

IN THE MATTER OF AN OPPOSITION by The Molson Companies Limited (now Molson Breweries, a Partnership) to application No. 542,665 for the trade-mark Coat of Arms Design filed by Schlossbrauerei Kaltenberg Irmgard Prinzessin Von Bayern KG

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On May 24, 1985, the applicant, Schlossbrauerei Kaltenberg Irmgard Prinzessin Von Bayern KG, filed an application to register the trade-mark Coat of Arms Design, a representation of which appears below, based upon registration of the trade-mark in the Federal Republic of Germany on March 6, 1979 under registration No. 983,052 and use of the trade-mark in the United States in association with "beer, lager, ale and porter".

At the examination stage, the applicant submitted an amended application in which it changed the registration number of the registration it had obtained in the Federal Republic of Germany from registration No. 983,052 to registration No. 1,060,774. Further, in respect of the Section 16(2) basis for registration, the applicant amended its claim from use in the United States to use of the trade-mark in the Federal Republic of Germany in association with "beer". At the request of the examiner to file an affidavit explaining the changes in the identity of the German registration being relied upon in respect of its basis for registration, the applicant submitted a document signed by one Dr. Winfried Kloepper, the trade-mark agent of the applicant located in the Federal Republic of Germany.

The opponent, The Molson Companies Limited (now Molson Breweries, a Partnership), filed a statement of opposition on September 11, 1987 in which it alleged that the applicant's application does not comply with Section 29 (now Section 30) of the Trade-marks Act in that the applicant's trade-mark was not used and registered in the Federal Republic of Germany in association with beer as alleged. Further, the opponent alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the

registration and prior user by the opponent of its registered trade-marks identified in its statement of opposition.

The applicant served and filed a counterstatement in which it, in effect, denied each of the opponent's grounds of opposition.

The opponent filed as its evidence the affidavit of Harold J. Moran while the applicant submitted the affidavits of Luitpold Prinz Von Bayern and M. Kevin Woodall.

Both parties submitted written arguments and both were represented at an oral hearing.

The opponent's first ground of opposition is based on Section 30(d) of the Trade-marks Act, the opponent asserting that the applicant has not used and registered the trade-mark in the Federal Republic of Germany in association with beer as alleged in its application. The material date in respect of a Section 30 ground is as of the filing date of the applicant's application. Further, as pointed out by the hearing officer in Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330, while the legal burden is on the applicant to show compliance with the requirements of Section 29 (now Section 30) of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of the Section 30 ground. However, an opponent may rely upon the evidence or submissions of the applicant to meet the initial evidential burden on it.

With respect to its Section 30 ground of opposition, the opponent submitted initially that the applicant did not comply with the examiner's request that it submit an affidavit explaining the reasons for its change in registration number in respect of its Section 16(2) basis for registration in that the document signed by Dr. Kloepper is neither an affidavit nor a statutory declaration. However, there are no provisions in either the Trade-marks Act or the Trade-marks Regulations which require an applicant to explain a change in a Section 16(2) basis for registration by way of affidavit. Further, neither Rules 36 nor 37 of the Regulations preclude the applicant from amending its trade-mark application in order to change the foreign registration being relied upon in support of the Section 16(2) basis for registration. Accordingly, these submissions do not support the opponent's first ground of opposition.

At the oral hearing, the opponent also argued that the applicant's application is not in compliance with Section 30(d) of the Act in that the applicant failed to comply with Section 31(1)

of the Trade-marks Act. Section 31(1) of the Act requires an applicant whose trade-mark application is based on use and registration abroad to file a certified copy of the foreign registration and a translation thereof in English or French prior to the advertisement of the application in the Trade-marks Journal. In particular, the opponent submitted that the English translation filed by the applicant identifies registration No. 1,060,774 as having been registered on March 3, 1984 (rather than March 9, 1984 as claimed in the present application) and the certified copy of the German registration appears to be dated July 15, 1985, which is subsequent to the date of the English translation thereof (July 9, 1985). Additionally, the opponent noted that the English translation does not include information appearing in the German language in the certified copy of registration No. 1,060,774. According to the opponent, the missing information might indicate that registration No. 1,060,774 had been expunged.

