IN THE MATTER OF AN OPPOSITION by Corby Distilleries Limited - Les Distilleries Corby Limitee to application No. 874,227 for the trade-mark WHISKEY CREEK filed by Alberta Distillers Limited

---

On March 31, 1998, the applicant, Alberta Distillers Limited, filed an application to register the trade-mark WHISKEY CREEK based on proposed use of the mark in Canada in association with the following wares: rye, whiskey, scotch whiskey, and corn whiskey. The right to the exclusive use of the word "whiskey" was disclaimed from the mark as a whole. The application was advertised for opposition purposes on April 7, 1999.

The opponent, Corby Distilleries Limited - Les Distilleries Corby Limitee, filed a statement of opposition on September 7, 1999. The applicant filed and served a counter statement on October 21, 1999, in which it generally denied the allegations asserted by the opponent in its statement of opposition.

As its evidence, the opponent submitted the affidavits of Jacqueline Horvat, Frederic Billon and Mike Michin. The applicant filed as its evidence the affidavits of Sheetal Bedi, Herta May and Alan Booth. Only the applicant filed a written argument. There was no oral hearing.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to s.12(1)(d) of the **Trade-Marks Act**, R.S.C. 1985, c.T-13 (hereinafter "the Act") because it is confusing with the opponent's registered mark PIKE CREEK, registered in Canada by the opponent on May 11, 1999, under Regn. No. 511,710 for distilled alcoholic beverages, namely whiskey. As its second ground, the opponent pleads that the applicant is not entitled to the registration pursuant to s.16(3)(a). In this regard, the opponent submits that at the date of filing of the applicant's application, namely March 31, 1998, the applicant's trade-mark was confusing with the opponent's trade-mark PIKE CREEK which had been previously used in Canada by the opponent in association with distilled alcoholic beverages, namely whiskey, such use not having

been abandoned as of the date of advertisement of the applicant's application, namely April 7, 1999. The opponent's third ground is that the applicant is not entitled to the registration pursuant to s.16(3)(b) of the Act. In this regard, the opponent claims that at the date of filing of the subject application, the applicant's trade-mark was confusing with the opponent's aforementioned trade-mark PIKE CREEK, which had been subject of an application filed by the opponent on October 22, 1997, under serial no. 859,411. The opponent's final ground of opposition is that, pursuant to s.38(2)(d) of the Act, the applied for mark is not distinctive.

The opponent's first ground of opposition turns on the issue of confusion between the applicant's trade-mark and the opponent's trade-mark. In assessing 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 the following specifically enumerated in s.6(5) of the Act: a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks 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. All of the factors under s.6(5) do not necessarily have equal weight and the weight to be given to each depends on the circumstances (see **Gainers Inc.** v. **Tammy Marchildon and the Registrar of Trade Marks** (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)). The Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the relevant date. In this regard, the material date with respect to the s.12(1)(d) ground of opposition is the date of my decision (see **Park Avenue Furniture Corporation** v. **Wickes/Simmons Bedding Ltd**, 37 C.P.R. (3d) 413 (F.C.A.)).

As for s.6(5)(a) of the Act, the applicant's mark is not inherently distinctive when used in

association with the applied for wares. As there is no evidence or advertising of the applicant's mark, I must therefore conclude that it has not become known in Canada.

The opponent's mark is inherently distinctive because it is not suggestive of the distilled alcoholic beverages with which it is used. With respect to the extent to which the opponent's mark has become known, Mr. Minchin, Vice-President, Marketing of Corby Distilleries Limited, stated in his affidavit that the opponent's PIKE CREEK whiskey has been sold in Canada since at least as early as January, 1998. He explains that PIKE CREEK is sold and marketed as part of a trio of whiskeys known as The Canadian Whiskey Guild. Attached as Exhibit D to his affidavit is a list of volume sales which shows that the opponent sold 1,742 9L cases of its PIKE CREEK whiskey between 1997 and 2000. Exhibit F reveals that the opponent spent approximately $212,000 in advertising its PIKE CREEK whiskey in the year 2000. The opponent also provided evidence of copies of several Canadian newspaper and magazine articles dated between January 16, 1998 and June 28, 2000, referring to the opponent's Canadian Whiskey Guild trio of whiskeys and the opponent's PIKE CREEK whiskey. From the evidence, I am able to conclude that the opponent's mark has become known to some extent in Canada.

