



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

Citation: 2010 TMOB 111
Date of Decision: 2010-07-16

**IN THE MATTER OF AN OPPOSITION by
BlackIce by Design Inc. to application
No. 1,212,441 for the trade-mark BLACK ICE in
the name of Molson Canada 2005**

[1] On April 6, 2004, Molson Canada filed an application to register the trade-mark BLACK ICE (the Mark) based upon use in Canada in association with wares (1) : earrings, since June 1993 and with wares (2): shirts, sweatshirts, t-shirts, jackets, bathing suits, umbrellas, caps, sports bags, cooler bags, glasses, key chains and bottle openers, since November 1993.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 17, 2004. I note that on November 14, 2005, the Registrar recorded an assignment from Molson Canada in favour of Molson Canada 2005. The current owner of the Mark, namely Molson Canada 2005, will hereinafter be referred to as the “Applicant”.

[3] On September 14, 2006, BlackIce by Design Inc. (the Opponent) filed a statement of opposition against the application.

[4] The Applicant filed and served a counter statement in which it denies the Opponent’s allegations.

[5] In support of its opposition the Opponent filed the affidavit of Diane Green, whereas the Applicant elected not to file any evidence.

[6] Both the Applicant and the Opponent filed written arguments and both parties requested and were represented at a hearing.

[7] The following are the grounds of opposition as pleaded in the statement of opposition:

2. The grounds for opposition are as follows

(b) The trademark is not registerable[*sic*];

(i) the mark had not been used in Canada since June 1993 on wares 1 and November 1993 on wares 2 as claimed in the application

(ii) in 1998, the applicant voluntarily abandoned its rights to Appl. No. 0750021 – BLACK ICE LABEL DESIGN, to which the wares in that application directly overlap this application

[8] I am of the view that paragraph 2(b)(ii) does not raise a proper ground of opposition as it contains allegations which do not form a valid basis for opposition. Furthermore, reference to application No. 750021 is irrelevant to the present proceeding. Accordingly, paragraph 2(b)(ii) is hereby disregarded.

[9] Although the appropriate sections of the *Trade-Marks Act*, R.S.C.1985, c.T-13 (the Act) have not been specifically pleaded in paragraph 2(b)(i), based on the wording I am prepared to infer that the ground is pleaded pursuant to s. 38(2)(a) and s. 30(b) of the Act. I am of the view that the Applicant has not been prejudiced by such an omission particularly in light of its written argument which is consistent with such a pleading [see *Sun Squeeze Juices Inc. v. Shenkman* (1990), 34 C.P.R. (3d) 467 (T.M.O.B.)].

[10] The material date that applies to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

[11] While the legal burden is on the Applicant to show that its application complies with s. 30 of the Act, there is 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 the 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.)].

[12] In this regard the Opponent filed the affidavit of Diane Green, an officer of the Opponent. This evidence pertains to telephone conversations between Ms. Green and various third parties including employees of the Applicant, regarding the availability of products sold under the Mark.

[13] The Applicant takes the position that the Opponent has failed to meet its burden as this evidence is inadmissible hearsay which does not meet the test of necessity and reliability. It further argues that the evidence submitted by the Opponent is irrelevant as it is largely subsequent to the filing date of the application. I agree with the Applicant on both counts.

[14] Ms. Green's statements about these telephone conversations comprise hearsay and in some cases double hearsay, which is inadmissible evidence [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.)].

[15] Ms. Green, representing the Opponent at the hearing, submitted that for the most part, the telephone conversations were with employees of the Applicant and that reporting these statements in her affidavit was necessary as these employees would probably not have been willing to provide their own sworn affidavits in an opposition proceeding against their employer. While I acknowledge that the Opponent faces some challenges when attempting to prove a negative (i.e. that the Applicant has not used the Mark in Canada), I do not find the reported statements of the third party declarants in the Green affidavit to be reliable. In some instances, their complete names are not provided. In other instances, although the positions held by these employees have been identified, there is no description as to their duties and responsibilities, making it rather difficult to assess the trustworthiness of the information provided. More importantly, there is the possibility that the individuals that spoke with Ms. Green were mistaken when answering her questions about the availability of BLACK ICE products or that they did not have complete knowledge of the facts.

[16] Statements by third parties are inherently unreliable. In this respect, I refer to *The Law of Evidence in Canada*, 2nd ed. Sopinka, Lederman, Bryant, (Toronto: Butterworths, 1999) at page 175:

(...) There is no guaranty of the veracity of the declarant and the trustworthiness of the declarant's statement. The declarant is not under oath and not subject to cross-examination and, therefore, the declarant's perception, memory and credibility cannot be tested. Thus, this evidence is unreliable and is rejected as hearsay.

[17] It follows that even though the Opponent's burden is lighter respecting the issue of non-conformance with s. 30(b) of the Act, I find the evidence adduced in this case to be unreliable and as a result the Opponent has not met its initial burden with respect to this ground of opposition [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* 1986, 10 C.P.R. (3d) 84 (T.M.O.B.); *Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. Consequently, the s. 30(b) ground is hereby dismissed.

[18] Even had I found the evidence to be reliable, most of the statements therein recount events beyond the material date and would thus be irrelevant. As for the statements within the material date, I am of the view that they do not establish clear inconsistencies with the Applicant's claimed date of first use. It follows that the Opponent would have failed to meet its initial evidentiary burden resulting in the ground being dismissed.

[19] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office