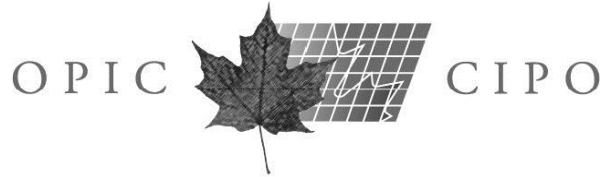


Editor's Note: Addendum released on November 12, 2013. Original judgment has been corrected with text of addendum appended.



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

Citation: 2013 TMOB 176
Date of Decision: 2013-10-15

**IN THE MATTER OF AN OPPOSITION
by Oregon Brewing Company to
application No. 1,484,257 for the trade-
mark The Rogue in the name of Flat Rock
Cellars Ltd.**

[1] Oregon Brewing Company, an Oregon corporation, brought an opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) against an application filed by Flat Rock Cellars Ltd. for the registration of the trade-mark The Rogue (the Mark) in association with wines. The application, filed on June 8, 2010, is based on proposed use of the Mark.

[2] Two grounds of opposition are premised on allegations that the application does not conform to the requirements of section 30 of the Act. The three other grounds of opposition are premised on allegations of confusion between the Mark and the trade-mark ROGUE registered and previously used or made known in Canada in association with “malted and fermented beverages, namely lagers, ales and barleywine; fermented beverages, namely, ciders”.

[3] Both parties filed evidence. Oregon Brewing Company (the Opponent) filed an affidavit of Brett Joyce, the Opponent’s President. Flat Rock Cellars Ltd. (the Applicant) filed an affidavit of Conor Cronin, a student-at-law employed by the firm acting as the Applicant’s trade-marks agent. No cross-examinations were conducted.

[4] Both parties filed written arguments and were represented at a hearing.

[5] For the reasons that follow, the application shall be refused.

Legal Onus and Evidential Burden

[6] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

The Issues

[7] The issues to be resolved in this opposition are:

1. Did the Applicant intend to use the Mark in Canada at the filing date of the application?
2. Could the Applicant have been satisfied of its entitlement to use the Mark in Canada at the filing date of the application?
3. Is the Mark registrable as of today's date?
4. Was the Applicant the person entitled to registration of the Mark as of the filing date of the application?
5. Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?

Analysis of the Issues

[8] I will analyze each of the above-identified issues in turn.

1. Did the Applicant intend to use the Mark in Canada at the filing date of the application?

[9] This issue arises from the ground of opposition alleging that the application does not conform to the requirements of section 30(e) of the Act because the Applicant did not intend to use the Mark in Canada at the time of the application.

[10] For the reasons that follow, I dismiss the section 30(e) ground of opposition.

[11] As the application contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada, it formally complied with section 30(e) of the Act on June 8, 2010. The question becomes whether or not the application substantially complied with section 30(e) of the Act, namely: Was the Applicant's statement that it intended to use the Mark true? [See *Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

[12] The Opponent did not file any evidence to establish that the Applicant falsely made the statement required by section 30(e) of the Act. Further, contrary to the Opponent's submissions, the fact that the Applicant provided no evidence of its intention to use the Mark in association with wines is not sufficient to discharge the initial evidential burden on the Opponent. An applicant does not have to evidence use of a proposed trade-mark and there is no requirement to use a proposed trade-mark until the application is approved [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC) at 335].

[13] Accordingly, the ground of opposition is dismissed for the Opponent's failure to meet its evidential burden.

2. Could the Applicant have been satisfied of its entitlement to use the Mark in Canada at the filing date of the application?

[14] This issue arises from the ground of opposition alleging that the application does not conform to the requirements of section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. The Opponent particularly alleges that such use would be unlawful because the Applicant was aware of the use and advertisement

of the Opponent's trade-mark ROGUE and would have the effect of depreciating the value of the goodwill attaching to the Opponent's registered trade-mark contrary to section 22(1) of the Act.

[15] For the reasons that follow, I dismiss the section 30(i) ground of opposition.

[16] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

[17] In addition, to my knowledge, neither the Registrar nor the Federal Court has ruled on the validity of a section 30(i) ground of opposition based on the violation of section 22 of the Act [*Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FC) at paras 38-42]. Even if I had found this to be a valid ground of opposition, the Opponent failed to file any evidence supporting a likelihood of depreciation of goodwill of its registered trade-mark contrary to section 22 of the Act [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC)].

