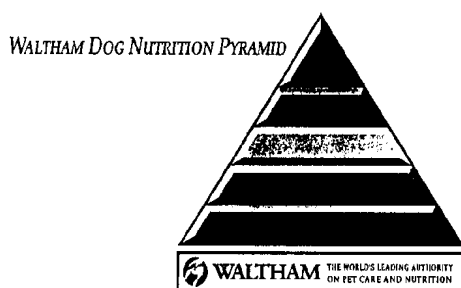


**IN THE MATTER OF AN OPPOSITION by Ralston Purina
Canada Inc. and Ralston Purina Company to registration of the
trade-mark WALTHAM DOG NUTRITION PYRAMID &
Design, application No. 780,399 filed by Effem Foods Ltd.**

On April 13, 1995, the applicant, Effem Foods Ltd., filed an application to register the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with “pet food”. The applicant disclaimed the right to the exclusive use of DOG and PET apart from its trade-mark.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 13, 1995 and the opponents, Ralston Purina Canada Inc. and Ralston Purina Company, filed a statement of opposition on February 9, 1996, a copy of which were forwarded to the applicant on February 27, 1996. The applicant served and filed a counter statement to the statement of opposition on June 25, 1996. The opponents submitted as their evidence the affidavit of Debbie L. Valois while the applicant filed as its evidence the affidavits of David Jones and Christopher Aide. David Jones was cross-examined on his affidavit, the transcript of the cross-examination and the exhibits to the cross-examination, together with the responses to undertakings given during the cross-examination, forming part of the record of this opposition. Both parties submitted written arguments and both were represented at an oral hearing.

The following are the grounds of opposition asserted by the opponents:

- a) The present application does not comply with Section 30 of the *Trade-marks Act* in that:
 - i) “pet food” is not an ordinary commercial term for the specific wares in association with which the trade-mark is proposed to be used, namely, dog food;
 - ii) the statement that the applicant is satisfied that it is entitled to use the proposed trade-mark in Canada is false in that only “WALTHAM” whose name appears in the proposed trade-mark is entitled as applicant to register the trade-mark;

b) Pursuant to Paragraph 12(1)(a) of the *Trade-marks Act*, the word WALTHAM in the applicant's trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is primarily merely the surname of an individual who is living or has died within the preceding thirty years, and the word WALTHAM is not a portion of the trade-mark which is independently registrable;

c) Pursuant to Paragraph 12(1)(b) of the *Trade-marks Act*, the applicant's trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is not registrable in that in that it is either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of pet food, or of the conditions of or the persons employed in the production of pet food or the place of origin of pet food;

d) The proposed trade-mark WALTHAM DOG NUTRITION PYRAMID & Design neither actually distinguishes the pet food in association with which it is used by the applicant from the wares and services of others including, but not limited to, Kal Kan Foods Inc. and the U.S. Department of Agriculture, the U.S. Department of Health and Human Services, nor is it adapted so to distinguish them. Further, the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design, if it is adapted to distinguish anything, which is denied, is adapted to distinguish a dog nutrition pyramid for dog food of WALTHAM and not dog food of the applicant.

At the oral hearing, the opponents withdrew their ground of opposition based on Subsection 30(a) as applied to the applicant's "pet food".

With respect to the first ground of opposition, the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*. There is, however, an initial evidential burden on the opponents to adduce sufficient evidence which, if believed, would support the truth of the allegations relating to the Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. The material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475]. To meet the evidential burden upon them in relation of a particular issue, the opponents must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Finally, the opponents' evidential burden can be met by reference not only to the opponents' evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R. (3d) 216, at p. 230]. However, while the opponents may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponents must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application.

With respect to the only remaining aspect of the Section 30 ground, the opponents have alleged that the statement that the applicant is satisfied that it is entitled to use the proposed trade-mark in Canada is false in that only “WALTHAM” whose name appears in the proposed trade-mark is entitled as applicant to register the trade-mark. No evidence has been furnished by the opponents to show that the applicant, as of the filing date of its application, could not have been satisfied that it is entitled to use its trade-mark WALTHAM DOG NUTRITION PYRAMID & Design in Canada. I would also note that the other grounds of opposition, even were they successful, would not preclude the applicant from using, as opposed to registering, its trade-mark in Canada. I have therefore dismissed this ground of opposition.

