



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

**Citation: 2016 TMOB 176**  
**Date of Decision: 2016-10-31**

**IN THE MATTER OF AN OPPOSITION**

**Anheuser-Busch LLC**

**Opponent**

**and**

**Molson Canada 2005**

**Applicant**

**1,629,556 for SUMMER TASTER**

**Application**

The Record

[1] On June 4, 2013, Molson Canada 2005 (the Applicant) applied for the Mark SUMMER TASTER in association with brewed alcoholic beverages, namely beer. The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of April 30, 2014, and an opposition was brought by Anheuser-Busch LLC (the Opponent) under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on September 30, 2014. The Opponent has raised two grounds of opposition: 1) the application does not conform to the requirements of section 30(b) of the Act because the Applicant has not used the Mark with the goods since the date claimed; and 2) the Mark does not actually distinguish and is not adapted to distinguish the Applicant's goods from the goods of others because in relation to beer, SUMMER TASTER is a phrase in the English language that clearly describes a taster pack of summer beer (i.e. beer well suited for consumption during the summer).

[2] The Applicant filed a counter statement on November 26, 2014, denying both of the allegations set out in the statement of opposition.

[3] As evidence in support of its opposition, the Opponent filed the affidavit of Nathan Haldane, articling student employed by the Opponent's agent. Mr. Haldane was not cross-examined.

[4] As evidence in support of its application, the Applicant filed certified copies of the following Canadian trade-mark registrations, all owned by the Applicant:

- WINTER TASTER, Registration No. TMA888855
- TASTER'S, Registration No. TMA785233
- TASTER'S 6 PACK, Registration No. TMA713075
- TASTERS 12 PACK, Registration No. TMA584677

[5] Both parties filed a written argument. A hearing was held at which both parties were represented.

### Onus

[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 CPR (3d) 293 (FCTD) at 298].

### Preliminary Issue

[7] The Applicant made various objections regarding the admissibility and the relevance of Mr. Haldane's evidence. As a preliminary matter, I will consider the Applicant's objection regarding the admissibility of Mr. Haldane's affidavit.

[8] Relying on the decision in *Cross-Canada Auto Body Shop Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA), the Applicant takes issue with the provenance of Mr. Haldane's affidavit, as Mr. Haldane was a student with the Opponent's agent at the time his affidavit was sworn.

[9] Mr. Haldane's evidence included photocopies of the definitions for the words "summer" and "taster" from the *Canadian Oxford Dictionary* and *the Canadian Edition of the Collins English Dictionary*, website printouts from various provincial liquor board websites, print-outs from the website for the Hockley Valley Brewing Company as well as archived pages, and blog posts, media posts and articles by third parties, with dates prior to October 2014, discussing CAMERON'S TASTER PACK, HOCKLEY TASTER PACK and ST. AMBROISE TASTER PACK.

[10] Having regard to the decision in *Canadian Jewellers Association v American Gem Society* 2010 TMOB 106, I agree with the Opponent that the concerns expressed by the FCA in *Cross-Canada Auto Body* do not apply in the present situation. It is quite apparent that the Internet searches were directed to see if anyone other than the Applicant had applied the phrase TASTER on Canadian websites. The fact that this evidence was introduced by an employee of the Opponent's agent does not make it less proper or open to suspicion than if the Opponent's agent had hired an outside investigator to do such searches and swear an affidavit.

[11] With respect to any hearsay concerns about such evidence, I also agree with the Opponent that the exhibits are evidence that as of such date, the printed pages appeared on the Internet and show that others have used the words "TASTER" or the phrase "TASTER PACK". As such evidence is not being presented to evidence the truth of the contents of these pages, but rather simply their existence, there is no hearsay issue with it.

[12] I will therefore give full weight to the Haldane affidavit.