3. Is the Mark registrable as of today's date?

[18] This issue arises from the ground of opposition alleging that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-mark ROGUE of registration No. TMA534,517 for "malted and fermented beverages, namely lagers, ales and barleywine; fermented beverages, namely ciders".

[19] For the reasons that follow, I accept the section 12(1)(d) ground of opposition.

[20] I have exercised the Registrar's discretion to confirm that the Opponent's registration No. TMA534,517 is extant as of today's date, as the material date for this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[21] Since registration No. TMA534,517 is extant, the Opponent has met its evidential burden. Thus the question becomes whether the Applicant has met its legal onus to show that the Mark is not reasonably likely to cause confusion with the Opponent's registered trade-mark ROGUE.

[22] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR. (4th) 321 (SCC); *Veuve Clicquot Ponsardin, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[24] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between the marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; it chose to begin its confusion analysis by considering that factor. Therefore, I turn to the assessment of the section 6(5) factors in the case before me by starting with the degree of resemblance between the trade-marks.

Section 6(5)(e): the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[25] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts; rather, the trade-marks must be considered in their entirety.

[26] I disagree with the Applicant's contention that there are minimal similarities between the parties' marks in appearance and sound. Rather, I agree with the Opponent that the article "the" in the Mark is not particularly striking and its distinctive element is the term "rogue", which is obviously identical to the trade-mark ROGUE.

[27] In terms of the ideas suggested by the marks, it should first be noted that there is no debate that "rogue" is an ordinary word of the English language. In fact, each party references dictionary definitions for this word in its written argument. Although these definitions have not been introduced into evidence, I may refer myself to dictionaries [see *Insurance Co of Prince Edward Island v Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)]. The following definitions for the word "rogue" in the *Canadian Oxford Dictionary* (2 ed.) are essentially those referenced by the parties: "a dishonest or unprincipled person" or "a mischievous person, esp. a child".

[28] The Applicant does not dispute that the idea suggested by the Mark is that of the dictionary word "rogue". Rather, the Applicant disputes that it is also the idea suggested by the Opponent's mark.

[29] More particularly, the Applicant points out that the record shows that the Opponent is a United States corporation organized under the laws of Oregon, with its principal place of business in Newport, Oregon; therefore, the Applicant contends that the idea suggested by the mark ROGUE is that of a geographic area in the Opponent's home state. In support of its contention, the Applicant relies on Exhibits "D", "E" and "F" to the Cronin affidavit purportedly showing that the Rogue Valley, through which flows the Rogue River, is a region within the Rogue Valley American Viticulture Area (Rogue Valley AVA) in Southern Oregon. The exhibits consist of Wikipedia articles printed from the Internet.

[30] In my view, the Applicant's contention is a red herring. Even if I were to afford any evidentiary value to the Wikipedia articles, to attribute a geographical reference to the Opponent's trade-mark is stretching the point altogether too far. The Applicant did not convince me that an average Canadian consumer would react to the Opponent's mark by thinking of anything else than a rogue, as previously defined. Thus, the marks suggest the same idea.

[31] Accordingly, the section 6(5)(e) factor significantly favours the Opponent.

Section 6(5)(a): the inherent distinctiveness of the trade-marks and the extent to which they have become known

[32] The Applicant submits that the Opponent's mark is not inherently distinctive because of its geographical significance. As I understand the Applicant's submissions, it contends that the Opponent's mark references a geographic area in the state of Oregon, but not that it describes the place of origin of the Opponent's wares. The Applicant submits that the Mark has a higher level of inherent distinctiveness because there is no geographic significance attaching to it.

[33] I find it somewhat difficult to reconcile the Applicant's contention that there is a geographic significance attaching to the Opponent's mark with its contention that this significance does not attach to the Mark for use in association with wines. After all, the Applicant relies on Exhibit "E" to the Cronin affidavit as evidence that the Rogue Valley AVA is a wine region in which at least 20 vineyards are located.

