IN THE MATTER OF AN OPPOSITION by Hershey Canada Inc. to application No. 520,202 for the trade-mark FROSTY CUPS filed by Regal Imports Canada Inc., and presently standing in the name of Regal Confections Inc.

On April 9, 1984, the applicant, Regal Imports Canada Inc., filed an application to register the trade-mark FROSTY CUPS based upon proposed use of the trade-mark in Canada in association with "chocolate flavoured confectionaries". The applicant disclaimed the right to the exclusive use of the word CUPS apart from its trade-mark.

The opponent, Hershey Canada Inc., filed a statement of opposition on October 22, 1985 in which it alleged that the applicant's application is not in compliance with Section 29 (now Section 30) of the Trade-marks Act in that the words FROSTY CUPS are not registrable in that the word FROSTY is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares and the word CUPS has been disclaimed apart from the trade-mark. The opponent next alleged that the applicant's trade-mark is not registrable in view of Section 12(1)(b) of the Trade-marks Act in that the word FROSTY is clearly descriptive or deceptively misdescriptive of the character or quality of wares described as "chocolate flavoured confectionaries" and the word CUPS has been disclaimed. As its final ground of opposition, the opponent alleged that the applicant's trade-mark is not distinctive in that it does not actually distinguish and it is not adapted to distinguish the wares of the applicant from the wares of others. Further, the opponent in respect of the non-distinctiveness ground of opposition asserted that the applicant's trade-mark is not distinctive in that it is either clearly descriptive or deceptively misdescriptive as alleged in respect of the Section 12(1)(b) ground of opposition.

The applicant served and filed a counter statement, and subsequently an amended counter statement, in which it in effect denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavits of Mildred Joan Lusk and Grace A. Thomas while the applicant filed as its evidence the affidavit of Henri Neufeld.

As evidence in reply, the opponent submitted yet a further affidavit of Mildred Joan Lusk (dated March 30, 1988). The applicant argued that the second Lusk affidavit which purports to show that the term FROSTY in reference to food products has been used generically in the marketplace was not strictly confined to matter in reply to the Neufeld affidavit. The opponent, on the other hand, submitted that the Lusk affidavit is in reply to paragraph 3 of the Neufeld affidavit. In paragraph 3

of his affidavit, Mr. Neufeld states the following:

> "3. As exemplified by the above registrations owned by the Applicant and by the Affidavit of MILDRED JOAN LUSK, sworn January 13, 1987, filed by the Opponent, other trade marks are being used by the Applicant and its competitors on the market, conveying or suggesting the same idea as the trade mark "FROSTY CUPS" filed for registration by the Applicant."

In so far as the affiant has commented on the first Lusk affidavit as opposed to placing facts before the Registrar, I consider this part of paragraph 3 of the Neufeld affidavit to be more a matter of legal argument and, as such, cannot form the basis upon which the opponent can justify the filing of reply evidence under Rule 45 of the Trade-marks Regulations. Further, no evidence has been adduced by the applicant that it has used any of the registered trade-marks referred to in paragraph 2 of the Neufeld affidavit and the reference to the opponent's registrations does not support the filing by the opponent of the second Lusk affidavit as reply evidence. Accordingly, the second Lusk affidavit is not strictly confined to matter in reply to the Neufeld affidavit and is therefore not proper reply evidence in this proceeding.

The opponent alone filed a written argument and both parties were represented at an oral hearing.

During the opposition proceeding, Regal Confections Inc. was entered as the applicant of record in respect of this application.

The opponent's first ground of opposition based on Section 30 of the Act is founded on the allegation that the applicant's trade-mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares. Accordingly, the determination as to whether the applicant's trade-mark is registrable in view of Section 12(1)(b) of the Trade-marks Act will effectively decide the first two grounds of opposition.

The issue as to whether the applicant's trade-mark FROSTY CUPS is clearly descriptive of the applicant's wares must be considered from the point of view of the average consumer or user of those wares. 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 (April 9, 1984). 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. Also, the material date with respect to the issue of distinctiveness is as of the date of opposition (October 22, 1985). Further, while the legal burden is on the applicant to establish the registrability and distinctiveness of its trade-mark, as well as to establish that its application is in compliance with Section 30 of the Act, there is an evidential burden on the opponent in respect of each of these grounds 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 and non-distinctiveness of the trade-mark FROSTY CUPS, as well as the alleged non-compliance of the applicant's application with Section 30 of the Act. 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 totality of the opponent's evidence relates to matters arising subsequent to the filing date of the applicant's application, as well as the filing date of the opponent's statement of opposition. The first Lusk affidavit relates to purchases made by the affiant in December of 1986, two and a half years after the filing by the applicant of its application and more than a year after the date of opposition. Further, I am not prepared to infer from the Lusk affidavit that any of the products identified in the affidavit were available in the marketplace as of either of the material dates. Likewise, Grace Thomas in her affidavit refers to matters existing as of the date of her affidavit (March 25, 1987) and therefore cannot be considered as relevant to any of the issues in this opposition.

Having regard to the above, I have concluded that the opponent has failed to meet the evidential burden upon it in respect of any of its grounds of opposition. Accordingly, I have rejected each of the grounds of opposition asserted by the opponent in its statement of opposition.

In view of the above, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF MAY 1990.

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