



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

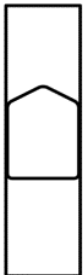
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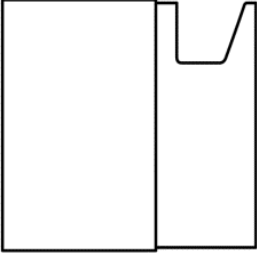
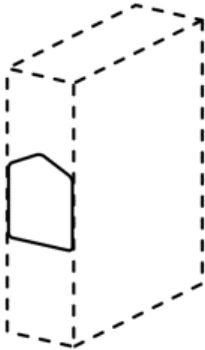
**IN THE MATTER OF THREE
OPPOSITIONS by Rothmans,
Benson & Hedges Inc. to application
Nos. 1370832; 1370833; 1370841 for
the design trade-marks SLIDE
PACK END; OPEN SLIDE PACK;
and SLIDE PACK KEYHOLE in the
name of Player's Company Inc.**

FILE RECORD

[1] On November 6, 2007, Player's Company Inc. filed three design trade-mark applications, shown in column one of Table 1 below, based on proposed use in Canada in association with "manufactured tobacco products." The application numbers and the applicant's names for its designs are shown in the second column of Table 1. The opponent refers to the three applications as the Pack Design Applications and I will do likewise.

Table I

	Application No. 1370832 Slide Pack End Design
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	<p>Application No. 1370833</p> <p>Open Slide Pack Design</p>
	<p>Application No. 1370841</p> <p>Slide Pack Keyhole Design</p>

[2] The subject applications were advertised for opposition purposes in the *Trade-marks Journal* issues dated August 20, 2008 and January 7, 2009 and were opposed by Rothmans, Benson & Hedges Inc. on January 19 and June 5, 2009. The Registrar forwarded copies of the statements of opposition to the applicant as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving counter statements generally denying the allegations in the statements of opposition.

[3] The opponent's evidence in each case consists of the affidavit of Simon Hitchens; certified copies of the file wrappers for the Pack Design Applications; and certified copies of one patent and two patent applications pertaining to cigarette containers. The applicant's evidence in each case consists of the affidavits of Louis-Philippe Pelletier; Christine Genge; and Jayson B. Dinelle. Each of the applicant's affiants was cross-examined on his or her affidavit. The transcripts of the cross-examinations, exhibits thereto, answers to undertakings and positions on questions taken under advisement form part of the evidence of record. The opponent's reply evidence consists of a further affidavit of Simon Hitchens. Both parties filed written arguments and both parties were represented at an oral hearing held on October 31, 2012.

STATEMENT OF OPPOSITION

Opponent's Theory of the Cases

[4] The opponent's theory of the subject cases informs the individual grounds of opposition which are quite similar, or the same, for each opposition. As the grounds of opposition are better understood in the light of the opponent's theory of the cases, I have taken extracts from the opponent's written arguments (they are similar for each opposition), shown below, which highlight the opponent's theory:

These trade-mark opposition proceedings relate to the three trade-mark applications in which the Applicant seeks to register as trade-marks two-dimensional design depictions of a cigarette package. The subject trade-mark applications are not registrable as trade-marks, because each depicts an intrinsic reference to principal functional features of the cigarette packaging. The alleged pack design marks are not registrable pursuant to [sic] well-recognized doctrine of functionality.

The impugned design marks depict intrinsic references to the principal and primary functional aspects of the cigarette packages themselves, namely, how the packages open and how the cigarettes are retrieved from the package once opened.

At the core of objection to the registrations of the subject designs as trade-marks is the fact that the Applicant is indirectly seeking to obtain patent protection through the guise of trade-mark protection. A patent protects function and design. It is abusive and unfair to the public to allow the impugned applications which seek to confer perpetual protection of functional design elements as trade-marks when these functional design elements are otherwise part of the public domain and incapable of patent protection.

[5] The pleadings in the statements of opposition refer to a distinguishing guise which is one of four types of trade-marks referred to in the interpretation section of the *Trade-marks Act*:

“trade-mark” means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

- (b) a certification mark,
- (c) a distinguishing guise, or
- (d) a proposed trade-mark

[6] For ease of reference shown below is the definition of a distinguishing guise set out in s.2 of the *Act*, and the requirements to register such a mark, set out in s.13:

“distinguishing guise” means

- (a) a shaping of wares or their containers, or
 - (b) a mode of wrapping or packaging wares
- the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

13. (1) A distinguishing guise is registrable only if

(a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration; and

(b) the exclusive use by the applicant of the distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry.

