

**IN THE MATTER OF OPPOSITIONS by  
Rothmans Benson & Hedges Inc. to  
applications Nos. 1122401 and 1122410 for the  
trade-marks PLAYER'S ORIGINAL and  
PLAYER'S CUSTOM respectively, filed by  
Player's Company Inc.**

---

[1]. On November 19, 2001, Player's Company Inc. (the Applicant) filed applications to register the trade-marks PLAYER'S ORIGINAL and PLAYER'S CUSTOM (the Marks) based upon proposed use of the Marks in Canada in association with "manufactured tobacco products" (the Wares).

[2]. The applications were advertised for opposition purposes in the Trade-marks Journal of March 19, 2003.

[3]. On August 19, 2003, Rothmans Benson & Hedges Inc. (the Opponent) filed essentially identical statements of opposition against each application. The grounds of opposition can be summarized as follows:

- a. The applications do not conform to the requirements of s. 30(e) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (the Act) in that the Applicant does not intend to use the Marks, as trade-marks, in association with the general class of wares described in the applications;
- b. The Marks are not registrable because, contrary to s. 12(1)(d) of the Act, the trade-mark applications for the Marks are confusing with various registered trade-marks; and
- c. The Marks are not distinctive of the Applicant as they do not distinguish the Wares of the Applicant from the wares of others, and in particular, the trade-mark registrations referred to above, nor are they adapted so as to distinguish them.

[4]. The Applicant filed and served a counter statement in each case in which it denied all grounds of opposition.

[5]. As its evidence in each case, the Opponent submitted an affidavit of Perry J. Lao. I will use the singular form to refer to both affidavits of Mr. Lao, which share the same structure. The Applicant filed a single set of affidavits of Edmond Ricard, Chantal Dorais, Adamo Santoianni, Timothy Owen Stevenson, Eric Weaver, Iva Morina and Gay Owens in respect of the two present oppositions as well as six oppositions to other applications involving the same Applicant and Opponent. Only the aspects of evidence relevant to the present oppositions will be discussed herein.

[6]. Each party filed a written argument in each case. Only the Applicant was represented at an oral hearing in each case.

#### Summary of the Opponent's Evidence

##### *Affidavit of Perry J. Lao*

[7]. Perry J. Lao identifies himself as a lawyer employed in the law firm representing the Opponent in the present opposition proceedings.

[8]. Mr. Lao states that he obtained various cigarette packages of the Applicant on April 14, 2004, from a convenience store located in Toronto. He attaches as Exhibits "A" to "C" to his affidavit, scanned images of the front and rear display panels featuring the design and text appearing on the "PLAYER'S Light/Légère, Extra Light/Extra Légère, or Filter/Filtre" cigarette packages of the Applicant. I am reproducing below the main features of the front display panel of the Applicant's "PLAYER'S Extra Légère" cigarette package that is being referred to in the present opposition proceedings:



[9]. Mr. Lao makes various observations regarding the indicia appearing on the said packaging. He further states that based on the Applicant's commercially available products that are included as Exhibits "A" to "C", it is reasonable to conclude that the applied for Marks would appear on packaging in a similar fashion to that of the PLAYER'S Light/Légère, Extra Light/Extra Légère, or Filter/Filtre packaging, whereby the word "PLAYER'S" would be separated from the word CUSTOM/ORIGINAL by a chevron. I am not prepared to accord any weight to this latter portion of Mr. Lao's affidavit that constitutes pure speculation on his part.

[10]. Mr. Lao further includes in his affidavit, a certified copy of the registration for the mark HARLEY DAVIDSON CUSTOM BLEND & DESIGN relied upon by the Opponent in support of one of the grounds of opposition b) mentioned above.

#### Summary of the Applicant's Evidence

##### *Affidavit of Edmond Ricard*

[11]. Edmond Ricard identifies himself as the Division Head, Marketing Futures and Development of the Marketing Division of Imperial Tobacco Canada Limited/Imperial Tobacco Canada Limitée ("ITCan"). He states that in his position, he is responsible for, among other things, maintaining trade-marks owned by ITCan and its subsidiaries (including Imperial Tobacco Company Limited ("ITCo"), John Player & Sons Ltd. ("John Player") and the Applicant) and monitoring the use of these trade-marks.

[12]. Mr. Ricard states that pursuant to a licence agreement between the Applicant and

John Player, John Player is licensed to use all of the Applicant's trade-marks in association with the manufacture and sale of tobacco products. The license also grants John Player the right to sub-license its rights to others and John Player has sub-licensed its rights to ITCan under the same terms as the license between the Applicant and John Player.

