

**IN THE MATTER OF AN OPPOSITION
by Labatt Brewery Company Limited / La
Brasserie Labatt Limitee to application No.
793,765 for the trade-mark GLACIER BERRY
filed by The Mark Anthony Group Inc.
(now Mark Anthony Properties Ltd.)**

On September 28, 1995, the applicant, The Mark Anthony Group Inc. (now Mark Anthony Properties Ltd.), filed an application to register the trade-mark GLACIER BERRY for "alcoholic beverages namely cider" based on use in Canada since March of 1995. The applicant amended its application to include a disclaimer to the word BERRY and the application was subsequently advertised for opposition purposes on September 18, 1996.



The opponent, Labatt Brewery Company Limited / La Brasserie Labatt Limitee, filed a statement of opposition on February 18, 1997, a copy of which was forwarded to the applicant on March 10, 1997. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks of the opponent:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
289,981	GLACIER	alcoholic brewery beverages
348,347	GLACIER LIGHT	alcoholic brewery beverages
348,879		alcoholic brewery beverages

		
458,033	K12 GLACIER PACK	alcoholic brewery beverages
456,477		alcoholic brewery beverages

The second ground of opposition is that the applicant's application does not conform to the provisions of Section 30(i). The opponent alleges that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark "in view of the facts contained herein." The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the following previously filed applications:

<u>Serial No.</u>	<u>Trade-mark</u>	<u>Wares</u>
752,625		(1) alcoholic brewery beverages namely, ale, beer, lager, malt liquor, porter and

		stout (2) cooler bags
751,641		(1) alcoholic brewery beverages namely, ale, beer, lager, malt liquor, porter and stout (2) cooler bags and key chains

and with the two trade-marks noted above and the five registered trade-marks noted above previously used in Canada. The fourth ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the various trade-marks used by the opponent.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Bernard Beasley. Mr. Beasley was cross-examined on his affidavit and the transcript of that cross-examination and the subsequently filed replies to undertakings form part of the record of this proceeding. As its evidence, the applicant submitted the affidavits of Anthony von Mandl, Mary P. Noonan and Kathryn Anne Marshall. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The Opponent's Evidence

In his affidavit, Mr. Beasley identifies himself as the Director, Intellectual Property of the opponent, a position he has held with the opponent and its predecessors for over twenty years. According to Mr. Beasley, beer bearing the trade-mark GLACIER has been sold for many years by the opponent and its predecessors in title. The representative labels and packaging appended as exhibits to the Beasley affidavit generally show that the trade-mark GLACIER is only a minor and subsidiary component and that the primary and dominant trade-mark is KOKANEE. In most cases, the word GLACIER appears at the bottom of the label or package in smaller script form in such phrases as GLACIER BEER, GLACIER PILSENER and GLACIER LIGHT BEER. The labels typically include what appears to be a representation of a glacier or snow covered mountains.

One of the labels included as part of Exhibit 4 to the Beasley affidavit shows the word GLACIER in a dominant position. However, I cannot assume that there were more than minimal sales of beer bearing that particular label since Mr. Beasley did not provide a breakdown of his company's sales by individual label or trade-mark. Furthermore, it appears that the label in question was an old label. The current label which was submitted as part of Mr. Beasley's replies to undertakings does not feature the word GLACIER as a dominant element.

Exhibits 2 and 3 to Mr. Beasley's affidavit are tabular summaries of annual Canadian sales figures for KOKANEE GLACIER beer and KOKANEE GLACIER LIGHT

beer respectively. In his affidavit, Mr. Beasley states that the sales figures were provided to him by John Tilden, National Market Analyst for the opponent. On cross-examination, Mr. Beasley stated that the tabular summaries were prepared by his secretary from summary sales figures provided to her by Mr. Tilden. Mr. Beasley did not view the documents provided by Mr. Tilden and thus did not know which particular label, trade-mark or product container the summary sales figures related to (see pages 27-30 of the Beasley transcript). Mr. Beasley undertook to produce some of the original documents provided by Mr. Tilden in order to clarify this matter but subsequently indicated that the documents were no longer available (see the replies to undertakings given for questions 141, 150 and 153).

Thus, although the sales figures provided by Mr. Beasley are significant, I must give them somewhat diminished weight since he was unable to be more precise about their provenance or meaning. More importantly, given the deficiencies in Mr. Beasley's evidence, I must conclude that the sales figures provided relate primarily, if not exclusively, to product with labels bearing the word GLACIER used in a subsidiary role and position.

