

**IN THE MATTER OF AN OPPOSITION  
by Molson Breweries, A Partnership to  
application No. 676,681 for the trade-mark  
GOLD COAST filed by Andres Wines Ltd.**

On February 27, 1991, the applicant, Andres Wines Ltd., filed an application to register the trade-mark GOLD COAST for "wine" based on proposed use in Canada. The application was advertised for opposition purposes on August 14, 1991.

The opponent, Molson Breweries, A Partnership, filed a statement of opposition on November 26, 1991, a copy of which was forwarded to the applicant on January 20, 1992. The statement of opposition states that the opponent is the owner of the following trade-mark registrations and applications for "alcoholic brewery beverages" or "brewed alcoholic beverages":

<u>Reg. No./Appl'n. No.</u>	<u>Trade-mark</u>
100,941	MOLSON'S GOLDEN ALE & Design
114,145	GOLDEN ALE & Design
161,252	MOLSON GOLDEN ALE & Design
290,098	MOLSON GOLDEN & Design
292,103	MOLSON GOLDEN
293,246	GOLDEN ALE & Design
309,841	MOLSON GOLDEN & Design
S.N. 506,627	GOLDEN

The first ground of opposition is that the application does not comply with the requirements of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use or register its trade-mark in view of the existence of the opponent's application and registrations. The second ground is that the application does not comply with the provisions of Section 30(e) of the Act because the applicant did not intend to use the applied for trade-mark. The third ground of opposition is that the applied for trade-mark is not registrable because it is confusing with the opponent's registered trade-marks noted above. The fourth ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because the applied for trade-mark is clearly descriptive or deceptively misdescriptive of the place of origin of the applicant's wares. The fifth ground of

opposition is that the applicant is not the person entitled to registration because its applied for trade-mark is confusing with the opponent's above-noted trade-marks previously used in Canada. The sixth ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of David Perkins and Eugene F. Derenyi. The applicant filed an affidavit of Robert W. Robbie. Mr. Robbie was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record of this proceeding. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the allegations of fact raised by the opponent do not support a ground of non-compliance with Section 30(i) of the Act. The mere existence of the opponent's application and registrations does not preclude the applicant from being satisfied that it is entitled to use its mark. The opponent did not even allege that the applicant was aware of the opponent's marks. Thus, the first ground of opposition is unsuccessful.

The opponent's second ground of opposition is based on the provisions of Section 30(e) of the Act. Section 30(e) reads as follows:

**30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....**

**(e) in the case of a proposed trade-mark, where the application is not accompanied by an application for registration of a person as a registered user, a statement that the applicant intends to use the trade-mark in Canada....**

The material time for assessing the applicant's compliance with Section 30(e) is the filing date of its application. The onus or legal burden is on the applicant to show its compliance with that subsection: see the opposition decisions in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and Canadian National Railway Co. v. Schwauss (1991), 35 C.P.R.(3d) 90 at 94 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent

respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(e) of the Act: see page 95 of the Schwauss decision and the opposition decision in Green Spot Co. v. J.B. Food Industries (1986), 13 C.P.R.(3d) 206 at 210-211.

The applicant's application formally complies with Section 30(e) of the Act since the required statement appears in the application. The issue then becomes whether or not the applicant has substantially complied with Section 30(e) - i.e. - is the applicant's statement that it intended to use the applied for trade-mark true?

In his affidavit, Mr. Robbie identifies himself as the Manager - Sales and Marketing Planning of the applicant and states that registered user applications were filed on October 7, 1991 in respect of the present application for companies related to the applicant, namely Andres Wines (B.C.) Ltd., Andres Wines Atlantic Ltd., Andres Wines (Alberta) Ltd. and Les Vins Andres du Quebec Ltee. Mr. Robbie states in his affidavit that use of the trade-mark commenced in May of 1991 and he appended, as Exhibit E to his affidavit, product labels used in association with the applicant's GOLD COAST wine.

The opponent submitted that the product labels appended to the Robbie affidavit do not support Mr. Robbie's contention that the applicant has used its mark or even that one of its related companies has used it. Each of those labels bears the trade-mark GOLD COAST together with the following wording appearing near the bottom of the label:

**Bottled for Gold Coast Vintners, Mildura, Victoria, Australia by  
Abbey Wines, Truro, Winona, Morris, Calgary, Port Moody, Canada.**

As submitted by the opponent, the product labels point to an entity named Gold Coast Vintners of Australia as the source of the wares. At the oral hearing, the applicant's agent submitted that Gold Coast Vintners is merely a business name of the applicant and that the labels therefore do not point to an entity other than the applicant. However, the applicant did not evidence that fact and it seems unlikely that the average consumer would assume such is the case since Gold Coast Vintners is identified on the labels as having an Australian address whereas the applicant has an Ontario address.

