable to a Section 30(c) ground of opposition. However, the activities which would support a claim to making known of a trade-mark in Canada are far broader in scope than would be the case of a claim to use of a trade-mark in Canada.

In Shyba v. Kinder-Care Learning Center, Inc., 76 C.P.R. (2d) 204, the Opposition Board considered the issue of the initial burden on an opponent in respect of a Section 30(c) ground of opposition. At pages 209-210, the hearing officer commented as follows:

In the present case, the applicant has claimed that it has made its trade-mark TOP SHELF well-known in Canada by reason of it having used the trade-mark in the United States and by reason of the advertising of its wares in association with the trade-mark in printed publications circulated in Canada and by advertising the trade-mark in association with the wares in television broadcasts received in Canada, in the ordinary course of business, amongst potential dealers in or users of such wares. As the applicant has not filed any evidence in this opposition, the sole issue is whether the opponent has met the evidential burden upon it in respect of its Section 30(c) ground of opposition. In this regard, the opponent submitted the affidavit of Margo L. Nightingale, a student-at-law employed by the trade-mark agents for the opponent.

In her affidavit, Ms. Nightingale states that she was "instructed to research whether George Hormel had "sold" food products under the name "TOP SHELF" in Canada on or around September 24, 1988 as alleged". However, the applicant has claimed that it has made its trade-mark TOP SHELF known in Canada since October 24 1988 in the manner contemplated by Section 5(b) [not Section 5(a)] of the Trade-marks Act. As a result, there are two inaccuracies, underlined above, in the instructions given Ms. Nightingale which were the bases upon which she undertook her research. However, I do not consider that either of these inaccuracies to be of any particular relevance to the results of the investigations undertaken by Ms. Nightingale.

According to Ms. Nightingale, she undertook an on-line search of various Quicklaw databases including Canada News-Wire, Canadian News Index, Canadian Business and Current Affairs, as well as the Infoglobe data base, and obtained no information regarding TOP SHELF food

products. However, from the Nightingale cross-examination, it would appear that these data bases are directed primarily to news or business articles. Further, on cross-examination, Ms. Nightingale indicated that she was uncertain as to whether any of the data bases contained advertising copy appearing in the newspapers from which the information in the data bases was extracted. As a result, the absence in the data bases of any advertising concerning the food product TOP SHELF does not assist the opponent in so far as meeting the evidential burden upon it in respect of the Section 30(c) ground.

In paragraph 5 of her affidavit, Ms. Nightingale states that she undertook a search for articles and advertisements relating to the TOP SHELF food product in various newspapers and magazines, but found no reference to TOP SHELF food products in any of the publications. The first three publications are indexes which do not contain advertisements and therefore are of no relevance. The remaining publications searched by Ms. Nightingale include McCall's, Macleans, Chatelaine, Ladies' Home Journal, Gourmet, Bon Apétit, Toronto Star and The Ottawa Citizen. As these publications are all dated prior to the applicant's filing date, the material date with respect to a Section 30 ground, I consider them to be of relevance to the Section 30(c) issue. Further, Ms. Nightingale did confirm on cross-examination that, but for Bon Apétit magazine, she was personally aware that the publications which she searched are circulated in Canada.

While Ms. Nightingale did not review a large number of magazines and newspapers, I am satisfied that if, as claimed by the applicant, its trade-mark has been made well-known in Canada, the affiant would have located some advertisements or at least some reference to the applicant's TOP SHELF products in the publications reviewed by Ms. Nightingale. The applicant submitted that Ms. Nightingale conceded on cross-examination that she did not read every word in each of the publications reviewed by her. However, had the applicant's product been advertised or even mentioned in any of the publications reviewed by the affiant, I am certain the applicant would have brought that matter to Ms. Nightingale's attention during her cross-examination.

In paragraphs 7 to 9 of her affidavit, Ms. Nightingale states the following:

7. On Wednesday, December 19, 1990, I made telephone inquiries of various food distributors to determine who might have distributed Hormel products.

8. I spoke to a Mr. Dave Reid, Director of Sales, at World Wide Food Distributor located in Toronto, Ontario. He advised me that he had been in the food distribution market for a number of years, and to his belief and knowledge Hormel TOP SHELF

products had never been sold in Canada due to their inability to get the product accredited.

9. On Wednesday, December 19, 1990, I also spoke with Dr. F. Jargaille, Chief of Import Programs of the Meat and Poultry Products Division in the Food Production and Inspection Branch, at the federal Department of Agriculture. He advised me that the Hormel plant had been voluntarily de-listed on June 27, 1982, and as a result products manufactured at that plant are not eligible for import into Canada, and have not been since 1982.