[34] In any case, I am not prepared to find that the Mark possesses a higher level of inherent distinctiveness than the Opponent's mark, as argued by the Applicant. Further, given the evidence of record, it is apparent that the most significant part of the section 6(5)(a) factor is the extent to which the trade-marks have become known in Canada.

[35] Since the Applicant did not provide any evidence of use or promotion of the Mark in Canada, it must be concluded that it has not become known to any extent. In other words, the Mark does not benefit from acquired distinctiveness.

[36] By contrast, the Opponent provided evidence of use and promotion of its trade-mark ROGUE in Canada in association with different types of beer, including lagers, ales and barleywine, since at least as early as May 1995, and in association with spirits since at least as early as July 2006. In that regard, Mr. Joyce's testimony may be summarized as follows:

- the Opponent, a brewer of craft beers and spirits, sells different types of beers and spirits under the trade-mark ROGUE;

- the ROGUE beers are sold in the provinces of Alberta, British Columbia, Manitoba, Nova Scotia, Ontario, Quebec and Saskatchewan;
- the ROGUE spirits are sold in the provinces of British Columbia and Saskatchewan;
- the Opponent's total sales figures of ROGUE beers in Canada for the years 1999 to 2011 were over \$1.8 million. According to the yearly breakdown of the sales figures provided in the affidavit, the Opponent's sales figures for the years 2008 to 2010 totaled over \$1.5 million; the sales figures for the years 2006 and 2007 combined totaled over \$120,000. There is no breakdown of the sales figures for the years 1999 to 2005 and 2011;
- on average, the annual advertising expenditures in Canada are approximately US\$11,200. These include approximately US\$4,200 spent by the Opponent and US\$4,200 spent by the Opponent's distributors. I note that the affiant states that these are for advertising and promoting "the goods" sold under the Opponent's mark;
- since 2006, the Opponent has participated in beer and spirits related festivals and events held in Canada. These include the "Mondial de la Bière" festival, held in Montreal, where the Opponent won awards for some of its ROGUE beers in 2011, 2009 and 2008; and
- the Opponent and its trade-mark ROGUE have been featured in Canadian newspapers, American newspapers discussing Canadian beer events, press releases, and trade publications.

[37] Insofar as documentary evidence is concerned, Mr. Joyce filed 41 exhibits to his affidavit, some of which are rather voluminous. Suffice it to say that the documentary evidence includes:

- a list of the different ROGUE beers and spirits sold in Canada by the Opponent along with photographs of ROGUE beers and spirits labeled bottles;
- lists of retail outlets in Alberta, British Columbia, Manitoba, Nova Scotia, Ontario, Quebec and Saskatchewan where ROGUE beers had been sold or were sold when Mr. Joyce swore his affidavit on October 26, 2011;

- examples of order forms, invoices, planning correspondence and shipping documents for different years;
- documents relating to the Opponent's participation at Canadian festivals and events for the years 2006 to 2011; and
- articles about the Opponent and the ROGUE beers published in newspapers and magazines, including articles referencing awards won by the Opponent at the "Mondial de la Bière" festival.

[38] The Applicant submits that no weight should be afforded to the evidence introduced by the Opponent as to the use of its trade-mark ROGUE in association with "spirits". Specifically, the Applicant submits that there is no reference to "spirits" in the statement of opposition nor are these wares referenced in the Opponent's registration. The Opponent does not dispute that its trade-mark is not registered for "spirits". Still, it contends that the evidence is relevant, especially when considering the nature of the trade.

[39] I will return to the parties' submissions about the relevancy of the evidence of use of the trade-mark ROGUE in association with "spirits" later on in my decision under the consideration of the section 6(5)(c) and (d) factors. Insofar as the section 6(5)(a) factor is concerned, it is unnecessary to address the Applicant's submissions as I find that the Opponent's evidence is insufficient to conclude that the trade-mark ROGUE has become known to any extent in Canada in association with spirits. Indeed, in my view the Joyce affidavit establishes, at best, only minimal commercial use of the trade-mark ROGUE in Canada in association with spirits, in particular rum, gin and whiskey.

[40] That being said, I disagree with the Applicant's contention that the Opponent's evidence does not give rise to a claim of "any level of acquired distinctiveness". Indeed, based on a fair reading of the Joyce affidavit in its entirety, I am satisfied that there is sufficient evidence to conclude that the trade-mark ROGUE in association with beers has become known to a significant extent in Canada.