### Grounds of Opposition

*Section 30(b)- Non-Compliance*

[13] The Opponent pleads that the application does not conform to the requirements of section 30(b) of the Act because the Applicant has not used the Mark with the applied for goods since the date claimed. Specifically, the Opponent pleads that the Applicant's statement that it has used the Mark since May 1, 2013, is not true for one or more of the following reasons:

- a) The Applicant has not displayed or associated the words "SUMMER TASTER" with the goods described in the application in a manner that would constitute "use" of the Mark under section 4 of the Act;
- b) The Applicant did not itself produce the goods described in the application and it did not control the character or quality of the goods associated with the Mark sufficiently to obtain the benefits of the deeming provision of section 50 of the Act.

[14] The issue under section 30(b) is whether the Applicant had continuously used the Mark in the normal course of trade from the alleged date of first use to the material date [see *Immuno AG v Immuno Concepts, Inc* (1996) 69 CPR (3d) 374 (TMOB); *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262 and *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323].

[15] There is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(b) of the Act, bearing in mind that the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas, supra*]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[16] The Opponent's first argument under this ground, as noted above, is that the Applicant is not using the Mark as applied for. In this regard, the Opponent points to Exhibits G and H of the Haldane affidavit which show print-outs of product listings for RICKARD'S SUMMER

TASTER and a representative picture of the packaging for RICKARD'S SUMMER TASTER PACK (both shown below).

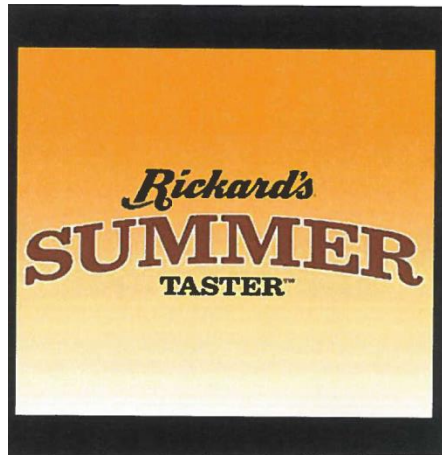


Exhibit G



Exhibit H

[17] The Opponent submits that the above examples either show use of the composite mark RICKARD'S SUMMER TASTER and Design or the separate trade-marks RICKARD'S and TASTER along with the descriptive term SUMMER which is displayed in a very different font.

[18] The Applicant, on the other hand, submits that it is trite law that use of a word mark can be supported by the use of a composite mark featuring the word mark and other design elements [*Stikeman Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 at 395]. The Applicant also submits that the case law is clear that there is nothing to prevent two trade-marks from being used at the same time [see *AW Allen Ltd v Warner-Lambert Canada Inc*, 6 CPR (3d) 270].

[19] I agree with the Applicant that the case law is clear that there is nothing to prevent two trade-marks being used at the same time. Further, the fact that the first component RICKARD'S appears in the possessive form and would likely be seen as a surname suggests that it would likely be perceived as the Applicant's house mark [see *Esselte Pendaflex Canada Inc v Cherrigold Ltd.* [(1987), 17 CPR (3d) 312 (TMOB)]. This in my view supports the argument that the commercial impression to the consumer is that the mark being used is SUMMER TASTER [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) and *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, S.A.* (1985), 4 CPR (3d) 523 (FCA)].

[20] The Opponent's second argument under this ground is that the Applicant did not itself produce the goods described in the application and it did not control the character or quality of the goods associated with the Mark sufficiently to claim the benefits of the deeming provision of section 50 of the Act. The Opponent has not, however, put forward any evidence or argument to show that the Mark being used is not being used by the Applicant. On the contrary, the Opponent acknowledges in its written argument that the Applicant owns both the RICKARD'S trade-mark (registration No. TMA728821) and the TASTER'S trade-mark (registration No. TMA785,233). Further, as pointed out by the Applicant, one of the webpages attached as Exhibit G to the Haldane affidavit which describes the SUMMER TASTER product, identifies the brewer as Molson. I therefore agree with the Applicant that the Opponent has adduced no evidence that the Mark has not been used by the Applicant as claimed.

[21] In view of the above, I reject this ground of opposition.

*Section 38(2)(d) – Non-distinctiveness*

[22] The material date with respect to distinctiveness is the date of filing the opposition [see *Andres Wines Ltd v E & J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA) at 130, and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA) at 424].

