



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

Citation: 2011 TMOB 43
Date of Decision: 2011-03-11

**IN THE MATTER OF AN OPPOSITION
by Molson Canada 2005 to application
No. 1,305,674 for the trade-mark BEER
BEER in the name of Drummond
Brewing Company Ltd.**

The File Record

[1] On June 16, 2006 Drummond Brewing Company Ltd. filed application number 1,305,674 to register the trade-mark BEER BEER (the Mark).

[2] The application was filed on the basis of proposed use and covers brewed alcoholic beverages, namely beer (the Wares).

[3] By letter dated January 2, 2007 an examiner raised some objections based on s. 12(1)(c) of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act; any subsequent reference to a section shall be a reference to the Act unless stipulated otherwise), and requested a disclaimer pursuant to s. 35 to the right of the exclusive use of the word BEER apart from the Mark. The examiner was of the opinion that BEER was the name of the Wares.

[4] The Applicant filed a revised application on April 23, 2007 which contained the disclaimer requested by the examiner.

[5] The application was advertised on June 20, 2007 in the *Trade-marks Journal* for opposition purposes. Molson Canada 2005 (the Opponent) filed a statement of opposition on October 31, 2007. The Applicant filed a counter statement on December 19, 2007 denying the allegations contained in the statement of opposition.

[6] The Opponent filed as its evidence the affidavits of Shana Poplack, Lori Ball and D. Jill Roberts while the Applicant filed the affidavit of Kevin Woods. There was no cross-examination of the deponents and no reply evidence was filed.

[7] Both parties filed written arguments and an oral hearing was held wherein only the Opponent was present.

The Grounds of Opposition

[8] The grounds of opposition raised by the Opponent are:

1. The application does not comply with the provisions of s. 30(i) in that the Applicant could not have been satisfied that it was entitled to use or register the Mark. The Applicant was fully aware that the Mark is clearly descriptive in nature and is an apt descriptor likely to be used by anyone selling beer;
2. The application does not comply with s. 30(e) in that the Applicant, by itself or through a licensee or by itself and through a licensee does not intend to use the Mark in Canada as a trade-mark but rather as a descriptive term, or not at all;
3. The Mark is not registrable in view of the provisions of s. 12(1)(b) as the Mark is clearly descriptive of the character or the quality of the Wares. The Applicant has recognized the descriptive nature of the words "BEER BEER" by disclaiming the word BEER in the application;
4. The Mark is not registrable in view of the provisions of s. 12(1)(c) as the Mark is the name of the Wares;
5. The Mark is not registrable in view of the provisions of s. 12(1)(e) as the Applicant is prohibited under s. 10 from adopting the words BEER BEER as a trade-mark in association with beer;

6. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) because at all material times, the Mark was confusing with the Opponent's prior use of the expressions "BEER BIERE" and "BIERE BEER"; and
7. The Mark is not distinctive, since it does not distinguish nor is it adapted to distinguish nor capable of distinguishing the Wares from the wares and/or services of others, including beer sold by the Opponent for the reasons set forth above. The Opponent states that the word BEER is commonly used by beer drinkers to describe a beer and accordingly, the phrase "BEER BEER" is not capable of distinguishing the Wares from those of others. The Opponent further states that the Opponent and other breweries in Canada use the expression "BEER BIERE" and/or "BIERE BEER" on labels and other packaging used in the sale of beer. As there is very little to distinguish between those expressions and the expression "BEER BEER", the Mark is not adapted to distinguish the wares from those of others.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[9] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Grounds of opposition that can be summarily dismissed

[10] The first ground of opposition as drafted is not a proper ground of opposition by itself. Section 30(i) only requires that the Applicant declares itself that it is satisfied that it is entitled to the registration of the Mark. Such statement is included in the application. The ground of opposition based on the allegation that the Mark is clearly descriptive is set forth in s. 12(1)(b). Section 30(i) can be the basis of a ground of opposition in specific

cases such as where fraud by the Applicant is alleged. [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R. (2d) 152]. This allegation is not part of the first ground of opposition. Under these circumstances, this ground of opposition is dismissed.

[11] As for the second ground of opposition the Opponent did not file any evidence to meet its initial onus. Moreover the affidavit of Mr. Woods, the Applicant's President, does include evidence of use of the Mark. Consequently, the second ground of opposition is also dismissed.