[41] In the end, I conclude that the overall consideration of the section 6(5)(a) factor favours the Opponent.

Section 6(5)(b): the length of time each trade-mark has been in use

[42] The Applicant acknowledges that this factor favours the Opponent. However, it submits that the Opponent's sales of beers prior to 2008 "were very minimal" and that they were "modest" in the years 2008 to 2010.

[43] The issue under consideration is the period of time the trade-mark ROGUE has been used in Canada. The Opponent's evidence lends support to a finding of continuous use of the trade-mark ROGUE in Canada in association with "malted and fermented beverages, namely lagers, ales and barleywine" since the date of first use claimed in registration No. TMA534,517, namely "at least as early as May 1995".

[44] Accordingly, the section 6(5)(b) factor significantly favours the Opponent.

Section 6(5)(c): the nature of the wares, services or business; and

Section 6(5)(d): nature of the trade

[45] In assessing these factors, I first revert to the parties' submissions about the relevancy of the Opponent's evidence concerning "spirits", although these submissions do not require a lengthy discussion. Suffice it to say that it is the statement of wares in the application for the Mark and the statement of wares in the Opponent's registration that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[46] Bearing this in mind, I will start my analysis of these factors with the following general comments.

[47] Firstly, since the mark ROGUE is registered for "malted and fermented beverages, namely lagers, ales and barleywine; fermented beverages, namely ciders", I will not discuss further the parties' submissions as to similarity or dissimilarity between "spirits" and "wines".

[48] Secondly, I will not discuss the wares "fermented beverages, namely ciders" listed in the Opponent's registration. Besides the fact that the Opponent's submissions focused on its mark

ROGUE for beers, I consider that comparing the mark registered for “malted and fermented beverages, namely lagers, ales and barleywine” and the Mark for “wines” is determinant in the assessment of the section 6(5)(c) and (d) factors. In other words, this case does not turn on comparing the Mark for “wines” and the mark ROGUE registered for “fermented beverages, namely ciders”.

[49] Finally, both parties cited several decisions in support of their respective cases under the section 6(5)(c) and (d) factors. Although I have reviewed all of these decisions, it is trite law that each case must be decided based upon its own merit. Accordingly, I will not discuss or reference the decisions cited by the parties, except for *Carling Breweries Ltd v Registrar of Trade-marks* (1972), 8 CPR (2d) 247 (FCTD) (*Carling Breweries*). The decision *Carling Breweries* involved an appeal from the Registrar’s decision refusing an application for the registration of the trade-mark WHITE CAP for alcoholic brewery beverages, namely beer ale, lager, porter and stout, on the ground of confusion with two registered trade-marks for the words WHITE CAP, one covering wines and the other covering rum. The appeal was dismissed by the Court. Interestingly, each party cited the decision *Carling Breweries* in support of its case.

[50] This last comment leads me to turn to the parties’ submissions. As both parties devoted a significant part of their written and oral arguments to the section 6(5)(c) and (d) factors, I will summarize these submissions to the extent possible.

[51] The Opponent submits that:

- both parties operate in the alcoholic beverage industry;
- beer has previously been held to be in the same general class of wares as wines; these products are all products of one industry;
- the sales of alcoholic beverages is highly regulated in Canada; each province has an agency responsible for regulating the consumption and sale of alcoholic beverages; the parties’ wares fall under the same provincial regulations; and
- sales of wines under the Mark would be primarily through private and government-owned retail liquor stores; these are the Opponent’s channels of trade.

[52] The Applicant submits that:

- the Opponent operates a brewery while the Applicant operates a winery; the Opponent did not introduce evidence of a manufacturer of brewed alcoholic beverages that also manufactures wines;
- a careful reading of the following comment of Justice Gibson in *Carling Breweries*, at page 251, reveals that Justice Gibson actually holds that beer and wine are not of the same general class: “In any event, in this case, s. 6(2) is relevant, if on some basis (but not in my opinion) beer, wines and spirits might be considered to be of the same general class of wares.” (My underlining);
- the great majority of private and government controlled retail liquor outlets throughout Canada stock wine in areas in a store separate from beer and other brewed alcoholic beverages;
- the fact that products may be sold in the same retail outlets is not conclusive of the issue of confusion; and
- Exhibit “A” to the Cronin affidavit shows that similar or identical marks for use in association with different types of alcoholic beverages have been allowed to coexist on the register. I note that the exhibit consists of copies of one application and thirteen registrations obtained from the Canadian trade-marks database.