Thus, the evidence of record suggests that use of the applicant's mark may have been by a party other than the applicant. Furthermore, the applicant has failed to show that it has specifically licensed any other entity to use its mark. Mr. Robbie was given an opportunity on cross-examination to provide copies of any written license agreements but he failed to do so.

Since it would appear that a party other than the applicant or one of its licensees may have been using the mark GOLD COAST, the applicant's statement that it intended to use the mark appears to be false. It should have been an easy matter for the applicant to evidence otherwise but it chose not to do so. Thus, I consider that the opponent has satisfied its evidential burden and the applicant has failed to clarify the matter. The second ground of opposition is therefore successful.

As for the fourth ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

In support of its fourth ground, the opponent has alleged that Gold Coast is a well known region in southeastern Australia. However, the opponent failed to support this allegation with evidence. In fact, standard dictionaries and atlases indicate that Gold Coast is the name of a region in Africa. Thus, the fourth ground of opposition is unsuccessful.

The remaining grounds of opposition all turn on the issue of confusion between the marks of the parties although the material time for each ground is different. The opponent's strongest ground is its ground of prior entitlement based on prior use of its trade-mark

**GOLDEN.** As required by Section 16 of the Act, the opponent has satisfied the burden on it to evidence use of its trade-mark GOLDEN prior to the applicant's filing date and non-abandonment of that mark as of the applicant's advertisement date. The ground therefore remains to be decided on the issue of confusion between the mark GOLDEN and the applicant's mark GOLD COAST.

The material time for considering the circumstances respecting the issue of confusion is as of the applicant's filing date in accordance with the wording of Section 16(3) of the Act. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. 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-mark GOLDEN is clearly descriptive of brewed alcoholic beverages: see the decision in John Labatt Ltd. v. Molson Cos. Ltd. (1987), 19 C.P.R.(3d) 88 (F.C.A.). The applicant's mark GOLD COAST is inherently distinctive in relation to wine although it does have a geographic connotation referring to a region in Africa.

In his affidavit, Mr. Robbie claims that there have been sales of GOLD COAST wine in Canada totalling approximately \$1 million. However, as discussed, it would appear that those sales support use of the mark GOLD COAST by an entity other than the applicant or a licensee of the applicant. In any event, all of those sales occurred after the filing of the present application. Thus, I must conclude that the applicant's mark had not become known at all in Canada as of the material time.

The opponent, on the other hand, has evidenced long and extensive use of its trade-mark GOLDEN in combination with its house mark MOLSON or MOLSON'S for brewed alcoholic beverages. In his affidavit, Mr. Perkins attests to sales by the opponent of beer bearing labels featuring the mark GOLDEN in excess of \$1 billion for the period 1970 to 1990. Advertising expenditures for that same period were greater than \$45 million. Thus, as of the

filing of the present application, the opponent's trade-mark GOLDEN had become very well known in Canada. (The opponent also relied on a photocopy of an affidavit of Daniel G. Herlihy appended as an exhibit to the Perkins affidavit to support its contention that its mark is very well known. However, the photocopy of the Herlihy affidavit is hearsay and is therefore inadmissible.)

The length of time the marks have been in use favors the opponent. The wares and trades of the parties are similar in line with the decision in Carling Breweries Ltd. v. Registrar of Trade Marks (1972), 8 C.P.R.(2d) 247 at 251 (F.C.T.D.). At the oral hearing, the applicant's agent conceded that the wares at issue are similar and the trades are overlapping. The marks of the parties bear a fair degree of visual and phonetic resemblance, the first component of the applicant's mark being very similar to the opponent's mark. On the other hand, the ideas suggested by the marks are somewhat different.

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 Robbie 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.

In his affidavit, Mr. Robbie makes reference to a state of the register search obtained at the Trade-marks Office on the "CD Name Search System" and he appended the results of that search as Exhibit F to his affidavit. However, on cross-examination, it was revealed that Mr. Robbie didn't conduct the search and he didn't know what a state of the register search was. Thus, I cannot assume that the search report appended to his affidavit is reliable and I have not considered it.

**Mr. Robbie also appended copies of what appear to be eleven trade-mark registrations for trade-marks which include the word GOLD registered for various alcoholic products. On cross-examination, Mr. Robbie admitted that he didn't make the copies and therefore they cannot be considered as reliable evidence in this proceeding. Even if they could be considered, however, the existence of eleven third party registrations would not have advanced the applicant's case significantly. If, on the other hand, the applicant had been able to evidence a large number of such marks on the register, this could have had a significant effect on the outcome of this ground.**

**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 similarities in the wares, trades and marks of the parties and the extent to which the opponent's mark has become known, I find that the applicant has failed to satisfy the legal burden on it to show that there is no reasonable likelihood of confusion between its mark GOLD COAST and the opponent's mark GOLDEN. The ground of prior entitlement is therefore successful and the remaining grounds need not be considered.**

**In view of the above, I refuse the applicant's application.**

**DATED AT HULL, QUEBEC, THIS 18<sup>th</sup> DAY OF DECEMBER, 1995.**

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