[23] The legal onus is on the Applicant to show that the Mark actually distinguishes or that it is adapted so to distinguish its goods from those of others throughout Canada [see *Muffin Houses Inc v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)]. However, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[24] In this case, the Opponent’s section 38(2)(d) ground of opposition has been pleaded as follows:

- a) The Mark is inherently lacking in distinctiveness in relation to beer because the word “Taster” clearly and accurately describes the fact that the associated package contains different kinds of beer, giving the consumer the chance to taste each; and the word “Summer” clearly and accurately describes the fact that the associated set of beers is considered well-suited for consumption during the summer months;
- b) “Taster Pack” is a phrase used by a number of different traders to convey the concept of offering a consumer the opportunity to sample different products by purchasing one package. Specifically in relation to beer, the Opponent has used the phrase “Taster Pack” in association with its beer in Canada. As well, CAMERON’S TASTER PACK, ST. AMBROISE SUMMER TASTER PACK and HOCKLEY TASTER PACK are examples of third party use of the phrase “Taster Pack” in Ontario for this purpose;
- c) The Mark has not been so used as to have become distinctive of the Applicant’s goods as described in the application.

[25] Before beginning my analysis of the evidence, I think it would be helpful at this point to set out some of the most relevant jurisprudence on this issue that was brought to my attention by the parties.

[26] First, as pointed out by the Opponent, the jurisprudence has held that it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion [see *Clarco Communications Ltd v Sassy Publishers Inc* (1994), 54 CPR (3d) 418]. In *Clarco*, Mr. Justice Denault stated the following at 428:

While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark within the meaning of s. 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others.

[27] The Opponent also refers to the following principles regarding distinctiveness taken from *Philip Morris Products SA v Imperial Tobacco Canada Limited* 2014 FC 1237 :

Whether a trade-mark is distinctive is a question of fact that is determined by reference to the message that it conveys to the ordinary consumer of the goods in question when the mark is considered in its entirety and as a matter of first impression.

The distinctiveness of a trade-mark is a fundamental principle linked to the purpose of a trade-mark which is to distinguish the owner's goods or services from those of others.

[28] Relying on the decision in *Canadian Council of Professional Engineers v APA-The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD), the Opponent further submits that even if the descriptiveness of a mark does not reach the section 12(1)(b) "clearly descriptive" threshold level, the Opposition Board has recognized that descriptiveness can still render a mark not distinctive [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB); *674802 BC Limited (Amanda Enterprises) v Encorp Pacific (Canada)*, 2011 TMOB 180].

[29] The Applicant agrees with the Opponent that whether a trade-mark is distinctive is a question of fact. The Applicant adds that in assessing whether a mark is distinctive, it must be determined whether an average consumer would perceive the mark in question as an identifier of the source of goods or services [*Shaw Communications Inc v TELUS Corporation* 2015 TMOB 173]. The Applicant also points out that, while common use of a mark by many traders may eventually cause the mark to lose distinctiveness, the amount of common use necessary to accomplish this result varies with the circumstances of each case [K. Gill and R.S. Joliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, section 10.3(c)].

[30] I will now review the evidence filed in support of this ground. I find that the Opponent's evidence regarding the descriptiveness of the Mark can be divided into two categories: 1) how



the term SUMMER TASTER is clearly descriptive and 2) how the word TASTER or the phrase TASTER PACK is commonly used in the trade.

*1) how the term SUMMER TASTER is clearly descriptive*

[31] In considering whether the Mark is not distinctive on the basis of its descriptiveness, evidence from dictionaries can be considered, as well as evidence obtained from Internet searches showing how the word or phrase at issue has been used.