On cross-examination, Mr. Beasley agreed that there is a Kokanee glacier in British Columbia. However, he couldn't say if the glacier pictured on the opponent's labels is that particular glacier. Finally, Mr. Beasley indicated that he was not aware of any incidents of actual confusion between the opponent's GLACIER beer and the applicant's GLACIER BERRY product.

The Applicant's Evidence

In his affidavit, Mr. von Mandl identifies himself as the President of the applicant. In 1994, his company started selling cider in association with the primary trade-mark OKANAGAN EXTRA. Various flavors were sold including raspberry and apple. In 1995, the applicant developed a new flavor comprised of several different berries which was named GLACIER BERRY "...to suggest a fresh, cold berry flavor (see paragraph 7 of the von Mandl affidavit).

Mr. von Mandl appended labels, packaging and advertising illustrating the manner of use of the trade-mark GLACIER BERRY. On those materials, the dominant trade-mark is OKANAGAN EXTRA and the mark GLACIER BERRY appears in smaller type and in a subsidiary position. According to Mr. von Mandl, sales of GLACIER BERRY cider were in excess of 900,000 nine-liter cases for the period 1995-2000 with revenues in excess of \$18 million for the period 1997-2000. Advertising and promotional expenses for all OKANAGAN EXTRA cider products for the period 1998-2000 were greater than \$1.6 million although only an unspecified portion of that figure would have related to GLACIER BERRY.

Mr. von Mandl states that his company sells its GLACIER BERRY product to liquor boards in the majority of provinces and in the Yukon. In paragraph 18 of his affidavit, he states that he has never been made aware of any customer confusion between his company's

trade-mark GLACIER BERRY and the trade-marks of the opponent.

The Noonan affidavit introduces into evidence the results of several trade-mark searches conducted by Ms. Noonan. The first search revealed a number of trade-marks incorporating the word GLACIER registered for various beverages. However, only two of those registrations cover alcoholic beverages and both of those design marks employ the word GLACIER descriptively as a very minor component of the mark.

Ms. Noonan also searched for pairs or groups of the same trade-mark owned by different owners for different types of beverages. She located seven such groupings presumably in an attempt to distinguish different beverage wares and trades. However, in accordance with the opposition decision in Saturn Sunroof Inc. v. General Motors Corp. (1989), 25 C.P.R.(3d) 343 at 346, all that can be inferred from the selected registrations is that the Examination Section of the Trade-marks Office has apparently distinguished certain beverage types and trade. It does not necessarily follow that those wares and trades are actually different.

Finally, Ms. Noonan searched for registered trade-marks wherein the statement of wares covers both alcoholic and non-alcoholic beverages. She located about twenty such registrations. It is not apparent what purpose that evidence was intended to serve.

In her affidavit, Ms. Marshall states that she telephoned provincial liquor control

boards across Canada with a view to determining the availability of alcoholic beverages bearing the word GLACIER or GLACIAL. The information acquired by Ms. Marshall from those calls constitutes inadmissible hearsay.

Ms. Marshall personally attended at a provincial liquor store in Toronto and purchased one product and viewed five others which used the word GLACIER or GLACIAL on the label. The purchased product was GLACIAL ICE VODKA lemon liqueur. The remaining products, however, use the word GLACIER or GLACIAL descriptively as part of text on the label which is subsidiary to any trade-marks.

Ms. Marshall also conducted Internet searches with a view to locating web sites for beverage products using the word GLACIER or GLACIAL. She located 24 such sites and appended materials from the sites as exhibits to her affidavit. For the most part, these web sites are irrelevant to the issues at hand since they are for water or non-alcoholic beverages and/or they are based in the United States with no evidence of any Canadian presence or reputation. There is only one site that is identifiably Canadian and offers for sale a product called GLACIER GOLDEN LAGER beer making kit. However, there is no evidence of the extent of sales in Canada of that product.

Ms. Marshall also identifies the web site of a British Columbia bottle return site that accepts a long list of bottles including several with names that include the word GLACIER or GLACIAL. However, there is no evidence as to the nature of the associated beverages or

the volume of returns, if any, for those bottles.

Ms. Marshall also located a web site for Big Rock Brewery of Calgary, Alberta. One of the products for sale by that brewery is called **KOLD GLACIER WATER** lager. Although that product uses the word **GLACIER** descriptively, its existence in the marketplace does establish a third party use of that term in association with an alcoholic product.