[12] I can also summarily dispose of the sixth ground of opposition for the reasons hereinafter set forth. This ground of opposition is commonly known as entitlement to the registration of the Mark. Section 16 is the basis for such ground of opposition. In summary, an applicant will not be entitled to the registration of a trade-mark if, prior to the filing date of the application, when such application is based on proposed use, the mark applied for was confusing with a previously used trade-mark or trade-name or it was confusing with a trade-mark for which an application was previously filed.

[13] In its statement of opposition the Opponent is not referring to a trade-mark or a trade-name, but rather to "an expression" to use its own terms, namely BEER-BIÈRE. Ms. Ball, the Director, Intellectual Property and Corporate Secretary for the Opponent, has filed samples of labels on which the words "beer" and "bière" appear right next to each other. In her affidavit she does explain that, in virtue of various provisions on labelling requirements (*Food and Drug Regulations, Consumer Packaging and Labelling Act, Consumer Packaging and Labelling Regulations*) the label on the products must identify the nature of the product in both official languages. It is clear then that the words "beer" and "bière" in close proximity or the expression "BEER-BIÈRE" are not used in a trade-mark or trade-name sense but simply to identify the nature of the product.

[14] Consequently the sixth ground of opposition is also dismissed.

Registrability of the Mark under s. 12(1)(b) of the Act

[15] The Opponent claims that the Mark is not registrable because it is clearly descriptive of the character or quality of the Wares. There is no doubt that the word “beer” is clearly descriptive of the character or quality of the Wares. In fact an examiner raised that issue and the Applicant had to disclaim the exclusive rights to the word “beer” apart from the trade-mark as a whole. However the trade-mark is not BEER but BEER BEER.

[16] A portion of the Opponent’s evidence and the parties’ argumentation had to do with the decision rendered in *Pizza Pizza Ltd. v. Canada (the Registrar of Trade-marks)* (1982), 67 C.P.R. (2d) 202 (FCTD). It is important at this stage, to understand the Opponent’s arguments, to summarize the facts in *Pizza Pizza*.

[17] The Registrar refused the application to register the trade-mark PIZZA PIZZA in association with pizza, lasagne, ravioli, spaghetti and submarine sandwiches; and in association with take out restaurant services. The applicant had disclaimed the right to the exclusive use of the word “pizza” apart from the trade-mark.

[18] The Registrar was of the opinion that such trade-mark was clearly descriptive or deceptively misdescriptive of those wares and services. In appeal, the applicant filed additional evidence to show the extent of the expansion of its business and the extensive use of its trade-mark in Canada. Moreover the applicant did file an affidavit of Professor Peter Allan Reich, professor of English and Linguistics at University of Toronto. Finally there was evidence of a telephone survey to show that the applicant had a distinguishable identity in the market-place. On the basis of this additional evidence that was not before the Registrar, the Court exercised its discretion and allowed the appeal.

[19] Another important factor not to be neglected is that in *Pizza Pizza* the Registrar refused the application at the filing stage under s. 37, not in the context of an opposition where the burden of proof under s. 38 is different.

[20] In order to distinguish *Pizza Pizza* the Opponent filed the affidavit of Dr. Poplack. She has been since 2001 Distinguished University Professor and holder of the Canada

Research Chair in Linguistics in the Department of linguistics at the University of Ottawa. Since 1982 she has been the Director of the Sociolinguistics Laboratory of the University of Ottawa. She holds a PhD in Linguistics from the University of Pennsylvania. She has been invited over the years to teach as a visiting scholar, at a number of other universities, in the United States and in Europe. She provides a list of awards she obtained and describes the work she did over the years including supervisions of post-graduate works, published books in the field of linguistics in general and sociolinguistics in particular. She files a copy of her *Curriculum Vitae*. On the basis of those credentials, I consider Dr. Poplack to be an expert in linguistics and sociolinguistics.

[21] She describes her mandate as follow:

“...I was asked to provide an expert opinion as a sociolinguist as to the effect of the reiteration of the word “beer” in the trade-mark BEER BEER an application for which had been filed in the Canadian Trade-marks Office. It was immediately my view that the pertinent issues in this regard are the frequency of reiteration in the English language and the effect, if any, on the interpretation of the reiterated word.”

[22] She was provided a copy of the present application, the decision of the Federal Court in *Pizza Pizza*, a copy of the affidavit of Professor Peter Allen Reich filed in those proceedings and a copy of s. 12 of the Act. It should be noted that the affidavit of Professor Reich was executed on September 10, 1981.

[23] She states that the Mark is an example of what is known in linguistics as “contrastive reduplication” (CR). It involves the copying of words and sometimes phrases. She states that “The semantic effect of the CR construction is to denote the prototypical instance of the reduplicated lexical expression”. To illustrate her point she uses the following example: “I’ll make the tuna salad, you make the salad salad”.