[53] I find it useful to conclude on the Applicant’s submissions by reproducing below an excerpt of its written argument, at page 17. Although lengthy, it seemingly explains the Applicant’s general argument that the Opponent has placed an undue emphasis on whether “beer” and “wine” are in the same industry as opposed to whether or not there is a likelihood of confusion between the marks under section 6 of the Act.

The Board should not fixate on whether the goods are of the same general class (they are not, as per Justice Gibson) or in the same industry (yes, broadly speaking that are both alcoholic beverages) or whether they are ever sold in the same types of stores (yes, retail liquor stores). All of this information is simply to be used to determine if there is a likelihood of confusion. Would an average consumer, who has some level of knowledge of the Opponent’s ROGUE beer, see a wine marketed as The Rogue in Canada, and make the inference that the wares are associated? If (*sic*) our view, the clear answer is no – and in support of this position we point to the differences in the ideas suggested by the marks [...], the

differences in the associated goods (beer vs. wine), the fact that the Opponent has not led any evidence about any brewers in Canada that also manufacture wine, and the fact that the Registrar has previously allowed a distinction among wine, spirits and beer in permitting the registration of similar word marks as applied to products in such different categories of alcoholic beverages. To hold that there is a likelihood of confusion is to ignore the commercial reality that consumers of alcoholic beverages recognize that beer and wine typically come from different sources and different manufacturers.

[54] As previously discussed, I disagree with the Applicant's contention that there are differences between the ideas suggested by the marks. Furthermore, as with all criteria under section 6(5) of the Act, the nature of the wares and the nature of the trade must be examined and given due weight.

[55] For the reasons that follow, in the circumstances of this case, the Applicant did not convince me that the section 6(5)(c) and (d) factors are not significant.

[56] For one thing, the likelihood of confusion between the marks at issue does not turn on whether or not "beer" and "wine" are part of the same general class of wares. On that point, it should be noted that section 6(2) of the Act states that a trade-mark may be confusing with another trade-mark "whether or not the wares or services are of the same general class"; this has been acknowledged by the Applicant. In addition, section 6(2) of the Act makes it clear that wares do not have to be sold side by side.

[57] Further, I agree with the Opponent that the following reasoning of Justice Gibson in *Carling Breweries*, at page 251, is applicable to the case before me:

As to the nature of the trade (s. 6(5)(d)), the only evidence adduced was of "off premises" sales. There was no evidence of the nature of the trade in "on premises" sales. In my view, however, the overriding factor is that beer, wines and spirits, are all products of one industry, and as a result, it is probable that the public would be more likely to confuse the source of origin of any of these products. In any event, on the evidence, any differentiation proved among these products is slight. [My underlining]

[58] Finally, I disagree with the Applicant's submissions that Exhibit "A" to the Cronin affidavit should be afforded weight in the assessment of the likelihood of confusion between the parties' trade-marks. On that point, the Applicant rightly submits that Justice Gibson in *Carling*

Breweries acknowledged that the Registrar permitted separate registrations of similar word marks as applied to products in different categories of alcoholic beverages. Still, Justice Gibson did not give any weight to this evidence. I reproduce the comments of Justice Gibson, at page 252, about the evidence of separate registrations of similar word marks for alcoholic beverages.

As to this, there may appear to be some inconsistency on the part of the Registrar in permitting heretofore the separate registration of word marks as applied to different classes of alcoholic beverages, some of which are set out [in Schedule I to the reasons for judgment], and refusing the appellant's application in this case. Perhaps there is. It is impossible, however, to say without the facts and decisions in each of these cases, especially as all in sch. I are different word marks, and different from the subject word mark. It may also be that in the interests of the purity of the Register and in the public interest, applications for registration such as the appellant's which seek registration of word marks which resemble the type of registered word marks set out in sch. I, are no longer approved. In any event, in this case it is not possible to give any weight to this "surrounding circumstance", if such it is, in the determination of the issue on this appeal. [My underlining]

[59] With due respect for the Applicant, I am not prepared to afford weight to Exhibit "A" to the Cronin affidavit simply because the Applicant does "not think it is appropriate for the Board (or the Courts) to distinguish prior cases examples merely on the basis of the fact they involve different marks from the marks at consideration before them in the present case – this will almost always be the case" [page 10 of its written argument].