Apart from being hearsay evidence, paragraphs 8 and 9 appear to relate to the absence of sales in Canada of the applicant's TOP SHELF food products. However, as noted previously, the present application is based upon making known of the trade-mark TOP SHELF in Canada in the manner contemplated by Section 5(b) of the Trade-marks Act, such that the inability of the applicant to import into Canada or to sell its TOP SHELF products in Canada is of little relevance to the issue of the applicant's alleged making known of its trade-mark in this country. Indeed, I would also observe that Section 30(c) of the Trade-marks Act appears to preclude an applicant from basing its trade-mark application on making known of its trade-mark in Canada if it has used its trade-mark in this country.

At the oral hearing, the applicant's agent submitted that it was prepared to waive its objection to the hearsay nature of paragraph 8 as it considered the statements made in the paragraph, as well as in the related portion of the transcript of the Nightingale cross-examination, to support the applicant's position in this proceeding. It would appear that Mr. Reid knew of TOP SHELF products as he would not otherwise have been able to inform Ms. Nightingale that TOP SHELF products had not been sold in Canada due to the inability of the applicant to get the product accredited. However, there is no evidence that he had become aware of the TOP SHELF products by way of printed publications circulated in Canada or by radio or television broadcasts received in Canada, as contemplated by Section 5(b) of the Trade-marks Act. As a result, I do not consider that paragraphs 8 and 9, or the corresponding portions of the Nightingale cross-examination, support the position of either party in this opposition.

During the Nightingale cross-examination, the applicant's agent presented to Ms. Nightingale a number of photocopies of pages for identification. However, Ms. Nightingale was unable to identify any of the publications from which the photocopies were made as being specific publications

which she came across during her searches. As a result, I do not consider that the photocopies have been properly adduced as evidence in this opposition and have ignored them for the purposes of deciding the outcome of this proceeding. Likewise, I have not had regard to the submissions made by the applicant at the oral hearing based on the content of these photocopies. Had the applicant wished to adduce such documents as evidence in this opposition, it could have done so by way of affidavit or statutory declaration at the Rule 44 evidentiary stage.

In its statement of opposition in relation to its non-entitlement and non-distinctiveness grounds, as well as at the oral hearing, the opponent pointed out that it had filed an application for registration of the trade-mark TOP SHELF in Canada on November 8, 1988. Further, as I have already confirmed in respect of the Section 16 ground, the opponent's application is based upon proposed use of the trade-mark in Canada and covers wares which are closely related to the applicant's wares. Thus, it would appear that approximately seven months after the filing date of the opponent's application for the trade-mark TOP SHELF, the applicant filed the present application based upon proposed use, use and registration of the trade-mark TOP SHELF in the United States of America, and making known of its trade-mark TOP SHELF in Canada since October 24, 1988. The applicant subsequently amended its application by deleting the proposed use and use and registration abroad bases from the present application.

Unlike a claimed date of first use of a trade-mark, a claimed date of making known of a trade-mark in Canada is far from being clearly identifiable. Indeed, the issue as to whether a trade-mark has become well-known is itself a nebulous concept. Added to these uncertainties is the issue as to whether a trade-mark can qualify as being well-known in Canada under Section 5(b) of the Trade-marks Act if it is well-known only to potential dealers in the wares. While the wording of Section 5(b) is susceptible to such an interpretation, I have my doubts as to whether that interpretation is consistent with the intent of Section 5. In any event, the applicant having filed the present application more than seven months after the filing by the opponent of its application and claiming a making known date which predates the opponent's filing date by about two weeks certainly raises some concerns in my mind regarding the applicant's claim to making known of its trade-mark in Canada.

Having regard to the above, I am satisfied that the opponent has raised at least some question relating to the applicant's claim that it has made its trade-mark TOP SHELF known in Canada in association with the wares covered in the present application since October 24, 1988. Accordingly, the opponent has therefore met the evidential burden upon it in respect of the Section 30(c) ground

of opposition. It may well be that there is a logical explanation for the applicant's product not having been advertised in any of the publications identified in paragraph 5 of the Nightingale affidavit. Certainly, it is possible that the applicant's making known of its trade-mark in Canada has been almost exclusively by way of television advertising received in Canada or by way of publications circulated in Canada other than those identified in the Nightingale affidavit. However, it is not the function of the Registrar to speculate as to the nature of the advertising relied upon by the applicant in concluding that it had made its trade-mark TOP SHELF well-known in Canada as of October 24, 1988. Rather, the legal burden is on the applicant to satisfy the Registrar that its application complies with Section 30(c) of the Act and, in the present case, the applicant has failed to meet this burden.

In view of the above, I have concluded that the applicant has failed to satisfy me that its application complies with Section 30(c) of the Trade-marks Act. I have therefore refused the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1993.

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