

IN THE MATTER OF AN OPPOSITION by Effem Foods Ltd. to
application No. 546,659 for the trade-mark UNCLE TONY'S
CRYSTAL & Design filed by Export/Import Clic Inc.

On July 25, 1985, the applicant, Export/Import Clic Inc., filed an application to register the trade-mark UNCLE TONY'S CRYSTAL & Design, a representation of which appears below, based upon use of the trade-mark in Canada since May 1, 1985 in association with "riz naturel à grain moyen italien". The applicant disclaimed the right to the exclusive use of the eleven point maple leaf apart from its trade-mark.

The opponent, Effem Foods Ltd., filed a statement of opposition on August 11, 1987 in which it alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior use by the opponent in Canada of its registered trade-marks UNCLE BEN'S, registration No. 149/38182, Portrait Design, registration No. 107,440, UNCLE BEN'S QUICK RICE, registration No. 217,389 and UNCLE BEN'S CONVERTED RICE, registration No. 328,610. The opponent further alleged that the applicant's application does not comply with section 29 (now Section 30) of the Trade-marks Act in that the applicant could not have been satisfied of its entitlement to registration of the applied-for mark, having regard to the opponent's trade-marks noted above.

The applicant served and filed a counterstatement in which it denied the allegations of confusion between the trade-marks of the parties.

The opponent filed as its evidence the affidavit of Donald M. Robinson while the applicant submitted the affidavits of Amine Rahal, Brian McBride, Sophie Dufresne, Rene Dame, Sylvain Inkel, Jean-Pierre Mondou, Michel Malette, Antoine Laplante, Daniel Lasalle, Stanley Gawrych and Milton Antypas.

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

During the opposition, the opponent was granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition in order to allege the further ground that the applicant's application was not in compliance with Section 29 (now Section 30) of the Trade-marks Act in that the applicant has not used its trade-mark in Canada since the claimed date of first use, having used a substantially different mark. Further, the applicant was granted leave to amend its counterstatement in order to respond to the additional ground of opposition based on Section 30 of the Act.

At the oral hearing, the opponent withdrew its grounds of opposition based on its Portrait Design trade-mark, registration No. 107,440.

The grounds of opposition relating to the registrability and distinctiveness of the applicant's trade-mark, as well as the applicant's entitlement thereto, turn on the issue of confusion between the applicant's trade-mark UNCLE TONY'S CRYSTAL & Design and one, or more, of the opponent's registered trade-marks. Further, the most relevant of the opponent's trade-marks is its registered trade-mark UNCLE BEN'S, registration No. 149/38182, covering, inter alia, "rice for food". Accordingly, the determination of the issue of confusion between the applicant's trade-mark and the registered trade-mark UNCLE BEN'S will effectively resolve all the issues based on the allegations of confusion set forth in the statement of opposition.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538. Further, the material date in respect of the non-entitlement ground of opposition is as of the applicant's claimed date of first use of May 1, 1985.

Considering the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark UNCLE TONY'S CRYSTAL & Design and the opponent's registered trade-mark UNCLE BEN'S possess some measure of inherent distinctiveness when considered in their entireties. The opponent's trade-mark includes the common given name Ben while the applicant's mark includes the common nickname Tony and neither add much inherent distinctiveness to the trade-marks at issue. However, the initial element UNCLE in each mark does add some inherent distinctiveness to the trade-marks of the parties and the other elements of the applicant's design trade-mark contribute to its inherent distinctiveness.

The opponent's trade-mark UNCLE BEN'S is very well known, if not famous, in Canada in association with rice. In this regard, the Robinson affidavit attests to gross sales in Canada of the opponent's UNCLE BEN'S rice from 1982 to 1988 exceeding \$188,000,000 while promotional expenditures in this country during that time were approximately \$29,000,000. The applicant has also established that it has used its trade-mark in Canada and has evidenced in excess of \$570,000 sales of its UNCLE TONY'S CRYSTAL rice in Canada by way of the Rahal affidavit. While the opponent has noted that the applicant's trade-mark as used varies from the trade-mark sought to be registered, I consider the changes in the applicant's marks as used to be very minor in nature. In this regard, it may well be that the drawing of the applicant's trade-mark as filed with the Trade-marks Office fails to clearly indicate the representation of a cedar tree within the design of the maple leaf, an element which the applicant claims in its evidence is a characteristic of its trade-mark. Further, I would note that the exhibits originally filed with the Trade-marks Office in support of the present application do include a representation of a cedar tree within the representation of a maple leaf.

The length of time that the trade-marks have been in use favours the opponent in that the opponent's UNCLE BEN'S rice has been distributed in this country since at least as early as 1947 whereas the applicant has claimed use of its trade-mark in Canada since May 1, 1985.