Considering next the ground of opposition based on Paragraph 12(1)(a) of the *Trade-marks Act*, the opponents have asserted that the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is not registrable in view of Paragraph 12(1)(a) of the *Trade-marks Act* in that the word WALTHAM in the applicant’s trade-mark is primarily merely the surname of an individual who is living or has died within the preceding thirty years, and the word WALTHAM is not a portion of the trade-mark which is independently registrable. The opponents appear to have conceded that this ground should be rejected in view of paragraph 38 of their written argument. However, as this ground has not been specifically withdrawn by the opponents, I will comment briefly on it. In considering the Paragraph 12(1)(a) ground, I have had regard to the following comments of Mr. Justice Cattanach in *Gerhard Horn Investments Ltd. v. The Registrar of Trade Marks*, 73 C.P.R. (2d) 23, at p. 30:

“The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is "primarily merely" a name or surname rather than something else.”

In the present case, no evidence has been furnished by the opponents in support of this ground. Thus, the first consideration for determining whether or not a word falls within the ambit of Paragraph 12(1)(a) of the *Act* has not been satisfied. Accordingly, I have concluded that the applicant’s trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is not primarily

merely a surname and have therefore rejected the Paragraph 12(1)(a) ground of opposition.

The opponents have also alleged that the applicant's trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that it is either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of pet food, or of the conditions of or the persons employed in the production of pet food or of the place of origin of pet food. Paragraph 12(1)(b) of the *Act* provides as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the applicant's trade-mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares, or of the conditions of or the persons employed in their production or of their place of origin, must be considered from the point of view of the average consumer of those wares. Further, in determining whether the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analysed, 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 pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

The only affidavit evidence submitted by the opponents is the Valois affidavit which introduces into evidence copies of trade-mark registrations from the United States of America and the United Kingdom. The trade-marks covered by the registrations from the United States stand in the name of KAL KAN FOODS, INC. and are for the following: WALTHAM THE WORLD'S LEADING AUTHORITY ON PET CARE AND NUTRITION & Design; PEDIGREE WALTHAM;

WALTHAM WORLD AUTHORITY ON PET CARE AND NUTRITION & Design; WALTHAM PET NUTRITION PYRAMID & Design; and WALTHAM INTERNATIONAL FOCUS. Further, the registrations from the United Kingdom stand in the name of Mars G.B. and are for the marks: DEVELOPED WITH WALTHAM WORLD AUTHORITY ON PET CARE & NUTRITION & Design; WALTHAM CENTRE FOR EQUINE NUTRITION AND CARE & Design; and PEDIGREE WALTHAM. While the opponents' evidence establishes that registrations for trade-marks similar to the applicant's mark have been granted to entities other than the applicant in both the United Kingdom and the United States of America, I would not expect that the average consumer who purchases pet food in Canada would be aware of any of these marks and their ownership by companies other than the applicant.

The applicant has disclaimed the right to the exclusive use of DOG and PET apart from its trade-mark. The applicant's disclaimer is arguably an admission by the applicant that the words DOG and PET are either clearly descriptive of the character or quality of its "pet food", or of the conditions of or the persons employed in the production of "pet food" or of the place of origin of "pet food" [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at p. 275]. The exhibits to the Jones' affidavit refer to WALTHAM as follows:

"The WALTHAM Centre for pet nutrition has studied growth in breeds of all sizes. This ensures that puppy foods developed by WALTHAM support growth in all breeds."

"All Pedigree® products have been researched and developed by the veterinarians and pet food nutritionists at the Waltham Centre for Pet Nutrition in England. Waltham may be a new name to you, but veterinarians and animal nutritionists worldwide have turned to Waltham for nutritional expertise for over 50 years. ...".

"At Waltham, hundreds of scientists, veterinarians, animal behaviorists and pet nutritionists study pets and their dietary needs on a day to day basis..".

"All the mainmeal Pet foods developed by Waltham are highly palatable, 100% complete and perfectly balanced for your animal."

