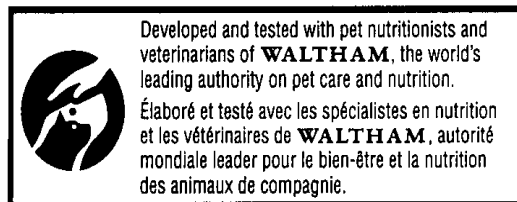


**IN THE MATTER OF OPPOSITIONS by Ralston Purina Canada Inc. and Ralston Purina Company to registration of the trade-marks WALTHAM & Design, application Nos. 765,293, 765,294, 765,295, 765,297, 766,908 and 766,909 filed by Effem Foods Ltd.**

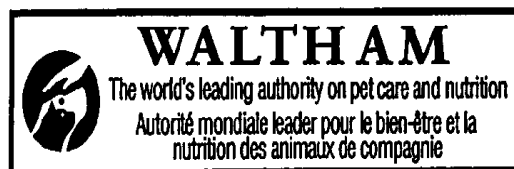
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On September 30, 1994, the applicant, Effem Foods Ltd., filed four applications to register the trade-marks WALTHAM & Design, representations of which appear below.



Application No. 765,293

Application No. 765,293 is based upon proposed use of the trade-mark in Canada in association with “pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.



Application No. 765,294

Application No. 765,294 is based upon use of the trade-mark in Canada since at least as early as 1992 in association with “pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.



Application No. 765,295

Application No. 765,295 is based upon use of the trade-mark in Canada since at least as early as

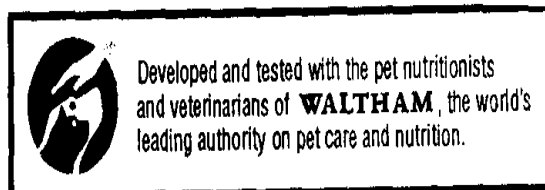
1992 in association with “pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.



Application No. 765,297

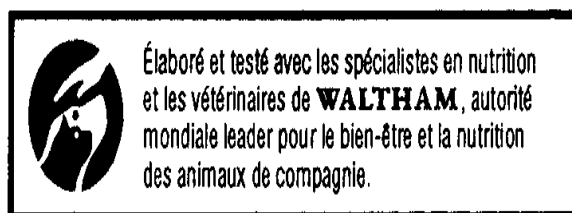
Application No. 765,297 is based upon proposed use of the trade-mark in Canada in association with “pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.

Further, on October 21, 1994, the applicant, Effem Foods Ltd., filed two further applications to register the trade-marks WALTHAM & Design, representations of which are also set out below.



Application No. 766,908

Application No. 766,908 is based upon proposed use of the trade-mark in Canada in association with “pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.



Application No.

766,909

Application No. 766,909 is based upon proposed use of the trade-mark in Canada in association with

“pet food” and services identified as “Advertising, marketing and promotional services relating to the pet food products of the applicant”. The applicant has disclaimed the right to the exclusive use of all reading matter except WALTHAM apart from its trade-mark.

The above applications were advertised for opposition purposes in the *Trade-marks Journal* as follows and the opponents, Ralston Purina Canada Inc. and Ralston Purina Company, filed statements of opposition to each of the applications on the following dates, copies of which were forwarded to the applicant:

<u>Application No.</u>	<u>Date of Advertisement</u>	<u>Date of Opposition</u>
765,293	November 15, 1995	January 15, 1996
765,294	December 6, 1995	January 17, 1996
765,295	December 6, 1995	January 17, 1996
765,297	December 6, 1995	January 17, 1996
766,908	November 8, 1995	December 21, 1995
766,909	November 8, 1995	December 21, 1995

The following are the grounds of opposition asserted by the opponents in each of the opposition proceedings:

- a) The present application does not comply with Subsection 30(a) of the *Trade-marks Act* in that the services specified herein are not services performed for others and, as a result, the proposed trade-mark WALTHAM & Design is outside of the definition of “trade-mark” set forth in Section 2 of the *Act*;
- b) Pursuant to Paragraph 12(1)(a) of the *Trade-marks Act*, the word WALTHAM in the trade-mark WALTHAM & Design is primarily merely the surname of an individual who is living or has died within the preceding thirty years, and the word WALTHAM in the trade-mark WALTHAM & Design 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 trade-mark WALTHAM & Design is not registrable in that it is either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares and services in association with which it is used or proposed to be used;
- d) The trade-mark WALTHAM & Design neither actually distinguishes the wares and services in association with which it is used by the applicant from the wares and services of others, nor is it adapted so to distinguish them. The trade-mark WALTHAM & Design, if it is adapted to distinguish anything, which is denied, is adapted to distinguish that which has been developed and tested with the pet nutritionists and veterinarians of Waltham and not that which has been developed

and tested with the pet nutritionists and veterinarians of the applicant, Effem Foods Ltd.

In their oppositions to application Nos. 765,297, 765,295 and 765,294, the opponents further alleged in relation to the Paragraph 12(1)(b) ground that the trade-mark WALTHAM & Design is also clearly descriptive or deceptively misdescriptive in the English or French languages of the conditions of or the persons employed in the production of the applicant's wares and services or of their place of origin.

The applicant served and filed a counter statement in each of the opposition proceedings. The opponents submitted as their evidence in each case 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 each of the oppositions. Both parties submitted written arguments and both were represented at an oral hearing. At the oral hearing, the applicant withdrew its services from its applications. Also, the opponents withdrew their grounds of opposition based on Paragraph 12(1)(a) of the *Trade-marks Act*.