[13]. Mr. Ricard states that ITCan has manufactured, marketed and sold PLAYER'S SILVER cigarettes in Canada since at least as early as October 15, 2001.

[14]. Mr. Ricard explains the manner in which the PLAYER'S SILVER cigarettes are being sold in Canada. He further attaches to his affidavit, representative samples of packaging, order forms and invoices for same. I am reproducing below the main features of the front display panel of the PLAYER'S SILVER cigarette packages:



*Affidavit of Chantal Dorais*

[15]. Chantal Dorais identifies herself as the Consumer Relations Team Leader for ITCan. Ms. Dorais states that her department handles customer communications, including questions, compliments, comments and complaints, concerning the products manufactured by ITCan, including ITCan's PLAYER'S SILVER cigarette product.

[16]. Ms. Dorais states that communications concerning ITCan's products are most often received by telephone, via a phone number printed on the outside of packages for ITCan's products. She further states that employees within the department, including her, take these calls and enter the subject of the discussion directly in an electronic database. At the conclusion of these calls, the department asks the customer to provide details of the communication in writing via a comment form, which is mailed to the customer by the department. These forms are then

returned to the department.

[17]. Ms. Dorais states that in the majority of cases customers refer to the product in issue by its full name. Thus, if a customer is contacting the department concerning ITCan's PLAYER'S SILVER product, the customers have, in the majority of cases, referred to the product as "PLAYER'S SILVER". Ms. Dorais further states that ITCan has received over 900 communications concerning ITCan's PLAYER'S SILVER cigarettes and she attaches as Exhibit "A" to her affidavit, representative samples of communications received from Canadian consumers concerning same.

*Affidavit of Adamo Santoianni*

[18]. Adamo Santoianni identifies himself as a Sales Representative employed by ITCo. He has held his position with ITCo and its predecessors for 23 years.

[19]. He states that his role is to work with retailers in the Montreal area in the merchandising of products manufactured by ITCan, for whom ITCo distributes cigarettes. Mr. Santoianni explains that he speaks with retailers regularly and also visits them in their stores to hand over informational documents, to maintain their stock of cigarette displays, etc. He further states that he often has the opportunity to speak with or overhear customers who enter retail stores while he is visiting the retailers. He states that over the past 23 years, he has spoken to, or overheard thousands of customers discussing or purchasing their cigarettes and that in the vast majority of cases (in his estimation, about 95% of the time), these customers refer to the cigarette brand in issue using its full name. He states that this is true of ITCan's PLAYER'S SILVER cigarettes, which are referred to by such customers as "PLAYER'S SILVER".

[20]. Mr. Santoianni further continues his affidavit by stating that this is not surprising as in his experience it has been and continues to be commonplace for a given tobacco manufacturer to offer a number of brands whose names use a common first element. He states as examples without further supporting facts, PLAYER'S FILTER, PLAYER'S LIGHT SMOOTH, PLAYER'S SILVER and PLAYER'S SPECIAL BLEND; and EXPORT A EXTRA LIGHT,

EXPORT A LIGHT, EXPORT A MEDIUM, EXPORT A MEDIUM FLAVOUR and EXPORT A MILD.

[21]. While the Opponent has not objected to the admissibility as evidence of Mr. Santoianni's statements, I will discuss same later on in my decision.

*Affidavits of Iva Morina, Timothy Owen Stevenson and Eric Weaver*

[22]. Iva Morina, Timothy Owen Stevenson and Eric Weaver identify themselves as respectively paralegal, summer student and student-at-law employed by the law firm representing the Applicant in the present opposition proceedings.

[23]. Iva Morina and Timothy Owen Stevenson have each attended one or more convenience stores in November 2004 and verbally ordered a pack of PLAYER'S SILVER cigarettes. Photocopies of the PLAYER'S SILVER pack of cigarettes received as well as receipt for same are attached to each of their affidavits.

[24]. Eric Weaver viewed and printed excerpts from the web page [www.whistlergrocery.com](http://www.whistlergrocery.com) on November 23, 2004. On the same date, he purchased a single pack of PLAYER'S SILVER cigarettes from this website. These excerpts as well as a confirmation of purchase page printed following his purchase are attached to his affidavit.

*Affidavit of Gay Owens*

[25]. Gay Owens identifies herself as a trade-mark searcher with the law firm representing the Applicant in the present opposition proceedings. She has attached to her affidavit, the results of computer-assisted state of the register searches that were conducted to locate active trade-mark registrations and applications that include the words "ORIGINAL" or "CUSTOM" in relation to tobacco and tobacco products. I will discuss the results of these searches later on in my decision.