In response to the above, the applicant submitted that compliance with Section 31(1) of the Act is not identified as a specific ground of opposition under Section 38(2) of the Trade-marks Act and, in any event, compliance with the requirements of Section 31(1) of the Act is a matter which is solely within the jurisdiction of the examiner at the examination stage of an application and therefore would not come within the scope of a ground of opposition based on Section 30(d) of the Trade-marks Act. However, as noted in the Seagram decision referred to above, the legal burden on the applicant to show compliance with Section 30 of the Act includes "both the question as to whether or not the applicant has filed an application which on its face includes the statements required by s. 29 and the question as to whether those statements are correct". As a result, I consider that the question of substantial compliance by the applicant with Section 30(d) would also include consideration of such questions as whether the applicant has met the requirements of Section 31(1) of the Act.

In my view, the Opposition Board is precluded from considering the Section 31(1) issue in that the opponent failed to specifically plead the applicant's alleged non-compliance with Section 31(1) of the Act in respect of the Section 30 ground of opposition. While I agree with the opponent that its Section 30 ground of opposition includes those matters which ought to have been readily apparent to the applicant from the record in the present proceeding, I certainly do not consider that the issue of the accuracy of the English translation of the applicant's German registration is a matter which would or should have been readily apparent to the applicant from the record in this opposition. Further, there certainly is nothing in the opponent's evidence or its written argument which would have alerted the applicant to this issue. As a result, I reject the opponent's first ground of opposition.

The opponent's remaining grounds of opposition are based on allegations of confusion between the applicant's design trade-mark and one, or more, of the opponent's registered trade-marks identified in its statement of opposition. In determining 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 those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538.

While the opponent failed to file copies of its registrations in this opposition, the Registrar has the discretion to check the register in order to determine whether the particular registrations relied upon in the statement of opposition exist (see Quaker Oats Co. of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd., 11 C.P.R.(3d) 410, at pages 411-412). I have, therefore, reviewed the register and would confirm that the opponent's registrations are still in good standing on the register. Further, the most relevant of these registrations for the purposes of this opposition is the registered trade-mark MOLSON GOLDEN & Design, registration No. 309,841, a representation of which appears below. As a result, the determination of the issue of confusion between the applicant's trade-mark and this registration will effectively resolve all the issues of confusion asserted by the opponent in its statement of opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark Coat of Arms Design and the opponent's registered trade-mark MOLSON GOLDEN & Design are inherently distinctive when considered in their entireties. The opponent's evidence establishes that its registered trade-mark MOLSON GOLDEN & Design has become very well known in Canada in association with brewed alcoholic beverages. On the other hand, the applicant has not filed any evidence relating to use or any other activities associated with its Coat of Arms Design trade-mark in Canada. As a result, it must be assumed that the applicant's mark had not become known to any extent in Canada. Likewise, the length of time that the trade-marks at issue have been in use favours the opponent in this opposition.

The wares and channels of trade associated with the wares of the parties must be considered as being identical for the purposes of deciding the outcome of this opposition.

As for the degree of resemblance between the trade-marks of the parties when considered in their entireties as a matter of immediate impression and imperfect recollection, I consider there to be at least some similarity in appearance between the trade-marks in that both marks include a pair of heraldic lion-like representations and a representation of a crown. However, the opponent's mark is dominated by the words MOLSON GOLDEN in combination with other elements which form part of what appears to be a design of a label for a bottle of beer or other brewed alcoholic beverage. On the other hand, the applicant's mark includes a central shield portion while the representations of the crown and pair of lions are far more detailed than are the corresponding elements of the opponent's mark.

The opponent's trade-mark would be sounded as MOLSON GOLDEN while the applicant's design trade-mark does not include any words, lettering or numerals which would lend itself to being sounded. With respect to the ideas suggested by the trade-marks at issue, the applicant's trade-mark suggests a coat of arms while the opponent's trade-mark suggests a brewed alcoholic beverage which is golden in colour from an entity associated with the name Molson.

