

**IN THE MATTER OF AN OPPOSITION by
Corporacion Cuba Ron, S.A. against
application No. 1185061 for the trade-mark
CUBA & Design owned by Hela Wines &
Spirits APS**

[1] On July 17, 2003, Hela Wines & Spirits APS [the Applicant], filed an application to register the trade-mark CUBA & Design [the Mark], shown below.



[2] The application is based upon proposed use of the Mark in Canada in association with: Alcoholic beverages namely, vodka and vodka based beverages. The Applicant disclaimed the right to the exclusive use of the words VODKA, MADE IN DENMARK, www and .com apart from the Mark as a whole.

[3] The application was advertised for opposition purposes in the Trade-marks Journal of June 14, 2006. On November 14, 2006, Corporacion Cuba Ron, S.A. [the Opponent] filed a statement of opposition. The Opponent pleaded grounds of opposition under s. 38(2)(a), s. 38(2)(b), and s. 38(2)(d) of the Trade-marks Act, R.S.C. 1985, c. T-13 [the Act]. The Applicant filed and served a counter statement.

[4] In support of its opposition, the Opponent filed the affidavit of Julie Schimmens. The Applicant elected not to file any evidence. Ms. Schimmens was not cross-examined on her affidavit.

[5] Both parties filed a written argument. An oral hearing was held at which only the Applicant was represented.

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[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, 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 each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Preliminary Issue

[7] The affidavit of Julie Schimmens, Trade-mark Searcher at the Opponent's law firm, has been submitted for the sole purpose of attaching a printout of an article from the website www.cubaheadlines.com entitled "Trading Shots over famed Havana Club rum". This article details a trade-mark dispute over the HAVANA CLUB trade-mark in the U.S. between the French liquor company Pernod Ricard and Bacardi Ltd.

[8] I agree with the Applicant that this evidence is hearsay. As such, it can only be relied upon by the Opponent to establish the existence of the article, but not the truth of the statements contained therein. Even if I were able to have regard to the content of the article, I agree with the Applicant that an author's views on the HAVANA CLUB trade-mark dispute in the U.S. over rum has no probative value to the present case.

Section 30(e), Section 12(1)(e) and Section 38(2)(d) Grounds of Opposition

[9] The Opponent did not provide any evidence or written argument to support the s. 30(e), s. 12(1)(e) or s. 38(2)(d) grounds of opposition. Accordingly, each of these grounds of opposition is dismissed.

Section 12(1)(b) Ground of Opposition

[10] The Opponent has pleaded that the Mark is not registrable pursuant to s. 12(1)(b) because, **when sounded**, it is deceptively misdescriptive of the place of origin of the wares. The Opponent affirms that Cuba, being located in the Caribbean, is well known for the production of spirits. As such, the Opponent submits, the average consumer would assume when faced with the word CUBA (where CUBA is the dominant feature of the Mark) that the spirits being produced by the Applicant emanate from Cuba when in fact they do not. In this regard, the Opponent notes that the Mark also shows in very small print “made in Denmark”. I also note that the right to the exclusive use of the word “Denmark” has been disclaimed from the Mark as a whole.

[11] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the place of origin of the applied for wares must be considered from the point of view of the average purchaser of those wares. The Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety and as a matter of immediate impression [*Wool Bureau of Canada Ltd. v. Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186 (*Atlantic Promotions*)]. The material date that applies to this ground of opposition is the filing date of the application [*Shell Canada Ltd. v. P.T. Sari Incofood Corp.* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

[12] The proper test to be applied when assessing whether a trade-mark is deceptively misdescriptive of wares emanating from a particular geographical origin was stated by Justice Cattanach in *Atlantic Promotions, supra*, at 186 as follows:

... the proper test to be applied as to the determination as to whether a trade-mark in its entirety is deceptively misdescriptive must be whether the general public in Canada would be misled into the belief that the product with which the trade-mark is associated had its origin in the place of a geographic name in the trade-mark.

Mr. Cattanach went on to state that if a geographical name is attached to wares made in that geographical region, it is “clearly deceptive of the origin”. If the wares are not made there then the word is misdescriptive and may be deceptively so depending on the circumstances.