### Onus and relevant dates

[26]. The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. There is, however, an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[27]. The relevant dates for assessing the circumstances in regard to each of the grounds of opposition in the present cases are the following:

- Grounds based on s. 30 of the Act: the filing date of the applications [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- Grounds based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on non-distinctiveness of the Marks: generally accepted as being the filing date of the statements of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[28]. I will now analyze the grounds of opposition in regard to the evidence filed in the record.

### Section 30(e) grounds of opposition

[29]. The Opponent's first ground of opposition in each case is that the applications do not conform to the requirements of s. 30(e) of the Act, in that the Applicant does not intend to use the Marks, as trade-marks pursuant to s. 2 of the Act, in association with the general class of wares described in the applications. More particularly, the Opponent has pleaded that the Applicant will use the PLAYER'S CUSTOM and PLAYER'S ORIGINAL Marks in a manner

such that the public, as a matter of first impression, will not perceive the alleged marks as being used as single or unitary trade-marks. The Opponent contends that the word “PLAYER’S” and the word “CUSTOM”/”ORIGINAL” will use different lettering or sizing and the word “CUSTOM”/”ORIGINAL” will be perceived as being purely descriptive or laudatory of the Wares, such that the public will not perceive this element as forming part of the trade-mark as a whole, and will only perceive the word “PLAYER’S” as functioning as a trade-mark.

[30]. As further set forth in the Lao affidavit and the Opponent’s written argument in each case, the Opponent relies on the Applicant’s commercially available products that are included as Exhibits “A” to “C” to the Lao affidavit, to argue that the Marks would appear on packaging in a similar fashion to that of the PLAYER’S SILVER packaging and other commercially available products of the Applicant shown in Exhibits “A” to “C” (i.e. the word “PLAYER’S” would appear separate from the word “CUSTOM”/”ORIGINAL”) and that such use of PLAYER’S ORIGINAL or PLAYER’S CUSTOM Marks would therefore not constitute use as unitary trade-marks.

[31]. Conversely, the Applicant contends that at most, this evidence demonstrates the manner in which the Applicant sold its unrelated PLAYER’S SILVER brand of cigarettes in 2004 and cannot possibly be taken as evidence of what the Applicant’s intention may have been some three years earlier, as to how it would sell its PLAYER’S ORIGINAL and PLAYER’S CUSTOM brands of cigarettes. As such, the Applicant contends that it is not possible to conclude from the evidence filed in the record that the Applicant’s intention in 2001 was not to use the PLAYER’S ORIGINAL and PLAYER’S CUSTOM Marks, particularly in view of the Applicant’s unequivocal and contemporaneous statements in its applications that it would use the Marks as trade-marks. I agree.

[32]. Assuming that there would be evidence supporting the Opponent’s contentions, I further agree with the Applicant’s contention that such manner of use would qualify as use as trade-marks.

[33]. Indeed, if the Applicant were to use the Marks in the same format as its PLAYER’S



SILVER cigarette product, I believe that such manner of use would qualify as use as trade-marks since the fact that the words “PLAYER’S” and “SILVER” [“CUSTOM”/“ORIGINAL”] appear [would appear] in different fonts, sizes and colours on the front, side and top panels of the cigarette packages does not in itself prevent the words from being considered use of the word mark PLAYER’S SILVER [PLAYER’S CUSTOM/PLAYER’S ORIGINAL] as a whole. The words “PLAYER’S” and “SILVER” [“CUSTOM”/“ORIGINAL”] always appear [would always appear] in close proximity with each other. For example, the word “SILVER” appears immediately adjacent to “PLAYER’S” with no other matter on one of the side panels except for the UPC barcode.

[34]. The said use of PLAYER’S ORIGINAL and PLAYER’S CUSTOM as trade-marks on cigarette packages is further supported by the use made of PLAYER’S SILVER on the invoices and order forms attached to the Ricard affidavit. “PLAYER’S SILVER” appears in the body of the invoices and the invoices accompany the wares or are shipped to the purchasers. “PLAYER’S SILVER” appears on order forms used by retailers and wholesalers to order cigarettes from ITCo. “PLAYER’S SILVER” further appears on consumer sales receipts as evidenced by the Morina and Stevenson affidavits.

[35]. Furthermore, the samples of communications attached to the Dorais affidavit evidence that PLAYER’S SILVER cigarettes are referred to by customers as “PLAYER’S SILVER”.

[36]. I do not need to determine the admissibility of the statements made by Mr. Santoianni as I consider the above outlined evidence sufficient to conclude in the circumstances that if the Applicant were to use the applied for Marks in the same format as its PLAYER’S SILVER cigarette product, such use would qualify as use of the proposed trade-marks.