(2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.

(3) The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

(emphasis added)

Grounds of Opposition

[7] 1. *Non-Compliance with s.30*

Section 30 of the *Trade-marks Act* requires that an application for registration pertain to a trade-mark, however, the subject applications are not “trade-marks” within the meaning of the *Trade-marks Act* because:

the depictions of the marks merely portray a utilitarian or functional feature of a package,

the alleged trade-marks are common shapes of packages on which other indicia of source appear.

2. *Non-Compliance with s.30(e)*

The applicant did not intend to use the applied-for design marks as trade-marks.

3. *Non-Compliance with s.30(h)*

The applications do not contain accurate drawings and representations of the alleged trade-marks and do not properly define the limits of trade-mark monopolies. Rather, the drawings show that the subject matter of the applications is a distinguishing guise, that is, a “mode of packaging” or a “shaping of containers for wares,” governed by s.13 of the *Trade-marks Act*. The requirements of s.13 have not been met.

4. *Non-Compliance with s.30(i)*

The applicant could not have been satisfied that it was entitled to use the applied for mark in Canada as the applicant was aware that its mark was not a trade-mark for the reasons outlined above.

5. *The Alleged Marks are not Registrable pursuant to s.12 and s.13*

If the claimed mark is a trade-mark at all, then it is a distinguishing guise because the applications relate to the shape of a container or a mode of packages of the wares, namely, manufactured tobacco products. As the distinguishing guise did not become distinctive of the applicant as of the filing date of the application, registration is barred by s.13(1)(a).

6. *The Applicant is Not a Person Entitled to Registration Pursuant to s.16(3)(a)*

The alleged trade-marks were, at the dates of filing the applications, confusing with the trade-marks of others, as applied to tobacco products, previously used and made known in Canada.

7. The Alleged Marks are not Distinctive

The applied for marks are not distinctive, pursuant to s.2, because the marks are views or perspectives of a utilitarian or functional feature of a package and as such cannot inherently function as trade-marks. Alternately, if the alleged marks are inherently capable of being trade-marks, they are not distinctive of the applicant.

[8] At the oral hearing the opponent advised that, in each opposition case, it withdraws the ground of opposition alleging that the applicant is not entitled to register the applied-for mark.

OPPONENT'S EVIDENCE

Simon Hitchens

[9] Mr. Hitchens identifies himself as an associate at the law firm representing the opponent. In July 2009 Mr. Hitchens purchased a carton of the applicant's tobacco products (cigarettes) from a retail outlet in Toronto, Ontario. Attached as exhibits to his affidavits are several photographs of different sides of an individual pack of cigarettes as well as an individual pack removed from the carton.

[10] Mr. Hitchens explains that the pack is comprised of an outer housing and an inner housing. When the inner housing is pushed out to the "open" position, the cigarettes contained in the inner housing become accessible. The inner housing is pushed to the "open" position by inserting a finger through the side "keyhole" illustrated in designs 1370841 and 1370832. I note that designs 1370832 and 1370841 appear to be representations of a side perspective of the pack illustrating the position of the "keyhole" while design 1370833 illustrates the front (or back) perspective of an "open" pack.

[11] The opponent's submissions with respect to the package represented by the applied-for marks is found at paragraphs 15 and 20 of its written argument, shown below:

15. The principal functional features associated with the Applicant's 'Player's Slide Series' packages are as follows:
 - an outer sleeve and an inner sliding compartment

- which contains the cigarettes;
- the outer sleeve contains a pentagonal keyhole cut out on its side wall to facilitate the opening of the cigarette package; and
- the inner sliding compartment has a slanted side notch cut out at the top to facilitate the removal of the cigarettes from the cigarette package.

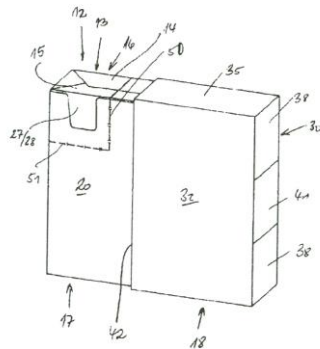
These principal functional features are all depicted in the subject design applications.