[13] A composite mark, when sounded, is not registrable pursuant to s. 12(1)(b) of the Act if it contains word elements that are clearly descriptive or deceptively misdescriptive of the place of origin of the wares and are also the dominant feature of the mark [see *Best Canadian Motor Inns Ltd. v. Best Western International, Inc.* (2004), 30 C.P.R. (4th) 481 (F.C.T.D)]. Further, one must consider whether the deceptively misdescriptive words “so dominate the applied for trade-mark as a whole such that... the trade-mark would thereby be precluded from registration” [*Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507 (F.C.T.D.)].

[14] In the present case, the word elements of the Mark include the word CUBA, the phrase MADE IN DENMARK, which appears in two different locations on the Mark, the phrase THE REVOLUTIONARY VODKA, which also appears twice, and reference to the Applicant’s website www.cubavodka.com. I find that the dominant feature of the Mark is the word CUBA as it appears in much larger and bolder font than any other word or design on the Mark, and also appears at the top of the design Mark.

[15] In view that I have concluded that CUBA is the dominant portion of the Mark when sounded, the test to be applied is whether the Canadian public would be misled by the Mark as a whole into believing that the Applicant’s vodka had its origin in Cuba. In *Gainers Inc. v. Hygrade Food Products Corp.* (1995), 63 C.P.R. (3d) 265 (T.M.O.B.) 265, former Chairman Partington ascertained whether the trade-mark WEST VIRGINIA was deceptively misdescriptive of the place of origin of ham or bacon as follows at p.269-270:

In the present case, the opponent's evidence fails to establish that the general public in Canada would be misled into the belief that the applicant's wares had their origin in West Virginia. In this regard, there is no evidence that the average consumer of ham and bacon in Canada would be aware that West Virginia is known as a source of ham or bacon or is even a source of these wares. Thus, even if the average Canadian consumer were aware of the existence of the State of West Virginia, there is no evidence suggesting they might be misled by the applicant's trade mark into the belief that the applicant's ham and bacon

have their place of origin in West Virginia. As a result, I have concluded that the applicant's trade mark WEST VIRGINIA is not deceptively misdescriptive of the place of origin of its wares. I have therefore rejected the first ground of opposition.

[16] In the present case, the only evidence filed in support of this ground was the affidavit of Ms. Schimmens, which, as noted above, has been given little weight. However, I am entitled to take judicial notice of dictionary definitions [*Envirodrive Inc. v. 836442 Canada Inc.*, 2005 ABQB 446, 140 A.C.W.S. (3d) 970], and the Canadian Oxford Dictionary defines CUBA as a Caribbean country, the largest and furthest west of the islands of the West Indies, situated at the mouth of the Gulf of Mexico. I am therefore prepared to take judicial notice in the present case that Cuba is well known to Canadians as a country in the Caribbean.

[17] The next issue to be determined is whether Cuba is known as a source for vodka. The Opponent has relied on four recent opposition decision in which four applications in the name of Bacardi & Company Limited for the trade-marks “OLD HAVANA”, “HAVANA SELECT”, “OLD HAVANA LABEL Design” and “OLD HAVANA & Design”, all for distilled alcoholic beverages, namely rum, were rejected on the basis that all four trade-marks were deceptively misdescriptive of the place of origin of the wares associated with each trade-mark. The HAVANA decisions can be distinguished from the present case, however, because in each of those decisions the applied for wares were rum, and the findings of Board Member Carriere were that Cuba was well known to Canadians as an island in the Caribbean and the Caribbean was known as a source of origin of rum. These decisions do not refer there to being any connection between rum and vodka.

[18] As a result, while I am prepared to take judicial notice that Cuba is well known to Canadians as a country in the Caribbean, there is no evidence that Cuba is a known source for vodka. Thus, even if some consumers are aware of the existence of Cuba, there is no evidence suggesting that they may erroneously assume that the Applicant's vodka was produced there. As a result, I cannot conclude that the Mark is deceptively misdescriptive of the place of origin of the applied for wares and this ground of opposition is unsuccessful.

[19] I would like to add that even if there was evidence to show that Canadians would consider the word CUBA to be misdescriptive of the place of origin of vodka, I still would not have found the Mark *as a whole* to be *deceptively misdescriptive* of the place of origin of the Applicant's vodka. In this regard, the reference to "made in Denmark" twice on the Mark contradicts any suggestion that the Applicant's vodka emanates from Cuba. Therefore, while CUBA may be the dominant feature of the Mark, I would not have found that it so dominates the Mark as a whole such that the Mark should be precluded from registration.

[20] 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.

DATED AT Gatineau, THIS 21st DAY OF December, 2009.

Cindy R. Folz
Member,
Trade-marks Opposition Board