[37]. Based on the foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Applicant does not intend to use the Marks, as trade-marks, in association with the Wares. The s. 30(e) grounds of opposition are accordingly dismissed.

Section 12(1)(d) grounds of opposition

[38]. Except for the HARLEY-DAVIDSON CUSTOM BLEND & DESIGN trade-mark registration referred to above, the Opponent has not filed certified copies of the registrations for the CUSTOM CUT trade-mark (TMA426,791), THE ORIGINAL NATURAL trade-mark (TMA554,642) and CRAVEN A ORIGINAL & DESIGN trade-mark (TMA583,303) relied upon by the Opponent in support of its s. 12(1)(d) grounds of opposition. I have exercised my discretion to review the register of trade-marks and confirm the current status of these registrations. As the HARLEY DAVIDSON CUSTOM BLEND & DESIGN trade-mark registration was expunged on October 27, 2005, it can no longer form the basis of a s. 12(1)(d) ground of opposition. As the other three registrations are in good standing, the Opponent's initial burden with respect to the s. 12(1)(d) grounds of opposition has been satisfied.

[39]. Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Marks and said extant registrations.

[40]. The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[41]. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207*

*Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée and al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[42]. A detailed analysis of the s. 6(5) factors is not required in the present cases. Suffice it to say that although the wares and channels of trade of the marks at issue are the same, each of the cited marks is sufficiently different from the PLAYER'S CUSTOM or PLAYER'S ORIGINAL Marks to make confusion unlikely.

[43]. Indeed, the Opponent has acknowledged in its written argument in each case that the Marks are made up of two components, namely "*the well-known house mark PLAYER'S*" appearing at the start of the Applicant's Marks and the ordinary dictionary words "CUSTOM" or "ORIGINAL". Their only resemblance with the cited registrations, which contain other distinguishing features and for which no evidence of use or making known in Canada has been provided, is that they share one of these ordinary dictionary words. Considering the very significant differences existing between the Marks and each of the cited marks in appearance, sound and the ideas suggested by them, and the fact that both the Applicant and the Opponent have acknowledged in their written arguments that the words "CUSTOM" and "ORIGINAL" are of low inherent distinctiveness - which fact may be supported to some extent by the state of the register evidence introduced by the Owens affidavit, which demonstrates that as of the date of the search, there were over a dozen trade-mark registrations for trade-marks containing the word "ORIGINAL" for use in association with tobacco products and one more trade-mark registration for a trade-mark containing the word "CUSTOM" for use in association with tobacco products - I do not find it necessary to detail here the analysis made in regard to each of these marks. As stated in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149:

"It is axiomatic that all these factors are not of necessity to be accorded equal weight and in some instances one or more of the factors mentioned might not even be present. Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances."

[44]. In view of my conclusions above, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the marks in issue as to the source of the parties' wares. The s. 12(1)(d) grounds of opposition are accordingly dismissed.

[45]. In its written argument in both cases, the Opponent has submitted in the alternative the following:

“C.2.(j) In the alternative, if the Hearing Officer finds the subject mark not to be confusing with the registered trade-marks identified on the basis that the other components in each of the trade-marks at issue is sufficient to distinguish each mark, it is submitted that the word CUSTOM [ORIGINAL] in the subject mark is a non-distinctive and weak component which is a common English word that ought to be available to all traders in the field.”

[46]. Having regard to my comments above and the fact that the Applicant does not seek to register the words “CUSTOM” and “ORIGINAL” *per se* but rather the Marks PLAYER’S CUSTOM and PLAYER’S ORIGINAL as a whole, I do not find it necessary to comment further on these latter contentions of the Opponent.

#### Non-distinctiveness grounds of opposition

[47]. The Opponent contends that the Marks are not distinctive of the Applicant as they do not distinguish the Wares of the Applicant from the wares of others, and in particular, the trade-mark registrations referred to above, nor are they adapted so as to distinguish them.

[48]. The Opponent has not met its initial evidential burden to show that as of the filing of the oppositions, any of the registered trade-marks referred to above had become known sufficiently to negate the distinctiveness of the applied for Marks. Accordingly, the non-distinctiveness grounds of opposition are dismissed. I wish to add that if the non-distinctiveness grounds of opposition were considered to be based on the allegation that the applied-for Marks will not be used for the purpose of distinguishing the Wares from those of other traders, they

would also fail at the very least for the same reasons that the s. 30(e) grounds of opposition failed.

Disposition

[49]. Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the oppositions to the registration of the Marks pursuant to s. 38(8) of the Act.

DATED AT Montréal, Québec, THIS 15th DAY OF July 2009.

Annie Robitaille  
Member  
Trade-marks Opposition Board