LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 262
Date of Decision: 2011-12-29

IN THE MATTER OF AN OPPOSITION by Icelandic Water Holdings EHF to application No. 1,295,493 for the trade-mark ICELAND SPRING & Design in the name of Iceland Spring a Islandi ehf.

[1] On March 28, 2006, Iceland Spring a Islandi ehf. (the Applicant) filed an application to register the trade-mark ICELAND SPRING & Design (the Mark), which is shown below:

[2] The application is based on both proposed use of the Mark in Canada and use and registration of the Mark in Iceland for the following wares: beers; mineral and aerated waters; non-alcoholic fruit drinks and fruit juices, namely drinks made with fruit extracts or fruit syrup, carbonated fruit drinks, fruit flavoured spring water; non-carbonated water, carbonated water; drinking water.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 9, 2008.

[4] Icelandic Water Holdings EHF (the Opponent) filed a statement of opposition against the application on September 9, 2008. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] Neither party has filed evidence. Only the Applicant filed a written argument. An oral hearing was not held.

Summary of Grounds of Opposition and Applicable Material Dates

[6] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are:

1. contrary to s. 38(2)(a)/30(d) – as of the filing date of the application, the Mark was not in use in Iceland in the normal course of trade in association with each of the wares covered in the application. "The applied for trade-mark identifies the associated wares as being 'IMPORTED' and as being 'Natural Icelandic Spring Water' when the applicant itself is located in Iceland and the wares covered in the application include *inter alia* 'beer, non-alcoholic drinks and fruit juices.'";

2. contrary to s. 38(2)(a)/30(e) – as of the filing date of the application, the Applicant did not intend to use the trade-mark ICELAND SPRING & Design in Canada in association with each of the wares covered in the application. The applied for design mark includes wording which appears in unilingual English without any reference to the French equivalent of the English terminology and therefore the applied for design mark could not have been intended to be used in Canada in the manner appearing in the application;

3. contrary to s. 38(2)(a)/30(i) – as of the filing date of the application, the Applicant could not have been satisfied that it is entitled to use the Mark in Canada since the Mark includes wording which appears in unilingual English without any reference to the French equivalent of the English terminology and therefore the Applicant could not have intended to use the Mark in Canada. Moreover, the Applicant was deemed to have been aware that the Mark was, as of the filing date of the application, confusing with the Opponent's trade-mark ICELANDIC GLACIAL & Design, as is represented in application No. 1,328,461, which had been previously used in Canada by the Opponent since at least as early as February 2006 in association with "bottled water".;

4. contrary to s. 38(2)(c)/16(3)(a) - the Applicant is not the person entitled to registration of the Mark because, as of the filing date of the application, the Mark was confusing and is still confusing with the Opponent's trade-mark ICELANDIC GLACIAL & Design, as is represented in application

No. 1,328,461, which had been previously used in Canada by the Opponent since at least as early as February 2006 in association with "bottled water".;

5. contrary to s. 38(2)(d)/2 - the Mark is not distinctive in that it will not distinguish as it is not adapted to distinguish the Applicant's wares as covered in the application from the wares of others and, in particular, from the "bottled water" of the Opponent offered in Canada in association with its ICELANDIC GLACIAL & Design mark.

[7] The material dates with respect to the grounds of opposition are as follows:

- s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 16(3)(a) – the date of filing of the application;

- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

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[8] 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].

[9] The Opponent has done nothing to meet its initial burden with respect to any of the pleaded grounds of opposition.

[10] Although the pleadings refer to a trade-mark application owned by the Opponent, the Opponent has not pleaded a s. 16(2)(b) or 16(3)(b) ground of opposition and so there is no basis on which I can exercise the Registrar's discretion to check the Trade-marks Office records to confirm the existence of that application [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at 529]. Moreover, even if the Opponent's application is based on use of its mark, that would not serve to meet the Opponent's initial burden with respect to any of the pleaded grounds of opposition [see *Rooxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

[11] As the Opponent has not met its initial burden with respect to any of the pleaded grounds, each of the grounds is dismissed.

Disposition

[12] 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.

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Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office