Finally, Ms. Marshall located twelve applications and registrations owned by the opponent for trade-marks which cover both alcoholic and non-alcoholic beverages. As with the similar evidence presented by Ms. Noonan, it is not apparent what purpose this evidence serves in this proceeding.

Grounds of Opposition

As for the second ground, it does not raise a proper ground of opposition. The fact that the applicant's mark may have been confusing with one or more of the opponent's trade-marks as of the filing of the present application is not, by itself, sufficient to support a ground of non-conformance with the provisions of Section 30(i) of the Act. Thus, the second ground is unsuccessful.

Considering next the third ground of opposition, the opponent has failed to clearly evidence use of its registered trade-marks **GLACIER LIGHT & Design (No. 348,879), K12**

GLACIER PACK (No. 458,033) and K12 GLACIER PACK & Design (No. 456,477) and its applied for trade-marks KOKANEE KOKANEE & Design (S. N. 752,625) and KOKANEE & Design (S. N. 751,641) prior to the applicant's claimed date of first use of March 31, 1995. Thus, those aspects of the third ground are unsuccessful.

As for the registered word marks GLACIER and GLACIER LIGHT, the opponent has evidenced prior use of those two marks and non-abandonment as of the applicant's advertisement date. Thus, those aspects of the third ground remain to be decided on the issue of confusion with the applicant's mark.

In accordance with the wording of Section 16(1) of the Act, the material time for considering the circumstances is as of the applicant's claimed date of first use - i.e. - March 31, 1995. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the opponent's trade-marks GLACIER and GLACIER LIGHT suggest "coldness" or "ice" or possibly even that the opponent's beer is made with glacier water. Thus, the opponent's marks, although inherently distinctive, are not inherently strong. Mr. Beasley has been able to point to longstanding and continuous use of the two marks. However, he was unable to provide a breakdown of sales figures by

specific label or trade-mark. Furthermore, the representative labels and packaging generally show **GLACIER** or **GLACIER LIGHT** in a minor, subsidiary position. Finally, Mr. Beasley has not evidenced any advertising or promotional activities specifically related to the trade-mark **GLACIER** and **GLACIER LIGHT**. Thus, notwithstanding the significant sales, I cannot conclude that the two marks have become well known in Canada. Nevertheless, I can conclude that they have become known to some extent.

The applicant's mark **GLACIER BERRY** is inherently distinctive although it, too, is not an inherently strong mark. As stated by Mr. von Mandl, **GLACIER BERRY** was basically adopted as a new flavor for his company's **OKANAGAN EXTRA** cider "...to suggest a fresh, cold berry flavour." As with the opponent's marks, the applicant's mark **GLACIER BERRY** is typically used as a secondary trade-mark and is given a less prominent position on the product label and in product advertising. As noted by the opponent, it is used as a flavor descriptor although **GLACIER BERRY** is not an actual berry or flavor but rather a fanciful term. Thus, **GLACIER BERRY** can also function as a trade-mark. Given the fairly significant sales and advertising attested to by Mr. van Mandl, I am able to conclude that the mark **GLACIER BERRY** has become known to some extent in Canada.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of both parties are alcoholic beverages. However, the opponent's product is a brewed alcoholic beverage (i.e. - beer) whereas the applicant's

product is a fermented alcoholic beverage (i.e. - cider). As noted by Mr. Justice Rouleau in Benedictine Distillerie de la Liqueur de l'Ancienne Abbaye de Fecamp v. John Labatt Ltée (1990), 28 C.P.R.(3d) 487 at 489 (F.C.T.D.), the buying public can easily distinguish beer from an alcoholized liqueur. Likewise, I consider that consumers can easily distinguish beer from cider. As noted by Mr. von Mandl, his company markets cider as an alternative to beer. However, the trades of the parties do overlap since their respective products can both be sold through provincially regulated liquor control outlets, liquor stores, bars and licensed restaurants.

As for Section 6(5)(e) of the Act, there is a fair degree of visual and phonetic resemblance between the marks at issue since the applicant's mark GLACIER BERRY includes the entirety of the opponent's mark GLACIER. However, the word GLACIER is not an inherently strong component. Furthermore, the ideas suggested by the marks differ.

The applicant has submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the Noonan affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the

marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

As discussed, Ms. Noonan's search only revealed two relevant registrations for trade-marks which include the word GLACIER. Furthermore, the word is used descriptively in a subsidiary fashion in both of those marks. Thus, I am unable to make any meaningful inferences from the state of the register evidence in this case.