[60] In the end, I conclude that the overall assessment of the section 6(5)(c) and (d) factors significantly favours the Opponent when considering the registered wares "malted and fermented beverages, namely lagers, ales and barleywine".

Additional surrounding circumstance

[61] The Applicant submits that the coexistence in the United States and in Australia of the Opponent's mark ROGUE with third party trade-marks ROGUE for wines is an additional surrounding circumstance that supports a finding of no likelihood of confusion. On that point, the Applicant submits at pages 17-18 of its written argument:

[...] we also note, as a relevant surrounding circumstance, that the trade-mark ROGUE is used by various traders for wine in both Oregon and Australia (see

affidavit of Conor Cronin, paragraph 4). The Opponent's beers are distributed in all fifty states of the U.S. (including Oregon, its home state) and Australia (see affidavit of Brett Joyce, paragraph 5). The Opponent therefore already co-exists in the marketplace (in the U.S. and Australia) with various traders using the trade-mark ROGUE in association with wine, and the Opponent has introduced no evidence suggesting that there has been actual confusion or that they have taken enforcement action against these traders.

[62] Paragraph 4 of the Cronin affidavit reads as follow:

I also had the occasions to research the use of the trademark "ROGUE" as a wine in both the state of Oregon and Australia. ROGUE is used for wine in both Oregon and Australia. Attached as Exhibit "C" are copies of Oregon and Australian vineyards' websites which employ the trademark ROGUE in their sales of wines. Cote du Rogue is a vineyard in Oregon. Troon Vineyard is a vineyard in Oregon and makes wines named Spirit of the Rogue River. Rogue Wines is a vineyard in New Zealand that sells wine in Australia.

[63] I am not affording any significance to the Applicant's evidence. For one thing, Mr. Cronin's statements about third party use of the mark ROGUE for wines consist of opinion evidence of the type that ought to be excluded from consideration pursuant to *Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* (2005) 43 CPR (4th) 21 (FC); aff'd 53 CPR (4th) 286 (FCA). At issue in that case was opinion evidence provided by an employee of counsel. Furthermore, the extracts of the websites are not proof of their content; these websites cannot be given any weight [see *ITV Technologies Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 (FC)].

[64] I wish to stress that I am not making any findings as to the relevancy of the state of the marketplace in a foreign country when assessing the likelihood of confusion in Canada.

Conclusion on the likelihood of confusion

[65] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In view of my assessment of each of the section 6(5) factors, I conclude that the Applicant has not discharged its legal onus to establish that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark ROGUE in association with the registered wares "malted and fermented beverages, namely lagers, ales and barleywine".

[66] Accordingly, the section 12(1)(d) ground of opposition is successful.

4. Was the Applicant the person entitled to registration of the Mark as of the filing date of the application?

[67] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act. More particularly, the Opponent alleges that the Mark, at the filing date of the application, was confusing with its trade-mark ROGUE previously used or made known in Canada in association “malted and fermented beverages, namely lagers, ales and barleywine; fermented beverages, namely ciders”.

[68] As a preliminary matter, I note that the Applicant here also submits that no weight should be afforded to the evidence concerning the use of the Opponent’s trade-mark ROGUE in association with “spirits” as these wares are not referenced in the pleadings. I agree. The non-entitlement ground of opposition, as pleaded, clearly does not allege prior use or making known of the Opponent’s mark ROGUE in association with “spirits”. Further, there is no reference to “spirits” in the statement of opposition.

[69] In the decision *Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC), the Federal Court has directed that an opposition is to be assessed in view of the grounds of opposition as pleaded. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded. I would add that nothing would have prevented the Opponent from requesting leave to amend its statement of opposition to rely upon the prior use of its mark ROGUE in Canada association with spirits.