"At the Waltham Centre alone, 200 dogs representing 10 breeds and 60 veterinarians, pet nutritionists and behavioralists are involved in the process every day."

"Now you can visit our web site and tour the Waltham facility to learn more about the science behind the PEDIGREE® brands. ([Http://www.waltham.com](http://www.waltham.com))"

Having regard to the foregoing, as well as the remaining evidence of record, I am of the view that some consumers who purchase pet food in Canada might possibly recognize the reference to

WALTHAM in the applicant's marks as identifying the Waltham Centre for Pet Nutrition which is involved in the research and development of pet food. To these consumers, the applicant's marks may indicate that the pet food manufactured and sold by the applicant was developed by pet nutritionists associated with the Waltham Centre. On the other hand, I suspect that the average consumer who purchases pet food would not likely be familiar with the applicant's promotional materials or advertisements and would therefore not be aware of the existence of the Waltham Centre. Thus, the average consumer who purchases pet food would perceive the reference to WALTHAM in the applicant's mark as possibly referring to some entity involved in pet nutrition and the development of pet food formulas, but not involved either in the manufacture or the sale of the "pet food". However, in either case, I do not consider that the average consumer who purchases pet food would perceive the applicant's trade-mark, when considered in its entirety, as being either clearly descriptive or deceptively misdescriptive in the English or French languages of either the character or the quality of "pet food". Further, the applicant's mark when considered in its entirety certainly is not descriptive of the conditions of or of the persons employed in the production of "pet food". Moreover, even if WALTHAM were perceived by the average consumer who purchases pet food as referring to a place where research into pet nutrition is carried out or where the formula for the applicant's pet food was developed, the mark WALTHAM *per se* would still not be clearly descriptive of the place of origin of the pet food. In this regard, I am of the view that the place of origin of pet food refers to where the pet food is manufactured. In any event, and even if I am incorrect, the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design includes reading matter and a pyramid design and, when considered in its entirety, certainly is not clearly descriptive or deceptively misdescriptive when depicted, written or sounded of the place of origin of pet food. I have therefore rejected the Paragraph 12(1)(b) ground of opposition.

As their final ground, the opponents have alleged that the proposed trade-mark WALTHAM DOG NUTRITION PYRAMID & Design neither actually distinguishes the pet food in association with which it is used by the applicant from the wares and services of others including, but not limited to, Kal Kan Foods Inc. and the U.S. Department of Agriculture, the U.S. Department of Health and Human Services, nor is it adapted so to distinguish them. Further, the opponents submit that the trade-mark WALTHAM DOG NUTRITION PYRAMID & Design, if it is adapted to distinguish

anything, is adapted to distinguish a dog nutrition pyramid for dog food of WALTHAM and not dog food of the applicant.

Having regard to my previous comments in relation to the Paragraph 12(1)(b) ground, and absent any evidence from the opponents to the contrary, I am of the view that the applicant's trade-mark is adapted to distinguish the applicant's "pet food" from the wares of others. While the average consumer might well conclude that there is an entity involved in the development of the formulation of the pet food manufactured and sold by the applicant in association with its trade-mark, that alone does not preclude the applicant's mark from being adapted to distinguish the applicant's wares from those of others in the marketplace in Canada. Further, as noted above, I do not consider that the average consumer who purchases pet food in Canada would be aware of the use or the registration either in the United States of America or in the United Kingdom of trade-marks similar to the applicant's mark by companies related to the applicant.

The opponents adduced as an exhibit to the Jones cross-examination an advertisement from Newsweek magazine which, according to Mr. Jones during his cross-examination, emanated from Kal Kan Foods, Inc. in the United States of America. While the advertisement includes a representation of a trade-mark similar to the applicant's mark together with the following copyright notice: © 1997 WALTHAM U.S.A., Inc., the advertisement *per se* is not use of that trade-mark in association with pet food and is therefore of limited relevance to the applicant's trade-mark. Moreover, the advertisement is dated about sixteen months after the material date for considering the non-distinctiveness ground and is therefore of little, if any, relevance to the determination of the final ground. I have therefore dismissed the non-distinctiveness ground of opposition.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponents' opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 10th DAY OF NOVEMBER, 1999.

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