The marketplace evidence introduced by the Marshall affidavit is, for the most part, unhelpful. As discussed, the Marshall affidavit does evidence the use of a few trade-marks incorporating the word GLACIER or GLACIAL for alcoholic beverages. However, that evidence relates to a situation more than five years after the material time and is therefore irrelevant to the issue at hand.

As a further surrounding circumstance, I have considered that there has been lengthy coextensive use of the three marks at issue without any evidence of incidents of actual confusion. Both Mr. Beasley and Mr. von Mandl stated that they were unaware of any such incidents. Although the coextensive use of the three marks occurred after the material time, I consider the absence of evidence of actual confusion during that period is also reflective of the likely state of affairs as of the material time.

The opponent contended that it has a series of trade-marks thereby increasing the likelihood of

confusion with the applicant's mark. I disagree. In order to show the existence of a series of marks embodying a common characteristic, it is necessary to evidence use of those marks. In the present case, the opponent has basically shown use of its trade-mark GLACIER alone and in association with non-distinctive wording such as LIGHT, BEER and PILSENER. That, in my view, does not comprise a series of trade-marks as that concept is discussed in McDonald's Corporation v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.).

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of the marks, the difference between the wares of the parties and the absence of evidence of incidents of actual confusion during a fairly lengthy period of coextensive use, I find that the applicant has satisfied the onus on it to show that its trade-mark GLACIER BERRY for cider was not confusing with the trade-marks GLACIER and GLACIER LIGHT previously used for beer. Thus, this aspect of the third ground is also unsuccessful.

As for the final aspect of the third ground, the opponent's two trade-mark applications were filed prior to the applicant's claimed date of first use. Furthermore, they were pending as of the applicant's advertisement date. Thus, the final aspect of the third ground remains to be decided on the issue of confusion between the applicant's mark and the opponent's two previously applied for marks. I consider that my conclusions respecting the

previous aspect of the third ground are, for the most part, applicable here as well. In fact, the opponent's case is weaker respecting its two applications because there is no evidence of any reputation for those marks and they bear less resemblance to the applicant's mark than the trade-marks **GLACIER** and **GLACIER LIGHT**. Thus, I find that the applicant's trade-mark **GLACIER BERRY** for cider was not confusing as of the applicant's claimed date of first use with the opponent's previously applied for trade-marks **KOKANEE KOKANEE & Design** and **KOKANEE & Design**. The final aspect of the third ground is therefore also unsuccessful.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). I have checked the trade-marks register and determined that registration No. 289,981 for the trade-mark **GLACIER** was expunged on July 3, 1997. Thus, there is no longer a basis for that aspect of the first ground of opposition and it is therefore unsuccessful.

As for the remaining registered trade-marks, my conclusions respecting the third ground of opposition are also applicable here. Furthermore, the limited evidence of third party use of **GLACIER** or **GLACIAL** trade-marks for alcoholic beverages introduced by the Marshall affidavit is a relevant circumstance as of the later material time. Thus, for the reasons discussed previously, I find that the applicant has satisfied the onus on it to show that its trade-mark **GLACIER BERRY** for cider is not confusing with the opponent's

trade-marks **GLACIER LIGHT**, **GLACIER LIGHT & Design**, **K12 GLACIER PACK** and **K12 GLACIER PACK & Design** registered for alcoholic brewery beverages. Thus, the first ground of opposition is also unsuccessful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - February 18, 1997): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fourth ground essentially turns on the issue of confusion with the opponent's trade-marks that have been shown to have been in use - i.e. - **GLACIER** and **GLACIER LIGHT**. My conclusions respecting the third ground are, for the most part, applicable to this ground as well. Thus, I find that the applicant's trade-mark was not confusing with those two marks as of the filing of the present opposition. The fourth ground is therefore also unsuccessful.

At the oral hearing, the opponent relied on paragraph 4(e) of the statement of opposition and submitted that the applicant's trade-mark was also not distinctive because it is not a trade-mark but rather a non-distinctive product descriptor. However, paragraph

4(e) does not detail such a ground of opposition and I am therefore precluded from considering it. In any event, I consider that the applicant's trade-mark in this case can serve to function both as a product variety indicator and as a trade-mark.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition pursuant to Section 38(8) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 12th DAY OF DECEMBER, 2003.

**David J. Martin,
Member,
Trade Marks Opposition Board.**