[24] She cites an extract of an article in a journal entitled “*Natural Language and Linguistic Theory*” wherein the authors state that CR restricts the interpretation of the copied element to a “real”, central or prototypical reading. She also quotes Laurence Horn, a world-renowned linguist according to her, wherein he characterized CR as singling out (from the set of meanings a noun may have) the meaning “that represents a

true, real, default or prototype instance”. According to her, CR rules out denotations that are less prototypical.

[25] She alleges that this is precisely the meaning attributed to this construction by Professor Reich in his 1981 affidavit in connection with the *Pizza Pizza* case. In fact Professor Reich states in his affidavit that “PIZZA PIZZA” would indicate to young children a “real pizza” as opposed to a frozen pizza”.

[26] She then explains that there has been an evolution in North American language since Professor Reich’s report in 1981. According to her, CR is now quite common in North America. There are 203 examples of naturally utterances featuring CR compiled in the *Corpus of English contrastive focus reduplications* by Ghomeshi et al. in conjunction with their article on the subject published in *Natural Language and Linguistic Theory*, 2004.

[27] She states that such research revealed that CR is used by a wide range of speakers, young and old. They are found in films and TV transcripts. CR is the subject of a number of scholarly linguistic articles. She lists four of them published since 1987. She affirms that these publications indicate that the process has been sufficiently widespread to attract the attention of linguists over the past 20 years at least.

[28] She finally comes to the following conclusions:

- CR is a linguistic construction that is part of normal and acceptable spoken and written English;
- There are a variety of CR constructions in the English language as spoken and read by adults as well as children;
- CR does have an assignable descriptive meaning, and this meaning, judging by the publication and the 203 examples she examined, is subject to rather widespread agreement in the scholarly literature as well as among the general North American and Canadian populace. It denotes the real, central, or prototypical meaning of the noun.

[29] Based on her experience as a sociolinguist and on her research, she believes that on seeing the trade-mark BEER BEER the average person would interpret the phrase to mean the “real” beer, as opposed to a less prototypical beer, such as light or non-alcoholic

(or even inferior) beer. She is of the opinion that the reiteration of the word “beer” within the Mark does not alter the underlying meaning of the reduplicated word. It intensifies and focuses the meaning of that word as describing a “real” or “prototypical” example of the product.

[30] The relevant date to assess a ground of opposition based on s. 12(1)(b) is the date of filing of the application (June 16, 2006) [see see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263, *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited*, (2004) 35 C.P.R. (4th) 541].

[31] The affidavit of Dr. Poplack was executed on July 9, 2008. However her conclusions are based on articles written in 1987, 1993, 2004 and 2007 (shortly after the relevant date). Therefore I do not see why her conclusions would be different if the affidavit was executed at the relevant date. I am satisfied that the Opponent has met its initial burden.

[32] The Applicant relies heavily in its written submissions on the case of *Pizza Pizza* that would stand for the proposition that the duplication of a single word used as a trade-mark does not have the same descriptive connotation than the single word has, if used alone. It argues that the Federal Court concluded that the trade-mark PIZZA PIZZA did not have the same meaning as the single word “pizza” and was registrable for use in association with pizza, among other wares and services.

[33] I do not think that the conclusions in *Pizza Pizza* are applicable to our case. Dr. Poplack has explained with reference to other scholars’ written opinion that the English language has evolved over the years. Professor Reich’s opinion goes back to 1981. Moreover the Court in *Pizza Pizza* had extensive evidence of use of the trade-mark PIZZA PIZZA as well as survey evidence to support the applicant’s contention that the trade-mark had become distinctive within the meaning of s. 12(2).

[34] Mr. Justice Joyal in *101482 Canada Inc. v. Registrar of Trade Marks* (1985), 7 C.P.R. (3d) 289 (F.C.T.D.), made the following comment with respect to the *Pizza Pizza* decision:

17 There is also the case of *Pizza Pizza Ltd.*, supra. In my humble opinion, this case deals only marginally with the prohibition contained in s. 12(1)(b). It is actually concerned with s. 12(2) of the Act, which reads as follows:

12. (2) A trade mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if 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.

18 It may be noted that this subsection can only create an exception to the "descriptive" rule in so far as a mark has become distinctive *at the date of filing an application*. I cannot find sufficient evidence in the record to indicate that, as in *Pizza Pizza Ltd.*, the exception created by s. 12(2) of the Act should be applied...