[32] In the present case, as noted above, Mr. Haldane attached as Exhibit F to his affidavit photocopies he made for the words “summer” and “taster” from the *Canadian Oxford Dictionary* and the *Canadian Edition of the Collins English Dictionary*. In light of this evidence, it is clear that each of the words that form the Mark is a common word in the English language. However, as noted by the Applicant, there are multiple possible meanings of the word TASTER that are applicable in the context of beer. In particular, according to the definitions included in Exhibit F of the Haldane affidavit, the word “taster” can mean:

- A person who samples food or drink for quality
- A device used in tasting or sampling
- A sample or preview of the product

[33] As the Mark is capable of having multiple meanings, all of which are applicable in the context of beer (i.e. A person who works during the summer sampling food or drink for quality, a device used for tasting or sampling during the summer, or a sample or preview of a product released or distributed during the summer), I agree with the Applicant that the Mark cannot be said to clearly describe anything, let alone a package of different kinds of beer considered well suited for consumption during the summer months as suggested by the Opponent. I will also add that there is no evidence of what a “summer” beer means in the industry nor evidence that the Applicant’s goods consist of beer well suited for consumption during the summer.

2) how the word *TASTER* or the phrase *TASTER PACK* is commonly used in the trade

[34] The Opponent also asserts that the word “TASTER” or the phrase “TASTER PACK” is used by numerous traders to convey the concept of offering consumers the opportunity to sample different products by purchasing one package. In support of this assertion, the Opponent relies on the evidence from Internet searches included in the Haldane affidavit which show how the words TASTER or TASTER PACK have been used by others.

[35] I note that much of Mr. Haldane’s evidence from Internet searches is dated after the material date for this ground which is September 30, 2014. For example, attached as Exhibits A and B to his affidavit are product pages from various provincial liquor board websites across Canada for research he did on March 12, 2015. The Opponent submits that such evidence shows 16 product descriptors or trade-marks across Canada that included the word TASTER in association with alcoholic beverages.

[36] Relying on the decision in *Yamaha Motor Canada Ltd v Polaris Industries Inc* (2011), 99 CPR (4th) 373 (TMOB), the Opponent submits that evidence obtained from Internet searches showing how the word TASTER has been used, even if the searches were conducted after the material date, is relevant to the question of whether the Mark at issue is descriptive, and can be used to make inference about the state of affairs that would have existed at the material date for this ground (i.e. September 30, 2014). However, I note that more recently, in *Philip Morris, supra*, the Federal Court would not consider evidence of Google search results conducted after the filing date of the statement of opposition because it found that it was not possible to determine whether the searches would have provided the same results before or at the date of filing of the opposition. I therefore will not take the contents of the Internet searches conducted after the material date into account under this ground of opposition [see also *Canadian Tire Corporation, Limited v Gestion André Touchette Inc*, 2016 TMOB 157].

[37] The only evidence from the Opponent that pre-dates the material date for this ground are the archived web pages from the Hockley website showing HOCKLEY TASTER PACK attached as Exhibit C to Mr. Haldane’s affidavit and a handful of Canadian blog posts, media posts and articles by third parties dated prior to October, 2014 discussing either HOCKLEY TASTER PACK, ST. AMBROISE TASTER PACK or CAMERON’S TASTER PACK attached

to his affidavit as Exhibit D. The word “taster” or “taster pack” is used in these materials to describe a variety package of beer from the same brewer.

[38] Even if I was willing to have regard to the Opponent’s evidence that post-dates the material date for this ground of opposition, I would not have been satisfied from the Opponent’s evidence as a whole that the Opponent had met its burden under this ground. The Federal Court of Appeal states that “[d]istinctiveness is to be determined from the point of view of an everyday user of the wares in question and the trade-mark *must be considered in its entirety* and as a matter of first impression” [*Apotex Inc v Canada (Registrar of Trade-marks)*, 2010 FCA 313 para 6-7]. In this case, the Opponent’s evidence focused on one component of the Mark as opposed to the Mark in its entirety. In this regard, evidence of the appearance of about 16 third party product descriptors or trade-marks across Canada that include the component TASTER or TASTER PACK is not enough, in my view, to show that the words SUMMER TASTER, as a whole, are commonly used in the trade such that the Mark is unable to distinguish the Applicant’s goods from those of others.

[39] I therefore reject this ground of opposition.

#### Disposition

[40] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I reject the opposition according to the provisions of section 38(8) of the Act.

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Cindy R. Folz  
Board member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2016-10-03

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