20. At the core of each ground of opposition is the fact that each of the trade-mark applications at issue are barred from registration under the doctrine of functionality. All three trade-mark applications are primarily two dimensional design depictions of the inherently utilitarian or functional aspects of the cigarette packaging associated with the wares in question. The principal issue before the Opposition Board is the effect of the doctrine of functionality on the registration of each application.

Canadian Patent Number CA 2027044; Patent Serial Nos: CA 2621915 and CA 2621865

[12] I note that the Canadian patent and patent applications (owned by third parties) evidenced by the opponent show essentially identical or similar functional features as those identified by the opponent in its above submissions. Extracts from the patent and patent applications are shown below:

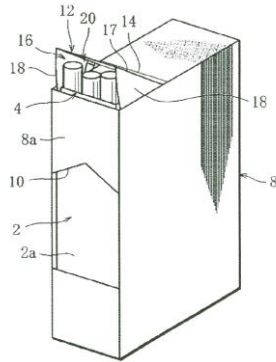
CA 2027044



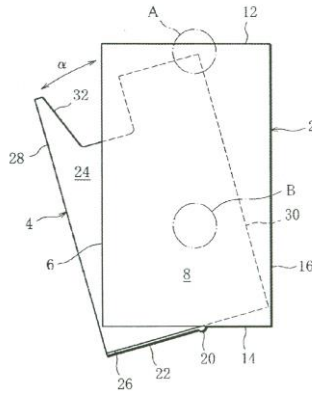
Pack made of thin cardboard, especially for cigarettes. In slide packs, a cigarette group (11) enwrapped by an inner wrapping (12) is located within a box part (17) being open at the top. This box part (17) is slideably arranged in a casing (18) open on one side (push-out opening 29). An oppositely situated side wall (30) is closed except for an

actuating opening (41). For mechanically producing such packs, the casing (18) is designed such that in an intermediate folding position it can be folded down flat. In this intermediate folding position, side tabs (39, 40) for forming the side wall (30) of the casing (18) extend in the plane of front wall (32) and rear wall (33).

CA 02621915



Abstract: A cigarette box has an inner case (2) for receiving a bundle of cigarettes and also has an outer case (8) for vertically movably receiving the inner case (2). The outer case includes a hinged lid (12) forming a part of an upper wall of the outer case (8), an window (10) formed in a side wall of the outer case (8) and partially exposing the inner case (2), and a link (20) for joining the inner case (2) and the hinged lid (12) to each other. When the inner case (2) is pushed up through the window (10) of the outer case (8) the link (20) pushes the hinged lid (12) upward to open it and at the opened position. The hinged lid (12) is projected out from the upper wall of the outer case (8) to provide a take-out opening (16) opened toward a side of the outer case (8).



Abstract: A cigarette box has an outer case and an inner case. The outer case has a movable base (22) that is at a part of the bottom wall (14) of the base and is pivotable about a hinge (20). The inner case (4) is placed in the outer case (2) and receives in it an inner pack of cigarettes. The inner case (4) is connected at only its bottom wall (26) to the movable base (22), and when pivoted together with the movable base (22) about the hinge (20), the inner case (4) is projected from an opening face (6) of the outer case (2) to a side of the outer case (2) and thereby the cigarette box is opened.

APPLICANT’S EVIDENCE

Loius-Philippe Pelletier

[13] Mr. Pelletier identifies himself as an employee of Imperial Tobacco Canada Limited (“ITCan”). From 2005 to 2008, Mr. Pelletier was a Brand Associate for his employer’s subsidiary company Player’s Company Inc (“Player’s”), the applicant herein.

[14] Player’s SLIDE SERIES cigarettes are sold to consumers in Canada in a distinctive package. The package in the open position, shown below, is one of five photographs of the package comprising Exhibit A of Mr. Pelletier’s affidavit:



[15] Distinctive features of the cigarette package are (1) the pentagonal keyhole that is positioned on the side wall of the outer sleeve and (2) a slanted side notch on the inner compartment of the package, both visible in the above photograph.

[16] The size, shape and position of the pentagonal keyhole and the slanted side notch are arbitrary and were selected by the applicant to be unique and distinctive and to assist smokers in identifying the slide pack as a Player's product. From March 2008 to August 2008, ITCan spent in excess of \$750,000 to advertise the availability of Player's SLIDE SERIES cigarettes in magazines and on posters in adult-only establishments such as bars.

[17] The subject trade-mark applications represent the pentagonal keyhole, a side view of the slide package with the pentagonal keyhole visible and the package in the open position with the slanted side notch visible.