The wares of the parties and the respective channels of trade associated with their wares are identical.

As for the degree of resemblance between the trade-marks at issue, the trade-marks do possess some degree of similarity in appearance when considered in their entireties as a matter of first impression and imperfect recollection. Both the applicant's trade-mark UNCLE TONY'S CRYSTAL & Design, which is dominated by the words UNCLE TONY'S, and the opponent's trade-mark UNCLE BEN'S, include the initial element UNCLE followed by the possessive form of a

common Christian name or nickname. As such, the trade-marks at issue are somewhat similar in appearance. Further, the applicant's wares would be identified aurally by the average consumer as UNCLE TONY'S rice and the opponent's as UNCLE BEN'S rice and, as such, the marks of the parties do bear some similarity when sounded. In this regard, I do not consider that the other elements of the applicant's trade-mark would be used by the average consumer when referring aurally to the applicant's rice product. Further, both of the trade-marks at issue suggest the idea of a particular individual associated with the wares of the parties and, as such, the trade-marks at issue do bear some similarity in the ideas suggested by them.

As a surrounding circumstance in this opposition, the applicant has filed the affidavit of Brian McBride, Executive Vice-President of K.J. Preiswerch, a division of Preisco Foods Ltd. In his affidavit, Mr. McBride states that Preisco Foods Ltd. is the registered owner of UNCLE TOM'S, registration No. 306,077, "for use in association with rice, and has used this mark in association with rice since at least as early as 1955". Further, according to the affiant, "PREISCO FOODS LTD. has been selling since 1955, and continues to sell UNCLE TOM'S brand rice in Canada". However, Mr. McBride has not provided any sales figures associated with the sale in Canada of his company's UNCLE TOM'S rice, nor has he furnished any evidence relating to the manner of use of his company's trade-mark. Accordingly, Mr. McBride's affidavit is of little value insofar as constituting evidence that the distinctiveness of the opponent's trade-mark UNCLE BEN'S has been diluted and, therefore, that the scope of protection which should be accorded to it in this proceeding should be limited.

In his affidavit, Amine Rahal, the director of marketing of the applicant, states that the applicant has identified its UNCLE TONY'S CRYSTAL rice in a number of buyer's guides and has distributed promotional materials which include reference to the applicant's UNCLE TONY'S rice. As well, according to Amine Rahal, the applicant's UNCLE TONY'S rice has been shown and promoted at a number of conventions and exhibitions in Canada which he has listed in his affidavit. In paragraph 12 of the Rahal affidavit, the affiant states:

"QUE les ventes totales liées à la marque de commerce UNCLE TONY'S CRYSTAL & DESSIN se lisent comme suit:

1985: 2% des ventes totales, soit 4 648.64 \$

1986: 4% des ventes totales, soit 48 402.16 \$

1987: 5% des ventes totales, soit 144 242.65 \$

1988: 7% des ventes totales, soit 377 398.06 \$

Les états financiers de la compagnie, démontrent les faits énumérés aux paragraphes 11 et 12 sont annexés à la présente sous la cote A-4 pour en faire partie intégrante;"

The Rahal affidavit points to sales in excess of \$570,000 of the applicant's UNCLE TONY'S CRYSTAL rice through more than 650 stores in Canada. Further, according to the affiant, no instances of actual confusion between the trade-marks at issue have been brought to the attention of the applicant. Further, the affidavits of Laplante, Lasalle, Antypas, Gawrych, Malette, Mondou, Inkel and Dame all attest to the sale of the applicant's UNCLE TONY'S CRYSTAL rice and the opponent's UNCLE BEN'S rice through retail stores employed or managed by them without any instances of actual confusion amongst their clients having been brought to their attention. While these affidavits confirm that no instances of actual confusion were brought to the attention of the affiants, they do not constitute direct evidence that consumers were not confused by the concurrent use of the trade-marks UNCLE TONY'S CRYSTAL & Design and UNCLE BEN'S, both in association with rice, in the marketplace.

Having considered the evidence of the parties, and bearing in mind that the legal burden is upon the applicant in respect of the issue of confusion, I am still left in doubt as to whether or not there would be a reasonable likelihood of confusion between the trade-marks at issue. In particular, the average consumer might well think that the applicant, in adopting the trade-mark UNCLE TONY'S CRYSTAL & Design, is thereby attempting to trade off the goodwill associated with the opponent's famous trade-mark UNCLE BEN'S. As a result, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion.

In view of the above, I find that the applicant's trade-mark UNCLE TONY'S CRYSTAL & Design is not registrable and not distinctive, and that the applicant is not the person entitled to its registration.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF December, 1991.

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