As a further surrounding circumstance, the applicant relied upon the affidavit of M. Kevin Woodall in support of its position that designs of lions on containers of beer are common to the brewed alcoholic beverage trade. As a result of his visit to a liquor store located in Vancouver, British Columbia, Mr. Woodall states in paragraph 3 of his affidavit:

3. I selected from the shelf stock, and purchased in the ordinary course of business, one bottle each of the following:

(a) Belhaven Scottish Ale, which the label states was brewed and bottled at the Belhaven Brewery Company Limited, Dunbar, Scotland;

- (b) Kronenbourg Beer, which the label states was brewed at the Brasserie Kronenbourg S.A., Strasbourg, France;
- (c) Steinlager Lager Beer, which the label states was brewed by New Zealand Breweries Limited, Auckland, New Zealand;
- (d) Kronenbrau Beer, which the label states was brewed under licence by Carling O'Keefe Breweries, Vancouver, Canada;
- (e) Coors Light Beer, which the label states was brewed under licence and supervision of Adolf Coors Company, Golden, Colorado, U.S.A. by Molson Breweries of Canada Limited;
- (f) Molson Golden Ale, which the label states was brewed by Molson Breweries of Canada Limited.

The affiant also states that he photographed each of the bottles, the photographs of which are annexed as exhibits to his affidavit.

With respect to the Woodall affidavit, the opponent submitted that two of the six labels on the bottles of beer include a single lion representation only and therefore do not bear any resemblance to the marks in issue. However, the opponent in its statement of opposition has alleged that there would be a likelihood of confusion between the applicant's trade-mark and four of its trade-mark registrations which feature a representation of a single heraldic lion. Nevertheless, I would agree with the opponent that the labels from the bottles of beer identified in the Woodall affidavit featuring a single heraldic lion are less relevant with respect to the issue of confusion than are those labels featuring a pair a heraldic lions.

The opponent also argued that Molson Golden Ale and Coors Light Beer are brewed by the opponent while Carling O'Keefe Breweries, the brewer of Kronenbrau Beer, is now owned by the opponent. However, the fact that the opponent has brewed Coors Light Beer under licence in Canada and may now be the owner of Carling O'Keefe Breweries which was brewing Kronenbrau Beer in Canada under licence do not, in my opinion, alter the perception of the average consumer that the goodwill associated with the trade-marks appearing on these wares accrues to an entity other than the brewer of the brewed alcoholic beverage. Indeed, I suspect that the average consumer would associate Coors Light Beer with Coors (U.S.) far more than they would associate the COORS trade-mark with the opponent. Likewise, the KRONENBRAU trade-mark would, in my view, be perceived as being that of Drei Kronen Brauerei rather than that of Carling O'Keefe or the opponent. Further, the fact that Coors Light Beer has established itself as the leading light beer brand in Canada (see page 8 of exhibit AR to the Moran affidavit) supports the conclusion that the average consumer would be accustomed to seeing heraldic lions as a element of a trade-mark as applied to beer and would therefore be more readily able to distinguish one such mark from another in the marketplace.

The opponent has relied upon the decision of the Opposition Board Member in Molson Cos. Ltd. v. Brasserie du Cardinal Fribourg S.A., 18 C.P.R. (3d) 224 in support of its position that the trade-marks at issue in this opposition would be confusing. In the M & Design trade-mark opposition, the hearing officer found there to be a likelihood of confusion between the applicant's M & Design trade-mark which included the representation of two heraldic lions and the opponent's registered MOLSON GOLDEN & Design trade-mark which is being relied upon by the opponent in this opposition. According to the opponent, the Board Member found the trade-marks at issue in that case to be confusing despite evidence of the state of the register which included trade-marks incorporating heraldic lions. However, I do not consider that I am bound by the M & Design trade-mark decision in that the applicant in the present opposition has adduced evidence of the state of the marketplace which is far more persuasive than is evidence relating to the state of the register. Certainly, I would be far more prepared to draw inferences concerning the common adoption of heraldic lion designs on labels of beer from such evidence as has been adduced by the applicant in this opposition than I would be prepared to draw from the existence of a few trade-mark registrations.

In view of the above, and having regard to the adoption and use by other entities of representations of one or two heraldic lions on labels of beer, and bearing in mind that the trade-marks at issue bear little similarity in appearance and no similarity in sounding or ideas suggested, I have concluded that, despite the fact that the opponent's MOLSON GOLDEN & Design trade-mark is well known, the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue. Accordingly, the applicant's Coat of Arms Design trade-mark is registrable and distinctive, and the applicant is the person entitled to its registration.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31<sup>ST</sup> DAY OF DECEMBER 1991.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.