[18] Mr. Pelletier is not aware of any other party having used trade-marks in Canada similar to those shown in the subject applications. Mr. Pelletier has reviewed the one patent and two patent applications filed as evidence in this proceeding. He is not aware of any "party in Canada other than Player's ever having promoted or sold cigarettes in cigarette packages such as those described in the patent and two patent applications . . . "

Christine Genge

[19] Ms. Genge identifies herself as a lawyer employed by the firm representing the applicant. Her affidavit pertains to the patents filed as part of the opponent's evidence. With respect to Patent No. 2027444, the size, shape and position of the "opening" in the side wall is not specifically claimed. Similarly, the size and shape of the "recesses" in the front and rear walls of the inner case are not specifically claimed. With respect to Patent

No. 2621865, the size, shape and position of the “push window” on the side wall is not specifically claimed. Similarly, the size and shape of the “pull-up mouth” on the front and rear walls of the inner case are not specifically claimed. Further, the patent application (at page 5) states that the “push window” may have an arbitrary shape. With respect to Patent No. 2621915, the size, shape and position of the “window” on the side wall is not specifically claimed.

Jayson B Dinelle

[20] Mr. Dinelle identifies himself as a law clerk employed by the firm representing the applicant. On Nov.12, 2009, Mr. Dinelle purchased, in Ottawa, a package of the applicant’s SLIDE SERIES cigarettes. Attached as Exhibit A to his affidavit are a series of photographs of the package from different perspectives. It appears that the package conforms to the designs which are the subjects of the present applications.

[21] I note that the testimony of Louis-Philippe Pelletier, Christine Genge and Jayson B. Dinelle on cross-examination do not contradict their affidavit evidence.

OPPONENT’S REPLY EVIDENCE

Simon Hitchens

[22] On Nov. 22, 2010, Mr. Hitchens purchased, in Ottawa, two packages of the applicant’s SLIDE SERIES of cigarettes. Attached as exhibits to his affidavit are photographs of the packages from different perspectives. It appears that the packages conform to the designs which are the subjects of the present applications.

WHAT ARE THE APPLIED-FOR MARKS?

[23] Based on my review of the evidence of record, summarized above, I am satisfied that the opponent has met the burden on it to put into issue whether the applied-for marks represent a distinguishing guise. The legal onus is therefore on the applicant to show, on a balance of probabilities, that the three applied-for marks do not represent a distinguishing guise. However, the weight of the evidence strongly indicates that the applicant intended to use, and that the applicant in fact began to use, a single mark; that mark is a three-dimensional mark and it is a distinguishing guise. The applicant’s distinguishing guise is

a shaping of a container for “manufactured tobacco products,” that is, cigarettes. The subject applications are in essence three different perspectives of a distinguishing guise. In one perspective the container is in the “open” position (application No.1370833). It appears to me that, based on the evidence of record, it is untenable for the applicant to take the position that it intended to use three distinct design marks for its wares. Whether certain aspects of the distinguishing guise are utilitarian features, and whether the mark as a whole is barred from registration by the doctrine of functionality, are questions separate and apart from the issue of whether the applicant has improperly applied for two-dimensional marks rather than for a distinguishing guise.

[24] In view of my finding that the proper subject of the trade-mark applications ought to have been a distinguishing guise, the opponent succeeds on the second and third grounds of opposition. In the event that it is possible to construe the three separate applications as constituting an application for a distinguishing guise (in my view it is not possible), then the applicant’s evidence filed herein is insufficient to establish that its mark was distinctive as of the filing date of the applications, that is, as of November 6, 2007. The opponent would succeed on the fifth ground of opposition.

THE DOCTRINE OF FUNCTIONALITY

[25] Both parties in their written arguments and at the oral hearing made extensive submissions on whether the applied-for marks were barred from registration by the doctrine of functionality. As I have found in favour of the opponent on the basis that the applied-for marks are in fact representations of a distinguishing guise, it is not necessary for me to address the remaining grounds of opposition, including those based on the allegation of functionality. Further, it may be preferable if I refrain from making findings on the issue of functionality. In this regard, nothing prevents the applicant (or others) from filing an application for a distinguishing guise having the same (or similar) features as the present mark, which application may result in an opposition proceeding where functionality will be in issue. If so, then this Board will have an opportunity at that time to examine the doctrine of functionality in the context of an application for a distinguishing guise.

DISPOSITION

[26] In view of my findings in paragraphs 23 and 24 above, the subject applications are refused. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office