[70] That being said, I am satisfied that the Opponent met its evidential burden of showing that its trade-mark ROGUE has been used in Canada before June 8, 2010 in association with “fermented beverages, namely lagers, ales and barleywine” and had not been abandoned at the date of advertisement of the application for the Mark, namely December 1, 2010 [section 16(5) of the Act]. Thus, the question becomes whether the Applicant has met its legal onus to show

that the Mark, as of June 8, 2010, was not reasonably likely to cause confusion with the Opponent's trade-mark ROGUE.

[71] In my view, assessing each of the section 6(5) factors as of June 8, 2010 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case. Thus, for reasons similar to those expressed under the section 12(1)(d) ground of opposition, I conclude that the Applicant has not discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the trade-mark ROGUE for "malted and fermented beverages, namely lagers, ales and barleywine" as of June 8, 2010.

[72] Accordingly, the non-entitlement ground of opposition is successful to the extent that it is based upon an allegation of confusion between the Mark and the trade-mark ROGUE previously used in Canada by the Opponent in association with "malted and fermented beverages, namely lagers, ales and barleywine".

5. Was the Mark distinctive of the Applicant's wares as of the filing date of the statement of opposition?

[73] This issue arises from the ground of opposition alleging that the Mark is not distinctive under section 2 of the Act. The material date for considering this issue is April 28, 2011, that is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[74] Here also, the pleaded ground of opposition revolves around the likelihood of confusion between the Mark and the Opponent's mark ROGUE in association with "malted and fermented beverages, namely lagers, ales and barleywine; fermented beverages, namely ciders".

[75] As per my previous review of the Joyce affidavit, I am satisfied that the Opponent has met its evidential burden to show that its trade-mark ROGUE, as of April 28, 2011, had a substantial, significant or sufficient reputation in Canada in association with "malted and fermented beverages, namely lagers, ales and barleywine" so as to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII), (2006), 48 CPR (4th) 427 (FC)].

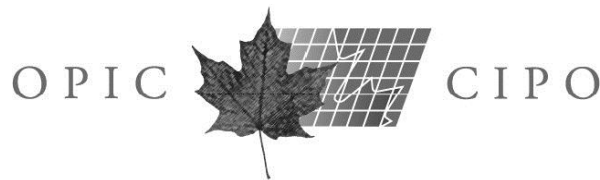
[76] Since the assessment of each of the section 6(5) factors as of April 28, 2011 does not impact my previous analysis of the surrounding circumstances of this case, I conclude that the Applicant has not discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the mark ROGUE in association with “malted and fermented beverages, namely lagers, ales and barleywine” as of April 28, 2011.

[77] Accordingly, the non-distinctiveness ground of opposition is successful.

Disposition

[78] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office



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

Citation: 2013 TMOB 194
Date of Decision: 2013-11-12

IN THE MATTER OF AN OPPOSITION
by Oregon Brewing Company to
application No. 1,484,257 for the trade-
mark The Rogue in the name of Flat Rock
Cellars Ltd.

AMENDED DECISION

[79] It has been brought to my attention that clerical errors were inadvertently made in paragraphs 36, 42 and 76 of my decision dated October 15, 2013. Accordingly, I hereby amend these paragraphs.

[80] The 5th bullet of paragraph 36 of my decision dated October 15, 2013 is amended to read:

- on average, the annual advertising expenditures in Canada are approximately US\$11,200. These include approximately US\$4,200 spent by the Opponent and US\$4,200 spent by the Opponent's distributors. I note that the affiant states that these are for advertising and promoting "the goods" sold under the Opponent's mark;

[81] Paragraph 42 of my decision dated October 15, 2013 is amended to read:

[42] The Applicant acknowledges that this factor favours the Opponent. However, it submits that the Opponent's sales of beers prior to 2008 "were very minimal" and that they were "modest" in the years 2008 to 2010.

[82] Paragraph 76 of my decision dated October 15, 2013 is amended to read:

[76] Since the assessment of each of the section 6(5) factors as of April 28, 2011 does not impact my previous analysis of the surrounding circumstances of this case, I conclude that the Applicant has not discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the mark ROGUE in association with "malted and fermented beverages, namely lagers, ales and barleywine" as of April 28, 2011.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office