The length of time the marks have been in use favours the opponent. The wares of the parties are essentially the same, namely whiskey. Presumably, the trades of the parties would also be the same.

As for s.6(5)(e) of the Act, although the marks must be considered as a whole, it was held in **Conde Nast Publications Inc**. v. **Unions des Editions Modernes** (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.), that the first word or first syllable in a trade-mark is the most important for the purposes of distinction. In the present case, the first word of the applicant's trade-mark (WHISKEY) is significantly different in appearance, sound and idea suggested from the first

word of the opponent's mark (PIKE). The only resemblance between the two marks is that the second component of both marks is the word "creek".

As a further surrounding circumstance, the applicant relies on the state of the register evidence in the form of the affidavit of Alan Booth, which provides the results of a search that he conducted of the Canadian Trade-marks Register in June, 2000. State of the register evidence was also provided by the opponent in the form of the affidavit of Frederic Billon, trade-mark research analyst for IntelPro Thomson & Thomson, a Division of Thomson Canada Ltd. 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.

Prior to my discussion about the state of the register evidence, I find it important to mention that I have considered the discrepancies between the search results of Mr. Booth and those of Mr. Billon. While both searchers appear to have conducted similar searches, Mr. Booth's search revealed 20 applications and 18 registrations for alcoholic beverages incorporating the word "creek" while Mr. Billon's report referred to 18 applications and 10 registrations for trade-marks containing the word "creek" for use in association with alcoholic beverages. I find that the discrepancies in their findings are mainly attributable to the fact that Mr. Billon selected 28 records out of a potential 40 potential references to include in his report while Mr. Booth provided the complete results of the search generated by his review. In any event, given the number of registrations in both affiants' evidence, I am prepared to infer that

some of those marks are in active use. Thus, consumers have been used to seeing marks including the component "creek" in the alcoholic beverage field and would be used to distinguishing such marks based on their other components.

The applicant's state of the register evidence is buttressed by Ms. Bedi and Ms. May's state of the marketplace evidence. Ms. Bedi, of the Liquor Control Board of Ontario (LCBO), listed 45 alcoholic beverage products incorporating the word "creek" that have been sold by the retail outlets of the LCBO between 1997 and 2001. The affidavit of Herta May of the British Columbia Liquor Distribution Branch (BCLDB) provides provincial sales between 1997 and 2001 for 91 alcoholic beverage products that incorporate the word "creek". This evidence combined fully supports the conclusion that such marks are in common use in the alcoholic beverage field. Such evidence underscores the fact that consumers would be able to distinguish such marks based on their other components.

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 low degree of resemblance between the marks at issue and the common adoption by other parties of the component "creek" in trade-marks for alcoholic beverages, I am satisfied that the applicant has met its burden of showing that there would be no reasonable likelihood of confusion between its mark WHISKEY CREEK and the opponent's mark PIKE CREEK, within the meaning of s.6 of the Act. Thus, the first ground of opposition is unsuccessful.

As for the second and third grounds of opposition, as discussed, the opponent has shown that as of the applicant's filing date, it had already used and filed an application in Canada for its PIKE CREEK trade-mark. Further, its PIKE CREEK application was pending as of the date of advertisement of the applicant's application (i.e. April, 7, 1999). As I am satisfied that the

opponent has met its burdens under these grounds, these grounds therefore remain to be decided on the issue of confusion between the parties' marks as of the applicant's filing date. My conclusions regarding the first ground of opposition are, for the most part, equally applicable to these grounds. Thus, I find that the two marks were not confusing as of the earlier date and the second and third grounds of opposition are also unsuccessful.

As for the opponent's 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. - Sept. 7, 1999): 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 supporting its ground of non-distinctiveness.

The fourth ground essentially turns on the issue of confusion. As before, my conclusions respecting the first ground of opposition are, for the most part, also applicable here. Thus, I find that the applicant's mark was not confusing with the opponent's mark as of the filing of the opposition and the fourth ground is therefore also unsuccessful.

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.

DATED AT GATINEAU, QUEBEC, THIS 24th DAY OF February, 2004.

C. R. Folz
Member,
Trade-Marks Opposition Board