As their first ground remaining for consideration, the opponents have alleged that the applicant's trade-marks WALTHAM & Design are not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that the trade-marks WALTHAM & Design are either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares and services in association with which they are used or proposed to be used or of the conditions of or the persons employed in the production of the applicant's wares and services or of their place of origin. 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 trade-marks WALTHAM & Design are clearly descriptive or deceptively

misdescriptive of the character or quality of the applicant's "pet food", 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-marks WALTHAM & Design are clearly descriptive, the trade-marks must not be dissected into their component elements and be carefully analysed, but rather must be considered in their 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.)].

In its written arguments, the opponents have argued that the applicant's marks are deceptively misdescriptive as follows:

45. Based on the cross-examination transcript of Mr. Jones, it is apparent that the word WALTHAM from the applicant's perspective has two meanings. Firstly, in context of pet food, it is identified in Canada as being a trade-mark of his company. However, as **WALTHAM the world's authority on pet care and nutrition**, reference to WALTHAM in this context is not to the applicant (Effem Foods Ltd.), but rather to one or more of the affiliated companies including Effem Foods Ltd. who operate under the "umbrella" of the Mars organization. Thus, while the Mars organization, collectively known as "Waltham", might possibly be the world's leading authority on pet care and nutrition, this statement in the hands of Effem Foods Ltd., the applicant, is clearly false. Indeed, the same or similar expressions are registered and/or used by other members within the Mars organization who are similarly identifying themselves, as opposed to the applicant herein, as "**WALTHAM the world's authority on pet care and nutrition**".

46. Put simply, the expressions "**Developed and tested with the pet nutritionists and veterinarians of "WALTHAM, the world's authority on pet care nutrition**" and "**WALTHAM the world's authority on pet care and nutrition**", as well as the French language equivalent of these expressions, based on the evidence, are both clear and unequivocal descriptive statements of fact. Further, it is also clear that the Canadian applicant applying to register these trade-marks is not **WALTHAM the world's authority on pet care and nutrition** or, itself, the party responsible for having "**developed and tested with pet nutritionists and veterinarians of WALTHAM, the world's authority on pet care and nutrition**" for the reason that this last mentioned phraseology references a third party - whoever that may be.

...

49. In the case at hand, the pet food Effem Foods sells in Canada may well be **Developed and tested with the pet nutritionists and veterinarians of "WALTHAM, the world's authority on pet care nutrition** and "**WALTHAM the world's authority on pet care and nutrition**; however, the referenced "WALTHAM", as admitted by Mr. Jones, is not his company. Similarly, and as again admitted by Mr. Jones, the expression **WALTHAM, the world's authority**

**on pet care nutrition** is not referable to his company, but rather to an amalgam of companies who have no licensing arrangement one between the other. Thus, both expressions under attack misdescribe Effem as the world's authority. Further, it is deceptive for Effem Foods to lay claim to either of these expressions when it knows and has admitted on the record that it is not **“the world's authority on pet care and nutrition”**.

50. As a consequence, applicant submits that the applications of Effem Foods identified as application Nos. 1-6 and 9 should be refused registration on the basis that each one of them is misdescriptive of it and deception to the public is a necessary result since there are many organizations within the Mars group each one of which in its own individual right, is laying claim to the same assertion.

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 marks 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 all the reading matter except the word WALTHAM apart from its trade-marks. The applicant's disclaimer of the reading matter apart from its trade-marks is arguably an admission by the applicant that the reading matter is 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 its “pet food” or of its place of origin [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at p. 275]. Further, 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 persons, 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 would perceive the reference to WALTHAM in the applicant’s marks 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 trademarks when considered in their 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 marks when considered in their entirety certainly are not descriptive of the conditions of or the persons employed in the production of “pet food”. Moreover, even if WALTHAM were perceived by the average consumer 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, the place of origin of wares, in my view, refers to where the pet food is manufactured. In any event, and even if I am incorrect, the trade-marks WALTHAM & Design include the reading matter and the silhouette design and, when considered in their entirety, are certainly 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) grounds of opposition.

The final ground in each of the oppositions is that the trade-marks WALTHAM & Design neither actually distinguish the applicant's "pet food" from the wares and services of others, nor are they adapted so to distinguish the applicant's wares. Having regard to my previous comments in relation to the Paragraph 12(1)(b) grounds, and absent any evidence from the opponents to the contrary, I am of the view that the applicant's trade-marks are either adapted to distinguish or in fact distinguish the applicant's "pet food" from the wares of others. While the average consumer who purchases pet food might well conclude from the applicant's marks 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-marks, that alone does not preclude the applicant's marks from being adapted to distinguish or in fact distinguishing the applicant's pet food in the marketplace in Canada. Further, as noted above, I do not consider that the average consumer of pet food in Canada would be aware of the use and certainly not the registration of their respective trade-marks by companies related to the applicant either in the United States of America or the United Kingdom.

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, emanates from Kal Kan Foods, Inc. in the United States of America. While the advertisement includes a representation of the trade-mark covered by application No. 765,297 together with the following copyright notice: © 1997 WALTHAM USA, Inc., the advertisement *per se* is not use of the trade-mark in association with pet food. Moreover, the advertisement is dated about eighteen months after the material dates for considering the non-distinctiveness grounds of opposition in the six cases and is therefore of little, if any, relevance to the determination of the final ground. I have therefore dismissed the non-distinctiveness grounds 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' oppositions pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 10<sup>th</sup> DAY OF NOVEMBER, 1999.

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