[35] The Applicant's evidence that might be relevant to the issue of distinctiveness of the Mark is part of Mr. Wood's affidavit. He alleges that the Applicant began selling beer in association with the Mark in August 2008. He filed invoices going back to October 2008, more than two years after the filing date of the application. He provides the sales figures as of February 2009 which total approximately \$72,000. He also filed pictures of beer cans bearing the Mark.

[36] This evidence falls short from establishing that the Mark is distinctive and thus registrable under s. 12(2). In any event such section stipulates that a clearly descriptive trade-mark could still be registered if the applicant establishes that the trade-mark has been so used in Canada as to have become distinctive at the filing date of the application (my underline).

[37] The expert opinion of Dr. Poplack has not been contradicted. She comes to the conclusion that, for an average consumer, the trade-mark BEER BEER would be clearly descriptive as the repetition of the word beer in the trade-mark means "real beer" as opposed to a less prototypical beer. The facts and the evidence in this case are far

different than those before the Court in *Pizza Pizza*. The type of proceedings was different so was the burden of proof. For these reasons I conclude that I can distinguish *Pizza Pizza* from the case at hand [see *D&S Meat Products Ltd. v. Peameal Beacon of Canada Ltd.*, February 15, 2011 TMOB (unreported), application No. 1,311,504].

[38] The Applicant argues that the Registrar has allowed since the *Pizza Pizza* case trade-marks that consist of repetition of the same word. There is no evidence of that nature in the file. Any reference to registered trade-marks in the Applicant's argument should have been filed as part of its evidence. The Registrar's discretion to verify the register does not go as far as verifying the cited trade-marks in a written argument. In any event I refer to the comments made by Mr. Justice Kelen in *Canadian Jewellers Assn. v. Worldwide Diamond Trademarks Limited* (2010), 82 C.P.R. (4th) 435 (F.C.T.D.):

80 Counsel for the applicant canvassed the jurisprudence which provides examples of trademark registrations which are descriptive. Each case turns on the evidence, and whether there was opposition. With respect, I would not have followed the line of thinking in many of these cases. I do not think it reflects the intention of Parliament in subsection 12(1)(b). Counsel for the applicant ably demonstrated to the Court that the jurisprudence goes both ways. That is the difficulty with this area of the law. Accordingly, I consider some of the jurisprudence in this particular area of trade-mark law to be inconsistent.

81 Moreover, the fact that the Registrar has allowed other registrations, which may not pass muster before me, does not entitle the applicant to a new registration. The law is the law regardless of inadvertent breaches in the past.

[39] The Applicant, in its written argument, argues that Ms. Ball and Dr. Poplack provide different examples as to what could be considered as less prototypical beer. The fact that they provide different examples for what could constitute "less prototypical beer" does not affect the descriptive nature of the expression "beer beer".

[40] The Applicant also argues that neither Ms. Ball nor Dr. Poplack were able to find examples of use of the expression "beer beer" in the normal spoken or written English. Thus the Mark would not be clearly descriptive. I do not think that the applicable test to determine if a trade-mark is clearly descriptive is the fact that the trade-mark is commonly used in the English language. Dr. Poplack has demonstrated in her affidavit that repetition of a common word is a more common construction in the English

language. It has been the subject of papers and it has a technical name namely, contrastive reduplication. As stated above, she opines that an average consumer confronted with the Mark would interpret the mark to mean “real beer” as opposed to a less prototypical beer. According to her, and there is no evidence to contradict her opinion, the repetition of the word “beer” intensifies the meaning of that word.

[41] For all these reasons I maintain the third ground of opposition.

Distinctiveness of the Mark

[42] If a trade-mark is held to be clearly descriptive of the character or quality of the wares, it cannot serve to distinguish those wares from the wares of others [see *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.)]. In those instances the only way that a clearly descriptive trade-mark can be registered is if the conditions set out in s. 12(2) of the Act on distinctiveness are met. As the relevant date under s. 12(2) is the filing date of the application, distinctiveness of the Mark must be determined as of the filing date of the application [see *Canadian Jewelers’ Assn.*].

[43] In view of my findings with respect to the ground of opposition based on s. 12(1)(b) of the Act and the fact that the Applicant has not proved that the Mark was distinctive at the filing date of the application, the ground of opposition based on lack of distinctiveness of the Mark is also maintained.

Other Grounds of Opposition

[44] Given the fact that the Opponent has already been successful under two different grounds of opposition, I do not intend to rule on the other grounds of opposition.

Disposition

[45] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse pursuant to s. 38(8) of the Act the Applicant's application for the registration of the Mark.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office